

O/0300/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003732378

BY NIO CO., LTD

TO REGISTER THE FOLLOWING TRADE MARK:

HALO

IN CLASSES 7, 9, 12, 22, 25, 28, 37, 39, 40 AND 42

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 432962

BY HALO ACCIDENT REPAIR CENTRE LTD

BACKGROUND AND PLEADINGS

1. On 13 December 2021, NIO CO., LTD (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. Various partial priority dates are claimed, the earliest of which is 12 October 2021 (China). The application was published for opposition purposes on 4 February 2022 and registration is sought for the goods and services set out in the Annex to this decision.¹

2. On 27 April 2022, the application was partially opposed by Halo Accident Repair Centre Ltd (“the opponent”) based upon sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (“the Act”). The opposition is directed at the applicant’s class 7, 9, 12, 37 and 39 goods and services only. The opponent relies upon UKTM no. 3003412 for the mark HALO, which was filed on 24 April 2013 and registered on 2 August 2013. The opponent relies upon all goods and services for which the mark is registered, namely:

Class 12 Parts and fittings for motor vehicles.

Class 19 Buildings and parts of buildings, being vehicle repair centres.

Class 37 Maintenance and repair of vehicles; painting of motor vehicles; paint spraying of motor vehicles.

3. Under section 5(1) of the Act, the opponent claims that the marks and the goods/services are identical.

4. Under section 5(2)(a) of the Act, the opponent claims that the marks are identical and the goods and services are identical or similar, with the result that there is a likelihood of confusion.

¹ Although the application also originally covered classes 18 and 35, these classes were deleted following the filing of a Form TM21B on 11 January 2024.

5. The applicant filed a counterstatement, admitting that the marks are identical, but denying the grounds of opposition. The applicant also requested that the opponent provide proof of use of the earlier mark.

THE HEARING

6. A hearing took place before me on 23 January 2024, by video conference. The applicant was represented by Sarah Husslein of Bristows LLP and the opponent was represented by Alexander Bajjon of Schlich. Both parties filed skeleton arguments in advance of the hearing.

EVIDENCE

7. The opponent filed evidence in chief in the form of the witness statement of Harry Abraham dated 9 May 2023, which is accompanied by 7 exhibits. Mr Abraham is a director of the opponent, a position he has held since 1 July 2022, prior to which he was Operations Manager.

8. The applicant did not file evidence.

8. I have taken the evidence into consideration in reaching my decision and will refer to it below where necessary.

RELEVANCE OF EU LAW

9. 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.

DECISION

Section 5(1)

10. Section 5(1) of the Act states:

“A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

11. By virtue of its earlier filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark had completed its registration process more than 5 years prior to the priority date of the application in issue, it is subject to the use provisions of section 6A of the Act.

Proof of use

12. I will begin by assessing whether there has been genuine use of the earlier mark. The relevant statutory provisions of section 6A are as follows:

“(1) This section applies where:

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

13. Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

14. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five-year period ending with the priority date of the application in issue. As noted above, there are a series of trade marks from which priority is claimed; the priority dates that are relevant to the classes in issue are 12 October 2021 and 22 October 2021. The parties seem to be in agreement that the relevant date should be taken from the earliest of these dates i.e. 13 October 2016 to 12 October 2021. However, in my view, genuine use should be assessed by reference to two different relevant periods (13 October 2016 to 12 October 2021 and 23 October 2016 to 22 October 2021). It is on that basis that I will proceed. However, given that these relevant periods differ by only 10 days, nothing will turn on this in any event and I will refer to them collectively as “the relevant period”.

15. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer*

Baumwollbörse [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are underway, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an

outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

16. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

17. I note the following from the opponent's evidence:

- a) The opponent was incorporated in April 2012 and has been using the earlier mark ever since.
- b) The opponent provides automobile accident repair services to insurers, motor manufacturers and directly to the general public.
- c) The opponent had 20 car repair centres across the UK at the time of Mr Abraham's evidence (in locations such as Cardiff, Swindon, Bognor Regis, Crewe and Bristol). Opening dates are not provided for these car repair centres, but Mr Abraham confirms that 10 of these were opened prior to October 2021.
- d) Mr Abraham states that the earlier mark has been prominently displayed on all of the opponent's repair centres, and has provided the following example from June 2019:²



