

O/271/12

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2558433
IN THE NAME OF EN+ GROUP LIMITED

AND

OPPOSITION THERETO UNDER NO 101662 BY ENI SpA

Background

1. Application No 2558433 stands in the name of En+ Group Limited (“En+”) and seeks registration of the following trade mark:



2. Registration is sought in respect of a wide range of goods and services in classes 1, 4, 6, 12, 16, 17, 35, 36, 37, 39, 40 and 42 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. I will set these out in greater detail later in this decision.

3. Following publication of the application in the *Trade Marks Journal*, notice of opposition was filed by ENI SpA (“ENI”). The notice discloses a single ground of opposition brought under section 5(2)(b) of the Act, based on the following Community trade mark and insofar as it is protected for goods and services in the following classes only (and which, again, I will set out in greater detail later in this decision):

Mark	No	Application date/ Registration date	Goods/services
ENI	9093683	5 December 2007/ 27 April 2010	1, 4, 6, 16, 17, 35, 36, 37, 39, 40 and 42

4. En+ filed a counterstatement in which it denied ENI’s claims.

5. Both parties filed evidence and the matter came before me for a hearing on 21 June 2012. At that hearing, En+ was represented by Denise McFarlane of counsel, instructed by Keltie, its legal representatives in these proceedings. ENI was similarly represented by Fiona Clark, also of counsel, instructed by Rapisardi Intellectual Property Ltd.

The evidence

6. Evidence was filed in the form of two witness statements by Dr Gianluigi Volontè on behalf of ENI and by Manuela Macchi on behalf of En+. Much of the evidence from both parties takes the form of submissions and for this reason I do not intend to summarise it. I do, however, take it into account and will refer to it as necessary in this decision.

The objection under section 5(2)(b) of the Act

7. Section 5(2) of the Act reads:

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

(a) ...

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

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

8. The meaning of “earlier trade mark” is set out in Section 6 of the Act which reads:

“6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.

(3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was no *bona fide* use of the mark during the two years immediately preceding the expiry.”

9. ENI’s trade mark is an earlier trade mark within the meaning of section 6(1) of the Act. En+’s application was published on 24 December 2010. As the earlier mark was not registered more than five years prior to this date, ENI is not required to prove use of its earlier trade mark in line with the requirements of Section 6A of the Act.

10. In determining the question under section 5(2)(b) of the Act, I take into account the guidance provided by the Court of Justice of the European Union (CJEU) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R 77, *Marca Mode CV v Adidas AG* [2000] E.T.M.R.723, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di Laudato & C. Sas v OHIM* C-334/05 (Limoncello), as cited with approval in *Och-Ziff Management Europe Ltd and Oz Management LP v Och Capital LLP, Union Investment Management Ltd and Ochoki* [2010] EWCH 2599 (Ch). It is clear from these cases that:

- (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, in certain circumstances, be dominated by one or more of its components;
- (f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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;
- (k) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

11. In essence, the test under Section 5(2)(b) is whether there are similarities in marks, goods and services which, when taking into account all the surrounding circumstances, would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address factors such as the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements and taking into account the degree of similarity in the goods or services, the category of goods or services in question and how they are marketed.

Comparison of goods and services

12. At the hearing, Ms Clark referred me to the notice of opposition which indicated that ENI is an integrated energy company whilst En+ is a diversified mining, metals and energy group, a position with which Ms McFarlane did not disagree. Whatever the actual area(s) of trade of the respective parties, I have to consider the specifications of goods and services as registered and for which registration is applied and on a notional basis. I am also mindful of the findings of the Court of First Instance (now General Court) in the case of *NHL Enterprises BV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-414/05*:

“71 The Court considers, first, that that assessment by the Board of Appeal is not called in question by the particular conditions in which the applicant’s goods are marketed, since only the objective marketing conditions of the goods in question are to be taken into account when determining the respective importance to be given to visual, phonetic or conceptual aspects of the marks at issue. Since the particular circumstances in which the goods covered by the marks at issue are marketed may vary in time and depending on the wishes of the proprietors of those marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, namely that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions of the trade mark proprietors-whether carried out or not- which are naturally subjective (see, to that effect, *NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, cited at paragraph 61 above, paragraph 49, and Case T-147/03 *Devinlec v OHIM – TIME ART (QUANTUM)* [2006] ECR II-11, paragraphs 103 to 105, upheld on appeal by the Court by judgment of 15 March 2007 in Case C-171/06 P *TIME ART v OHIM*, not published in the ECR, paragraph 59).”

