BL O/1206/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3751791

BY BEZZA HOLDINGS LIMITED

TO REGISTER THE TRADE MARK:

IN CLASSES 9, 11 AND 37

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 434119

BY NOVELTIS

BACKGROUND AND PLEADINGS

1. On 7 February 2022, Bezza Holdings Limited ("the applicant") applied to register the trade mark shown on the cover page of this decision ("the contested mark") in the UK. The application was published for opposition purposes on 1 April 2022, and registration is sought for goods and services in Classes 9, 11 and 37.[1]

2. On 10 June 2022, NOVELTIS ("the opponent") filed a notice of opposition. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 ("the Act") and is directed against all the goods and services contained in the application.

3. The opponent relies upon the following comparable United Kingdom Trade Mark ("UKTM"): [2]

UKTM 801430186

The earlier mark was filed on 25 June 2018 and became registered on 27 March 2019, in respect of goods and services in Classes 9 and 42. For the purpose of these proceedings, the opponent relies upon all its goods and services.[3]

4. Given the respective filing dates, the opponent's mark is an earlier mark, in accordance with section 6 of the Act. However, as it had not been registered for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified within section 6A of the Act. As a consequence, the opponent

[1] See goods and services comparison.
[2] On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM. As a result of the opponent's EUTM number 1430186 being registered 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 the original EUTM filing dates remain.
[3] See goods and services comparison.

may rely upon all of the goods and services for which the earlier mark is registered without having to establish genuine use.

5. The opponent claims that the marks are highly similar and that the goods and services covered by the marks are either identical or similar, resulting in a likelihood of confusion.

6. The applicant filed a defence and counterstatement denying the grounds of opposition.

7. The applicant is represented by Dummett Copp LLP and the opponent is represented by IP Lab Limited. Neither party requested a hearing nor filed written submissions in lieu of a hearing. Only the applicant filed evidence. This decision is taken following a careful review of the papers.

PRELIMINARY ISSUES

8. The applicant has raised a point in its submissions that I intend to address as a preliminary issue. Before going any further into the merits of this opposition it is necessary to explain why, as a matter of law, this point will have no bearing on the outcome of this decision.

- Previous UK Intellectual Property Office ("UKIPO") examination decision under Section 3(1)(b) and (c) of the Trade Marks Act (absolute grounds)

9. In its submissions the applicant highlighted a past refusal of the word only mark SOLARHOME by the UKIPO,[4] and on this basis, argues that the words ought to be considered non-distinctive. In addition, it is noted that as evidence the applicant has provided copies of the corresponding exam report and follow up correspondence.[5]

[4] Trade mark application UK00003751785 – 'SOLARHOME'

[5] See witness statement of Lewis Jones (Chartered Trade Mark Attorney at Dummett Copp LLP), dated 14 April 2023, and supporting exhibits LAJ1-LAJ2.

However, I am not bound by previous examination decisions and will form my own view of the dominant and distinctive elements of the marks.

RELEVANCE OF EU LAW

10. 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. This is why this decision continues to make reference to the trade mark case law of EU courts.

DECISION

Section 5(2)(b)

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

> "A trade mark shall not be registered if because–
>
> (a)…
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

12. Section 5A of the Act is as follows:

> "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."

13. 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:

The principles

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

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

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

d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

Comparison of goods and services

14. 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 comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*. where the CJEU stated at paragraph 23 of its judgment:

"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. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited ("Treat")* [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

17. In *Kurt Hesse v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-50/15 P, the CJEU stated that complementarity is capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court ("GC") stated that "complementary" means:

"82 … there is a close connection between [the goods], in the sense that one is indispensable or important for the use of the other in such a way that

customers may think that the responsibility for those goods lies with the same undertaking…".

18. In *Gérard Meric v Office for Harmonisation in the Internal Market ('Meric')*, 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 fur 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".