² Exhibit HA1

e) The opponent's website has displayed the word only sign HALO (in title case) as well as the logo shown in the above image during the relevant period.³

f) The opponent's turnover (in approximate figures) is as follows:

1 January 2017 – 31 December 2017 ⁴	£4.5million
1 January 2018 – 31 December 2018	£4.9million
1 January 2019 – 31 March 2020	£9.7million
1 April 2020 – 31 March 2021	£11.3million
31 March 2021 – 31 December 2021	£12.7million

g) The opponent's marketing spend is as follows:

1 January 2018 – 31 December 2018	£678
1 January 2019 – 31 March 2020	£15,666
1 April 2020 – 31 March 2021	£4,145
31 March 2021 – 31 December 2021	£8,722

h) I note that neither the turnover figures, nor the marketing spend are broken down by goods and services.

i) Mr Abraham states that the opponent's repair service includes the painting/repainting of motor vehicles.

j) The opponent has provided 5 invoices addressed to customers in the UK dated 13 March 2017, 7 March 2017, 25 November 2016, 7 November 2016 and 28 February 2023.⁵ Plainly, the invoice dated 2023 is outside of the relevant

³ Exhibit HA2

⁴ Although the witness statement actually records this date as 2018, Mr Bajjon confirmed at the hearing that this was a typographical error and that the date was intended to refer to the calendar year 2017. This is the only logical interpretation of the figures provided in the witness statement, as otherwise the figures for 2018 would be greater than the combined figures for 2017 and 2018.

⁵ Exhibit HA4

period. The invoices relate to various vehicle repair services. They also include the provision of goods such as headlamps, grilles and lights.

- k) The opponent has provided some examples of customer reviews dated during the relevant period which make reference to part replacement and vehicle repairs being carried out.⁶

18. As noted above, the opponent predominantly uses its mark in the form of the logo listed at paragraph 17(d) above. Ms Husslein submitted that this is not use of the earlier mark as registered or acceptable variant use. I have given consideration to whether the word at the centre of that logo will be recognised by the average consumer as the word HALO. In my view, it would, albeit it is presented in an unusual font. The word HALO continues to indicate origin within that logo. Consequently, I consider this to be use of the earlier mark as registered, upon which the opponent can rely.⁷

19. The opponent has a significant turnover in the UK and it operated multiple vehicle repair centres during the relevant period. The opponent's narrative evidence is that it offers a motor vehicle repair service, and this is supported by invoices and customer reviews. I also note that there is evidence of vehicle parts being provided to customers by the opponent. I have considered whether these parts are actually being provided under the trade mark; I conclude that they are. Firstly, they are listed on invoices that display the earlier mark. Secondly, Mr Abraham confirms that the opponent has sold all goods and services under the earlier mark. Thirdly, if this were a case where the opponent was merely supplying car parts that were actually branded with a different mark (such as those supplied direct from the car manufacturer, for instance), I would expect this to be reflected in the product description listed on the invoice (e.g. Ford engine etc.). I have borne in mind Ms Husslein's submission that the turnover figures provided are not broken down by goods/services. However, Mr Abraham's narrative evidence confirms that the opponent's business is in the provision of motor vehicle repair services (which necessarily involves the provision of replacement parts). I have

⁶ Exhibit HA5

⁷ *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12 and *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22

no reason to believe that there are any broader goods and services being sold by the opponent to which these turnover figures might relate.

20. I do not consider there to be any evidence of sales made in relation to goods that could properly be deemed 'fittings' for cars (as opposed to parts). In my view, the distinction between these terms arises because parts for cars are parts of the car itself, whereas 'fittings' are goods that are not part of the car itself but are subsequently fitted to the car. The goods covered by the invoices are things such as headlamps, wheels, and bumpers, all of which would be part of the car itself. There is no evidence at all in relation to the provision of building parts in class 19. Mr Bajjon suggested that the fact that the opponent owns vehicle repair centres was enough to maintain a registration in class 19. I disagree. Plainly, the fact that the opponent may own buildings (and I have no evidence that they actually own them, as opposed to renting them) from which it offers vehicle repair services is not the same as attempting to create or maintain a share in the market in relation to buildings or parts of buildings in class 19. With regard to the services in class 37, the only evidence that I have been able to identify which relates to painting/repainting of motor vehicles is one entry in an invoice from 2016 which refers to "corrosion protect". I accept that this may be some sort of paint applied to prevent corrosion, but it may equally be some other type of product. In my view, there is insufficient evidence to establish that there has been genuine use of that term. In any event, nothing will turn on this as the evidence is sufficient to establish genuine use in relation to the broader term repair of motor vehicles in class 37. Consequently, I consider a fair specification to be:

Class 12 Parts for motor vehicles.