13. Immediately before the hearing began, I was made aware of Ms Clark's intention to make submissions having regard to the CJEU's decision issued the previous day in *The Chartered Institute of Patent Attorneys v Registrar of Trade Marks (IP Translator)*, Case C-307/10 and to which, clearly, she had not been in a position to refer in her skeleton argument. At the hearing, she submitted that I should take the findings of the CJEU as meaning that En+'s specification covered all goods and services within the majority of the classes under which they were classified as, "with the exception of those in classes 16, 35, 39 and possibly 41", the specification used was that of the class heading and therefore covered all goods or services within that class which would mean they were necessarily identical to the other side's goods or services within the same classes. For her part, Ms McFarlane submitted that En+ should not benefit from the „windfall result' of the decision. She referred me to paragraph 64 of the judgment which states:

“64 Therefore, the answer to the questions referred is that:

-Directive 2008/95 must be interpreted as meaning that it requires the goods and services for which the protection of the trade mark is sought to be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection conferred by the trade mark;

-Directive 2008/95 must be interpreted as meaning that it does not preclude the use of the general indications of the class headings of the Nice Classification to identify the goods and services for which the protection of the trade mark is sought, provided that such identification is sufficiently clear and precise;

-an applicant for a national trade mark who uses all the general indications of a particular class heading of the Nice Classification to identify the goods or services for which the protection of the trade mark is sought must specify whether its application for registration is intended to cover all the goods or services included in the alphabetical list of that class or only some of those goods or services. If the application concerns only some of those goods and services, the applicant is required to specify which of the goods or services in that class are intended to be covered.”

14. For reasons that will become clear, I do not consider it necessary to make a finding as to whether the use of a particular class heading does, in fact, mean that ENI's earlier mark covers all possible goods or services in that class.

15. In reaching my conclusions on the similarity or otherwise of the respective goods and services, I take into account the findings in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 280 (“TREAT”), where Jacob J said (at 289):

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all, a trade mark specification is concerned with use in trade.”

He went on (at 295) to set out the following factors as being relevant to the question of similarity of goods and services:

- (a) the respective uses of the respective goods or services;
- (b) the respective users of the respective goods or services;
- (c) the nature of the goods or services;
- (d) the respective trade channels through which the goods or services are marketed;
- (e) the extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify the goods or services, for instance whether market research companies put them into the same or different sectors.

16. Subsequently, in *Canon Kabushiki Kaisha v MGM Inc* the CJEU stated:

“23. In assessing the similarity of the goods or services concerned.....all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.”

17. In Case T-420/03 – *El Corte Inglés v OHIM- Abril Sanchez and Ricote Sauger* (Boomerang TV) the General Court commented:

“96.....Goods or services which are complementary are those where there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking (Case T14169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, and judgment of 15 March 2006 in Case T-31/04 *Eurodrive Services and Distribution v OHIM – Gomez Frias* (euroMASTER), not published in the ECR, paragraph 35).”

18. I also take into account Jacob J’s comment in *Avnet* (supra) where, in relation to services, he said:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meaning attributable to the rather general phrase.”

