

O-316-06

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2357272  
BY GENASYS POWER SYSTEMS TO REGISTER A  
TRADE MARK IN CLASSES 37 AND 42**

**AND**

**IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO. 92853 BY GENERSYS PLC**

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### **BACKGROUND**

1. On 2 March 2004, Genasys Power Systems applied to register **GENASYS POWER SYSTEMS** as a trade mark. Following examination, the application was accepted and published for the following services in Classes 37 and 42:

**Class 37:** The installation and maintenance of electricity generating apparatus based on wind, water, hydro energy, diesel, liquefied gas and other hydrocarbon fuels, but none relating to solar energy.

**Class 42:** The design of electricity generating installations and parts and fittings for the aforesaid, based on wind, water, hydro, diesel, liquefied gas and other hydrocarbon fuels, but none relating to solar energy.

2. On 8 October 2004, Forrester Ketley & Co, acting as agents for Genersys plc filed a notice of opposition. There is only one ground of opposition which is based on Section 5(2)(b) of the Act. The Opponent is the owner of Community trade mark No. 2352508 for the mark **GENERSYS** which was applied for on 24 August 2001 and registered on 5 July 2005. It stands registered for the following goods and services:

**Class 9:** Solar energy apparatus and installations; solar collectors; solar panels; parts and fittings for all the aforesaid goods.

**Class 11:** Solar energy powered heating apparatus and installations; solar energy powered air-conditioning apparatus and installations; solar collectors for heating; solar collectors for air-conditioning; solar panels for heating; solar panels for air-conditioning; parts and fittings for all the aforesaid goods.

**Class 42:** Advisory and consultancy services in the field of solar energy; advisory and consultancy services in the field of solar energy-powered heating and air-conditioning.

The Opponent frames their objection to the application in the following terms:

“1. The mark applied for is GENASYS POWER SYSTEMS. The words “POWER SYSTEMS” are non-distinctive in respect of the services claimed, as a result of which the “essential particular” of the mark forming the subject of application...is GENASYS.

2. The trade marks GENASYS and GENERSYS are visually and phonetically similar.

3. It has been noted that the applicants have excluded services relating to solar energy, but this is insufficient to overcome any risk of confusion, in that energy providers can provide more than one source of energy to consumers, e.g. gas and electricity through the same provider.”

3. On 20 December 2004, Ian Palmer Intellectual Property Limited, acting as agents for the Applicant filed a counterstatement in which the ground of opposition is denied. The counterstatement comments on: (i) the sophisticated nature of both the goods and services at issue and the average consumer of such goods and services, (ii) the respective trade marks, (iii) the exclusion of services relating to solar energy appearing in the Applicant’s specifications, and (iv) the companies involved in the dispute. The applicant’s counter-statement concludes in the following terms:

“There would be no confusion between the names Genersys plc and Genasys Power Systems in the minds of anyone likely to purchase products or services from either organisation;

There is no overlap in the forms of energy to which the two marks refer; and

Genasys Power Systems was established and trading about a year before Genersys plc was formally registered as a company.”

4. Both sides filed evidence and both ask for an award of costs in their favour. The parties were invited to say whether they wished to be heard. Neither indicated a wish to do so. However, written submissions have been received on behalf of both parties. Acting on behalf of the Registrar, I give this decision.

## **EVIDENCE**

### **Opponent’s Evidence**

5. This consists of a witness statement, dated 11 May 2005, by Robert Kyriakides. Mr Kyriakides explains that he is the Chief Executive of Genersys plc, a position he has held since March 2001. He confirms that the facts contained in his statement come from his own knowledge or from his firm’s records to which he has full access.

6. He states that the Opponent provides goods and services under the GENERSYS trade mark, and explains that these goods and services all relate to the production of renewable and sustainable energy producing products. The goods are described as solar thermal panels,

controllers, pump stations and home energy and district heating systems, and the services, as the design of thermal solar systems and district heating systems and training and marketing for installers of the system. The first use of the GENERSYS trade mark in the United Kingdom was in March 2001; exhibit RAFK2 consists of literature illustrating the manner in which the trade mark is used. I note that some of this literature is either undated or from after the material date in these proceedings, and that where dated before the material date, GENERSYS is, on occasion, accompanied by one or more device elements.

