O/0276/25

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001722156 IN THE NAME OF BELDEN INC. FOR THE FOLLOWING MARK:

IN CLASS 9

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. OP000443305 BY PRYSMIAN S.P.A

Background and pleadings

1. Belden Inc. ("the holder") is the holder of the International Registration shown on the cover page of this decision ("the IR"). The IR was registered on 14 February 2023 and, with effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol of the Madrid Agreement. The IR was accepted and published in the Trade Marks Journal for opposition purposes on 30 June 2023. The holder seeks protection in the UK for the following goods:

   Class 9: Electronic wires and cables.

2. The IR is derived from an earlier trade mark registered by the holder in the United States of America. As such, the IR benefits from an earlier priority date of 18 August 2022, being the filing date of the holder's US mark.

3. On 28 September 2023, Prysmian S.P.A ("the opponent") filed an opposition opposing the application in full under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). The opponent stated in correspondence to the Tribunal on 29 January 2024 that they did not intend to file evidence to support their opposition under section 5(4)(a) of the Act in the interests of procedural economy and the strength of the opponent's opposition under section 5(2)(b) of the Act. The Tribunal accepted this and the section 5(4)(a) ground was subsequently withdrawn. As such, this decision proceeds on the basis of the section 5(2)(b) ground only.

4. The opponent relies on the following International Registration:

   International registration number WO0000001596868 ("opponent's mark")
   Relying on some goods only, being:

Class 9: Electric cables; optical cables; fiber optic cables; data cables.

5. The opponent's mark was registered on 22 March 2021 and, with effect from the same date, the opponent designated the UK as a territory in which it seeks to protect its mark under the terms of the Protocol of the Madrid Agreement. Protection was granted on 4 February 2022.

6. The opponent's mark is derived from an earlier trade mark registered by the opponent in Italy. As such, the opponent's mark benefits from an earlier priority date of 8 March 2021, being the filing date of the opponent's Italian mark.

7. The opponent's case is that the marks at issue are closely similar since both marks include the words 'eco' and 'cable' and that the goods are identical, resulting in a likelihood of confusion.

8. The holder filed a counterstatement denying the claims made against it.

9. The opponent is represented by Mathys & Squire LLP. The holder is represented by Lucas & Co. The holder filed evidence in these proceedings. The opponent did not. No hearing was requested and only the holder filed written submissions in lieu of the same. This decision is taken following a careful perusal of the papers.

10. 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.

THE EVIDENCE

11. The holder's evidence came in the form of the witness statement of Nicholas R Birk dated 19 April 2024. Mr Birk is Vice President, Global Product Category at the

holder and has served in this position since 2022, having been employed by the company for twelve years. His statement is accompanied by four exhibits, being NB1 – NB4. Whilst the purpose of the evidence is not expressly set out, it consists of a range of evidence that purports to show use of the IR.

12. I do not intend to summarise the evidence filed by the holder or the holder's submissions in lieu in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent deemed necessary below.

PRELIMINARY ISSUES

EUIPO Decisions

13. In its counterstatement, the holder refers to a decision by the EUIPO Board of Appeal on 6 November 2013, being that under case R0416/2013-4. The holder claims this EUIPO decision confirms that both words ECO and CABLE either alone or in combination are completely descriptive and devoid of distinctive character. Exhibit NB1 of the witness statement of Nicholas Birk appends a copy of this decision. While this decision is noted, it is of no relevance to the present opposition. Further, I remind myself that by virtue of the opponent's mark being a registered trade mark, it must be assumed to have at least some distinctive character.[1]

14. In its written submissions in lieu, the holder states that there is a parallel opposition under number B 003200619 at the EUIPO against the EU designation. The holder states that this file is now closed and ready for a decision. While noted, I am unsure of the relevance of this point to present opposition as (1) no decision has been issued and (2) even if it had, it would not be binding on the decision I must make here.

[1] Paragraphs 41-44, *Formula One Licensing BV v OHIM*, Case C-196/11P

Honest Concurrent Use

15. In its written submissions in lieu, the holder raises the issue of honest concurrent use. This defence was not pleaded and that would, in my view, be sufficient reason to dismiss the claims. Nevertheless, I will give my views for the sake of completeness. The holder is claiming honest concurrent use of the ECOCABLE / ECO CABLE terminology in the UK since March 2021 to rebut the presumption of a likelihood of confusion. The holder states it would be unconscionable to allow a later user with a banal image to disrupt a competitor's attempt to provide reliable messaging using a distinctive logo.

