

O/0066/25

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF TRADE MARK REGISTRATIONS UK00003713364,
UK00003713368 AND UK00003713369 IN THE NAME OF BANTI RAM

AND

APPLICATIONS 505670, 505671 AND 505672

BY HY-PRO INTERNATIONAL LIMITED FOR DECLARATIONS
THAT THE AFOREMENTIONED REGISTRATIONS ARE INVALID

Background and Pleadings

1. Banti Ram is the Registered Proprietor ('the RP') of the following three trade mark registrations ('the Contested Marks'), all of which have a filing date of 22 October 2021:

i) UK00003713364

ZIMX

Date of entry in register: 27 May 2022

The mark stands registered for a variety of goods and services in classes 9, 12, 28 and 35.¹ Invalidation is sought in respect of the following only:

Class 9:

Protective helmets; bicycle helmets; hover board helmets; helmets for electric scooters; helmets for self-balancing two-wheeled motorised personal transporters with handle bars; consoles; chin straps for bicycle helmets; trunks for bicycle helmets; cases, housings, and accessories for bicycle helmets; mounting devices for bicycle helmets for attaching electronic devices for recording, storage, transmission of sound, images and data; mounting devices for bicycle helmets for attaching cameras, lights, direction indicators, sports glasses and air pumps; mounting devices for bicycle helmets for attaching energy food, energy drinks and water bottles; safety lights mounted on bicycle helmets; display apparatus mounted on bicycle helmets; spectacle glasses; sports glasses; data processing apparatus and computers for bicycles, scooters, self-balancing two-wheeled motorised personal transporters with handle bars, hover boards; communication systems mounted on bicycle helmets; protective equipment for cyclists, including helmets; protective equipment for cyclists, including vests, jackets, jerseys, pants, gloves, shorts, footwear, clothing for protection against accident

¹ The full specification can be found at: [Search for a trade mark - Intellectual Property Office \(ipo.gov.uk\)](https://www.ipo.gov.uk)

Class 12:

Apparatus for locomotion by land or air; Bikes; Electric bikes; Bike and scooter wheels; Scooters; Scooters [for transportation]; Scooters [vehicles]; Electric one wheel scooters; Electrically operated scooters; Electrically powered scooters; Electrically powered scooters [vehicles]; Electrically-powered motor scooters; Motorized scooters; Self balancing electric scooters; Self-balancing one-wheeled electric scooters; Self-balancing two-wheeled electric scooters; Spare wheels for vehicles; Wheels; Wheels (Spoke clips for -); Wheels (Vehicle -); Wheels for motor vehicles; Wheels for vehicles; Vehicle wheels; Remote control vehicles, other than toys; Electric self-balancing boards; hover boards; Electric hover boards; self-balancing two-wheeled motorised personal transporters without handlebars; self-balancing two-wheeled motorised personal transporters with handle bars; Saddle covers for bicycles or motorcycles; Handlebars for bicycles; Direction indicators for bicycles; Air pumps for bicycles; Water bottle holders for bicycles; Replacement parts and accessories for vehicles, in particular for scooters, e-scooters, electric scooters; electric hover boards; electric scooters; electric unicycles; accessories for electric vehicles, scooters, electric scooters and bicycles, self-balancing two-wheeled motorised personal transporters with handle bars and hover boards; parts for electric hover boards, namely wheels, tyres, frames and mudguards; self-balancing one-wheeled motorised personal transporters; electric self-balancing hover boards; non-motorised attachable and detachable seat, handles and single wheel apparatus for hover boards; electric scooters, electric kick scooters; electric bicycles; electric motorbikes; Parts and fittings for the aforesaid vehicles and devices; electric self-balancing two-wheeled motorised personal transporters with handle bars; electric self-balancing two-wheeled motorised personal transporters without handle bars.

Class 28:

Toys and playthings; games; sporting articles; gym equipment; sports equipment; balance boards [gymnastic and sporting articles]; skateboards; electric skateboards; electric surfboards; skateboard wheels; skateboard decks; elbow, knee, shin and leg guards (sporting articles); bags adapted for

skateboards; electric skateboards; four wheel electric skateboard; Christmas decorations; electric skateboards; Skateboards; parts and fittings for all the aforesaid goods.

Class 35:

Online retail, retail and wholesale services, all in relation to the sale of electric self-balancing two-wheeled motorised personal transporters with handle bars electric hover boards, electric scooters, accessories for electric vehicles, scooters, electric scooters and bicycles, self-balancing two-wheeled motorised personal transporters with handle bars and hover boards, chargers, electric unicycles, self-balancing one-wheeled motorised personal transporters, electric skateboards, electric self-balancing two-wheeled motorised personal transporters with handle bars, electric hover boards, namely wheels, tyres, frames and mudguard, protective helmets, bicycle helmets, hover board helmets, helmets for electric scooters, helmets for self-balancing two-wheeled motorised personal transporters with handle bars, consoles, chin straps for bicycle helmets, trunks for bicycle helmets, cases, housings, and accessories for bicycle helmets, mounting devices for bicycle helmets for attaching electronic devices for recording, storage, transmission of sound, images and data, mounting devices for bicycle helmets for attaching cameras, lights, direction indicators, sports glasses and air pumps, mounting devices for bicycle helmets for attaching energy food, energy drinks and water bottles, safety lights mounted on bicycle helmets, display apparatus mounted on bicycle helmets, spectacle glasses, sports glasses, data processing apparatus and computers for bicycles, scooters, self-balancing two-wheeled motorised personal transporters with handle bars, hover boards, communication systems mounted on bicycle helmets, protective equipment for cyclists, including helmets, non-motorised attachable and detachable seat, handles and single wheel apparatus for hover boards, protective equipment for cyclists, including vests, jackets, jerseys, pants, gloves, shorts, footwear, clothing for protection against accident, headsets, audio-visual headsets for playing video games, virtual reality headsets adapted for use in playing video games, keyboards, mobile phone cases, accessories for mobile phones, accessories for computers, cases for computers, apparatus for

locomotion by land or air, Bikes, Electric bikes, Bike and scooter wheels, Scooters, Scooters [for transportation], Scooters [vehicles], Electric one wheel scooters, Electrically operated scooters, Electrically powered scooters, Electrically powered scooters [vehicles], Electrically-powered motor scooters, Motorized scooters, Self balancing electric scooters, Self-balancing one-wheeled electric scooters, Self-balancing two-wheeled electric scooters, Spare wheels for vehicles, Wheels, Wheels (Spoke clips for -), Wheels (Vehicle -), Wheels for motor vehicles, Wheels for vehicles, Vehicle wheels, Remote control vehicles, other than toys, Electric self-balancing boards, hover boards, Electric hover boards, self-balancing two-wheeled motorised personal transporters without handlebars, self-balancing two-wheeled motorised personal transporters with handle bars, Skateboards, Electric Skateboards, Saddle covers for bicycles or motorcycles, Handlebars for bicycles, Direction indicators for bicycles, Air pumps for bicycles, Water bottle holders for bicycles, Replacement parts and accessories for vehicles, in particular for scooters, e-scooters, electric scooters, Parts and fittings for the aforesaid vehicles and devices, toys and playthings, games, sporting articles, gym equipment, sports equipment, balance boards [gymnastic and sporting articles], skateboards, electric skateboards, electric self-balancing hover boards, electric surfboards, skateboard wheels, skateboard decks, elbow, knee, shin and leg guards (sporting articles), bags adapted for skateboards, electric scooters, electric kick scooters, electric bicycles, electric skateboards and electric motorbikes, four wheel electric skateboard, parts and fittings for all the aforesaid goods.

ii) UK00003713368

ZIMX
H O V E R B O A R D S
W I T H A T T I T U D E

Date of entry in register: 4 March 2022

The mark stands registered for a variety of G&S in classes 9, 12, 28 and 35.²

Invalidation is sought in respect of the following only:

Class 9:

Protective helmets; bicycle helmets; hover board helmets; helmets for electric scooters; helmets for self-balancing two-wheeled motorised personal transporters with handle bars; consoles; chin straps for bicycle helmets; trunks for bicycle helmets; cases, housings, and accessories for bicycle helmets; mounting devices for bicycle helmets for attaching electronic devices for recording, storage, transmission of sound, images and data; mounting devices for bicycle helmets for attaching cameras, lights, direction indicators, sports glasses and air pumps; mounting devices for bicycle helmets for attaching energy food, energy drinks and water bottles; safety lights mounted on bicycle helmets; display apparatus mounted on bicycle helmets; spectacle glasses; sports glasses; data processing apparatus and computers for bicycles, scooters, self-balancing two-wheeled motorised personal transporters with handle bars, hover boards; communication systems mounted on bicycle helmets; protective equipment for cyclists, including helmets; protective equipment for cyclists, including vests, jackets, jerseys, pants, gloves, shorts, footwear, clothing for protection against accident.

Class 12:

Apparatus for locomotion by land or air; Bikes; Electric bikes; Bike and scooter wheels; Scooters; Scooters [for transportation]; Scooters [vehicles]; Electric one wheel scooters; Electrically operated scooters; Electrically powered scooters; Electrically powered scooters [vehicles]; Electrically-powered motor scooters; Motorized scooters; Self balancing electric scooters; Self-balancing one-wheeled electric scooters; Self-balancing two-wheeled electric scooters; Spare wheels for vehicles; Wheels; Wheels (Spoke clips for -); Wheels (Vehicle -); Wheels for motor vehicles; Wheels for vehicles; Vehicle wheels; Remote control vehicles, other than toys; Electric self-balancing boards; hover boards; Electric hover boards; self-balancing two-wheeled motorised personal transporters

² The full specification can be found at: [Search for a trade mark - Intellectual Property Office \(ipo.gov.uk\)](https://www.ipo.gov.uk)

without handlebars; self-balancing two-wheeled motorised personal transporters with handle bars; Skateboards; Saddle covers for bicycles or motorcycles; Handlebars for bicycles; Direction indicators for bicycles; Air pumps for bicycles; Water bottle holders for bicycles; Replacement parts and accessories for vehicles, in particular for scooters, e-scooters, electric scooters; electric hover boards; parts for electric hover boards, namely wheels, tyres, frames and mudguards; electric scooters; accessories for electric vehicles, scooters, electric scooters and bicycles, self-balancing two-wheeled motorised personal transporters with handle bars and hover boards; electric unicycles; self-balancing one-wheeled motorised personal transporters; electric self-balancing hover boards; non-motorised attachable and detachable seat, handles and single wheel apparatus for hover boards; electric scooters, electric kick scooters, electric bicycles; electric motorbikes; Parts and fittings for the aforesaid vehicles and devices; electric self-balancing two-wheeled motorised personal transporters with handle bars.