7. Turnover under the GENERSYS trade mark (in relation to both goods and services) for the period 2002-2004 is as follows:

<b>Year</b>	<b>£</b>
2002	200,000
2003	360,000
2004	505,000

In relation to these figures, Mr Kyriakides, says:

“Sales by my company are of product only and mainly comprise sales to installers who themselves market and sell to end users GENERSYS products on a fully installed basis using only the GENERSYS name. Installers are not permitted to re-brand the product. An average installation costs about one and a half times more than the cost of the product itself, so that goods sold for £1,000 end up with a total installation value under the mark of around £2,500. To get a true picture of the sales, the annual sales should be multiplied by a factor of two and a half, to allow for installer’s margins.”

8. Mr Kyriakides explains that the Opponent advertises the GENERSYS trade mark, and exhibit RAFK3 which consists of a Department for Environment Food and Rural Affairs publication entitled “Energy Resource Environmental and Sustainable Management” and which is dated September/October 2004 (i.e. after the material date) is, he says, an example of this. He notes that pages 22 and the rear page of the publication contain an advertising feature and advertisement respectively, which relate to the Opponent’s business. He adds that the Opponent promotes its activities at exhibitions, shows, seminars etc and a list of the events attended together with the number of attendees is provided from June 2002 to April 2005. In the period prior to the material date, the Opponent attended 8 events, which attracted a total of 5,260 attendees. Expenditure on promotion of the trade mark in the period 2001-2004 is as follows:

<b>Year:</b>	<b>£</b>
2001	2,000
2002	126,000
2003	149,100
2004	227,000

In relation to these figures, Mr Kyriakides, says:

“The amounts actually spent on promotion are extremely high when compared with actual sales because my company is using a brand strategy and has decided to invest heavily in the brand.”

He adds that the Opponent has sold or distributed around 8,000 copies of a book entitled “A Concise Guide to Energy in the United Kingdom” and is in the course of preparing a second edition of the book. Exhibit RAFK4 is a copy of the book which I note was first published in 2002. The Opponent also displays the GENERSYS trade mark on, for example, company stationery, examples of which are provided as exhibit RAFK5.

9. The opponent has, says Mr Kyriakides, made sales in every region of the United Kingdom with the exception of Northern Ireland, where the GENERSYS trade mark is being used with the Opponent’s permission by Genersys Ireland Limited. Whilst recognising that research is hard to undertake with any degree of accuracy given that the Opponent’s competitors file “small business” accounts, he comments that according to their own research, the Opponent has approximately one quarter of the United Kingdom solar thermal market.

10. Finally, Mr Kyriakides comments on the Applicant’s counter-statement. I do not propose to record his comments here, but will, of course, bear them in mind when reaching my decision.

### **Applicant’s evidence**

11. This consists of two witness statements. The first, dated 9 August 2005, is by Simon Jarvis. Mr Jarvis explains that he established Genasys Power Systems (the Applicant) on 23 June 2000 and commenced trading immediately. Exhibit SJ1 consists of a copy of the Applicant’s passbook with the Furness Building Society which shows an “Opening LPB” date of 23 June 2000. Exhibits SJ2 and SJ3 consist of invoice Nos: FE2 for £627.45 and FE3 for £428.87 both on Genasys Power Systems headed paper and dated 24 July 2000 and 26 February 2001 respectively, and both to the Finance Division, Town Hall, Barrow-in-Furness. I note that sums corresponding to these invoices were paid into the Applicant’s account on 29 August 2000 and 24 March 2001 respectively. He adds that on 17 October 2000, the website [www.genasyspowersystems.co.uk](http://www.genasyspowersystems.co.uk) was established, and on 4 May 2001, Genasys Power Systems Limited, with Mr Jarvis as the Managing Director, was registered with Companies House.