Class 37 Repair of motor vehicles.

Identity of the marks

21. The applicant accepts that the marks are identical.⁸

⁸ See paragraph 13 of the applicant's skeleton argument.

Comparison of goods and services

22. The opponent narrowed its pleading under section 5(1) in its skeleton argument claiming that only certain goods and services in the applicant's specification were identical to those in the opponent's specification. Consequently, I will deal with only those terms here, returning to the goods and services that the opponent claims are only similar to those in its own specification under the section 5(2)(a) ground.

23. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

"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."

24. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

25. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

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

26. 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. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“...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.”

Class 7

Air filter (engine parts); Pistons for vehicle engines; mufflers for motors and engines; Automobile engine exhaust gas recirculation system; Automobile engine exhaust

purification device (catalytic reactor); Cylinders for motors and engines; Hydraulic engine and motor; Radiator for automobile engine cooling; Generator Set; Motor and engine starter; Cylinder heads for engines; Alternator; Compressors (machines); Valves (machine, engine or motor parts); Hydraulic pumps; Pressure regulating valve; Electric door openers; Vehicle bearings; Automobile engine crank shaft; Electric window closers; Machine linkage; Shock absorber plungers [parts of machines].

27. The opponent claims that these are all parts of vehicles and are, therefore, identical to its own class 12 goods. These are not parts of vehicles, as such, but are parts of items which are themselves parts of vehicles (such as windows, doors and engines). This is why they are not proper to class 12, but class 7. I do not, therefore, consider them to be identical to the opponent's class 12 goods. However, I do accept that there is an overlap in nature, trade channels and user and the goods will be similar to at least a medium degree.

Dust removing installations for cleaning purposes.

28. Mr Bajjon suggested that this term would include the vents used in cars which, he claimed, remove dust whilst circulating air. I disagree, because such goods would be in class 11, not class 7. In any event, I have no evidence before me to suggest that vents used in vehicles are fitted with any sort of air filtration used for removing dust. In any event, when considering the meaning of terms in a specification, it is important to consider their literal meaning.⁹ I do not consider that this term can be construed so widely as to include parts of a car air conditioning system, not least because the term specifically includes reference to the device being used "for cleaning purposes". I can see no basis for there to be an overlap in trade channels, nature, method of use, purpose or user. There is no competition or complementarity. I consider the goods to be dissimilar.

⁹ *Sky v Skykick* [2020] EWHC 990 (Ch)

Class 9

Navigation instruments; Signal lights; Batteries for vehicles; Battery; Alarm; Sensor; Mirror (optical); Radio equipment for vehicles; Camera (photography) for vehicles, not for use in the professional film and television industry; Driving recorder; Rear-view camera for vehicle; none of the aforementioned goods being for use in the healthcare or hygiene sector, with the exception of goods that monitor the health of a vehicle driver and vehicle passengers.

29. I accept that these are all goods that would be included or used within a vehicle. However, they are included in class 9 (rather than class 12) due to their particular primary functions. Consequently, I consider that the goods would overlap in trade channels and user with the opponent's class 12 goods. There is no competition or complementarity. The goods are similar to at least a low degree.

Measuring tools; Measuring device; none of the aforementioned goods being for use in the healthcare or hygiene sector, with the exception of goods that monitor the health of a vehicle driver and vehicle passengers.

30. In my view, these terms are broad enough to include goods such as speedometers which are parts of a motor vehicle, used to enable the driver to measure their speed. For the same reasons given in paragraph 29 above, I consider these goods to share a low degree of similarity with the opponent's goods.

Weighing instruments; none of the aforementioned goods being for use in the healthcare or hygiene sector, with the exception of goods that monitor the health of a vehicle driver and vehicle passengers.