19. For the purposes of considering the issue of similarity of goods or services, 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), Mr Geoffrey Hobbs QC, sitting as the Appointed Person, and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

20. The competing goods and services are as follows:

Opponent's goods and services	**Applicant's goods and services**
Class 9 Diagnostic software in the field of renewable energy; diagnostic apparatus other than for medical use; diagnostic apparatus not for medical use; electronic sensors for measuring solar radiation; precision measuring apparatus; radiation measuring apparatus; electric measuring apparatus; radiation measuring instruments; measuring apparatus and instruments; measuring and testing machines and instruments; sensors (measurement apparatus) other than for medical use; automatic solar tracking	Class 9 Photovoltaic apparatus and installations for generating electricity; Photovoltaic cells; parts and fittings for the aforesaid goods. Class 11 Apparatus and installations for heating; Heat pumps; Solar energy powered heating installations and apparatus; Solar powered water heating apparatus and installations; solar heating panels; geothermal energy-powered heating apparatus; geothermal energy-powered heating installations; parts and fittings for the aforesaid goods.

sensors; photovoltaic apparatus for converting solar radiation to electrical energy; software that assists computers in deploying parallel applications and performing parallel computations; application software; downloadable computer software applications; downloadable applications for mobile devices; software applications for use on mobile devices; database and application integration software; two or three-dimensional simulation software for the design and the development of industrial products; computer programs for user interface design; computer software for project management; computer programs for project management; computer software and applications for the simulation and calculation of the solar potential of a roof. Class 42 Design of diagnostic apparatus; design of diagnostic apparatus and equipment; design and development of diagnostic apparatus; development of diagnostic apparatus; computer-aided diagnostic testing services; scientific and industrial research in the field of photovoltaics and solar collectors; design and development of software for control, regulation and monitoring of solar energy systems; technical development of structural elements, devices and systems for solar collectors and photovoltaic plants; technical consultancy in connection with energy-saving measures; studies and research in the scientific and technological fields provided by engineers; development of software application solutions; design and development of computer hardware and software for industrial applications; software design; design of computer firmware; design of data processing apparatus; design of data processing software; design of data processing programs; design of diagnostic apparatus and equipment; design of data processing systems; computer system	Class 37 Installation, maintenance and repair of solar-powered heating installations, Solar powered water heating apparatus and installations, geothermal-powered hot water systems, solar heating panels, photovoltaic electrical systems, heat pumps, heating installations.

design; design and development of software; design and development of computer systems; design and development of photovoltaic systems; research and design services; design and development of energy management software; design and development of software for evaluation and calculation of data; design and development of computer hardware and software intended for use in the field of solar energy; conducting of technical project studies for construction projects; technical project studies; preparation of reports relating to technical project studies for construction projects; technical project studies in the field of construction; conducting technical project studies and research related to the use of natural energy; provision of information regarding studies, technical projects and research on the use of natural energy; providing temporary use of on-line non-downloadable software for creating quotations and for converting quotations into bills.	

21. With regard to the similarity of the goods and services at issue, in its written submissions the opponent states the following:

> "[Class 09 Goods] The goods for which protection is sought, namely "Photovoltaic apparatus and installations for generating electricity; Photovoltaic cells; parts and fittings for the aforesaid goods" all relate to photovoltaic devices for generating electricity. They are highly similar to "photovoltaic apparatus for converting solar radiation to electrical energy" protected by the Earlier Right, due to the fact that these goods have the same function, namely converting light and solar radiation into electricity, they have the same distribution channels and have the same end consumers.

[Class 11 Goods] The goods “Apparatus and installations for heating; Heat pumps; Solar energy powered heating installations and apparatus; Solar powered water heating apparatus and installations; solar heating panels; geothermal energy-powered heating apparatus; geothermal energy-powered heating installation; parts and fittings for the aforesaid goods” in the Application are similar to the goods “photovoltaic apparatus for converting solar radiation to electrical energy” protected by the Opponent’s Earlier Right. The heating devices for which protection is sought all require solar energy, or at least renewable energy, in order to operate. There is therefore a close relation between the goods of class 11 and the ones of class 09 since they depend on the class 09 goods to operate, they have the same distribution channels, they are offered and set up by the same fitters and they can be manufactured by the same producers. There is therefore similarity between the contested goods of class 11 and the prior right’s goods of class 09.