19. Finally, in *Gérard Meric v OHIM*, Case T-133/05, the General Court said:

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

T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

20. I set out below the goods and services of the respective marks:

Class	Ent+'s application	ENI's earlier mark
1	Alumina, silicon, magnesite.	Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry
4	Fuels (including motor spirit), oil-gas, fuel gas, carburants, petroleum, raw or refined, coal, coal briquettes, electrical energy.	Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles and wicks for lighting.
6	Common metals and their alloys, magnesium, aluminium, aluminium sheets and bands, wrapping or binding bands of aluminium, aluminium foil, foils of metal for wrapping and packaging, including bags for baking, tin cans, packaging containers of metal	Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores.
12	Bunker boat for oil transportation	
16	Printed matter, calendars, envelopes [stationery], fountain pens, albums, posters, tickets, printed forms, note books, pamphlets, booklets, writing paper, newspapers, bookmarkers, printed publications, pencils, catalogues, adhesive bands for stationery or household purposes, stickers [stationery], conical paper bags, flags of paper, labels, not of textile; plastic film for wrapping, bags	Adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks.

	[envelopes, pouches] of plastics for packaging, bags for microwave cooking	
17	Semi-processed plastic substances, plastic film other than for wrapping	Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal.
35	Marketing studies, marketing research, business information, efficiency experts, professional business consultancy, import-export agencies, commercial information agencies; sales promotion for others, procurement services for others [purchasing goods and services for other businesses], commercial or industrial management assistance, demonstration of goods; organization of exhibitions and trade fairs for commercial or advertising purposes, presentation of goods on communication media, for retail purposes; auctioneering; commercial information and advice for consumers [consumer advice shop], business management and organization consultancy, economic forecasting, personnel management consultancy, personnel recruitment, psychological testing for the selection of personnel, compilation of information into computer databases, systemization of information into computer databases	Business management; business administration; office functions; selling of fuels, chemicals, varnishes, paints, cosmetics for vehicles, oils, machinery and motors, boilers and turbines, measuring apparatus and meters, watches, jewellery, fancy goods, bags, pipes and buildings materials, bitumen, foodstuffs, newspapers.
36	Financial clearing, mutual funds, issue of tokens of value, issuance of credit cards; capital investments; financing services, financial management, financial sponsorship, financial analysis, financial evaluation [insurance, banking, real estate], financial information, financial consultancy; hire-purchase financing, factoring, brokerage, securities	Insurance; financial affairs; monetary affairs; real estate affairs.

	brokerage, financial business liquidation services	
37	Mining extraction, including bauxites, silica, coal; drilling of wells, vehicle maintenance, including vehicle service stations [refuelling and maintenance]; oil pipelines construction and maintenance	Building construction; repair; installation services.
39	Transport, railway transport, boat transport, marine transport, barge transport; transport by pipeline, freight forwarding, stevedoring, vehicle rental, rental of storage containers, transport reservation, transport brokerage, freight brokerage, freighting, electricity distribution	Transport of materials, in particular distribution and storage of energy and electricity; energy distribution information; packaging services; storage of goods; travel arrangement.
40	Processing of oil, water treating, metal treating, including metal casting, tempering, rolling and pressing; blacksmithing, production of energy	Treatment of materials.
42	Research and development for others, engineering, geological research, analysis for oil-field exploitation, oil-well testing, oil-field surveys, geological prospecting, oil prospecting, technical research, surveying	Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software.

21. En+'s *Alumina, silicon and magnesite* are all included within the terms *chemicals used in industry, science and photography, as well as in agriculture* as are included within ENI's earlier mark and are therefore identical goods in line with the *Meric* principles.

22. As *fuels (including motor spirit)* appear in the specifications of both marks, they are clearly identical. *Oil-gas, fuel gas, carburants, petroleum, raw or refined, coal, coal briquettes* and *electrical energy* are also types of fuel and thus they are also identical to them.

23. *Common metals and their alloys* are common to both specifications and are identical. Each of the other goods listed in class 6 of En+'s application are either common metals and their alloys or are goods of common metal and are included within these terms as they appear in ENI's earlier mark. They are therefore identical goods.