Class 28:

Toys and playthings; games; sporting articles; gym equipment; sports equipment; balance boards [gymnastic and sporting articles]; skateboards; electric skateboards; electric surfboards; skateboard wheels; skateboard decks; elbow, knee, shin and leg guards (sporting articles); bags adapted for skateboards; electric skateboards; four wheel electric skateboard; parts and fittings for all the aforesaid goods.

Class 35:

online retail, retail and wholesale services, all in relation to the sale of electric self-balancing two-wheeled motorised personal transporters with handle bars, electric hover boards, electric scooters, accessories for electric vehicles, scooters, electric scooters and bicycles, self-balancing two-wheeled motorised personal transporters with handle bars and hover boards, chargers, electric unicycles, electric gyro wheels, electric skateboards, electric self-balancing two-wheeled motorised personal transporters with handle bars, electric hover boards, namely wheels, tyres, frames and mudguard, protective helmets, bicycle helmets, hover board helmets, helmets for electric scooters, helmets for self-

balancing two-wheeled motorised personal transporters with handle bars , consoles, chin straps for bicycle helmets, trunks for bicycle helmets, cases, housings, and accessories for bicycle helmets, mounting devices for bicycle helmets for attaching electronic devices for recording, storage, transmission of sound, images and data, mounting devices for bicycle helmets for attaching cameras, lights, direction indicators, sports glasses and air pumps, mounting devices for bicycle helmets for attaching energy food, energy drinks and water bottles, safety lights mounted on bicycle helmets, display apparatus mounted on bicycle helmets, spectacle glasses, sports glasses, data processing apparatus and computers for bicycles, scooters, self-balancing two-wheeled motorised personal transporters with handle bars, hover boards, communication systems mounted on bicycle helmets, protective equipment for cyclists, including helmets, protective equipment for cyclists, including vests, jackets, jerseys, pants, gloves, shorts, footwear, clothing for protection against accident, apparatus for locomotion by land or air, Bikes, Electric bikes, Bike and scooter wheels, Scooters, Scooters [for transportation], Scooters [vehicles], Electric one wheel scooters, Electrically operated scooters, Electrically powered scooters, Electrically powered scooters [vehicles], Electrically-powered motor scooters, Motorized scooters, Self balancing electric scooters, Self-balancing one-wheeled electric scooters, Self-balancing two-wheeled electric scooters, Spare wheels for vehicles, Wheels, Wheels (Spoke clips for -), Wheels (Vehicle -), Wheels for motor vehicles, Wheels for vehicles, Vehicle wheels, Remote control vehicles, other than toys, Electric self-balancing boards, hover boards, Electric hover boards, self-balancing two-wheeled motorised personal transporters without handlebars, self-balancing two-wheeled motorised personal transporters with handle bars, Skateboards, Electric Skateboards, Saddle covers for bicycles or motorcycles, Handlebars for bicycles, Direction indicators for bicycles, Air pumps for bicycles, Water bottle holders for bicycles, Replacement parts and accessories for vehicles, in particular for scooters, e-scooters, electric scooters, Parts and fittings for the aforesaid vehicles and devices, toys and playthings, games, sporting articles, gym equipment, sports equipment, balance boards [gymnastic and sporting articles], skateboards, electric skateboards, electric self-balancing hover boards, electric surfboards, hoverkarts, skateboard

wheels, skateboard decks, elbow, knee, shin and leg guards (sporting articles), bags adapted for skateboards, electric scooters, electric kick scooters, electric bicycles, electric skateboards and electric motorbikes, four wheel electric skateboard, motorised, electric, gyroscope, self-propelled, self-balancing skateboards, parts and fittings for all the aforesaid goods.

iii) UK00003713369

ZIMX

Date of entry in register: 27 May 2022

The mark stands registered for a variety of G&S in classes 9, 12, 28 and 35.³
Invalidation is sought in respect of the following only:

Class 9:

Protective helmets; bicycle helmets; hover board helmets; helmets for electric scooters; helmets for self-balancing two-wheeled motorised personal transporters with handle bars ; consoles; chin straps for bicycle helmets; trunks for bicycle helmets; cases, housings, and accessories for bicycle helmets; mounting devices for bicycle helmets for attaching electronic devices for recording, storage, transmission of sound, images and data; mounting devices for bicycle helmets for attaching cameras, lights, direction indicators, sports glasses and air pumps; mounting devices for bicycle helmets for attaching energy food, energy drinks and water bottles; safety lights mounted on bicycle helmets; display apparatus mounted on bicycle helmets; spectacle glasses; sports glasses; data processing apparatus and computers for bicycles, scooters, self-balancing two-wheeled motorised personal transporters with handle bars, hover boards; communication systems mounted on bicycle helmets; protective equipment for cyclists, including helmets; protective equipment for cyclists,

³ The full specification can be found at: [Search for a trade mark - Intellectual Property Office \(ipo.gov.uk\)](https://www.ipo.gov.uk)

including vests, jackets, jerseys, pants, gloves, shorts, footwear, clothing for protection against accident

Class 12:

Apparatus for locomotion by land or air; Bikes; Electric bikes; Bike and scooter wheels; Scooters; Scooters [for transportation]; Scooters [vehicles]; Electric one wheel scooters; Electrically operated scooters; Electrically powered scooters; Electrically powered scooters [vehicles]; Electrically-powered motor scooters; Motorized scooters; Self balancing electric scooters; Self-balancing one-wheeled electric scooters; Self-balancing two-wheeled electric scooters; Spare wheels for vehicles; Wheels; Wheels (Spoke clips for -); Wheels (Vehicle -); Wheels for motor vehicles; Wheels for vehicles; Vehicle wheels; Remote control vehicles, other than toys; Electric self-balancing boards; hover boards; Electric hover boards; self-balancing two-wheeled motorised personal transporters without handlebars; self-balancing two-wheeled motorised personal transporters with handle bars; Saddle covers for bicycles or motorcycles; Handlebars for bicycles; Direction indicators for bicycles; Air pumps for bicycles; Water bottle holders for bicycles; Replacement parts and accessories for vehicles, in particular for scooters, e-scooters, electric scooters; electric hover boards; electric scooters; electric unicycles; accessories for electric vehicles, scooters, electric scooters and bicycles, self-balancing two-wheeled motorised personal transporters with handle bars and hover boards; parts for electric hover boards, namely wheels, tyres, frames and mudguards; self-balancing one-wheeled motorised personal transporters; electric self-balancing hover boards; non-motorised attachable and detachable seat, handles and single wheel apparatus for hover boards; electric scooters, electric kick scooters; electric bicycles; electric motorbikes; Parts and fittings for the aforesaid vehicles and devices; electric self-balancing two-wheeled motorised personal transporters with handle bars; electric self-balancing two-wheeled motorised personal transporters without handle bars.

Class 28:

Toys and playthings; games; sporting articles; gym equipment; sports equipment; balance boards [gymnastic and sporting articles]; skateboards; electric skateboards; electric surfboards; ; skateboard wheels; skateboard decks; elbow, knee, shin and leg guards (sporting articles); bags adapted for skateboards; electric skateboards; four wheel electric skateboard; parts and fittings for all the aforesaid goods.

Class 35:

Online retail, retail and wholesale services, all in relation to the sale of electric self-balancing two-wheeled motorised personal transporters with handle bars, electric hover boards, electric scooters, accessories for electric vehicles, scooters, electric scooters and bicycles, self-balancing two-wheeled motorised personal transporters with handle bars and hover boards, chargers, electric unicycles, self-balancing one-wheeled motorised personal transporters, electric skateboards, electric self-balancing two-wheeled motorised personal transporters with handle bars, electric hover boards, namely wheels, tyres, frames and mudguard, protective helmets, bicycle helmets, hover board helmets helmets for electric scooters, helmets for self-balancing two-wheeled motorised personal transporters with handle bars , consoles, chin straps for bicycle helmets, trunks for bicycle helmets, cases, housings, and accessories for bicycle helmets, mounting devices for bicycle helmets for attaching electronic devices for recording, storage, transmission of sound, images and data, mounting devices for bicycle helmets for attaching cameras, lights, direction indicators, sports glasses and air pumps, mounting devices for bicycle helmets for attaching energy food, energy drinks and water bottles, safety lights mounted on bicycle helmets, display apparatus mounted on bicycle helmets, spectacle glasses, sports glasses, data processing apparatus and computers for bicycles, scooters, self-balancing two-wheeled motorised personal transporters with handle bars, hover boards, communication systems mounted on bicycle helmets, protective equipment for cyclists, including helmets, protective equipment for cyclists, including vests, jackets, jerseys, pants, gloves, shorts, footwear, clothing for protection against accident, headsets, audio-visual headsets for playing video games, virtual reality headsets adapted for use in playing video games,

keyboards, mobile phone cases, accessories for mobile phones, accessories for computers, cases for computers, apparatus for locomotion by land or air, Bikes, Electric bikes, Bike and scooter wheels, Scooters, Scooters [for transportation], Scooters [vehicles], Electric one wheel scooters, Electrically operated scooters, Electrically powered scooters, Electrically powered scooters [vehicles], Electrically-powered motor scooters, Motorized scooters, Self balancing electric scooters, Self-balancing one-wheeled electric scooters, Self-balancing two-wheeled electric scooters, Spare wheels for vehicles, Wheels, Wheels (Spoke clips for -), Wheels (Vehicle -), Wheels for motor vehicles, Wheels for vehicles, Vehicle wheels, Remote control vehicles, other than toys, Electric self-balancing boards, hover boards, Electric hover boards, self-balancing two-wheeled motorised personal transporters without handlebars, self-balancing two-wheeled motorised personal transporters with handle bars, Skateboards, Electric Skateboards, Saddle covers for bicycles or motorcycles, Handlebars for bicycles Direction indicators for bicycles, Air pumps for bicycles, Water bottle holders for bicycles, Replacement parts and accessories for vehicles, in particular for scooters, e-scooters, electric scooters, Parts and fittings for the aforesaid vehicles and devices, toys and playthings, games, sporting articles, gym equipment, sports equipment, balance boards [gymnastic and sporting articles], skateboards, electric skateboards, electric self-balancing hover boards, electric surfboards, non-motorised attachable and detachable seat, handles and single wheel apparatus for hover boards, skateboard wheels, skateboard decks, elbow, knee, shin and leg guards (sporting articles), bags adapted for skateboards, electric scooters, electric kick scooters, electric bicycles, electric skateboards and electric motorbikes, four wheel electric skateboard, parts and fittings for all the aforesaid goods

2. The specifications for the Contested Marks are largely identical, but I have set out each for the sake of completeness. One difference, by way of example, is the presence of the Class 12 term *electric self-balancing two-wheeled motorised personal transporters without handle bars* in two of the specifications, while absent from the remaining specification. It will be seen that the differences between the

RP's specifications are such that they make no material difference to the outcome of the comparison of the parties' goods/services.