[Class 37 Services] The contested services “Installation, maintenance and repair of solar-powered heating installations, Solar powered water heating apparatus and installations, geothermal-powered hot water systems, solar are similar to the services “scientific and industrial research in the field of photovoltaics and solar collectors; technical development of structural elements, devices and systems for solar collectors and photovoltaic plants; design and development of photovoltaic systems; conducting technical project studies and research related to the use of natural energy” protected by the Earlier Right. Without the research and the development of products relating to the power generation and the use of natural energy, there will be no installation for devices and systems that rely on renewable energy and the services mentioned in class 37 of the Application would be groundless. Furthermore, the above-mentioned services are also similar in relation to their origin and/or their distribution channels. The companies providing the contested services are often the same as the ones creating the devices relying on the renewable energy in order to operate. This complementary interplay between services in classes 37 and 42 is illustrated in the EUIPO’s decision of 09/04/2014, T-144/12, Comsa, EU:T:2014:197, § 65-67.

The comparison of the goods/services shows that the products and services covered by the Application are the same or confusingly similar to the ones protected by the Earlier Right."

22. In its written submissions the applicant states the following:

"We deny each of the general sweeping arguments made by the Opponent in respect of the goods and services. We submit the following specific arguments.

[Class 11] The Applicant submits that the Opponent has presented both flawed analysis and then over-generalised and broad statements based on that analysis. We would first simply submit that these goods are very clearly dissimilar. The Opponent's submission that all the products would require solar or renewable energy in order to operate is already self-evidently incorrect given the broad nature of some of the terms applied for (e.g. Apparatus and installations for heating).

Further, the Applicant denies that the assertion that solar energy being a potential input energy source means that the goods would be considered similar. The Opponent would appear to be arguing that generators of energy (or products that generate energy) should all be considered linked to, and similar to, products that use energy. This is very clearly nonsensical and would provide an incredibly and incorrectly broad level of protection to the earlier right. We would highlight that it is very clearly not the case that, for instance, batteries (equivalent to photovoltaic cells) would be considered similar to all products that batteries power.

We would also submit that the Opponent has provided no evidence that the goods under comparison would have the same distribution channels, have the same fitters, etc. Further, the fact that products can be manufactured by the

same producers is utterly irrelevant. It is very clearly possible for a manufacturer to offer completely unrelated products.

[Class 37] We submit that the analysis presented here is highly flawed and again attributes an incorrectly broad coverage to the earlier right. Again, we would highlight the nonsensical nature of this argument by substituting in 'batteries' - the argument here would be that research and development of batteries is then similar to any service which installs battery-powered products. In short, the services are too many steps removed from one another to be considered similar. We would also highlight that whilst producers of products may possibly conduct research and development (we make no judgement on this either way), there is no evidence presented that similar research and development would be carried out by installers of the products. Further, installers of products are very often different to the producers of the products.

The Opponent has not presented a copy of the EUIPO decision referred to, and so this reference should be disregarded. The decision also appears to only be available in Spanish and French on the EUIPO website, furthering the case for the disregarding of this reference unless the Opponent can provide a copy of the decision in English for review by the Applicant and the UKIPO."

Class 9 of the contested application

Photovoltaic apparatus and installations for generating electricity; parts and fittings for the aforesaid goods

23. *Photovoltaics* is a method of generating electrical power using solar panels composed of *photovoltaic* solar cells which convert energy from the sun. With the exception of *parts and fittings for all the aforesaid goods,* I find that the opponent's *photovoltaic apparatus for converting solar radiation to electrical energy,* falls within the scope of the contested goods, rendering the respective goods identical under the *Meric* principle. With regards to the contested *parts and fittings for all the aforesaid goods,* I will proceed on the basis that these goods are similar to at least a medium

degree to the opponent's *photovoltaic apparatus for converting solar radiation to electrical energy,* given their overlap in trade channels, user, methods of use, purpose and that they are complementary to each other.

Photovoltaic cells; parts and fittings for the aforesaid goods.

24. With the exception of *parts and fittings for all the aforesaid goods,* I find that the above contested goods are included in the broader term *photovoltaic apparatus for converting solar radiation to electrical energy* contained in the opponent's goods and therefore are considered identical in line with the principle set out in *Meric.* With regards to the contested *parts and fittings for all the aforesaid goods,* I will proceed on the basis that these goods are similar to at least a medium degree to the opponent's *photovoltaic apparatus for converting solar radiation to electrical energy,* given their overlap in trade channels, user, methods of use, purpose and that they are complementary to each other.