16. As set out above, the holder has filed evidence. Whilst the purpose of the evidence is not expressly set out, it consists of a range of evidence that purports to show use of the IR. Given what the holder goes on to submit, it appears that such evidence was filed to demonstrate a defence of honest concurrent use. I will say that any use in support of such a defence must be demonstrated in the relevant territory which, for these proceedings, is the UK.[2]

17. As demonstrated by the Court of Justice of the European Union ("CJEU") in the case of *Budejovicky Budvar NP v Anheuser-Busch Inc*, Case C-482/09, EU:C:2011:605, circumstances wherein a defence of honest concurrent use succeeds are exceptional. In that case, the marks at issue had been used alongside one another in the same trade for almost 30 years prior to the registration of the marks concerned. Plainly this is not the case here as the evidence before me only covers alleged concurrent use since 2018 at the very earliest. This is on the basis that Mr Birk's witness statement confirms that exhibits NB2 and NB3 are from 2018. At best, any concurrent use would be over approximately four years on the basis that the relevant date for these proceedings is 18 August 2022 (being the priority date for the IR). Even taking this into account, the actual level of use shown by the holder in the UK is very limited. On this point, I note that the holder has provided brochures distributed by Alpha Wire in Europe (including in the UK) from

[2] Reputation or genuine use in the EU is not required for a successful demonstration of honest concurrent use. This is because honest concurrent use is a defence used to diminish the likelihood of confusion and because likelihood of confusion is focused on the UK consumer, use in another jurisdiction has no impact.

2018.[3] While both are from prior to the relevant date, there is nothing to suggest the level of readership of these brochures obtained in the UK.

18. The holder has provided evidence of a selection of Alpha Wire invoices addressed to customers in the UK for the products from 2021 onwards.[4] Mr Birk states in his witness statement that these invoices are examples only and are not intended to indicate the actual sales values which are confidential and proprietary to the holder, but to show a snapshot of ECOWIRE and ECOCABLE sales on random dates to show that there were ongoing continuing sales arising from the 2018 brochures and other sales efforts by Alpha Wire. As I have nothing before me to indicate the totality of the sales and how many consumers were subsequently exposed to the IR in the UK, I do not consider this evidence demonstrates any real level of awareness amongst the UK consumer base. Even ignoring the unknown level of sales, the main issue here is that this covers just two years of use. When compared to the case of *Budvar* (cited above) (wherein honest concurrent use was found as a result of 30 years of concurrent use),[5] this is a very short period of time.

19. In any event, it is noted that the holder's evidence does not relate solely to the IR but to other marks such as ECO WIRE, ECO FLEX and ALPHA WIRE diluting the weight of this evidence. The IR does not appear to be shown in any of the exhibits appended to Mr Birk's witness statement.

20. As a result of the above, it is clear that the holder's use of its IR is not such that there exists honest concurrent use of the IR. I will, therefore, say no more about this point.

DECISION

Section 5(2)(b): legislation and case law

21. Section 5(2)(b) of the Act reads as follows:

[3] Exhibits NB2 and NB3
[4] Exhibit NB4
[5] I note that the time period of 30 years is not a requirement but a helpful indicator of the longevity of use required to validly demonstrate such a defence.

"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".

22. Section 5A of the Act states as follows:

"Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

23. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

"(6)(1) In this Act an "earlier trade mark" means –

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

24. The opponent's mark qualifies as an earlier trade mark under the above provisions. As the opponent's mark had not completed its registration process more than five years before the priority date of the IR, it is not subject to proof of use requirements. Consequently, the opponent may rely on the goods highlighted in its notice of opposition.

25. The following principles are gleaned from the decisions of the CJEU in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case

C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) ("OHIM"),* Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

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

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

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

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

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

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

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

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

Comparison of the goods

26. The parties goods are as follows:

The opponent's goods	**The holder's goods**
Class 9 Electric cables; optical cables; fiber optic cables; data cables.	Class 9 Electronic wires and cables

27. The opponent's position is that the holder's goods are identical to its own goods since they have identical natures, intended purposes, end users and methods of use, and are therefore complementary. In the holder's counterstatement dated 21 November 2023, the holder admits that the goods are identical.