3. On 22 December 2022, Hy-Pro International Limited, the Cancellation Applicant ('the CA') applied to invalidate the RP's registrations, pursuant to sections 47(2)(a) and 5(2)(b) of the Trade Marks Act 1994 ('the Act'). The requests for invalidation (CA505670, CA505671 and CA505672, respectively) are directed against some of the goods and services for which the Contested Marks are registered (as set out above). The CA relies upon the following earlier registration in all three actions:

UK00911581221

ZINC

This mark is a comparable mark pursuant to Article 54 of the Withdrawal Agreement, based on an EUTM which was filed on 18 February 2013.

Filing date: 18 February 2013

Date of entry in register: 28 June 2013

Registered for a variety of goods and services in classes 9, 12, 25 and 28, the following of which are relied upon:⁴

Class 9:

Sports helmets; protective helmets; sports glasses; protective glasses; sports goggles; parts and fittings for the aforesaid goods.

Class 12:

Apparatus for locomotion by land; bicycles, BMX bikes; bicycle pumps; scooters, scooters for children, scooters for adults, pedal scooters, motorised scooters, electrically powered scooters, scooters for commuting; gliders; parts and fittings for the aforesaid goods.

⁴ The full specification can be found at: [Search for a trade mark - Intellectual Property Office \(ipo.gov.uk\)](https://www.ipo.gov.uk)

Class 28:

Skate boards; skates, in-line skates, roller skates, roller blades, gliders (playthings); childrens' toy bicycles; toy scooters; protective padding for sports; athletic protective arm pads for cycling, skating and skateboarding; athletic protective elbow pads for cycling, skating and skateboarding; athletic protective knee pads for cycling, skating and skateboarding; parts and fittings for the aforesaid goods.

4. The CA's pleading is essentially the same for each invalidation action: that the parties' marks are similar and for identical/similar goods and services, thus leading to a likelihood of confusion.
5. The RP filed Defences and Counterstatements for all three invalidation actions, denying the claims against them in their entirety.
6. The CA is represented by Dolleymores. The RP is represented by Trade Mark Wizards Limited.
7. Both parties filed evidence. A hearing was granted at the request of the RP. Skeleton arguments were filed by both parties in advance of the hearing, held on 12 March 2024. Ms Kathryn Pickard, of Counsel, 11 South Square, appeared for the CA. Ms Kendal Watkinson, of Counsel, Hogarth Chambers, appeared for the RP. The following decision has been made after careful consideration of the papers and oral submissions.
8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

9. The CA has filed three Witness Statements:
 - i. Witness Statement of Atul Shah, Director of the CA, dated 14 June 2023;
 - ii. Witness Statement of Chirag Rohitbhai Shah, Commercial Director of the CA, dated 2 November 2023;
 - iii. Witness Statement of Victoria Bennett, Partner and Trade Mark Attorney of the CA's legal representative, dated 3 November 2023.

10. Mr Atul Shah's Witness Statement is accompanied by six exhibits: 1 to 6. Mr Shah's evidence concerns the history of the CA and its activity in respect of the earlier mark. This evidence is intended to support the CA's argument that its mark enjoys an enhanced level of distinctiveness by virtue of the use that has been made of it.⁵

11. The Witness Statements of Mr Chirag Shah and Ms Victoria Bennett are in reply to the RP's evidence (which is referred to below at [12]).

12. The RP has filed a Witness Statement from the RP himself, dated 4 September 2023, accompanied by two exhibits: BR1 and BR2. The RP's evidence concerns the genesis and history of the Contested Marks, and trading activity in respect thereof.

13. I will refer to points from the evidence and oral submissions where necessary.

DECISION

The relevant legislation

14. Section 47 of the Act states as follows:

'47. (1) [...]

⁵ CA's Skeleton Argument, [5] and [30].

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) ...

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

(2ZA) [...]

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

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

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

(c) the use conditions are met.

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

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

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

15. Section 5(2)(b) of the Act states:

'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.'

Earlier mark

16. In accordance with section 6 of the Act, the CA's mark is an earlier mark by virtue of its filing date, which fell before the filing dates of the respective contested registrations.

Proof of use

17. In the instant case, the earlier mark had been registered for more than five years before the filing dates of the Contested Marks. The use provisions set out in section 47 of the Act are therefore engaged. The CA has stated that it has used its marks for all of the goods/services relied upon; and the RP subsequently requested proof of such.⁶ In invalidation proceedings, there are two relevant periods in which use is required to be shown. The first is the five years ending with the date of application for invalidation, i.e. 23 December 2017 – 22 December 2022. The second is the five years ending with the date of application for the contested marks, i.e. 23 October 2016 – 22 October 2021. However, during the hearing, the RP conceded that the CA had made genuine use of the earlier mark in respect of all of the terms

⁶ Defence and Counterstatements (Form TM8), at [7].

upon which it seeks to rely. Consequently, the CA may rely upon all of its terms as pleaded in its statement of use.⁷

Section 5(2)(b) case law

18. The following principles are derived from the decisions of the Court of Justice of the European Union (CJEU) in *Sabel BV v Puma AG*, Case C-251/95; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97; *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98; *Matratzen Concord GmbH v OHIM*, Case C-3/03; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C120/04; *Shake di L. Laudato & C. Sas v OHIM*, Case C-334/05P; and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

⁷ Application to declare invalid a registration or a protected international trade mark (UK) (Form TM26(I)), section A, at [Q2].

components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

Comparison of goods and services

19. 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.

20. The CJEU in *Canon*, Case C-39/97, stipulates that all relevant factors relating to the parties' goods and services must be taken into account:

'[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, their intended purpose and their method of use and whether they are in competition with each other or are complementary'.

21. Goods or services will be found to be in a competitive relationship only where one is substitutable for the other.⁸ In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court described "complementary" in the following terms: "[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".⁹ In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods.

⁸ *Lidl Stiftung & Co KG v EUIPO*, Case T-549/14.

⁹ Paragraph 82

22. Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281¹⁰, identified the following factors for assessing similarity of the respective 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 physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and, in particular, whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

23. Goods (or services) may be grouped together for the purposes of assessment, as Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, said in *Separode Trade Mark* BL O-399-10:

‘The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.’

24. Case law establishes that “... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise” but “Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the

¹⁰ *British Sugar Plc v James Robertson & Sons Ltd* [1996] R. P. C. 281, pp 296-297.

language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”¹¹

25. The CA has provided a table setting out its comparisons of the parties’ respective offerings.¹² Ms Pickard identified the particular points of identity and similarity in her oral submissions. It is convenient to set out the CA’s case in the table following this paragraph.¹³ The RP has made a number of concessions to the extent that it accepts that the terms that I have marked in emboldened text are identical (whether frankly identical; synonymous; or identical per *Meric*) and/or similar to the CA’s goods/services. It is appropriate at this point to deal with Ms Watkinson’s argument that the CA is not relying on the class 12 goods ‘hoverboards’ or ‘self-balancing two-wheeled motorised personal transporters’ in its specification and that those goods have not been pleaded.¹⁴ I respectfully disagree on the grounds that this is inconsistent with the RP’s concession that the CA has made genuine use of its earlier mark in respect of the broad class 12 term *Apparatus for locomotion by land or air*, which encompasses ‘hoverboards’ and self-balancing two-wheeled motorised personal transporters’ by way of *Meric*. In the light of the RP’s concession, it is not open to it to argue that already conceded terms are to be narrowed. The terms that are not emboldened in the following table are still in dispute.

Earlier Mark:	The Contested Marks:
Class 9	
<i>Sports helmets;</i>	<i>bicycle helmets; hover board helmets; helmets for electric scooters; helmets for self-balancing two-wheeled motorised personal transporters with handle bars;</i> [identical].
<i>protective helmets;</i>	<i>Protective helmets</i> [identical].

¹¹ *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch).

¹² CA’s Skeleton Argument, Annexe 2.

¹³ This is based on the CA’s table, which I have then refined to incorporate Ms Pickard’s oral submissions.

¹⁴ RP’s Skeleton Argument, [24].

<p><i>parts and fittings for the aforesaid goods</i></p>	<p><i>protective equipment for cyclists, including vests, jackets, jerseys, pants, gloves, shorts, footwear, clothing for protection against accident [similar, albeit the CA has not indicated to what degree]</i></p> <p><i>chin straps for bicycle helmets; trunks for bicycle helmets; cases, housings, and accessories for bicycle helmets; mounting devices for bicycle helmets for attaching electronic devices for recording, storage, transmission of sound, images and data; mounting devices for bicycle helmets for attaching cameras, lights, direction indicators, sports glasses and air pumps; mounting devices for bicycle helmets for attaching energy food, energy drinks and water bottles; safety lights mounted on bicycle helmets; display apparatus mounted on bicycle helmets [identical].</i></p> <p><i>Consoles; spectacle glasses; sports glasses</i> [similar, albeit the CA has not indicated to what degree]</p> <p><i>data processing apparatus and computers for bicycles, scooters, self-balancing two-wheeled motorised personal transporters with handle bars, hover boards [similar, albeit the CA has not indicated to what degree]</i></p> <p><i>communication systems mounted on bicycle helmets [identical or similar]</i></p> <p><i>protective equipment for cyclists, including helmets [identical]</i></p>
<p>Class 12</p>	

<p><i>Apparatus for locomotion by land</i></p>	<p>Apparatus for locomotion by land or air [identical]</p> <p>Bikes; Electric bikes; Scooters; Scooters [for transportation]; Scooters [vehicles]; Electric one wheel scooters; Electrically operated scooters; Electrically powered scooters; Electrically powered scooters [vehicles]; Electrically-powered motor scooters; Motorized scooters; Self balancing electric scooters; Self-balancing one-wheeled electric scooters; Self-balancing two-wheeled electric scooters; Electric self-balancing boards; hoverboards; Electric hover boards; self-balancing two-wheeled motorised personal transporters without handlebars; self-balancing two-wheeled motorised personal transporters with handle bars; electric hover boards; electric scooters; electric unicycles; self-balancing one-wheeled motorised personal transporters; electric self-balancing hover boards; electric bicycles; electric motorbikes; electric self-balancing two-wheeled motorised personal transporters with handle bars; electric self-balancing two-wheeled motorised personal transporters without handle bars. [identical].</p> <p>Remote control vehicles, other than toys; [similar, albeit the CA has not indicated to what degree]</p>
<p><i>Bicycles, BMX bikes</i></p>	<p>Bikes; Electric bikes;¹⁵ electric bicycles; electric motorbikes [identical]</p>
<p><i>Bicycle pumps</i></p>	<p>Air pumps for bicycles [identical]</p>
<p><i>Scooters, scooters for children, scooters for adults, pedal scooters,</i></p>	<p>[Scooters; Scooters [for transportation]; Scooters [vehicles]; Electric one wheel scooters; Electrically operated scooters; Electrically powered scooters; Electrically powered scooters [vehicles]; Electrically-powered</p>

¹⁵ These also appear earlier in the CA's table because it has submitted that these are also identical to *apparatus for locomotion by land*.