Class 11 of the contested application

Apparatus and installations for heating; Heat pumps; Solar energy powered heating installations and apparatus; Solar powered water heating apparatus and installations; solar heating panels; parts and fittings for the aforesaid goods

25. Solar heating apparatus and installations use sunlight to heat water or air in buildings. With the exception of *parts and fittings for all the aforesaid goods,* the above contested goods are either types of solar powered heating apparatus and instruments, or in the case of the broad term *apparatus and installations for heating*, could reasonably include solar powered heating apparatus and instruments. As such, I consider these goods share a degree of similarity with the opponent's *photovoltaic apparatus for converting solar radiation to electrical energy* in Class 9, on the basis that they are likely to be an essential component in the contested goods. Furthermore, it is likely that producers of *photovoltaic apparatus for converting solar radiation to electrical energy* may also be responsible for the production of the contested goods. As such, I find that there is likely to be an overlap in trade channels and user.

Furthermore, there is a complementarity between the goods. Overall, I find the goods at issue to be similar to at least a low degree. With regards to the contested *parts and fittings for all the aforesaid goods,* I will proceed on the basis that these goods are similar to a low degree to the opponent's *photovoltaic apparatus for converting solar radiation to electrical energy,* given that the goods may overlap in trade channels and user.

Geothermal energy-powered heating apparatus; geothermal energy-powered heating installations; parts and fittings for the aforesaid goods

26. Generally speaking, geothermal energy heat sources are derived from heat in the ground, as opposed to photovoltaic energy heat sources which are derived directly from the sun. Therefore, although geothermal and photovoltaic energy heat sources are both environmentally friendly renewable energy sources, there are clearly differences between them. The above contested goods relate to geothermal energy heat apparatus and installations, along with their parts and fittings. The primary function of the contested goods is to capture heat energy from within the earth and convert it into electrical power generation in order to provide a heat source. It is noted that the opponent's goods in Class 9 do not appear to include any goods directly relating to geothermal energy-powered heating apparatus or instruments.

27. Accordingly, I do not find any obvious similarity between the contested goods and the opponent's goods other than the fact that they all relate to renewable energy sources, albeit different types of renewable energy as previously discussed. However, I consider this too superficial for a finding of similarity between the goods. Furthermore, the opponent has not provided any persuasive submissions in relation to the comparison between the competing goods, other than they all need renewable energy in order to function, and therefore on this basis, will have the same distribution channels and producers, etc. Whilst it is acknowledged that the respective goods all relate to renewable energy sources, I am of the view that these goods will satisfy different consumer needs and will ordinarily originate from different providers. Furthermore, the respective goods are neither in competition nor are they complementary. Accordingly, I find that the contested Class 11 goods listed above are

dissimilar to all the opponent's Class 9 goods. The same conclusion applies to the opponent's services in Classes 42, on the basis that they share no direct similarities with the above contested goods.

Class 37 of the contested application

Installation, maintenance and repair of solar-powered heating installations, solar powered water heating apparatus and installations, solar heating panels, photovoltaic electrical systems, heat pumps, heating installations

28. The applicant is providing a service involving the installation, maintenance and repair of solar-powered heating installations, solar powered water heating apparatus and installations, solar heating panels, photovoltaic electrical systems and heating installations. These services are likely to be provided by the manufacturer of such apparatus and installations, or by specialised companies within the renewable energy field. Furthermore, the opponent's *photovoltaic apparatus for converting solar radiation to electrical energy,* may well be an essential component in such installations and apparatus. As such, I find that there is a degree of complementarity between the goods and services at issue. Furthermore, the producers of the opponent's goods may also be responsible for the installation, maintenance and repair of the apparatus and installations at issue. Consequently, despite the goods and services having different natures and methods of use, overall, I consider them to be similar to a low degree.