28. In light of the above, I agree with the parties and hereby find that the goods are identical.

The average consumer and the nature of the purchasing act

29. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

30. The average consumer for the goods at issue will vary and could include professionals, such as electricians or telecommunications engineers, or members of the general public at large as well as business users. Regardless of the identity of the consumer, the goods are generally going to be selected via general retailers or retailers specialising in electronic goods. In such retailers, the goods will be displayed on racks or shelves where they will be self-selected by consumers. The goods are also likely to be selected online via those retailers' websites where the goods will be selected after the consumers view images of them. I consider that the selection process will be primarily visual. That being said, I cannot ignore the fact that an aural component will play a role via word-of-mouth recommendations or discussions with sales staff.

31. The goods at issue are relatively low cost goods that will be selected somewhat frequently. In terms of the level of attention paid, I consider that this will generally be at a medium level as consideration will be paid to generally ordinary factors such as compatibility and quality. Such information is commonly emblazoned

clearly on the goods' packaging or webpages so seeking out this information will not require any detailed consideration.

Comparison of marks

32. 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.

33. 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."

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

35. The respective trade marks are shown below:

The opponent's mark	The IR
	

36. In the notice of opposition and statement of grounds, the opponent argues that the IR is closely similar to the opponent's mark since both marks include the words 'eco' and 'cable'.

37. In its counterstatement, the holder admits that both the IR and the opponent's mark include the elements ECO and CABLE. The holder compares both the opponent's mark and the IR in further detail in its written submissions in lieu. I do not intend to summarise this comparison here but I can confirm I have taken it into account to the extent deemed necessary in making the following comparison.

Overall impression

38. The IR is a figurative mark which consists of the words 'eco cable' in a black bold lower case font. The word 'eco' is placed on top, and slightly to the left of, the word 'cable'. There are two black semi circles located to the right of the 'o' of 'eco, and two black semi circles located to the left of the 'c' of 'cable'. While the words are presented in a specific typeface, the typeface used is a fairly standard typeface that will have very little impact on the overall impression of the mark. Instead, I find that it is the words 'eco cable' that will dominate the overall impression of the mark with the semi circles being seen as a decorative element, therefore contributing less to the overall impression of the mark.

39. As for the opponent's mark, this is a figurative mark consisting of the words 'ECO CABLE' in a white upper case font on a green rectangular background with a green leaf located to the left of the rectangular background and two white concentric circles located to the right of the words with three smaller white circles in the shape of a triangle located in the smaller concentric circle. 'ECO' is presented in a larger font size than 'CABLE' and is placed directly on top of 'CABLE'. The holder states in its written submissions in lieu that the opponent's mark includes a depiction of a cross-section through a cable (the arrangement of white circles), although I cannot see that the opponent has argued this. I do not believe the average consumer would view this arrangement of white circles as a cross section through a cable. While the words 'ECO' and 'CABLE' are presented in a specific typeface, the typeface used is fairly standard and it will have very little impact on the overall

impression of the mark. I remind myself that consumers tend to be drawn to parts of the mark that can be read. Given this, I find that it is 'ECO CABLE' that will dominate the overall impression of the mark. As for the figurative elements, I find that the leaf device will play a secondary role in the overall impression of the mark due to its size and position within the mark whereas the figurative concentric circle elements will play an even less role. Lastly, I appreciate the presence of a coloured background, however, this is nothing more than a banal background element that will have a negligible impact on the mark as a whole.

Visual comparison

40. Visually, the opponent's mark and the IR overlap through the use of the words 'ECO' and 'CABLE'. Both have 'ECO' on the top line and 'CABLE' on the bottom line. Albeit the holder's displacement of the words is slightly off centre. The points of visual difference that apply here are the upper case font, the leaf, the concentric circle pattern and the green background of the opponent's mark as well as the lower case font and the four semi circles that form part of the IR. Regardless of the various roles these elements play in their respective marks, they all contribute as points of visual difference between the marks. Overall, I am of the view that the shared use of the two words 'ECO' and 'CABLE', being the dominant elements of the marks, is sufficient to result in a finding that the marks at issue are visually similar to a high degree.

Aural comparison

41. The only aural elements of the marks lie in the words 'ECO CABLE'. This will be pronounced in the ordinary way and, as such, the marks are plainly aurally identical.