<p><i>motorised scooters, electrically powered scooters, scooters for commuting; gliders</i></p>	<p>motor scooters; Motorized scooters; Self balancing electric scooters; Self-balancing one-wheeled electric scooters; Self-balancing two-wheeled electric scooters;]¹⁶ <i>electric scooters, electric kick scooters</i> [identical].</p>
<p><i>Parts and fittings for the aforesaid goods</i></p>	<p>Bike and scooter wheels; Spare wheels for vehicles; Wheels; Wheels (Spoke clips for -); Wheels (Vehicle -); Wheels for motor vehicles; Wheels for vehicles; Vehicle wheels; Saddle covers for bicycles or motorcycles; Handlebars for bicycles; Direction indicators for bicycles; Water bottle holders for bicycles; Replacement parts and accessories for vehicles, in particular for scooters, e-scooters, electric scooters; accessories for electric vehicles, scooters, electric scooters and bicycles, self-balancing two-wheeled motorised personal transporters with handle bars and hover boards; parts for electric hover boards, namely wheels, tyres, frames and mudguards; non-motorised attachable and detachable seat, handles and single wheel apparatus for hover boards; electric self-balancing two-wheeled motorised personal transporters with handle bars; electric self-balancing two-wheeled motorised personal transporters without handle bars; Parts and fittings for the aforesaid vehicles and Devices [identical].</p>
<p>Class 28</p>	
<p><i>Skate boards; skates, in-line skates, roller skates, roller</i></p>	<p>Toys and playthings; <i>games; sporting articles; gym equipment; sports equipment; balance boards; [gymnastic and sporting articles]; skateboards; electric</i></p>

¹⁶ As above.

<p><i>blades, gliders (playthings); childrens' toy bicycles; toy scooters</i></p>	<p>skateboards; electric surfboards; electric skateboards; four wheel electric skateboard; electric skateboards; Skateboards. [identical].</p>
<p><i>protective padding for sports; athletic protective arm pads for cycling, skating and skateboarding; athletic protective elbow pads for cycling, skating and skateboarding; athletic protective knee pads for cycling, skating and skateboarding</i></p>	<p>elbow, knee, shin and leg guards (sporting articles) [identical]</p>
<p><i>parts and fittings for the aforesaid goods.</i></p>	<p>skateboard wheels; skateboard decks; bags adapted for skateboards; parts and fittings for all the aforesaid goods [identical].</p>
<p>Class 35</p>	
<p>The goods under the earlier registration to which the contested retail services relate.</p>	<p>Online retail, retail and wholesale services, all in relation to the sale of electric self-balancing two- wheeled motorised personal transporters with handle bars electric hover boards, electric scooters, accessories for electric vehicles, scooters, electric scooters and bicycles, self-balancing two-wheeled motorised personal transporters with handle bars and hover boards, chargers, electric unicycles, self- balancing one-wheeled motorised personal</p>

transporters, **electric skateboards**, electric self-balancing two-wheeled motorised personal transporters with handle bars, electric hover boards, namely wheels, tyres, frames and mudguard, **protective helmets, bicycle helmets, hover board helmets, helmets for electric scooters, helmets for self-balancing two-wheeled motorised personal transporters with handle bars, consoles, chin straps for bicycle helmets, trunks for bicycle helmets, cases, housings, and accessories for bicycle helmets, mounting devices for bicycle helmets for attaching electronic devices for recording, storage, transmission of sound, images and data, mounting devices for bicycle helmets for attaching cameras, lights, direction indicators, sports glasses and air pumps, mounting devices for bicycle helmets for attaching energy food, energy drinks and water bottles, safety lights mounted on bicycle helmets, display apparatus mounted on bicycle helmets, spectacle glasses, sports glasses, data processing apparatus and computers for bicycles, scooters, self-balancing two-wheeled motorised personal transporters with handle bars, hover boards, communication systems mounted on bicycle helmets, protective equipment for cyclists, including helmets, non-motorised attachable and detachable seat, handles and single wheel apparatus for hover boards, protective equipment for cyclists, including vests, jackets, jerseys, pants, gloves, shorts, footwear, clothing for protection against accident, apparatus for locomotion by land or air, Bikes, Electric bikes, Bike and scooter wheels, Scooters, Scooters [for transportation], Scooters [vehicles], Electric one wheel scooters, Electrically operated scooters, Electrically powered scooters, Electrically powered scooters**

	<p><i>[vehicles], Electrically-powered motor scooters, Motorized scooters, Self balancing electric scooters, Self- balancing one-wheeled electric scooters, Self-balancing two-wheeled electric scooters, Spare wheels for vehicles, Wheels, Wheels (Spoke clips for -), Wheels (Vehicle -), Wheels for motor vehicles, Wheels for vehicles, Vehicle wheels, Remote control vehicles, other than toys, Electric self-balancing boards, hover boards, Electric hover boards, self-balancing two-wheeled motorised personal transporters without handlebars, self-balancing two-wheeled motorised personal transporters with handle bars, Skateboards, Electric Skateboards, Saddle covers for bicycles or motorcycles, Handlebars for bicycles, Direction indicators for bicycles, Air pumps for bicycles, Water bottle holders for bicycles, Replacement parts and accessories for vehicles, in particular for scooters, e-scooters, electric scooters, Parts and fittings for the aforesaid vehicles and devices, toys and playthings, games, sporting articles, gym equipment, sports equipment, balance boards [gymnastic and sporting articles], skateboards, electric skateboards, electric self-balancing hover boards, electric surfboards, skateboard wheels, skateboard decks, elbow, knee, shin and leg guards (sporting articles), bags adapted for skateboards, electric scooters, electric kick scooters, electric bicycles; electric skateboards and electric motorbikes, four wheel electric skateboard, parts and fittings for all the aforesaid goods. [similar, albeit the CA has not indicated to what degree]</i></p>
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26. In the light of the RP's concessions set out above, the following contested terms are identical to those under the earlier registration:

Class 9:

bicycle helmets; hover board helmets; helmets for electric scooters; helmets for self-balancing two-wheeled motorised personal transporters with handle bars; Protective helmets; chin straps for bicycle helmets; trunks for bicycle helmets; cases, housings, and accessories for bicycle helmets; mounting devices for bicycle helmets for attaching electronic devices for recording, storage, transmission of sound, images and data; mounting devices for bicycle helmets for attaching cameras, lights, direction indicators, sports glasses and air pumps; mounting devices for bicycle helmets for attaching energy food, energy drinks and water bottles; safety lights mounted on bicycle helmets; display apparatus mounted on bicycle helmets.

Class 12

Apparatus for locomotion by land or air; Bikes; Electric bikes; Scooters; Scooters [for transportation]; Scooters [vehicles]; Electric one wheel scooters; Electrically operated scooters; Electrically powered scooters; Electrically powered scooters [vehicles]; Electrically-powered motor scooters; Motorized scooters; Self balancing electric scooters; Self-balancing one-wheeled electric scooters; Self-balancing two-wheeled electric scooters; electric scooters; electric bicycles; electric motorbikes; Air pumps for bicycles; electric scooters, electric kick scooters; Bike and scooter wheels; Spare wheels for vehicles; Wheels; Wheels (Spoke clips for -); Wheels (Vehicle -); Wheels for motor vehicles; Wheels for vehicles; Vehicle wheels; Saddle covers for bicycles or motorcycles; Handlebars for bicycles; Direction indicators for bicycles; Water bottle holders for bicycles; Replacement parts and accessories for vehicles, in particular for scooters, e-scooters, electric scooters; accessories for electric vehicles, scooters, electric scooters and bicycles [...]; Parts and fittings for the aforesaid vehicles and Devices.

Class 28

Toys and playthings; sports equipment; skateboards; electric skateboards; electric skateboards; four wheel electric skateboard; electric skateboards; Skateboards; elbow, knee, shin and leg guards (sporting articles); skateboard wheels; skateboard decks; bags adapted for skateboards; parts and fittings for all the aforesaid goods.

My approach

27. My comparison will address both:

- the contested terms still in dispute;
and
- the terms in respect of which the parties have agreed that there is similarity, albeit neither has proposed what degree of similarity there may be. I will therefore form my own view and my findings in this regard will be deemed to be conceded by the RP.

I have referred to terms as 'contested' where no concession has been made. Where concessions have been made, I refer to the terms in question simply as 'RP's goods/services'.

Class 9

RP's goods: *protective equipment for cyclists, including vests, jackets, jerseys, pants, gloves, shorts, footwear, clothing for protection against accident*

[The parties have agreed these terms to be similar to those under the earlier mark, without proposing the degree of similarity]

28. Ms Pickard submitted that the RP's goods were similar to the CA's *protective helmets* and *sports helmets*, rather than identical. I consider the word 'including', which appears in the RP's term, to be synonymous with the wording 'in particular' in that it functions merely to enumerate particular examples of goods encompassed

by the first part of the term ‘protective equipment for cyclists.’¹⁷ The goods subsequently enumerated do not, therefore, amount to an exhaustive list. Given the breadth of the RP’s term, it is my view that the CA’s *protective helmets* (and *sports helmets*), being examples of items of protective equipment for cyclists, will be encompassed by the RP’s term. I consider the parties’ goods to be identical based on the principle in *Meric*. However, given the CA’s explicit submission that the respective goods are not identical, and the RP’s subsequent concession, I find the goods to be highly similar.

RP’s goods: *Consoles*

[The parties have agreed these goods to be similar to those under the earlier mark, without proposing the degree of similarity]

29. Ms Pickard submitted that *consoles* are similar to the CA’s *protective helmets*, *sports helmets* and *parts and fittings for the aforesaid goods*. It is my understanding that ‘consoles’ are components of electric bicycles located on the handlebars which display, *inter alia*: battery power status, ‘apps’. The core function of bicycle helmets (which are encompassed by the CA’s terms) being to protect the cyclist from head injury. Although the respective goods are used whilst cycling, they will have distinct purposes. Users will inevitably overlap. Trade channels will also overlap; both offerings will typically be sold in cycling or sports shops and their online equivalents. Methods of use and the physical natures of the goods will be different. There is no competition between the goods; neither being substitutable for the other. I do not find complementarity, either; neither good being particularly useful or important for the other. In the light of the foregoing, I find the parties’ goods to have a low level of similarity.

RP’s goods: *spectacle glasses; sports glasses*

[The parties have agreed these goods to be similar to those under the earlier mark, without proposing the degree of similarity]

¹⁷ Case T-336/09 *Häfele GmbH & Co. KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM), decision of the General Court, at [33].