Installation, maintenance and repair of geothermal-powered hot water systems

29. The contested services are likely to be provided by the manufacturer of *geothermal-powered hot water systems*, or by specialised companies within the renewable energy field. As previously discussed, geothermal energy heat sources are derived from heat in the ground, as opposed to photovoltaic energy heat sources which are derived directly from the sun. Therefore, whilst both heat sources concern environmentally friendly renewable energy sources, there are clear differences between them. The above contested services are solely concerned with the installation, maintenance and repair of geothermal-powered hot water systems. As

such, I can see no point of contact between the opponent's Class 9 goods and the above contested services. Furthermore, not only do I find that the goods and services at issue have different natures and methods of use, but also, I do not consider the goods and services to be complementary or in competition. Accordingly, I find the above services to be dissimilar to all of the opponent's Class 9 goods. The same conclusion also applies to the opponent's services in Class 42, on the basis that they share no direct similarities with the above contested services.

Summary

30. Where there is no similarity between the goods and services, there can be no likelihood of confusion under section 5(2)(b) of the Act: see *eSure Insurance Limited v Direct Line Insurance Plc* [2008] EWCA Civ 842 CA at paragraph [49]. The opposition therefore fails in respect of the following goods and services:

Class 11 Geothermal energy-powered heating apparatus; geothermal energy-powered heating installations; parts and fittings for the aforesaid goods.

Class 37 Installation, maintenance and repair of geothermal-powered hot water systems.

The average consumer and the nature of the purchasing act

31. 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 (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

32. 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."

33. The average consumer of the goods and services at issue is likely to include members of the general public as well as a more specialised commercial customer or business. The goods and services will mainly be available via retailers, being both general retailers and more specialist ones, and their online equivalents. The goods are most likely to be the subject of self-selection from retail outlets, catalogues and websites and therefore visual considerations are likely to dominate the selection process. Visual considerations will also dominate the selection of the associated services in Class 37. However, I do not discount an aural component playing a part given that orders may be placed by telephone or that word-of-mouth recommendations and advice may be received from sales assistants. Given the nature and type of goods and services at issue, the price and frequency of purchase is likely to vary widely, therefore, selection of the goods and services at issue will likely result in an above average level of attention being paid by both the average consumer as well as a more specialised commercial customer. A similar level of attention will also be paid to the selection of a trader specialising in the maintenance, installation and repair of the goods at issue.

Comparison of the marks

34. It is clear from *Sabel BV v. Puma AG* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, that:

> “34. […] 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.”

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

36. The trade marks to be compared are as follows:

Opponent’s mark	Applicant’s mark
	

37. With regard to the similarity of the marks at issue, in its written submissions the opponent states the following:

> “The Earlier Right is composed of the verbal elements MY SOLAR HOME together with the representation of a solar panel and a representation of an arc in the background of the logo. The Application comprises of solar panels representing a roof and the verbal elements SOLARHOME together with the strapline words energy by nature. According to Case Law Selenium-Ace (14/07/2005, T312/03, Selenium-Ace, EU:T:2005:289, § 37), the verbal element of a sign consisting of verbal and figurative elements usually has a stronger impact on the consumers than the figurative element because the public will

more easily refer to the signs in question by their verbal element than by describing their figurative elements. Furthermore, it is important to note that consumers usually pay more attention to the beginning of the signs, which is because they read from left to right and from top to bottom. The addition of the word My in the Earlier Right does not add anything from a trade mark perspective and may be discounted when considering the comparison of the signs.

The strapline of the Application, i.e. energy by nature, can be considered as descriptive of the good and services for which the application has been filed since said goods and services refer to the energy of nature, or renewable energy. Said strapline is therefore not a dominant element of the Application.

The words SOLAR HOME can therefore be considered as the dominant elements of each sign. These dominant elements can be considered to be visually, aurally and conceptually identical or highly similar based on the following.

[…]

Consumers will have the Earlier Right brought to mind when they see the sign which is the subject of the Application and, as a result, are likely to consider that the goods and services of the Opponent are being supplied by those of the Applicant. We consider the marks to be confusingly similar when placed side by side and considered by the relevant consumer of the relevant goods and services.

38. In its written submissions the applicant states the following:

"[…]

Contrary to the Opponent's arguments, SOLARHOME cannot be the dominant element of the marks. Given that this is discussed throughout the

Opponent's submissions regarding the comparison of the marks, this clearly highlights the inherent weaknesses in the Opponent's submissions on the similarity of the marks. In short, said submissions should be disregarded as inaccurate, given the significant degree to which they rely on an erroneous assertion that SOLARHOME is the dominant and distinctive part of the marks.