24. In its notice of opposition, ENI acknowledges that *Bunker boat for oil transportation* is not "directly covered" by its earlier mark but submits that such goods are similar to "industrial oils and greases; fuels (including motor spirit)" and

“transport of materials, in particular distribution and storage of energy and electricity” as appear in the earlier mark.

25. *Bunker boats* are boats which transport something, in this case oil from e.g. a ship to a storage depot. They are specialist vessels supplied by shipbuilders and used by those in the relevant trade to contain and move oil across the water from one place to another and therefore have very different uses, users, natures and trade channels to those of *industrial oils and greases; fuels (including motor spirit)*. Someone needing fuel to e.g. power or heat something will not use a boat to do so nor will someone needing a boat to move something be able to do that simply by the use of e.g. a grease or fuel. The respective goods are not in competition nor are they complementary. I find that *bunker boat for oil transportation* is not similar to *industrial oils and greases; fuels (including motor spirit)*. As for *transport of materials, in particular distribution and storage of energy and electricity*, this is the movement of materials including the named products but not limited to them. The transport of materials would include the transport of oil and would include its transport by bunker boat. The respective goods and services would have the same users and uses and have a complementary relationship. I find these respective goods and services to have a degree of similarity.

26. *Printed matter, note books, pamphlets, booklets, writing paper, newspapers and printed publications* as appear in En+'s application are items which may take the form of educational matter and are therefore included within *instructional and teaching material (except apparatus)* as appears in ENI's earlier mark and are therefore identical goods. Likewise, *calendars, envelopes [stationery], fountain pens, posters, tickets, printed forms, bookmarkers, pencils, catalogues, adhesive bands for stationery or household purposes, stickers (stationery) and labels, not of textile* are all included within the term *office requisites* as appear in the earlier mark and are identical goods. *Plastic materials for packaging (not included in other classes)* as appears in ENI's earlier mark includes plastic bags and wrapping and is therefore identical to *plastic film for wrapping, bags [envelopes, pouches] of plastic for packaging* and similar to *conical paper bags*. *Albums* which could include books or binders for keeping e.g. drawings, are included within the term *artists' materials* and are therefore identical goods. I do not consider that *flags of paper* and *bags for microwave cooking* to be similar to any of the goods or services of the earlier mark as their users, uses and natures are entirely different and they are not complementary.

27. I consider *semi-processed plastic substances* to be similar, if not identical, to *plastics in extruded form for use in manufacture*. *Plastic film other than for wrapping* is similar, if not identical, to *packing, stopping and insulating materials*.

28. With the exception of *demonstration of goods, auctioneering and commercial information and advice for consumers [consumer advice shop]*, all of the services as are included within En+'s application in class 35 are included within, and therefore identical to, the *business management, business administration and office functions* services of the earlier mark.

29. The *demonstration of goods* is part and parcel of the process of the selling of those goods as is *commercial information and advice for consumers [consumer*

advice shop]. *Auctioneering* is the selling, by auction, of e.g. goods or property. Each of these services is therefore identical to *selling of fuels, chemicals, varnishes, paints, cosmetics for vehicles, oils, machinery and motors, boilers and turbines, measuring apparatus and meters, watches, jewellery, fancy goods, bags, pipes and buildings materials, bitumen, foodstuffs and newspapers*.

30. Each of the services as are applied for in class 36 are included within those services of the earlier mark in the same class. They are therefore identical services.

31. In relation to *mining extraction, including bauxites, silica, coal*, ENI submits that they are similar to “*building construction; repair, installation services*”, “*transport of materials, in particular distribution and storage of energy*”, “*treatment of materials*” and “*scientific and technological services*” as appear in the earlier mark. It submits that they “are all energy-related [and] are very similar in nature and purpose and are complementary....and are a natural business extension of the services [it offers]”. It does not provide any further explanation of its position nor has it filed any evidence to support it.