31. At the hearing, I asked Mr Bajjon for submissions in respect of this term and how it could be said to be part of a car. He submitted that: 1) there would be parts of a car that are monitoring the presence of fuel (presumably by reference to weight) and 2) there will be various car parts that measure the mass of something for monitoring the status of the car. I have no evidence before me as to any examples of weighing instruments being used within motor vehicles and I do not consider it to be a fact of

which I can take judicial notice. I would have thought it more likely that fuel levels within a car are monitored by reference to the level of fuel within the tank, rather than by reference to weight. With that in mind, I can see no overlap in trade channels, method of use, purpose or nature with the opponent's goods and services. There is no competition or complementarity. Clearly, the users may overlap, but that is not sufficient on its own for a finding of similarity. I consider the goods and services to be dissimilar.

Electronic terminal equipment for expressway toll collection.

32. Again, I asked Mr Bajjon for submissions on this term at the hearing. His position was that this term would include goods such as smart tags that would be fitted to a car so that when the user drives through a toll it is possible for the user's car to be matched with an account through which the requisite payment is made. When interpreting the meaning of terms they should be given their literal meaning. In my view, the term "electronic terminal equipment" is unlikely to be so broad as to include smart tags fitted to the inside of vehicles; rather, this seems more likely to me to cover goods such as the actual terminals stationed at tolls which collect the data from smart tags. I have no evidence before me to the contrary. In any event, even if I am wrong in that finding, smart tags cannot, in my view, be described as car parts. They might be fitted to a car, but they are not part of the car itself. I consider it unlikely that such goods would be sold by businesses that sell car parts, as they are more likely to be sold by the businesses operating the tolls themselves. There is, therefore, no overlap in trade channels. The nature, purpose and method of use of the goods clearly differs. There is no competition or complementarity. Whilst I accept that the user is the same, that is not sufficient on its own for a finding of similarity. I consider the goods to be dissimilar.

Time recording device.

33. I have no evidence before me to suggest that there are time recording devices typically included as parts of motor vehicles. This is not something that I have knowledge of myself, and not something that I consider it appropriate to take judicial notice of. The burden is on the opponent to demonstrate that the goods and services in issue are identical or similar. In my view, they are not identical. Further, there is no

obvious point of similarity in nature, purpose, method of use or trade channels with the opponent's goods and services. There is no competition or complementarity. The users may overlap, but that is not sufficient on its own for a finding of similarity. I consider the goods and services to be dissimilar.

Interactive touch screen terminals; Video display screen.

34. I accept that these terms are broad enough to include the visual display terminals often found on the dashboard of motor vehicles. Consequently, for the same reasons set out above, there is an overlap in trade channels and user. I consider there to be at least a low degree of similarity with the opponent's class 12 goods.

Computer peripheral equipment.

35. I accept that motor vehicles often have built in computer systems which carry out various functions. I also accept that they often have built in monitors as part of that system. In my view, those monitors are a type of computer peripheral equipment. Consequently, for the same reasons set out at paragraph 34 above, I consider these goods to be similar to a low degree.

Semiconductor devices; Chip (integrated circuit); Semiconductor; Cable.

36. Again, these goods seem most likely to me to be parts of items that are themselves parts of motor vehicles. For the same reasons set out above, I consider that there is likely to be an overlap in trade channels and user, resulting in a low degree of similarity with the opponent's goods.

Personal accident prevention device.

37. It is not entirely clear to me what this term would include. However, in my view, it is more likely to refer to items used to prevent, for example, falls whilst engaging in outdoor pursuits or completing tasks in dangerous working environments; certainly, there is nothing in the term itself to suggest that these are goods that would typically be found within vehicles. I have no evidence before me to suggest that they would be

or to set out examples of what car parts might fall within this term. I recognise that cars have accident prevention devices (such as anti-lock braking apparatus), but this is not within this class. I have also considered whether features such as automatic braking or lane assist functions within a motor vehicle might be included within this term. However, I do not consider that they would be. Firstly, I am not convinced that this would actually be a 'good' or 'device' in itself, as opposed to a functionality of certain parts of a motor vehicle. Secondly, even if it was, I am not convinced that it would properly be described as 'personal' as it relates to the safety of a motor vehicle, and its passengers, rather than the safety of an individual. Consequently, I can see no basis for finding any overlap in nature, trade channels, method of use or purpose. There is no competition or complementarity. Any overlap in user is insufficient on its own for a finding of similarity. The goods and services are dissimilar.