Conceptual comparison

42. The opponent's mark consists of the words 'ECO' and 'CABLE'. These are ordinary dictionary words that will be well-known to the average consumer. I consider that the word 'ECO' will be immediately recognised as reference to being

connected with the environment and ‘CABLE’ will be immediately recognised as a set of wires, covered by plastic, that carry electricity or signals. Consumers are likely to think that ‘ECO CABLE’ is reference to cables that are environmentally friendly. The opponent’s mark also consists of a green leaf and two white concentric circles with three circles in a triangular pattern inside the smallest concentric circle. I consider the leaf and use of green to bolster the ECO concept being highly allusive of the opponents ‘eco’ section of their goods. While the holder argues that the concentric circle pattern is the cross section of a cable, I do not believe that a significant proportion of consumers would recognise this and would just see this as a circular pattern with no conceptual impact. If I am wrong and consumers do recognise this figurative element as a cross section of a cable, this once again bolsters the CABLE concept. The IR consists of the same words as the opponent’s mark. As for the semi circle figurative elements, I do not consider them to have any conceptual impact on the IR as a whole. Given this, I find that the marks are conceptually identical.

Distinctive character of the opponent’s mark

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

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

widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

44. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it. While the opponent has pleaded that the use of their mark has led to an enhanced degree of distinctiveness, they have not filed any evidence in support of this, so I only have the inherent position to consider.

45. I have discussed above that the message conveyed by the opponent's mark is of a cable that is environmentally friendly. I consider this is descriptive of the goods relied upon. That being said, I repeat what I have above in that by virtue of being a registered trade mark, it is afforded at least some distinctive character. Overall, I find that the opponent's mark enjoys only a low degree of distinctive character.

Likelihood of confusion

46. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me

to keep in mind the distinctive character of the opponent's mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

47. Weak distinctive character of an earlier trade mark does not preclude a likelihood of confusion. In *L'Oréal SA v OHIM*, Case C-235/05 P, the CJEU found that:

> "45. The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders."

48. In respect of the goods at issue, I have found them to be identical. The average consumer base is formed of professionals, such as electricians or telecommunications engineers, or members of the general public at large who will select the goods by primarily visual means, although I do not discount an aural component. I have concluded that the average consumer will pay a medium degree of attention during the selection process. I have found the marks to be visually similar to a high degree and aurally and conceptually identical. I have found the opponent's mark to possess a low degree of inherent distinctive character.

49. Taking all of these factors into account and bearing in mind the principle of imperfect recollection, I consider the present case represents an example of direct confusion. I base this finding primarily in reliance upon the high degree of visual similarity and aural and conceptual identity between the marks. While there are some presentational differences, I consider that the consumer would attempt to pin their recollection of the marks on the words 'ECO CABLE', even despite its descriptive nature. As such, the presentational differences will be misremembered. I consider that consumers will misremember which mark offered goods by 'ECO CABLE' with a leaf, concentric circle pattern and green background as opposed to 'eco cable' with black semi circles and vice versa, especially in light of the principle of imperfect recollection and the fact that consumers rarely have the opportunity to compare marks side by side. As a result, I consider that there exists a likelihood of direct confusion between the marks.

50. In the event I am incorrect about this case being an example of direct confusion, I will now consider whether there is a likelihood of indirect confusion. *In L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

51. In the present circumstances, I consider it likely that consumers would, when confronted by both the opponent's mark and the IR, believe them to originate from the same or economically connected undertakings. Even if the consumer noticed the figurative differences between the marks, they would consider them to be alternative marks of the same undertaking or marks that have been subject to a logical re-branding. Even acknowledging the low degree of distinctive character of the opponent's mark, the identity of the word elements in the marks will not be ignored and, as above, the differences in presentation merely suggest alternative marks. As a result, I consider there to be a likelihood of indirect confusion.

CONCLUSION

52. The opposition succeeds in full and, subject to any successful appeal, the IR is refused protection in the UK for all goods for which protection was sought.

COSTS

53. As the opponent has been successful in opposing the IR, it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Note 1/2023. In the circumstances, I award the opponent the sum of £350 as a contribution towards the cost of the proceedings.[6] The sum is calculated as follows:

Official fee:	£100
Preparing a notice of opposition and considering the other side's statement:	£250
Total:	**£350**

54. I therefore order Belden Inc. to pay Prysmian S.P.A the sum of £350. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 21st day of March 2025

N Barratt

For the Registrar

[6] While the opponent paid £200 for the official fee, it did not pursue the additional ground of section 5(4)(a). As a result, I am awarding £100 for the official fee, being the ordinary cost for filing section 5(2)(b) grounds only.