32. Mining extraction is a process by which materials are removed by taking them from the supply source which is below the surface of e.g. the earth or seabed. Whilst I accept, as Ms Clark submitted at the hearing, that a mine will be “constructed”, the services here are not mines per se but are *mining extraction*. I do not consider these to be similar services to the *building construction, repair and installation services* of the earlier mark. These latter services are such, self-evidently, which provide for the erection, repair or installation of buildings and are not services which are necessarily the same or similar to whatever might go on in the building when it is eventually used. The uses, users and nature of the services all differ and nor do I consider them to be complementary. The respective services are not similar.

33. As for the comparison of *mining extraction, including bauxites, silica, coal* with *transport of materials, in particular distribution and storage of energy*”, the transport of materials, as I indicated above, involve moving materials from A to B, whilst *mining extraction* involves taking materials from, e.g. the earth so that they can be moved elsewhere and later used. Where the material being extracted is such as is used in energy production, the services will have some complementarity and I consider them to have a degree of similarity.

34. As I indicate above, *mining extraction* involves the physical removal of something from e.g. the earth. The *treatment of materials* are services by which materials are subjected to some sort of process or by which some substance is applied to them. Whilst it may be possible to carry out treatment to materials which have been extracted by mining, this is a step removed from the extraction itself. I do not consider, absent evidence, the respective services to be similar. The users, users and the nature of them, differ.

35. *Scientific and technological services* is a wide ranging term which could include such services in relation to the field of mining extraction such that there is at least a degree of similarity between them.

36. *Transport* includes *railway transport, boat transport, marine transport, barge transport; transport by pipeline*. Each of these services refer to the movement of goods or people and I consider them to be similar to the *transport of materials* and *travel arrangement* as appear in the earlier mark. *Freight forwarding* and *freighting* are synonymic with, and therefore identical to, *transport of materials*. *Stevedoring* is the loading and unloading of ships and is part of the process of transporting materials by sea and therefore identical to *transport of materials*. The *rental of storage containers* is included within, and therefore identical to *storage of goods*. *Transport reservation, transport brokerage and freight brokerage* are included within the terms *transport of materials* and *travel arrangement* and these are also identical services. *Vehicle rental* is a service which can be provided either as part of a service of *transport of materials* or *travel arrangement* and are at least similar services. *Electricity distribution*, is identical to *transport of materials, in particular distribution and storage of energy and electricity* as is included within the earlier mark.

37. *Processing of oil, water treating, metal treating, including metal casting tempering, rolling and pressing; blacksmithing, production of energy* are all material treatment processes and included within, and therefore identical to, *treatment of materials* of the earlier mark.

38. Each of the services applied for in class 42 are included within, and therefore identical to, the *scientific and technological services and research and design relating thereto* as are included within the specification of the earlier mark.

The average consumer and the nature of the purchasing process

39. Both the application and the earlier mark cover a wide range of goods and services. Some of the respective goods and services, e.g. envelopes or adhesives for stationery or household purposes, will be used by the general public. Others, e.g. fuels (including motor spirit) could be used by individual members of the public or by businesses. Still others will be used by businesses only (albeit by all types of business) e.g. marketing studies, business management whilst some will be used by highly specialised businesses only e.g. bunker boat for oil transportation, analysis for oil-field exploitation. Because of this, the nature of the purchasing process is also likely to vary widely with the more common goods being an everyday purchase of low value and widely available by self-selection off the shelf with limited thought being given to the purchase by the consumer, the business only services likely to be a more considered and infrequent purchase of somewhat higher value and the highly specialised services likely to be a highly expensive and infrequent purchase made after a lengthy consultation, design and commission process. The purchasing processes of the goods and services mean the visual aspects of the respective marks are likely to be highly significant (whether choosing items from a shelf or given the paperwork likely to be part of the purchasing process of the services) though not to the extent that the other aspects will be overlooked or ignored.

The comparison of marks

40. In making a comparison between them, I must have regard to each mark's visual, aural and conceptual characteristics. Without engaging in an artificial dissection of them, as the average consumer usually perceives a mark as a whole

and does analyse its various details, I must decide which, if any, of their components are dominant and distinctive.