30. Ms Pickard submitted that the RP's goods were similar to the CA's *protective helmets, sports helmets and parts and fittings for the aforesaid goods*. She argued that they would be sold alongside, and worn with, one another. The respective goods will overlap in purpose to the extent that (where the RP's glasses/spectacles are worn for sports) both parties' offerings will be used for their protective properties. However, their specific purposes will be different; protection from head injury in the event of a sporting accident versus protection of the eyes from the elements during sports generally. Users will inevitably overlap given that both parties' goods might be used during the same sporting activity, e.g. cycling. Trade channels will also overlap, both offerings likely to be sold in the same retail outlets (e.g. sports/cycling shops) and their online equivalents. Methods of use and physical natures of the competing goods will differ; one will be strapped to the head, the other worn over the eyes. There is no competition between the goods, neither being substitutable for the other. I do not find complementarity, either; neither good is necessary or particularly important for the other. All things considered, I find the goods to have a level of similarity in the low range.

RP's contested goods: *data processing apparatus and computers for bicycles, scooters, self-balancing two-wheeled motorised personal transporters with handle bars, hover boards*

31. Ms Pickard submitted that these goods were similar to the CA's *protective helmets, sports helmets and parts and fittings for the aforesaid goods*; arguing that they would be used in conjunction with various electronic devices attached to the handlebars and/or cycling helmets which collect data (e.g. helmet-mounted cameras). Ms Pickard suggested that the RP's goods were items which, after a bicycle ride, are used to 'extract' the data from the devices which are mounted on bicycles or helmet. While this is noted, in the absence of any evidence to demonstrate how the RP's goods are typically used, it is my view that data processing apparatus/computers *for bicycles* are more likely to be the devices which are affixed to the bicycles/helmets, rather than 'free-standing' devices used after cycling. I consider an example of such goods to be the RP's 'consoles',

already dealt with. Accordingly, I find the parties' goods to have a low level of similarity, for the reasons provided at [29].

RP's goods: *communication systems mounted on bicycle helmets*

32. Ms Pickard submitted that these goods were 'mounting devices' and, therefore, identical to the CA's *parts and fittings for [...] helmets*. My view is that the goods in question are devices which are *mounted to* bicycles helmets rather than 'mounting devices' which I deem to be the fixtures (or 'mounts') upon which devices are affixed/mounted. Nevertheless, I consider that the RP's communication systems, as goods to be mounted to bicycle helmets, are 'fittings' therefor. I find the parties' offerings to be identical according to the principle in *Meric*.

RP's goods: *protective equipment for cyclists, including helmets*

33. Ms Pickard submitted that the RP's term was identical to the CA's *protective helmets* and *sports helmets*. As noted earlier, the word 'including' is to be construed as enumerating the subsequent item by way of one example of the goods included by the term. I find that the CA's terms, to the extent that they cover helmets for cycling, will be encompassed by the RP's term. The parties' goods are identical according to the principle in *Meric*.

Class 12

RP's contested goods: *Electric self-balancing boards; hoverboards; Electric hover boards; self-balancing two-wheeled motorised personal transporters without handlebars; self-balancing two-wheeled motorised personal transporters with handle bars; electric hover boards; electric unicycles; self-balancing one-wheeled motorised personal transporters; electric self-balancing hover boards; electric self-balancing two-wheeled motorised personal transporters with handle bars; electric self-balancing two-wheeled motorised personal transporters without handle bars.*

34. Ms Pickard submitted that the RP's goods will be encompassed by the CA's broad term *Apparatus for locomotion by land* and that the parties' goods are therefore identical according to the principle in *Meric*. I agree.

RP's goods: ***Remote control vehicles, other than toys***

[The parties have agreed these goods to be similar to those under the earlier mark, without proposing the degree of similarity]

35. Ms Pickard submitted that 'remote control vehicles' were not identical to the CA's *Apparatus for locomotion by land* because one 'would not have thought remote control vehicles are something you would travel in'. She argued that the parties' goods were, instead, similar. I respectfully consider Ms Pickard's argument to be flawed because the fact that a vehicle might be incapable of carrying passengers does not prevent it from being 'apparatus for locomotion by land'. 'Locomotion' simply means movement from one point to another and 'remote controlled' simply means, for example, that the vehicle is controlled without the 'driver' being on board (by radio control, for example). That said, it is my understanding that some passenger trains are controlled remotely. My view is that the RP's goods will, as a matter of fact, be encompassed by the CA's goods and that the parties' offerings are identical according to the principle in *Meric*. However, I am prevented from making such a finding in the light of the CA's pleading that the goods are merely similar; and taking account of the RP's subsequent concession. Consequently, I find the goods to be highly similar.

RP's contested goods: *parts for electric hover boards, namely wheels, tyres, frames and mudguards; non-motorised attachable and detachable seat, handles and single wheel apparatus for hover boards*

36. Ms Pickard has submitted that the RP's goods are identical to the CA's *parts and fittings for [...]* 'the aforesaid vehicles and devices' according to the principle in *Meric*. I agree; the parties' goods are identical.

Class 28

RP's contested goods: games

37. Ms Pickard submitted that the RP's term 'games'¹⁸ encompassed the CA's 'skate boards; skates, in-line skates, roller skates, roller blades' and that the parties' goods were, therefore, identical according to the principle in *Meric*. I disagree. Although both games and roller skates/skateboards can be deemed playthings, they are not ordinarily considered to be games. A 'game', in the sense of a tangible good, can be defined as some sort of 'set' or item, played in a way that typically involves skill, knowledge or chance, in which a set of rules is followed, the object of which is to win against an opponent or solve a puzzle.¹⁹ While the activities of skating/skateboarding might be sports, a pair of skates/skateboard is not. I will therefore assess the extent to which the respective goods might be similar.

38. Both parties' offerings will serve the broad purpose of providing amusement to the user. The specific purposes will, however, differ; a game enables the user to participate in a contest or to solve a puzzle, whereas skates/skateboards enable the user to move around on wheels. Users will overlap to the fairly unremarkable extent that the end-users of games and skates/skateboards are typically children/teenagers. I recognise, however, that the purchasers of these goods will be both adults (for example, parents or carers of children) and children/teenagers themselves. Trade channel overlap is possible; both goods might be sold in the same toy shops, for example. Methods of use will also differ; skates and skateboards will be worn/ridden on, whereas games will unlikely be used in this manner. Whilst it is conceivable that an average consumer (choosing a gift for a child, for example) might deliberate over whether to purchase some toy roller-skates or a game of some sort, I do not consider the respective goods to be competitive in a commercial sense. I do not find complementarity, either; neither good being necessary or important for the other. All things considered, I find the parties' goods to be dissimilar. The fact that users and trade channels may overlap is, without more, insufficient to support a finding of similarity in this case.

¹⁸ As well as several other terms already dealt with.

¹⁹ Online Collins Dictionary, accessed 17 December 2024, at 13:48.

RP's contested goods: sporting articles

39. Ms Pickard submitted that the RP's term encompasses the CA's skateboards, skates, inline skates, roller skates and roller blades and that the parties' goods are therefore identical according to the principle in *Meric*. I agree.

RP's contested goods: balance boards [gymnastic and sporting articles]

40. Ms Pickard's argument as I understand it was that all of the RP's class 28 terms encompassed some or other of the CA's class 28 goods. However, I do not consider that argument to succeed with respect to the contested term *balance boards [gymnastic and sporting articles]*. This term covers balance boards only, rather than gymnastic and sporting articles at large; the qualification in parentheses merely clarifying that the balance boards are gymnastic or sporting articles. The term 'balance boards' does not appear in the CA's specification. I will compare 'balance boards' to the CA's 'skateboards', which I consider to be the closest comparator. It is my understanding that a balance board is a board which is typically curved or mounted on a ball to enable the user to practise maintaining their balance as the board undulates. It is typically used to improve one's balance, either generally, or, particularly to improve surfing, skate-boarding or skiing technique. My view is that the goods will differ in terms of their specific purposes; skateboards are used either as a mode of self-propelled transport, or to perform tricks, whereas balance boards are typically used in exercises to improve balance. Users and trade channels may overlap. Methods of use will overlap to the extent that, for both goods, the user is required to balance on them. However, skateboards are moved across distances whereas balance boards move centripetally or from side to side. The goods will diverge in terms of physical nature to the extent that skateboards are mounted on wheels whereas balance boards are either curve-shaped or mounted on a ball-shaped structure. The goods will be similar in physical nature to the extent that both feature a board structure, albeit the respective shapes may differ. The goods are neither competitive nor complementary; neither being substitutable or necessary/important for the other. In the light of the foregoing, I find the goods to have a low to medium level of similarity.

RP's contested goods: gym equipment

41. Following my finding above at [40], *gym equipment*, to the extent that it encompasses 'balance boards' will be similar to the CA's skateboards to a low to medium degree.

RP's contested goods: electric surfboards

42. Ms Pickard submitted that 'electric surfboards' were similar to the CA's electric skateboards. It is my understanding that an electric surfboard is a surfboard powered by a motor, whose advantages over traditional surfboards include the ability to move the board forwards without paddling or having to exploit the wind, currents or waves to progress. I consider the goods to overlap in purpose to the extent that both are intended to be ridden across distances by way of 'balance-focused' exercise without the need for self-propulsion. The specific purposes of the goods will differ; riding on bodies of water (electric surfboards) versus riding on land. Users will likely overlap somewhat given that surfing enthusiasts might also gravitate towards skateboarding, both surfing and skating being sports/pass-times requiring skill in maintaining balance. Trade channels will likely overlap; my understanding and experience, as an ordinary member of the public, is that shops specialising in both skate-boards and surfboards are not unusual. Both goods will be put to use by way of the user balancing on and riding them. Their methods of use will diverge in that one will be used on water whereas the other will be used on land. The goods will have some similarity as to their physical natures; both being boards of a roughly similar shape, and driven by motors. I do not consider the parties' offerings to be in a competitive relationship; neither good being substitutable for the other. They are not complementary, either; neither being necessary or important for the other. All things considered, I find the goods to have no more than a medium level of similarity.