12. Mr Jarvis comments that he established Genasys Power Systems when he identified the importance of providing electrical power at remote locations i.e. away from mains supplies. He explains that he has concentrated on wind energy in this regard. He adds that the Applicants are: “specialists in remote power and renewable energy” i.e. the provision of electrical power in remote locations and most often produce this power from renewable energy sources such as wind/hydro turbines, photo-voltaics, inverters, batteries, gas/diesel powered generators and fuel cells. Mr Jarvis comments:

“The services offered include: – consultancy, design, procurement and installation. Genasys Power Systems Ltd offer a complete “turn key” service, i.e. design, procurement and installation using its own staff and DTI accredited agents, who are qualified to install Genasys Power Systems Ltd designed and supplied equipment (local personnel may be

used as sub-contract labour, e.g. for civil engineering operations, under Genasys/Agent supervision). Genasys Power Systems Ltd does NOT offer devices to convert directly solar energy into hot water.”

13. Exhibits SJ4, SJ5 and SJ6 consist of leaflets in relation to wind turbines, inverters and chargers and deep cycle batteries respectively, which Mr Jarvis says cover some of the current range of products and services offered by the Applicant. I note that all of the leaflets (which appear to be undated), bear the GENASYS POWER SYSTEMS trade mark (with the GENASYS element presented in significantly larger text than the words POWER SYSTEMS), the combination is accompanied by a device element. The Applicant’s turnover and promotion during the period 2001-2004/05 is as follows:

<b>Year</b>	<b>£</b>	<b>Promotion</b>
2001/02	42593	120
2002/03	108137	226
2003/04	180510	1023
2004/05	243069	1427

Having contrasted the above figures with those of the Opponent, and in particular the percentage each party spends on promotion of their trade marks, Mr Jarvis comments:

“This disparity is to be expected with Genersys plc’s strong share of a mass market and the need to maintain a high profile in the public mind. In contrast, specialist engineering markets do not (normally) react to promotions and new sales are much more dependent on the performance of current installations. However, once the performance and reliability of such installations is proven, the supplier/market should become established.....Thus, the above turnover and promotional figures show the classical differences between the “mass” and “specialist” engineering markets, i.e. they prove that Genersys plc and Genasys Power Systems Ltd do operate in two entirely separate market sectors.”

14. He goes on to say that apart from its website, the Applicant does not “mass market” its products and obtains new commissions mainly by word of mouth via its agents or advertisements in specialist magazines. Exhibits SJ7 and SJ8 consist of advertisements relating to the Applicant’s business which appeared in the 2005 Country Land & Business Association Annual Handbook (which is after the material date) and an undated page from Yellow Pages respectively. In addition, Mr Jarvis explains that the Applicant has demonstrated at exhibitions in early and late 2004. He notes that on only one occasion, the Olympia Exhibition of 19-22 October 2004, (which once again is after the material date) and which he says is the largest of all those listed and the only one likely to cover the “mass” and “specialist” markets, have the two parties exhibited together, concluding that this is indicative that the companies are operating in different market sectors.

15. Finally, Mr Jarvis observes that the Opponent has provided no evidence of confusion. He adds that only one such case is known to him, explaining that a client of the Opponent contacted the Applicant by mistake and was immediately re-directed.

16. The second witness statement also dated 9 August 2005, is by Ian Palmer. Mr Palmer explains that he is the Managing Director of Ian Palmer Intellectual Property Limited, a position he has held since March 2004. From 1 January 1997 to 31 March 1999, Mr Palmer was the Innovation and Technology Counsellor for Business Link Cumbria. In 2000, he worked on the Cumbria Innovators' Roadshow. As a result of open meetings to which inventors were invited, confidential meetings were offered to identify what further assistance might be available; exhibit IP1 is a copy of a confidentiality agreement dated 11 October 2000 between Mr Jarvis and MAREL, a division of Furness Enterprise Limited. Mr Palmer then goes on to explain how he met with Mr Jarvis on 7 November 2000 to discuss his vertical axis wind turbine project"; exhibits IP2-IP4 are provided in support.

17. The remainder of Mr Palmer's statement consists of submissions in relation to: (i) the meanings of the words solar energy and solar power, (ii) the single product nature of the opponent's goods, as opposed to the variety of products utilised by the Applicant and (iii) that as mentioned by Mr Jarvis, the Opponent has not pointed to any instances of confusion.