[…]

Based on the UKIPO's previous indications, it (SOLARHOME)[6] is completely lacking in distinctive character, and so all other elements of the mark should be considered dominant in comparison to it. Indeed, when bearing in mind their distinctive and dominant components of the marks (Sabel BV and Puma AG and Rudolph Sport, paragraph 23), it is other distinctive elements that must be borne in mind – namely colouring, fonts, stylised/logo elements, and the tag line of the applied for mark. All these elements are entirely different.

We submit that it is very important to consider the public interest which supports the inherent registrability requirements for marks – particularly Section 3(1)(c) of the Act. Descriptive terms should be kept free for use by traders. As SOLARHOME has been found, by the UKIPO itself, to be a descriptive term, it should be kept free for use. The Opponent should not be able to assert exclusive rights in respect of the SOLARHOME term, and so should not be able to use it as a point of comparison between the marks. The coincidence of this term should be disregarded from a comparison of the marks.

We agree with the Opponent's overarching argument […] that a descriptive element is not the dominant element of a mark. The Opponent has, though, identified the wrong element. SOLARHOME has been found by the UKIPO to be directly descriptive, whereas the strapline is allusive at most - indeed, the Opponent presents the interpretative step required by consumers to extract information from the strapline.

[6] Trade mark application UK00003751785 – 'SOLARHOME'

We submit that once the coincidence of SOLARHOME is removed as a point of comparison, or at the very least disregarded as a potential 'dominant and distinctive' component, the marks are very clearly different overall.

[…]

The way in which the concept of solar panels is presented by both sides is completely different. The earlier mark's presentation simply consists of a five-by-five grid of squares/rectangles, with a vanishing point. By contrast, the applied as if installed on a roof element. Further, the applied-for mark's roof element has individual, impactful character, given that it is clearly presented over the word 'home', forming a roof for the metaphorical home/house. The presentation is tongue-in-cheek and would resonate with consumers. There is an additional distinctive element within the earlier mark as well, namely what appears to be a minimalist-esque depiction of the sun in a gold curve.

Overall, keeping in mind that the dominant and distinctive components (i.e. all components except the words SOLARHOME) are different between the two marks, the marks can only be viewed as dissimilar overall.

Overall impression

39. The opponent’s mark is a composite mark consisting of words and figurative device elements. The words ‘My SOLAR Home’ are placed in order, one on top of the other. The words ‘My’ and ‘Home’ are grey in colour and are presented in upper and lowercase letters, whereas the word ‘SOLAR’ is presented in orange capital letters. A large blue and white rectangle, grid-like figurative element is positioned to the left of the words and an orange curved semi-circle shaped device, arcs from the grid-like device to the word ‘My’. Bearing in mind the goods and services at issue and the words present in the mark, I find that the grid element will be perceived as a solar panel, and the orange semi-circle device will be perceived as the sun. Whilst the figurative elements in the mark are larger than the words, I find the eye is naturally drawn to

the elements of the mark that can be read, keeping in mind *MigrosGenossenschafts-Bund v EUIPO*, T-68/17, where it was stated that:

> "…in the case of a mark consisting of both word and figurative elements, the word elements must generally be regarded as more distinctive than the figurative elements, or even as dominant, since the relevant public will keep in mind the word elements to identify the mark concerned, the figurative elements being perceived more as decorative elements…"

40. Accordingly, I find on balance that both the figurative elements and words dominate the overall impression in roughly equal measure.

41. The applicant's mark is also a composite mark consisting of words and a figurative device element. The conjoined words 'SOLARhome' are centrally placed in the mark. The word 'SOLAR' is presented in green, uppercase letters, whereas the word 'home' is presented in grey lowercase letters. Placed beneath the word 'home' in small, green, lowercase letters are the words 'energy by nature'. Positioned above the word 'home' is a green, triangular prism-like shaped device, featuring three dark green rectangle grid-like shapes. Taking into account the goods and services at issue and the words in the mark, I find that the device will be perceived as a pitched roof with solar panels placed upon it. Due to their position and relative size, and also bearing in mind *MigrosGenossenschafts-Bund v EUIPO*, T-68/17, mentioned above, I find the words 'SOLARhome' to be the more dominant and distinctive element in the mark. Less dominant is the pitched roof device element, followed by the strapline 'energy by nature' which due to the size of these words and the fact that they will be perceived as a strapline, play a lesser role in the overall impression.