Class 35

RP's services: *Online retail, retail and wholesale services, all in relation to the sale of [...] electric scooters, accessories for electric vehicles, scooters, electric scooters and bicycles, [...] electric skateboards [...] protective helmets, bicycle helmets, hover board helmets, helmets for electric scooters, helmets for self-balancing two-wheeled motorised personal transporters with handle bars, consoles, chin straps for bicycle helmets, trunks for bicycle helmets, cases, housings, and accessories for bicycle helmets, mounting devices for bicycle helmets for attaching electronic devices for recording, storage, [...] sports glasses and air pumps, mounting devices for bicycle helmets for attaching energy food, energy drinks and water bottles, safety lights mounted on bicycle helmets, display apparatus mounted on bicycle helmets, spectacle glasses, sports glasses, [...] protective equipment for cyclists, including helmets, non-motorised attachable and detachable seat, handles and single wheel apparatus for hover boards, protective equipment for cyclists, including vests, jackets, jerseys, pants, gloves, shorts, footwear, clothing for protection against accident, apparatus for locomotion by land or air, Bikes, Electric bikes, Bike and scooter wheels, Scooters, Scooters [for transportation], Scooters [vehicles], Electric one wheel scooters, Electrically operated scooters, Electrically powered scooters, Electrically powered scooters [vehicles], Electrically-powered motor scooters, Motorized scooters, Self balancing electric scooters, Self-balancing one-wheeled electric scooters, Self-balancing two-wheeled electric scooters, Spare wheels for vehicles, Wheels, Wheels (Spoke clips for -), Wheels (Vehicle -), Wheels for motor vehicles, Wheels for vehicles, Vehicle wheels, Remote control vehicles, other than toys, [...] Skateboards, Electric Skateboards, Saddle covers for bicycles or motorcycles, Handlebars for bicycles, Direction indicators for bicycles, Air pumps for bicycles, Water bottle holders for bicycles, Replacement parts and accessories for vehicles, in particular for scooters, e-scooters, electric scooters, Parts and fittings for the aforesaid vehicles and devices, toys and playthings [...] skateboards, electric skateboards, [...] skateboard wheels, skateboard decks, elbow, knee, shin and leg guards (sporting articles), bags adapted for skateboards, electric scooters, electric kick scooters, electric bicycles; electric skateboards and*

electric motorbikes, four wheel electric skateboard, parts and fittings for all the aforesaid goods.

[The parties have agreed these services to be similar to the goods under the earlier mark to which these retail/wholesale services relate, albeit without proposing the degree of similarity]

43. Ms Pickard argued that where the RP's retail/wholesale services concern goods which are identical or similar to goods with the CA's specification, the parties' respective offerings will be similar.

44. When comparing goods against the retail or wholesale of goods, I bear in mind *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, in which the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

45. I also note that on the basis of the European courts' judgments in *Sanco SA v OHIM*,²⁰ and *Assembled Investments (Proprietary) Ltd v. OHIM*,²¹ upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*,²² Geoffrey Hobbs QC (as he then was) sitting as the Appointed Person in the MissBoo case,²³ concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to

²⁰ Case C-411/13P

²¹ Case T-105/05, at paragraphs [30] to [35] of the judgment

²² Case C-398/07P

²³ *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14; see paragraph 9 of that ruling.

envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

46. Retailing entails the bringing together and making available for sale, either in physical outlets or online, a variety of goods. Purchasers of retailed goods are predominantly the general public. Wholesaling, on the other hand, brings together and holds out for sale goods to other businesses (e.g. retailers), often in bulk. Purchasers of wholesale goods might, *inter alia*, re-sell those goods in their retail outlets or use them in the course of providing services.

47. The goods sold via the RP's services are present in the CA's specification, or identical to the CA's goods by way of *Meric*. The CA's goods are intended to be ridden, worn or to accessorise skateboards/scooters/helmets etc. The specific purposes of the goods are therefore distinct from the purposes of the retail or wholesale services. Users will inevitably overlap; the general public and retailers/trade purchasing the goods will simultaneously be accessing the services through which they are held out for sale. Trade channels will therefore necessarily overlap. The respective goods and services will be complementary; the CA's goods are necessary in order to deliver the retail or wholesale services in respect of those goods, and the average consumer may presume both to originate from the same undertaking, since it is quite normal for a retailer or wholesaler to sell the goods under its own mark. I find the parties' goods and services to have a medium level of similarity.

RP's contested services: *Online retail, retail and wholesale services, all in relation to the sale of electric self-balancing two- wheeled motorised personal transporters with handle bars electric hover boards, [...] self-balancing two-wheeled motorised personal transporters with handle bars and hover boards, chargers, electric unicycles, self- balancing one-wheeled motorised personal transporters [...] electric self-balancing two-wheeled motorised personal transporters with handle bars, electric hover boards, namely wheels, tyres, frames and mudguard, [...] mounting devices for bicycle helmets for attaching electronic devices for [...] transmission of sound, images and data, mounting devices for bicycle helmets for attaching cameras, lights, direction indicators, [...] data processing apparatus and computers for bicycles, scooters, self-balancing two-wheeled motorised personal transporters with handle bars, hover boards, communication systems mounted on bicycle helmets, [...] Electric self-balancing boards, hover boards, Electric hover boards, self-balancing two-wheeled motorised personal transporters without handlebars, self-balancing two-wheeled motorised personal transporters with handle bars, [...] , games, sporting articles, gym equipment, sports equipment, balance boards [gymnastic and sporting articles], [...] , electric self-balancing hover boards, electric surfboards*

48. With the exception of 'games', the goods sold via the RP's retail and wholesale services have been found to be identical or similar to goods within the CA's specification. For reasons analogous to those provided above at [47], I find the parties' offerings to have a medium level of similarity.

49. I have already found the RP's class 28 term *games* to dissimilar to the CA's goods and services. My view is that the RP's retail or wholesale services in relation to the sale of games is even further away from the CA's goods. The parties' offerings are dissimilar.

50. Some similarity between the parties' goods and services is necessary in order for an invalidation action under section 5(2)(b) of the Act to succeed.²⁴ I will therefore give no further consideration to the goods and services that I have found to be

²⁴ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, per Lady Justice Arden, [49].

dissimilar, since the invalidation actions must necessarily fail to that extent. For the avoidance of doubt, the goods and services that I have found to be dissimilar are:

Class 28: <i>games</i>
Class 35: <i>online retail, retail and wholesale services in relation to the sale of [...] games</i>

51. The invalidation actions remain live for the remaining goods and services.

Average consumer and the purchasing act

52. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect. The word “average” denotes that the person is typical. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

53. Ms Pickard submitted that the average consumer of the goods and services at stake was the general public.²⁵ It was submitted that the purchasing act would be primarily visual to the extent that purchasers would encounter the goods online, in retail stores and in catalogues; with an aural aspect in the case of word-of-mouth recommendations or discussions with retail staff.²⁶ Ms Pickard also described a scenario in which parents/carers ‘at the school gates’ might comment on a child’s scooter, for example, and enquire as to the brand. It was argued that the goods were relatively common, although they would not be purchased frequently; typical purchases might occur for birthdays or school holidays. Ms Pickard submitted that the price-point was around £10-£20, at the lower end of the scale, for toy scooters, rising to a few hundred pounds for items like hoverboards. It was submitted that helmets retailed for around £15 and that some scooters (not being toy scooters) were around £100. I was directed to product listings for the aforementioned goods

²⁵ CA’s Skeleton Argument, [40].

²⁶ As above, [41] – [42].

in excerpts from the 2016 and 2018 Autumn/Winter Argos catalogues by way of supporting evidence, and I accept Ms Pickard's submissions on the matter of pricing.²⁷ It was submitted that the average consumer would pay a level of attention higher than that typically displayed when purchasing, say, groceries, albeit not a high level of attention.²⁸

The goods: classes 9, 12 and 28:

54. The goods in question will be purchased from retail outlets and their online equivalents. I agree with the CA's submission that the purchasing process will be primarily visual in nature, with an aural aspect in some instances. I consider that many of the goods will be self-selected in physical retail outlets or by way of 'clicking' on online product listings. In some instances, the goods may be requested from retail staff if they are not on display (particularly components, e.g. wheels). Factors influencing the purchasing process will likely include, *inter alia*: the colour/size of the goods; the compatibility of the components/accessories with the scooter etc, as the case may be. My view is that the prospective purchaser will likely pay a medium level of attention when purchasing the goods, which aligns with the CA's submission on this point.

The class 35 services:

55. I will address the wholesale services first. The average consumer of wholesale services in general is predominantly the professional public, particularly retailers who will then resell the goods in retail stores or their online equivalents. In the instant case, the average consumer will be retailers in the business of selling bicycles, scooters etc and related goods. The general public will unlikely engage these services. Wholesale goods have significantly lower unit prices than for retailed offerings. Goods purchased on a wholesale basis are often bought in bulk, or several units at a time. I consider the purchasing act to be primarily visual; purchasers having first encountered the wholesalers upon exposure to, *inter alia*: their websites or physical stores/warehouses, or in advertising or printed matter. I

²⁷ Exhibit 5 to the Witness Statement of Mr Atul Shah. The pagination of the documents is obscured but the page numbers from the catalogues themselves are shown as page 1648 of the 2016 catalogue, and page 1633 of the 2018 catalogue.

²⁸ CA's Skeleton Argument, [41].

bear in mind that, in some instances, there will be an aural aspect to the purchasing process; for example, recommendations by word-of-mouth. Despite wholesale goods having much lower price-points than retail goods, the average consumer (e.g. a retailer of scooters) will likely demonstrate some measure of care during the purchasing act by virtue of their commercial agenda. Factors influencing the purchasing act might include, *inter alia*: whether the wholesaler has sufficient stock to fulfil the purchaser's order; how soon it can deliver the goods. I find that the wholesale services will be engaged with a medium to high level of attention.

56. I now consider the retail services. The average consumer will be predominantly the general public; e.g. parents/carers of young people or, in the case of adults, cycling/skating/surfing enthusiasts and hobbyists. The purchasing act will be primarily visual, with an aural component in some cases, in the manner described above at [55]. The services will be accessed by the very act of entering the retail premises/viewing the online equivalent and browsing and inspecting the goods being retailed. The decision as to whether to access the retail service will, in my view, likely be influenced by, *inter alia*: the variety of cycling/skating etc, as the case may be, goods on offer via the retailer. I find that the decision to engage the retail services will likely be made with at least a medium level of attention.

Comparison of the marks

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

‘...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, *inter alia*, an analysis of the components of a sign and of their relative weight

in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.'

58. I will deal with each application for invalidation in turn.

CA505670:

The marks to be compared are thus:

CA's mark:	RP's mark:
ZINC	ZIMX

Overall impression of the marks

The earlier mark:

59. The CA's mark is a word mark²⁹ comprising the single word element 'ZINC' rendered in a plain typeface, all characters in upper case. Given the absence of embellishment/stylisation, the overall impression resides solely in the word itself.

60. The RP's mark is a word mark comprising the single 'word' element 'ZIMX' rendered in a plain typeface, all characters in upper case. In the absence of embellishment/stylisation, the overall impression resides solely in the 'word' itself.