### **Opponent's evidence in reply**

18. This consists of a witness statement, dated 7 November 2005, by the same Robert Kyriakides mentioned above. The statement, as it must, simply replies to the Applicant's evidence and as such, I do not propose to summarise it in detail here; I will of course keep its contents in mind when reaching my decision. That said, I note that exhibit RAFK4 consists of an incomplete page dated 18 August 2005 (after the material date) taken from the Applicant's website on which Mr Kyriakides comments as follows:

"Moreover, Mr Jarvis confirms that their interests include photo-voltaics...a printout from the Applicant's website showing use of solar panels for the generation of electricity. Of note, reference is made to "solar water heating", wherein the Applicant advises that, whilst they do not install solar heating technologies, they are well placed in the market to advise on suitable suppliers. This is, in my opinion, a clear admission on their part that consumers interested in solar water heaters would look to the Applicant for such products."

That concludes my summary of the evidence filed in so far as I consider it necessary.

### **The Opponent's written submissions**

19. The main points arising from the Opponent's written submissions are as follows:

- that the matter must be judged from the standpoint of the average consumer, and that in these proceedings the average consumer is the public at large;
- that the trade marks GENERSYS and GENASYS POWER SYSTEMS are confusingly similar. The words POWER SYSTEMS contained in the Applicant's mark are non-

distinctive/ descriptive in relation to the services claimed. The essential particular of the Applicant's trade mark is GENASYS;

- that GENASYS and GENERSYS are visually similar and phonetically identical, a point conceded in the Applicant's counterstatement of 16 December 2004, in which it states at paragraph 2 that: "The marks GENASYS and GENERSYS are visually and phonetically similar. True". Both trade marks are word only with no additional figurative or colour element;
- that the Opponent and Applicant operate in the same field, and that the respective goods and services are identical or similar, and, that the installation, design and maintenance of electricity generating apparatus in the Applicant's specifications are inextricably linked to solar energy apparatus and installations and advisory and consultancy services relating thereto covered by the Opponent's specifications. The generation of electricity and the use of solar energy are synonymous with each other;
- that whilst the Applicant tries to distinguish between the respective goods and services by reference to the distinction between "solar power" and "solar energy" the average consumer is unlikely to make the same distinction. It is clear that renewal energy suppliers such as the Applicant and the Opponent could be seen by the average consumer as providing the same resources. Both parties operate in the renewable-energy field. They have attended the same exhibition and there has been a recorded instance of confusion between the respective parties;
- that the Applicant's website makes reference to solar panels, with the Applicant making clear that they are "well placed in the market", invariably the same market, to advise on suitable suppliers of these goods/services.

### **The Applicant's written submissions**

20. The main points arising from the Applicant's written submissions are as follows:

- that Mr Kyriakides' definition of photo-voltaics as the conversion of light solar energy into electrical power is not correct. The words actually mean conversion of light energy into electrical power. His reference to solar energy is typical of his confusion of terminology in the way that a technically qualified person would not do;
- that there could be no confusion with the products of the Opponent as their sole function is to heat water;
- that the exclusion of solar energy in the Applicant's specifications was to reinforce this distinction;
- that the Opponent's interests are the utilisation of solar energy solely for heating, whereas the Applicant's interests are the utilisation of a variety of energy sources solely for electricity generation (one of which could be photo-voltaic);

- that “energy” and “power” are different technical terms;
- that after over four years of both companies trading, the Opponent has not provided any instances of confusion, and that the Applicant is only aware of one instance of confusion;
- that from the evidence provided, it is clear that the Applicant was trading prior to November 2000;
- that the reference to the Applicant’s website (exhibit RAFK4), again confirms that the two companies supply separate products in different sectors of the market.

## DECISION

21. The sole ground of opposition is based on section 5(2)(b) of the Act. This reads:

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

(a) ....

(b) it is similar to an earlier 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.”