Portable Media Player.

38. This is a device such as a tablet or MP3 player than enables you to listen to music or watch videos whilst on the move. Whilst I accept that motor vehicles may have inbuilt media players, the very fact that this term is described as portable prevents it from being a part which is physically attached or integrated into a vehicle, in my view. With that in mind, I can see no basis for finding any overlap in trade channels, method of use, nature or purpose with the opponent's goods and services. There is no competition or complementarity. I consider the goods and services to be dissimilar.

Class 12

Tires for vehicles, none being tyres for bicycles; steering wheels for vehicles; Parts and fittings for vehicles, none being parts and fittings for bicycles; clips adapted for fastening automobile parts to automobile bodies.

39. These are all parts and fittings for motor vehicles. To the extent that they are parts for motor vehicles, they will be self-evidently identical or identical on the principle outlined in *Merit* to the opponent's goods. I do not consider "fittings" to be identical to "parts", as explained above, but I accept that some fittings for motor vehicles may be

sold through the same retailers, to the same users, and may overlap in nature, method of use and purpose with the opponent's goods. Consequently, they are highly similar.

Safety seats for children, for vehicles.

40. I recognise that these goods would be fitted within a motor vehicle by the user. However, they cannot be described a "part" of a motor vehicle. I asked Mr Bajjon about the factors relevant to similarity at the hearing, but he said that his focus was upon identity and elected not to make any back-up submissions in relation to similarity. In my experience, these goods are typically sold by different retailers (being retailers specialising in children's goods) to those who sell vehicle parts and associated services (being car retailers and maintenance businesses). Even if there are some retailers that sell both types of goods, they are likely to be very large and the goods would be sold in distinct sections. The purpose of the goods clearly differs, as does the nature and method of use. There is no competition or complementarity. I consider the goods and services to be dissimilar.

Class 37

Car maintenance and repair; Repair and maintenance of electric vehicles.

41. The applicant admits that these services are identical to those of the opponent. To the extent that these services are maintenance, rather than repair, they would be highly similar to the opponent's services due to an overlap in trade channels, user, method of use, nature and purpose.

Mechanical installation, maintenance and repair.

42. This term is broad enough to cover the opponent's motor vehicle repair services. Consequently, I consider it to be identical on the principle outlined in *Meric* to the opponent's services.

Installation and repair of heating equipment; Installation and repair of anti-theft alarm system.

43. In my view, these terms could all cover the repair of parts of vehicles (being the heating system or the alarm system within the car). Consequently, I consider them to be encompassed by the opponent's services and they are identical on the principle outlined in *Meric*.

Elimination of interference of electronic equipment.

44. To my understanding, this service would cover the elimination of interference caused by an external source which is affecting electronic equipment. I have no evidence before me to suggest that this is a service that would be offered through the same trade channels as the opponent's goods and services, nor do I consider it likely. This appears to me to be a specialised service that would be offered by a distinct business. There is no overlap in nature, method of use or purpose. I can see no obvious point of competition (given the differing purposes) or complementarity (given that the same undertaking would not be perceived as a responsible for the goods/services). The user may overlap, but that is not sufficient on its own for a finding of similarity. The goods and services are dissimilar.

Vehicle battery replacement.

44. Ms Husslein submitted that these should not be considered identical to the opponent's services, because they are not repair services; it is simply the replacement of a depleted battery for a new battery. However, I consider that to be too narrow an interpretation of this term. A customer may require vehicle battery replacement for any number of reasons; for example, because the battery has simply depleted over time and requires replacement, or because it has been damaged in the course of an accident. In the context of motor vehicles, the repair of a vehicle is likely to involve the replacement of a defective part. Consequently, I agree with Mr Bajjon that these services are identical on the principle outlined in *Meric* to the opponent's services.

Car body repair.

45. Ms Husslein submitted that this service is not a type of repair service because it relates to “work on the aesthetic parts of the exteriors” of the car, rather than a service that repairs “the vehicle itself”. However, I put it to Ms Husslein at the hearing that if I damaged the exterior of my car in the course of an accident or collision, that I would require body work to be undertaken as part of the repair of the vehicle. Ms Husslein accepted that that was correct. To my mind, these services are clearly identical on the principle outlined in *Meric* to the opponent’s services.

Delivery vehicle repair service.