42. Visually the marks coincide insofar as they share the same words 'SOLAR Home / SOLARhome'. The competing marks are visually different in that the word 'SOLAR' in the opponent's mark is presented in orange, whereas the word 'SOLAR' in the applicant's mark is presented in green. In addition, the word 'My' present in the opponent's mark is not replicated in the applicant's mark, and the words 'energy by nature' present in the applicant's mark are not replicated in the opponent's mark.

Insofar as the words present in the respective marks are concerned, the differences between the capitalisation and fonts are not that significant, on the basis that the capitalisation plays a very small role in the overall impressions and the standard fonts are unremarkable. With regard to the figurative elements present in the mark, whilst they are different, I bear in mind that both contain elements that represent solar panels. Accordingly, weighing the similarities against the differences, I find the marks to be visually similar to no more than a medium degree.

43. Aurally, the opponent's mark is likely to be pronounced as 'MY-SO-LAR-HOME'. With regards to the applicant's mark, given the size of the words 'energy by nature', and the fact that they will likely be perceived as a strapline I consider it unlikely that these words will be articulated. Therefore, the applicant's mark will likely to be pronounced as 'SO-LAR-HOME'. The figurative elements in the marks at issue will not be articulated. Consequently, I find the marks are aurally similar to between a medium to high degree.

44. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] E.C.R.-I-643; [2006] E.T.M.R 29.

45. Conceptually, the meanings of the words 'MY', 'SOLAR' and 'HOME' are obvious, therefore, the words 'SOLAR Home', will convey the concept of a household that is solar powered, and as such, these words have the same meaning in both marks. Furthermore, the word 'My' present in the earlier mark does not alter this meaning but qualifies it with ownership and/or belonging. As previously stated, the figurative elements present in the marks, are likely to be perceived as solar panels on roofs and therefore reinforce the concept of the words 'SOLAR HOME' present in both marks. The words 'energy by nature' present in the applicant's mark, will likely be perceived as a strapline alluding to the concept of solar energy, i.e. energy by nature, e.g. the sun. Accordingly, I find the marks to be conceptually similar to at least a medium degree.

Distinctive character of the earlier mark

46. 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 *Windsurfing Chiemsee v Huber and Alternberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered, the market share held by the mark, how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark, the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking, and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

47. Registered trade marks possess varying degree of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

48. Although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the opponent has not filed any evidence of use. Consequently, I have only the inherent position to consider.

49. The earlier mark contains the words ‘My SOLAR Home’ which as previously stated, will likely be perceived as a reference to a household that is solar powered, i.e. one that generates useable electricity from the sun. With regard to the figurative elements present in the mark, as previously stated, they are likely to be perceived as representing a solar panel and the sun. Consequently, when considered as a whole, I find that the phrase ‘My SOLAR Home’ and the figurative elements have an allusive nature in terms of the goods and services at issue. Overall, I find that the opponent’s mark has a low degree of inherent distinctive character.

Likelihood of confusion

50. 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/services, and vice versa. As I 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 the nature of the purchasing process. In doing so, I must be mindful to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

51. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods/services down to the responsible undertakings being the same or related.

52. Earlier in the decision I concluded that the marks are visually similar to no more than a medium degree, aurally similar to between a medium and high degree, and conceptually similar to at least a medium degree. I have found that the earlier mark has a low degree of inherent distinctive character for the goods and services at issue. Furthermore, I have found that similarity between the goods and services ranges from

dissimilar to identical. I have identified the average consumer of the goods and services at issue to be members of the general public as well as a more specialised commercial customer or business, who will pay at least a medium degree of attention when selecting the goods or services. I am of the view that the purchasing process will be largely visual, however, I have not discounted aural considerations.