An earlier right is defined in section 6 of the Act, the relevant parts of which state:

“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,”

In these proceedings, the Opponent relies on a single earlier trade mark, namely: Community trade mark No. 2352508 which has a filing date of 24 August 2001. The Applicant’s trade mark was filed on 2 March 2004. Consequently, the Opponent’s trade mark is an “earlier trade mark” as defined by Section 6(1) of the Act.

22. In reaching a decision I take into account the well established guidance provided by the European Court of Justice (ECJ) in: *Sabel BV v. Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Mayer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723.

It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors: *Sabel BV v. Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, 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; *Marca Mode CV v. Adidas AG + Adidas Benelux BV*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

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

## Comparison of marks

24. For the sake of convenience, the respective trade marks at issue in these proceedings are reproduced below:

### Opponent's trade mark:

**GENERSYS**

### Applicant's trade mark:

**GENASYS POWER SYSTEMS**

25. Ordinarily at this point in my decision, I would offer an analysis of the respective trade marks, comparing them from the visual, oral/aural and conceptual standpoints. I would also access the distinctive character of the Opponent's earlier trade mark, as this may enhance its distinctive character and in so doing widen the penumbra of protection. However, in this case, I do not think such a full analysis is necessary. Commenting briefly on the distinctive character of the Opponent's earlier trade mark, I note that the trade mark has been used since March 2001, with turnover and promotion in the period 2002-2004 amounting to some £1.1m and £500k respectively (although given the application date of 2 March 2004, not all of the 2004 turnover and promotion figures are eligible for consideration). That said, in my view, the trade mark GENERSYS is, in relation to the goods and services for which it is registered, an inherently distinctive trade per se, and it is doubtful that the use made of the trade mark from March 2001 to 2 March 2004 has enhanced the trade mark's distinctive character to any appreciable extent.

26. Turning to the trade marks themselves, I note that in paragraphs 1 and 2 of their counterstatement the Applicant comments, *inter alia*, as follows:

"1 It is claimed that the words "POWER SYSTEMS" are non distinctive and do not distinguish the Applicant's name from the Opponent. This is not so. Power systems are not casual pick up items from a DIY supermarket shelf or shop counter. They are specialised items of equipment and are almost invariably designed, i.e. engineered individually for a bespoke situation. In order to receive an appropriate design and quotation, an engineer from the potential purchaser must provide a detailed Tender Specification, defining the existing installation, including a statement of requirements..... Such a tender document would be prepared by a qualified and competent engineer skilled in his art e.g. a Chief Engineer or Senior Designer....it is inconceivable that he/she would confuse their relative technical competencies and services offered on the basis of GENASYS or GENERSYS.....

2. GENASYS and GENERSYS are visually and phonetically similar. True. However, the marks are presented in very different forms and colours. As stated above, power systems are not casual pick up items. One could imagine a harassed, busy mother mistaking, say a "Mans" bar for a "Mars" bar in the mass of items on a corner shop sweet counter but, as explained above, this could not happen on a highly technical subject."

27. From the above, it is clear that the Applicant accepts that GENERSYS and the GENASYS element of the Applicant's trade mark are visually and phonetically similar; this is, in my view, a

sensible concession and an assessment with which I agree. If support for this were needed, I would simply point out that these elements are seven and eight letters long respectively, both begin with the letters GEN and end with the letters SYS. In addition, in my view, the respective elements also share a conceptual similarity as they are, it would appear, both phonetic equivalents or phonetically very close to the well known dictionary word GENESIS. This phonetic misspelling is, in my view, likely to be kept in the average consumer's mind regardless of how circumspect and cautious they may be.

28. However, the Applicant then goes on to say that the respective trade marks are presented in different forms and colours. In their written submissions, the Opponent observes that both parties trade marks are word only trade marks with no figurative or colour element. This is of course correct, and it is on the basis of the Applicant's trade mark as applied for and the Opponent's trade mark as registered (and not the trade marks as used) that my comparison must be made. In so far as the POWER SYSTEMS element of the Applicant's trade mark is concerned, I share the Opponent's view of the matter. In relation to the services for which registration is sought, the words would, in my view, be perceived as purely descriptive. Consequent on that decision, it follows that I share the Opponent's view that the GENASYS element of the Applicant's trade mark is the distinctive and dominant element of the trade mark and the element by which the trade mark is likely to be referred to and remembered.