41. The marks to be compared are as follows:

EN+'s mark	ENI's earlier mark
 The image shows a stylized, rounded, and somewhat blurry mark consisting of the letters 'E' and 'n' joined together, followed by a plus sign '+'. The letters are thick and the overall appearance is soft and indistinct.	ENI

42. EN+'s application consists of the upper case letter E and a lower case letter n, the two being conjoined. These are followed by, but separated from, a plus symbol. As Ms McFarlane submitted at the hearing, the characters have a slightly rounded appearance though I do not consider there is anything particularly unusual about this. The plus symbol signifies that something is added to something else and, because of this and its position at the end of the mark, I consider the letters EN to be the dominant element of the mark with the plus symbol having a subordinate role. In her witness statement on behalf of EN+, Ms Macchi submitted:

“EN- would be perceived as an abbreviation or an allusive reference to the word “energy””.

She refers to a number of trade marks taken from both the UK and OHIM registers which, she says:

“shows on the one hand that the element “EN” is generally associated with the word “energy” and on the other that its distinctiveness is diluted in the relevant field”.

43. For his part, Dr Volontè disagrees that EN would be seen as an abbreviation of, or allude to, the word energy. He submits:

“Of the nine trade marks cited by the Applicant in paragraph 6 of the Applicant’s Witness Statement, five do not cover any goods or services that are specifically energy-related. Moreover, in the remaining trade marks cited by the Applicant the element “EN” does not constitute a dominant part.”

There is some force in these latter submissions. I do not consider the state of the register assists EN+.

44. The letters en are used as a prefix to mean (to put) in or on. They are also a word for a particular unit of measurement though I have no evidence that the

average consumer would be aware of this meaning. Whilst I accept that the letters EN make up the first two letters of the word energy, I have no evidence that they are used as an abbreviation for that word. In my view, the element En is not only the dominant element of the mark applied but is also the distinctive element within the mark.

45. ENI's earlier mark consists of the three letters ENI, all in upper case. Dr Volontè refers to it being an acronym derived from the company's previous name, however, there is no evidence that the average consumer will be aware of this though it is possible that because each letter is presented in upper case, some may view it as an acronym for something. Others are likely to see it as a word in its own right. However it is seen, it has no dominant elements and its distinctiveness rests in the whole.

46. Both marks have the letters E and N at the beginning and have one other character. That third character differs. Dr Volontè submits that "66% of the signs-the first two characters and syllable of each sign-are not only similar, but identical". In *Inter-Ikea Systems BV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-112/06* the GC stated:

"54 As regards the visual comparison between the verbal element of the contested mark and the earlier word marks, the applicant claims that the only difference between them is the presence of the letter 'd' in the contested mark and the letter 'k' in the earlier word marks. However, the Court has already held in Case T-185/02 *Ruiz-Picasso and Others v OHIM–DaimlerChrysler(PICARO)* [2004] ECR II-1739, paragraph 54) that, in the case of word marks which are relatively short, even if two marks differ by no more than a single consonant, it cannot be found that there is a high degree of visual similarity between them."

47. Whilst I accept the above, as a rule of thumb, I have to consider the respective marks as wholes. Both marks begin with the same two letters EN/En. Given the inclusion of the plus symbol in the mark applied for, which is absent from the earlier mark which itself ends in a letter I, the ends of the respective marks differ. Given the presence of the horizontal cross member of the plus symbol, I do not consider it would be seen as a stylised form of the letter I, as Dr Volontè submits. Owing to the common presence of the letters EN at the beginning of each of the respective marks, there is a degree of visual similarity between them but when considering the marks as wholes, the degree of similarity is low.