46. Ms Husslein submitted that this term was not identical to the opponent’s services because it was a delivery service, not a repair service. I questioned Ms Husslein about this at the hearing, as I read this term as covering the repair of delivery vehicles, which would plainly be a type of repair service. Ms Husslein submitted that it is a delivery service for vehicle repairs, which involves “a company going from one place to the other offering repair services”. Firstly, if this was in fact a delivery service it would be in class 39 and not class 37. Secondly, Ms Husslein’s own explanation makes it clear that this would in fact be a repair service, albeit a mobile one. Consequently, I consider this service to be identical on the principle outlined in *Meric* to the opponent’s services.

Vehicle service station (refueling and maintenance).

47. I accept that businesses that offer refuelling and maintenance services may also offer repair services for motor vehicles. Consequently, there is some overlap in trade channels and user with the opponent’s services. Maintenance services typically offered at a service station are things such as pumps to increase tyre pressure. They are unlikely to be the same in nature or method of use with the opponent’s services. However, there will be some overlap in purpose, as they are all aimed at the successful functioning of the vehicle. I consider the services to be similar to a medium degree.

Customized installation of car interiors.

48. I accept Ms Husslein's submission that these are not repair services, because they are services undertaken for customisation purposes rather than because there has been some damage caused. However, the same businesses may provide both services, to the same users. There may also be some limited overlap in nature and/or method of use. Consequently, I consider the services to be similar to a medium degree.

Class 39

Car Rental; Transportation; Towing service for vehicle failure; Motor transportation; Travel and transportation arrangements.

49. Mr Bajjon submitted that it is the opponent's case that these services include the provision of courtesy cars, which are actually part of a repair service (the inference being that they are identical to the repair services). I disagree. They are clearly distinct services, recorded in different classes. I accept that the same businesses that offer repair services are also likely to offer courtesy cars. However, I am not convinced that the provision of courtesy cars would fall within the natural meaning of 'car rental' which typically involves paid for use of a car by a customer, as opposed to a free courtesy car. I do not, therefore, consider there to be an overlap in trade channels. The nature, method of use and purpose of the services clearly differ. There is no competition or complementarity. I find them to be dissimilar.

Transportation; Towing service for vehicle failure; Motor transportation.

49. Mr Bajjon submitted that it is the opponent's case that these services include the provision of towing services. For the same reasons given above, I do not consider this to be identical to the opponent's services. However, I accept that the same businesses that offer repair services are also likely to offer towing services for their users. There is, therefore, an overlap in trade channels and user with the opponent's services. However, the nature, method of use and purpose of the services differ. There is no competition or complementarity. I find them to be similar to a low degree.

Travel and transportation arrangements.

50. Mr Baijon made the same arguments in relation to these services. However, in my view, these services relate to the making of 'arrangements' for transportation, rather than the provision of a service such as a towing service in itself. This suggests some sort of intermediary role. In my view, there is no basis for finding an overlap in trade channels, nature, method of use or purpose. There is no competition (given the differing purposes) and no complementarity (given that the same undertaking would not be perceived as responsible for the services). The user may overlap at a broad level, but that is not enough on its own for a finding of similarity. I consider the goods and services to be dissimilar.

Conclusions on section 5(1)

50. The parties agree that the marks are identical, and so the section 5(1) ground of opposition must succeed for all goods and services that I have found to be identical to the opponent's goods and services. The opposition under this ground therefore succeeds in relation to the following goods and services:

Class 12 Tires for vehicles, none being tyres for bicycles; Steering wheels for vehicles; Parts [...] for vehicles, none being parts [...] for bicycles; clips adapted for fastening automobile parts to automobile bodies.

Class 37 Installation and repair of heating equipment; Mechanical installation, maintenance and repair; Installation and repair of anti-theft alarm system; Car maintenance and repair; Delivery vehicle repair service; Repair and maintenance of electric vehicles; Car body repair; Vehicle battery replacement.

Section 5(2)(a)

51. Section 5(2)(a) of the Act states:

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

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

(b) [...]

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

52. The same findings apply in relation to proof of use as set out above.

52. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(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 greater degree of similarity between the marks, and vice versa;

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

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

53. I apply the same findings here as set out above under the section 5(1) ground.

54. Further, I also make findings in respect of those goods and services in the applicant's specification that the opponent considers to be similar to its own specification (rather than identical).