²⁹ In *LA Superquimica v EUIPO*, Case T-24/17, at paragraph [39] it was held that:

'[...] it should be noted that a word mark is a mark consisting entirely of letters, words or groups of words, without any specific figurative element. The protection which results from registration of a word mark thus relates to the word mentioned in the application for registration and not the specific figurative or stylistic aspects which that mark might have. As a result, the font in which the word sign might be presented must not be taken into account. It follows that a word mark may be used in any form, in any colour or font type (see judgment of 28 June 2017, *Josel v EUIPO — Nationale-Nederlanden Nederland (NN)*, T-333/15, not published, EU:T:2017:444, paragraphs 37 and 38 and the case-law cited).'

Visual comparison

61. Ms Pickard submitted that there was a very high degree of visual similarity between the marks by virtue of:

- the identical first two characters 'ZI';
- the difference of merely 'one line' between the 'N' in the earlier mark and the 'M' of the contested mark;
- and
- the fact that the visual difference between the 'C' in the earlier mark and the 'X' in the contested mark was 'relatively small' in that an 'X' is essentially composed of two 'C' characters presented as mirror images.³⁰

62. Ms Watkinson submitted that the marks were visually dissimilar; arguing that the marks 'overlap only in respect of the first 2 letters' and differ in their final two characters ('NC' versus 'MX').³¹ It was argued that, to the extent that any similarity between the marks might be found, such similarity could be no more than low in degree.³² Ms Watkinson clarified that this concession was made in respect of the RP's word mark only (UK00003713364) and did not extend to the marks with figurative elements (UK00003713368 and UK00003713369).

63. I bear in mind the rule of thumb according to which the beginnings of words tend to have more visual and aural impact than their endings.³³ I remind myself that this is not an absolute rule. In the instant case, both marks are relatively short, each comprising just four characters. Whilst the initial two characters of the marks are identical, my view is that the different respective endings of the marks will be readily perceived by the average consumer. In this connection, I note the following dicta from the case of *dm-drogerie markt GmbH & Co. KG v OHIM*:³⁴

³⁰ CA's Skeleton Argument, [44] – [46].

³¹ RP's Skeleton Argument, [17] – [18].

³² As above, [20].

³³ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, per the General Court at [81] to [83].

³⁴ Case T-304/10.

'42 That assessment would not be affected, moreover, even if their word elements alone were taken into account, the Court approving, in that regard, the findings of the Board of Appeal referred to at paragraph 32 above. It must be added that, since those word elements consist of five and six letters respectively, the differences between them, duly noted by the Board of Appeal, will be more easily grasped by the average consumer. Thus, the Court has already held that, in the case of word signs which are relatively short, even a difference consisting of a single consonant will preclude a finding that there is a high degree of visual similarity between the two signs (see judgment of 16 January 2008 in Case T-112/06 *Inter-IKEA v OHIM – Waibel (idea)*, not published in the ECR, paragraph 54 and the case-law cited).'

64. I respectfully disagree with Ms Pickard's submission that the visual differences between, respectively, 'N' and 'M', and 'C' and 'X', are small. I am unconvinced that the character 'X' resembles two 'C' characters in reflection. Furthermore, even if I were to presume that the 'X' was indeed composed of two 'C' characters in reflection, such an arrangement would not, in my view, necessarily be visually similar to a single 'C' character. Whilst both marks are four characters in length, the first two characters being identical, my view is that the differences residing in the final two characters will be readily perceived given the shortness of the marks. That said, I disagree with the RP's case that there is no visual similarity whatsoever. All things considered, I find the marks to have no more than a medium level of visual similarity.

Aural comparison

65. The CA submitted that there was a high degree of aural similarity between the marks.³⁵ Ms Pickard submitted the following:

³⁵ RP's Skeleton Argument

- that the RP's mark would be articulated as 'ZIMKS' and that both marks comprised a single syllable;
- that both marks began with the 'ZEE' sound, which, aurally speaking, was the most important element of each of the marks;
- that both marks featured 'nasal' consonants ('N' versus 'M'), which sound very similar and are 'often muddled' in speech;
- that similarity also resided in the endings of the marks, 'C' versus 'KS'.

66. The RP submitted that the marks are aurally dissimilar.³⁶ Ms Watkinson argued that the RP's mark would be articulated as 'ZIM-EX' and that, aurally speaking, the final 'EX' sound was the dominant aspect of the mark.

67. On the matter of articulation, I prefer the RP's submission. In my view, the RP's mark 'ZIMX' is not readily articulable as one syllable in the manner suggested by Ms Pickard. It is difficult to conceive of a word in the English language in which the characters 'MX' appear together in this order. My view is that the average consumer would unlikely be inclined to articulate the mark as 'ZIMKS', not least because it is, in my view, particularly difficult to vocalise by virtue of the absence of oral continuity between 'M' and 'X' and so it would not be pronounced that way by a significant proportion of average consumers. I consider the two-syllable articulation 'ZIM-EX' to be more likely. Both marks begin with the 'ZI' sound. The points of aural difference are:

- the CA's mark is one syllable whereas the RP's mark comprise two syllables, rendering the latter twice as long as the former in terms of its sound;
- the 'NC' sound at the end of the CA's mark versus the 'EX' sound at the end of the RP's mark.

68. In the light of the foregoing, I find the marks to have a level of aural similarity somewhere between low and medium.

Conceptual comparison

³⁶ CA's Skeleton Argument, [18].

69. The CA has submitted that the average consumer is unlikely to ascribe any meaning to either 'zinc' or 'ZIMX' and that the marks are, therefore, conceptually neutral.³⁷ Ms Pickard argued that, although 'zinc' is the name of a metallic element, that the meaning of the word needed to be looked at in the context of the goods and services in respect of which the earlier mark is registered.

70. The RP has submitted that the earlier mark 'zinc' will be understood as referring to the chemical element, zinc, a metal; whereas the contested mark 'ZIMX' will be perceived as an invented word to which no particular concept will attach.³⁸ It was submitted that the marks were, therefore, conceptually dissimilar. Ms Watkinson argued that it was incorrect to assess the conceptual aspect of the mark in the context of the specification for which it is registered.


71. I agree with Ms Watkinson that, when making a comparison of competing marks, their conceptual aspects must be assessed by reference to the overall impressions of the marks, rather than by reference to the specifications for which they are registered/registration is sought. The matter of the goods and services will be taken into account when the marks are assessed for their distinctive character.

72. My view is that 'zinc' is a word with which many average consumers will be familiar, the majority of which understand it as a reference to the metallic element by that name. I also recognise that a small number of average consumers might understand 'zinc' merely as a chemical or substance without appreciating that it is a metal. Whilst it is possible that some consumers might be unfamiliar with the meaning of 'zinc', I consider such individuals to be so few in number that they would unlikely constitute a significant proportion of average consumers. I agree with both parties that a significant proportion of average consumer would likely perceive the RP's mark 'ZIMX' as an invented word or mere string of alphabetic characters. In the light of the foregoing, I find that there is no conceptual similarity between the marks.

³⁷ CA's Skeleton Argument, [49]

³⁸ RP's Skeleton Argument, [19].

CA505671:

CA's mark:	RP's mark:
ZINC	 <p>The logo for ZIMX Hoverboards features the word 'ZIMX' in a large, bold, sans-serif font. The 'X' is stylized with a chevron-like pattern. Below 'ZIMX' are the words 'HOVERBOARDS' and 'WITH ATTITUDE' in a smaller, spaced-out, sans-serif font.</p>

Overall impression of the RP's mark

73. The RP's mark is a figurative mark comprising the text 'ZIMX' in a large font size underneath which the wording 'HOVERBOARDS WITH ATTITUDE' is presented in a much smaller font size relative to 'ZIMX'. The characters 'ZIMX' are in upper case, emboldened and of uniform size. The 'ZIM' portion is lightly stylised by way of the angles on the characters being curved and the characters have solid black infills. The 'X' character has a more complex level of stylisation that might be described as a 'chevron-like' arrangement in contrasting black and white. The stark difference in stylisation between the 'ZIM' and 'X' is somewhat jarring and has the effect of creating a measure of visual separation. The 'HOVERBOARDS WITH ATTITUDE' wording will likely be perceived as a 'strap-line'. I find that 'ZIMX' will be the dominant and distinctive element of the mark by virtue of its size, stylisation and positioning; with the 'strap-line' element being noticed, but playing a much lesser role within the mark as a whole.

Visual comparison

74. The visual similarities and differences that I have identified above, at [63] and [64], in my consideration of the RP's 'word' mark also apply here. In addition, I note the following points of visual difference:

- the stylisation present in the RP's mark, as described above, which is absent from the CA's mark;
- the presence of the wording 'HOVERBOARDS WITH ATTITUDE' in the RP's mark, which is absent from the CA's mark.

All things considered, I find the marks to have a low level of visual similarity.

Aural comparison


75. The average consumer will, in my view, unlikely articulate the wording 'HOVERBOARDS WITH ATTITUDE' in the RP's mark, given its font size; and following my finding that it will likely be perceived as a 'strap line'. Paragraph [64] is therefore adopted here. Aurally speaking, I find a level of similarity somewhere between low and medium.

76. If the mark were articulated in full, the level of aural similarity would be no more than low.

Conceptual similarity

77. My comments above regarding the perceived meaning of 'ZIMX', at [72] also apply here. However, the wording 'HOVERBOARDS WITH ATTITUDE' present in the mark will convey a concept to the average consumer; i.e. the idea of hoverboards being 'edgy'/'cool' or having, in modern parlance, 'street cred'. The mark as a whole will therefore likely be understood as belonging to a 'cool'/'edgy' purveyor of hoverboards by the name of 'ZIMX'. I find that there is no conceptual similarity between the parties' marks.

CA505672

CA's mark:	RP's mark:
ZINC	

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Overall impression of the RP's mark

78. The RP's mark is a figurative mark comprising the characters 'ZIMX' in upper case, emboldened and of uniform size. The 'ZIM' portion is lightly stylised by way of the angles on the characters being curved, and the characters have solid black infills. The 'X' character has a more complex level of stylisation that might be described as a 'chevron-like' arrangement in contrasting black and white. The stark difference in stylisation between the 'ZIM' and 'X' is somewhat jarring and has the effect of creating a measure of visual separation. The overall impression resides in the mark as whole.

Visual comparison

79. The CA's mark is a word mark, whereas the RP's mark is figurative. Both marks comprise four characters, the first two of which are shared, i.e. 'ZI'. My comments on the differences in spelling ('NC' versus 'MX') above at [64], also apply here, albeit with greater force by virtue of the level of stylisation residing in the 'X' in the RP's mark making the 'X' 'stand out' from the remaining characters presented in solid black. All things considered, I find the marks to have a level of visual similarity of between low and medium.

Aural comparison

80. My comments at [67] and [68] also apply here. The level of aural similarity between the marks is somewhere between low and medium.