48. In my view, whilst it is possible that some may refer to it as E-N- plus, the mark applied for is most likely to be referred to as EN plus. As for the earlier mark, some may refer to it by the letters E-N-I whilst others will try to make a word out of it and pronounce it as "en-ee" or, less likely, "en-eye". Where pronounced as a word, there is a degree of aural similarity between the respective marks given that both begin with the same „en' sound. Where the mark is pronounced as three separate letters, in my view the most likely approach, aural similarity rests on the commonality of the 'n' sound within the respective marks with the beginning and endings being different. However it is pronounced, when taken as wholes, the degree of aural similarity of the respective marks is low.

49. As I indicated above, EN, whether taken as letters or a word has a meaning both as a prefix and a unit of measurement, however, neither of these meanings are likely to come to the mind of the average consumer of the goods and services at issue. Whilst the letters make up the first two letters of the word energy, there is no evidence that they are an abbreviation of that word or that the average consumer uses it in such a way. The plus symbol is likely to be seen as referring to something having been added, however, of itself, I do not consider that the average consumer will accord the mark applied for with any particular meaning. The earlier mark, ENI, is equally unlikely to bring any particular image to the mind of the average consumer. From a conceptual perspective, the position is neutral.

Likelihood of confusion

50. The likelihood of confusion must be appreciated globally, taking account of all relevant factors. The matter must be judged through the eyes of the average consumer. The decision of the General Court in *New Look Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 and T-171/03, indicates that the circumstances in which the relevant goods or services and the marks are encountered by the consumer, particularly at the point at which the purchase is made, is an important consideration. In making the assessment of all relevant factors I also have to take into account the fact that the consumer will rarely have an opportunity to compare marks side by side but will instead rely on the imperfect picture of them he has kept in his mind (*Lloyd Schuhfabrik Meyer & Co, supra*). Another factor to be taken into account is the distinctive character of the earlier trade mark having regard to its inherent characteristics and the reputation it enjoys with the public.

51. Whilst evidence, in the form of two witness statements, was filed on behalf of ENI, it consists primarily, as I indicated above, of submissions. Dr Volontè does, however, state that ENI was founded in 1953 and operates “in the oil and gas, electricity generation and sale, petrochemicals, oilfield services construction and engineering industries”. At GV1, he exhibits a printout dated 5 July 2011 from ENI’s website showing the company profile, which confirms this. Whilst the company itself has clearly been in existence for some years, there is no evidence of any actual use which may have been made of the earlier mark in the UK or elsewhere. That being the case, the mark cannot be shown to have benefitted from any enhanced distinctiveness through its use and therefore, I have only its inherent distinctive character to consider. Being a mark made up of three letters with no apparent meaning, it is a mark with an average degree of inherent distinctive character.

52. I have found the marks to have a low degree of similarity from both the visual and aural perspectives with the position from the conceptual perspective being neutral. The earlier mark is of average distinctive character. With the exception of *flags of paper* and *bags for microwave cooking* which I found to be dissimilar, I have found each of the goods and services applied for to be either similar or identical to goods and services as are included within the registration of the earlier mark. I have found that for some, limited, goods, such as stationery, the purchasing process is likely to be an everyday one with the general public giving little thought to the process. The purchasing process is likely to be more complex and considered as the goods and services become more specialised and/or technical. Taking all of the

above factors into account, I conclude that the differences between the respective marks outweigh the similarities, even where identical goods and services are involved and little thought is given to the purchasing process. The average consumer will not, in my view, confuse the mark of one of these undertakings for that of the other, either directly or indirectly. I consider there is no likelihood of confusion.

Summary

53. The opposition has failed in its entirety.

Costs

54. The opposition having failed, En+ is entitled to a contribution towards its costs. I take into account the fact that the evidence filed was extremely limited and consisted, for the most part, of submission which would have taken little time and effort to prepare and review. I also take into account the fact that a hearing took place. I make the award on the following basis:

Preparing a statement and considering the other side's statement:	£200
Preparing evidence and considering and commenting on the other side's evidence:	£300
Preparing for and attending a hearing:	£500
Total:	£1000

55. I order ENI SpA to pay En+ Group Limited the sum of £1000. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th day of July 2012

**Ann Corbett
For the Registrar
The Comptroller-General**