**In summary, I have concluded that the distinctive and dominant element of the Applicant's trade mark i.e. GENASYS is, to a high degree, similar to the Opponent's earlier trade mark, GENERSYS.**

**Comparison of goods and services**

29. A good deal of the Applicant's evidence and submissions are directed at distinguishing the services of the Applicant from the goods and services of the Opponent. These are as follows:

<b>Opponent's specifications</b>	<b>Applicant's specifications</b>
Class 9: Solar energy apparatus and installations; solar collectors; solar panels; parts and fittings for all the aforesaid goods.	Class 37: The installation and maintenance of electricity generating apparatus based on wind, water, hydro energy, diesel, liquefied gas and other hydrocarbon fuels, but none relating to solar energy.
Class 11: Solar energy powered heating apparatus and installations; solar energy powered air-conditioning apparatus and installations; solar collectors for heating; solar collectors for air-conditioning; solar panels for heating; solar panels for air-conditioning; parts and fittings for all the aforesaid goods.	Class 42: The design of electricity generating installations and parts and fittings for the aforesaid, based on wind, water, hydro, diesel, liquefied gas and other hydrocarbon fuels, but none relating to solar energy.
Class 42: Advisory and consultancy services in the field of solar energy; advisory and consultancy services in the field of solar energy-powered heating and air-conditioning.	

30. In determining whether the Opponent's goods and services are the same or similar to the Applicant's services, I am guided by the decision of the European Court of Justice in *Canon Kabushiki Kaisha and Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117. In that decision, the ECJ has given the following guidance when it comes to comparing goods (and services):

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

(see paragraph 56 of Case T-169/03 explaining the change from 'end consumers' to 'intended purpose'. This appears to have resulted from a mis-translation of the original text.)

31. In determining whether the goods and services covered by the Opponent's earlier trade mark are similar to the services covered by the Applicant's mark, I also bear in mind the guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 as set out below:

“[T]he following factors must be relevant in considering whether there is or is not similarity:

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

32. Whilst I accept that in view of the judgement of the ECJ in *Canon* the above case may no longer be wholly relied upon, the ECJ said the factors identified by the UK government in its submissions, which are those listed above, are still relevant in respect of the comparison.

33. The Opponent's trade mark is registered for a range of solar energy apparatus in Classes 9 and 11 and for advisory and consultancy services relating to solar energy in Class 42. The Applicant is seeking registration for installation, maintenance and design of electricity generating apparatus and installations in Classes 37 and 42. I note that the Applicant's specifications in both Classes contain the following wording: "but none relating to solar energy".

34. A plain reading of the Opponent's specification in Class 9 **as registered** (as opposed to the goods on which the mark may at present be used) provides them with rights in relation to, *inter alia*, solar collectors and solar panels for electricity generation. Applying the *Canon* and *Treat* criteria mentioned above, it appears that if it were not for the exclusion relating to solar energy present in the Applicant's specifications (to which I will return), the Applicant's services in Classes 37 and 42 would be considered complementary to the Opponent's goods, at the very least, in relation to the goods in Class 9. In addition, the services in Class 42 of the application would be identical, or if not identical highly similar, to the Opponent's services in Class 42. I reach this conclusion because, in my view, a potential purchaser of, for example, solar panels for electricity generation may reasonably assume that a company trading in such goods may also design, install and maintain the goods. As such, the users of the respective goods and services and their trade channels are likely to be similar.

35. So, do the exclusions assist the Applicant? In my view, they do not. A prospective purchaser requiring electricity generation equipment, for example, by renewable means, has a wide range of options from which to choose. For example, they have the wind, water, hydro energy, diesel, liquefied gas and other hydrocarbon fuels of the Applicant, or the solar energy of the Opponent. These technologies are both competitive and complementary. With that in mind, and having re-applied the *Canon* and *Treat* criteria to the totality of the Applicant's specifications, it appears to me that the Applicant's services in Classes 37 and 42 are still similar to the goods and services of the Opponent, at the very least, in so far as Classes 9 and 42 of the registration are concerned.