Conceptual comparison

81. My comments above at [72] also apply here. I do not consider that the stylisation of the RP's figurative mark add anything conceptually over and above that

conveyed by the RP's word mark 'ZIMX'. I do not find any conceptual nexus between the marks.

Distinctive character of the earlier mark

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

'22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

83. Registered trade marks possess varying degrees of inherent distinctive character. Where a mark is suggestive or allusive of a characteristic of the goods or services, it tends to be low. Inherent distinctive character may range up to a high level for marks which consist of invented words with no allusive qualities.

84. The word 'Zinc' will be recognised by a significant proportion of average consumers as the name for the metal element. In my view, the mark neither describes nor alludes to the goods in respect of which it is registered. I find that the earlier mark has a medium level of inherent distinctiveness for the relevant goods.

85. I now consider the matter of enhanced distinctiveness. The relevant date at which enhanced distinctiveness must be assessed is 22 October 2021 (i.e. the date on which all three applications for the contested marks were filed). The CA has submitted that the earlier mark enjoys an enhanced level of distinctiveness by virtue of the use that has been made of it. I note the following from the CA's evidence:

a) Turnover figures from sales in the UK have been provided as follows:³⁹

Year	Turnover of products bearing the ZINC mark
2012	£6,634,695
2013	£7,078,797
2014	£9,087,870
2015	£9,244,737
2016	£9,793,834
2017	£10,285,269
2018	£11,355,808
2019	£7,597,454
2020	£7,918,324
2021	£8,693,237
2022	£7,595,782
2023 (May)	£1,868,711

b) Marketing spend in respect of goods under the Zinc mark has been provided, although it is not clear whether these figures relate exclusively to the UK:⁴⁰

³⁹ Witness Statement of Atul Shah, [11].

⁴⁰ Witness Statement of Atul Shah, [13].

Year	Marketing Spend
2012	£464,429
2013	£495,516
2014	£636,151
2015	£647,132
2016	£685,568
2017	£719,969
2018	£794,907
2019	£531,822
2020	£554,283
2021	£608,527
2022	£531,705
2023 (May)	£130,810

c) Excerpts from catalogues for the retailer 'Argos' showing product listings for Zinc goods for the following years: 2010, 2011, 2012, 2013, 2014, 2015, 2016, 2017, 2019; 2018; 2019.⁴¹ Goods listed include: skateboards; scooters (including 'toy' versions for small children); bicycles; BMX bicycles; cycling helmets; bicycles pumps; bicycle locks; bicycle lights; stunt scooters; knee and elbow pads; wrist guards; roller skates (quad and in-line); hoverboards; long boards; smart electric cruisers. I note that a range of goods under the Zinc brand is featured in each catalogue issue, often running to several pages; with the CA's mark shown consistently and prominently. Furthermore, I note that the page of Zinc goods in the 2019 catalogue includes the text 'UK'S NO.1 SCOOTER BRAND' in the 'header'.

d) A large number of invoices in respect of orders placed by UK retailers has been provided, spanning the period 2012 to 5 June 2023.⁴² I note that high value orders have been placed frequently and consistently across each of the years in that period. Orders have been placed by retailers including, *inter alia*: Argos, Asda, The

⁴¹ Exhibit 5 to Witness Statement of Atul Shah.

⁴² Exhibit 4 to Witness Statement of Atul Shah.

Range, Sports Direct, Halfords and Hamleys. There is repeated steady custom from Argos. The vast majority of invoices relate to large bulk orders comprising thousands of units. Even the smallest order is for several hundreds of units. Taking one example, an invoice to Argos, dated 18 October 2022, concerned 11,632 units of scooters.⁴³ The sums payable are substantial, in many cases in the hundreds of thousands of US dollars. I note that 'Zinc' is mentioned in many of the invoices by way of the descriptions of the goods sold. The goods sold are predominantly various types and models of scooters. Other goods sold include: skates, gliders, BMX bikes, bicycles and hoverboards.

86. It is clear that the CA has enjoyed substantial sales of goods under the 'Zinc' mark from 2012 onwards. Although the figures indicate fluctuating sales over the years, the revenue generated was a six-figure sum even at the lowest point. Notwithstanding that sales appear to have peaked in 2018 and declined somewhat in the following years, the turnover in 2022 is circa £7.5million, which is still a significant sum. The sales figures are well-supported by a good selection of invoices which demonstrate frequent orders for consistently large consignments of goods, predominantly scooters of various kinds. The excerpts from Argos catalogues indicate that a range of goods under the 'Zinc' brand has been held out for sale, borne out by the fact that, based on the selection of invoices available, Argos is the most frequent purchaser of the CA's goods and its large bulk orders consistently comprise thousands of units. My view is that the totality of evidence indicates a level of awareness of the 'Zinc' brand which has likely contributed to customer awareness. I find that this has likely increased the distinctiveness of the mark for the relevant consumer of scooters. The mark already enjoys a medium level of distinctiveness inherently, by virtue of being neither descriptive nor allusive of the goods in respect of which it is registered and not being an invented word. I find that the level of distinctiveness of the earlier mark has been enhanced somewhat but remains within the medium range.

Likelihood of confusion

⁴³ As above, page [202].

87. Confusion can be direct or indirect. Mr Iain Purvis Q. C., (as he then was) as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v By Back Beat Inc*⁴⁴. Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*⁴⁵, the CJEU recognised that the average consumer rarely encounters the two marks side by side but must rely on the imperfect picture of them that they have kept in mind. Direct confusion can therefore occur by imperfect recollection when the average consumer sees the later mark but mistakenly matches it to the imperfect image of the earlier mark in their ‘mind’s eye’. Indirect confusion occurs when the average consumer recognises that the competing marks are not the same in some respect, but the similarities between them, combined with the goods/services at issue, leads them to conclude that the goods/services are the responsibility of the same or an economically linked undertaking.

88. I must keep in mind that a global assessment is required taking into account all of the relevant factors, including the principles a) – k) set out above at [18]. When considering all relevant factors ‘in the round’, I must bear in mind that a greater degree of similarity between goods/services *may* be offset by a lesser degree of similarity between the marks, and vice versa.

89. I have found a number of the contested goods and services to be identical, or to have some level of similarity, to the CA’s goods/services. I will first consider the matter of the likelihood of confusion based on the highest points of the CA’s case. Given that the specifications are more or less the same for all three of the contested marks, I will conduct my analysis:

- in respect of the RP’s word mark ‘ZIMX’ (UK00003713364), which I have found to be the closest comparator to the CA’s earlier mark;
and
- based on the class 12 goods *scooters*, a term present in both parties’ specifications, and the goods in respect of which I have found the earlier mark to enjoy an enhanced level of distinctiveness.

⁴⁴ Case BL O/375/10 at [16].

⁴⁵ *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].

90. I have found the RP's word mark to have no more than a medium level of visual similarity to the CA's mark. Aurally speaking, I have found a level of similarity of between low and medium. I have found that there is no conceptual nexus between the marks, given that the meaning of the CA's mark 'ZINC' will likely be understood whereas the RP's 'ZIMX' will be seen as an invented word or mere string of initials whose meaning is unknown. My view is that the net effect of the differences that I have identified between the marks, along the three 'planes' of comparison, is sufficient to prevent one party's mark from being mistaken for the other. Despite the marks sharing the first two characters 'ZI', I consider that the visual and aural differences between the marks will be particularly marked because the marks are short. Aurally speaking, the RP's mark is two syllables (ZIM-EX) versus the CA's single syllable ('ZINC') making the former sound twice as long as the latter. I have found the purchasing act to be primarily visual in most cases. I remind myself of the possibility that a greater degree of similarity between goods/services *may* offset a lesser degree of similarity between marks. However, in the instant case, even where the goods are identical, my view is that the impact of the visual and aural differences will unlikely be muted, particularly given the shortness of the marks. I have borne in mind that the earlier mark enjoys a medium level of inherent distinctive character which has been enhanced somewhat, although remains in the medium range, through use in the case of *scooters*. While the likelihood of confusion is greater where the earlier mark has a high level of distinctive character, in the instant case, the distinctive characters of the parties' marks arise in different ways. The distinctiveness of the contested mark derives from the fact that the mark will be seen as an invented word. Taking all relevant matters into consideration, I find that there is no likelihood of confusion between the marks. I find this to be the case even where only a medium level of attention is paid during the purchasing act.

91. Given that my finding is based on: the closest of the contested marks by way of a comparator; the parties' identical goods; and the higher of the levels of distinctiveness ascribed to the earlier mark (i.e. in respect of *scooters*), it is unnecessary to consider any other goods/services, or other of the contested marks. I have found the two remaining contested marks to be more distant from

the earlier mark. There is therefore no likelihood of confusion in respect of contested marks UK00003713368 or UK00003713369, either.

92. I now consider whether there is a likelihood of indirect confusion. I note that in the case of *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.

93. In *L.A. Sugar Limited v By Back Beat Inc*⁴⁶ Mr Iain Purvis Q. C., (as he then was) as the Appointed Person, explained that [my words in parentheses]:

“17. Instances where one may expect the average consumer to reach such a conclusion [i.e. to conclude that marks relate to the same or economically linked undertakings] 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.).

⁴⁶ Case BL O/375/10

(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)".

94. My view is that the instant case does not fall within any of the categories outlined by Mr Purvis above. It is acknowledged that these categories are not intended to be exhaustive. Nevertheless, the prospect of an average consumer presuming the marks to be related by way of deriving from the same or economically-related undertaking (e.g. as sub-brands or variant marks for the same brand) is, to my mind, not a realistic one. It is difficult to conceive of any commercially sensible rationale for the marks 'ZINC' and 'ZIMX' being perceived as related brands. I can find no proper basis for a finding of a likelihood of indirect confusion.

Conclusion

95. All three applications for invalidation have failed in their entirety. Subject to a successful appeal, registrations UK00003713364, UK00003713368 and UK00003713369 may remain on the Register.

Costs

96. The RP is the successful party and is therefore entitled to a contribution to its costs based upon the scale published in Tribunal Practice Notice 2/2016 calculated as follows:

Consideration of the Invalidation Actions and preparation of Defences and Counterstatements (x3 actions):	£400
Preparing for and attending the hearing:	£600
Total:	£1,000

97. Given the consolidation of the three invalidation actions and the fact that the contested specification is more or less the same for each, I have declined to award the minimum sum in respect of each of the three Defences and Counterstatements filed. I consider £400 to be a fair sum for this head of costs.

98. I have also declined to award costs in respect of the RP's evidence filed. My view is that the material adduced was neither necessary nor of particular relevance to the matters at stake in these proceedings.

99. I therefore order Hy-Pro International Limited to pay to Banti Ram the sum of £1,000. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24th day of January 2025

N. R. Morris
For the Registrar,
the Comptroller-General