53. I bear in mind that, although the marks share the same words 'SOLAR' and 'Home / home', I remind myself that there are differences which would not be overlooked, i.e. the word 'My', the words 'energy by nature' and the differing figurative elements. Accordingly, even taking into account the principle of imperfect recollection, I find the similarities between the marks, namely, the shared words 'SOLAR' and 'Home / home', are outweighed by these differences which are, in my view, sufficient for the average consumer not to directly confuse the marks, that is, to mistake or misremember one mark for the other, even for identical goods. As such, I find there is no likelihood of direct confusion.

54. Having found no likelihood of direct confusion, I turn now to the possibility of indirect confusion.

55. In *L.A. Sugar Limited v By Back Beat Inc,* Case BL O/375/10, Mr Iain Purvis Q.C., (as he then was) 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)."

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

57. I acknowledge that a finding of indirect confusion should not be made merely because the two marks share a common element. It is not sufficient that a mark merely calls to mind another mark:[7] this is mere association not indirect confusion.

[7] *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17

58. Having regard to all the above principles, whilst I find that the average consumer will recognise that there are differences between the competing marks, I am of the view that they will also recognise the fact that the words 'SOLAR Home / SOLARhome' are present in both marks. As such, whether consciously or unconsciously, this will lead the average consumer through the mental process described above in *L.A. Sugar*. It is considered that the differences between the competing marks will be attributed to the same company presenting its mark in two slightly different ways. To my mind, the inclusion of the word 'My', to the words 'SOLAR Home' in the earlier mark is likely to be perceived as a more personalised offering than the standard 'SOLAR HOME', and with regards to the inclusion of the words 'energy by nature' to the words 'SOLARhome' present in the applicant's mark, this addition is likely to be perceived as a variant 'SOLAR HOME' brand that is merely utilising a marketing strapline. Furthermore, the figurative elements present in the marks, are likely to be perceived as solar panels on roofs and therefore reinforce the concept of the words 'SOLAR HOME' present in both marks. Accordingly, with all things considered, I am satisfied that consumers, even those paying an above average level of attention, would assume a commercial association between the parties, or sponsorship on the part of the opponent, due to the shared words 'SOLAR Home / SOLARhome'. As such, I consider there to be a likelihood of indirect confusion. I should add that this finding extends to goods and services that are only similar to a low degree. This is because, taking account of the interdependency principle, the overall levels of similarity between the competing marks are, in my view, sufficient to counteract the lesser degree of similarity between those goods and services. This is so even bearing in mind the earlier mark's low level of inherent distinctive character. In reaching this conclusion I note that a degree of caution is required before finding a likelihood of confusion on the basis of common elements which are either descriptive or are low in distinctive character,[8] nevertheless, I maintain that there is a likelihood of indirect confusion.

Conclusion

[8] *Nicoventures Holdings Limited v The London Vape Company Ltd* [2017] EWHC 3393 (Ch) and *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch)

59. The opposition under section 5(2)(b) has been partially successful. The application is refused for the following goods and services:

Class 9 Photovoltaic apparatus and installations for generating electricity; Photovoltaic cells; parts and fittings for the aforesaid goods.

Class 11 Apparatus and installations for heating; Heat pumps; Solar energy powered heating installations and apparatus; Solar powered water heating apparatus and installations; solar heating panels; parts and fittings for the aforesaid goods.

Class 37 Installation, maintenance and repair of solar-powered heating installations, solar powered water heating apparatus and installations, solar heating panels, photovoltaic electrical systems, heat pumps, heating installations.

60. The opposition fails under Section 5(2)(b) for the following goods and services which can proceed to registration:

Class 11 Geothermal energy-powered heating apparatus; geothermal energy-powered heating installations; parts and fittings for the aforesaid goods.

Class 37 Installation, maintenance and repair of geothermal-powered hot water systems.

Costs

61. The opponent has enjoyed the greater degree of success and, consequently, is entitled to a contribution towards its costs based on the scale published in Tribunal Practice Notice 2/2016. I have taken the opponent's only partial success into account in making this award. Consequently, I award the opponent the sum of £600, calculated as follows:

Notice of opposition fee	£100
Preparing the Notice of Opposition and	£250

considering the counter statement	
Preparing written submissions and considering the other side's written submissions	£250
TOTAL	**£600**

62. I therefore order Bezza Holdings Limited to pay NOVELTIS the sum of £600. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 21st day of December 2023

Sam Congreve
For the Registrar