**In summary, I have concluded that the Opponent's goods and services are, at the very least in Classes 9 and 42 of the registration, still similar to the Applicant's services in Classes 37 and 42, notwithstanding the exclusion of solar energy.**

### **Likelihood of confusion**

36. In reaching a conclusion, I must apply the global approach advocated having assessed the degree of visual, oral/aural and conceptual similarity between the respective trade marks. I must keep in mind the degree of similarity between the specifications of goods and services for which the Opponent's trade mark is registered, and the services contained in the application. I must also keep in mind the traits of the average consumer of the goods and services in question. In this regard, I note that in their counterstatement the Applicant mentions the specialised nature of the consumer of Power Systems and also comments that there would be no confusion between the respective trade marks in the minds of anyone likely to purchase products from either organisation. The Opponent's position is that the average consumer is a member of the general public. Once again, I find myself agreeing with the Opponent. I see no reason why a member of the general public, a farmer perhaps, who has no technical understanding and who has electricity

generation requirements may not approach both the Applicant and the Opponent before reaching a conclusion between the competitive technologies available.

37. In so far as the Applicant cites only one instance of actual confusion, in what is described as the four or so years that the parties have been trading alongside each other, I note the comments of Millett LJ in *The European Limited v The Economist Newspaper Limited* [1998] FSR 283 when he said:

“..Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff’s registered trade mark..”

In addition, the issue of concurrent trading was dealt with by the Hearing Officer in *Codas Trade Mark* [2001] RPC 14. At paragraph 24, the Hearing Officer said, *inter alia*:

“...But in relation to section 5(2) the respective trade marks or respective specifications of goods or services may only be similar and the fact that there has been actual use of the trade mark in suit concurrently with the earlier trade mark, may be relevant in determining whether there is a likelihood of confusion.”

38. It is of course permissible for me to consider the fact of concurrent trading to inform my decision as to whether or not there is a likelihood of confusion. The application in suit was applied for on 2 March 2004. The Applicant began trading in June 2000 and the Opponent in March 2001. As such, there are only three years of concurrent trading for me to take into account. The Applicant’s turnover in that time has risen from £43k in 2001/02 to £181k in 2003/04, with promotion rising from £120 in 2001/02 to £1023 in 2003/04. In use, the Applicant’s trade mark is often presented in a slightly unusual type face and accompanied by a device element (see exhibits SJ4-7), although it is possible to find use of the trade mark in block capitals (see exhibits SJ2 and SJ3). In the period 2002-2004 the Opponent’s turnover has amounted to some £1.1m with £500k spent on promotion. Like the Applicant, on occasions, the Opponent’s mark is used together with a device element or elements (see, for example, exhibit RAFK2). Notwithstanding the use that has taken place, in my view, an insufficient amount of time has passed for me to be satisfied that the public have been exposed to the trade marks of the respective parties (in the form in which they are applied for and registered) and are able as a result of that exposure to distinguish between them. In fact, the instance of confusion mentioned in the Applicant’s evidence appears to point the other way.

39. Having considered all of these interdependent factors, I have concluded that: (i) there is a high degree of visual and oral/aural similarity between the Opponent’s trade mark and the distinctive and dominant element of the Applicant’s trade mark, (ii) that the respective trade marks share similar conceptual ideas and (iii) that the goods and services contained, particularly in Classes 9 and 42 of the Opponent’s earlier trade mark, are similar to the services contained in the application and (iv) that the length, extent and nature of the trade marks used during the period of concurrent trading is insufficient to inform my decision on the likelihood of confusion.

## **CONCLUSION**

40. Taking all of the above into consideration, and bearing in mind the well established principle of imperfect recollection, I have come to the clear conclusion that there would be a likelihood of confusion between the respective parties' trade marks and the opposition under Section 5(2)(b) of the Act succeeds accordingly.

## **COSTS**

41. The opposition having succeeded, the Opponent is entitled to a contribution towards their costs. I order the Applicant to pay to the Opponent the sum of £1200. This sum 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 8th day of November 2006**

**C J BOWEN**  
**For the Registrar**  
**The Comptroller-General**