Class 7

Lifting device; Three-dimensional garage with lifting equipment; metalworking machines; Handling machines, automatic [manipulators]; Industrial Robot; Cutting Machine.

55. The opponent's argument regarding these terms is that they are all machines that would be used within a vehicle repair centre. However, it seems to me that even if that is correct, the purpose of the goods clearly differs to those of the opponent's goods and services. The opponent's goods have specific purposes dependent on their function within a vehicle, and the opponent's services have the purpose of repairing vehicles. The fact that the applicant's goods might be used by a business that is undertaking these activities does not mean that the goods themselves have the same purpose as the opponent's goods and services. The nature and method of use will also differ. The fact that vehicle repair centres use these goods does not indicate an overlap in trade channels, as they are not likely to sell such goods, whereas they would sell the opponent's goods and services. There is no competition or complementarity. If there is any overlap in user by virtue of the fact that vehicle repair centres may purchase car parts which are then used as part of their repair service, and also purchase these goods to use within their centres, that is not sufficient on its own for a finding of similarity. I consider the goods and services to be dissimilar.

Class 9

Charging stations for electric vehicles.

56. I accept that businesses that make and sell electric cars (and their parts) are likely to also provide charging stations for users to be able to recharge their vehicles. Consequently, there is an overlap in trade channels and user. The goods do not have

the same purpose, method of use or nature. They are not in competition (given their differing purposes) or complementary (as one is not important or indispensable for the other). I consider the goods to be similar to a low degree.

Copying and fax machines.

57. I can see no reason for the goods to overlap in method of use, purpose, trade channels or nature with the opponent's goods and services. There is no competition or complementarity. The user may overlap to the extent that they may all be used by members of the general public, but that is not sufficient for a finding of similarity. I consider the goods and services to be dissimilar.

Optical fiber (optical fiber).

58. I understand these to be a type of flexible glass or plastic fibre that can transmit light from one end to the other. Unlike other terms in the applicant's class 9 specification, the opponent did not argue that these goods were identical to parts for motor vehicles, suggesting that it does not consider that they are themselves vehicle parts. The opponent argued that they are only similar to the opponent's class 12 goods. However, if they are not themselves parts of vehicles, I can see no basis for there to be an overlap in trade channels, nature, method of use or purpose and no explanation is put forward by the opponent. There is no competition or complementarity. The user may overlap to the extent that they may all be used by members of the general public, but that is not sufficient for a finding of similarity. I consider the goods and services to be dissimilar.

Facial recognition equipment; Humanoid robot with artificial intelligence.

59. The opponent's submissions in relation to these goods focus on the fact that they might be provided as part of or found within a motor vehicle. I have no evidence of this before me, nor do I consider it to be a notorious fact of which I can take judicial notice. I can see no obvious point of overlap in trade channels, method of use, nature or purpose with the opponent's goods and services. There is no competition or

complementarity. Any overlap in user is not sufficient on its own for a finding of similarity. I consider the goods and services to be dissimilar.

Remote control device.

60. I accept that these goods could include car keys which are used as part of a remote control central locking system. Consequently, there is an overlap in trade channels and user with the opponent's goods. The nature, method of use and purpose of the goods will differ. However, there may be some complementarity with other parts of the central locking system (which would be covered by the opponent's specification). I consider the goods to be similar to a medium degree.

Electrolysis device.

60. I understand these to be devices that facilitate the passing of an electric current through a particular substance in order to produce chemical changes. These are clearly technical goods, and I have no knowledge of whether these would be used within a car. Further, I have no evidence before me to suggest that they would be. In the absence of any such evidence, I can find no basis for there to be an overlap in trade channels, method of use, purpose or nature with the opponent's goods and services. There is no competition or complementarity. Any overlap in user is not sufficient on its own for a finding of similarity. I consider the goods and services to be dissimilar.

Lightning rod.

61. I understand these to be rods fitted to structures to prevent damage in the event of a lightning strike. I have no evidence before me to suggest that such rods are fitted to vehicles, and it is not a notorious fact of which I can take judicial notice. I can see no obvious point of overlap in nature, purpose, method of use or trade channels. There is no competition or complementarity. Even if there would be an overlap in user, that is not sufficient on its own for a finding of similarity. I consider the goods and services to be dissimilar.

Heat regulation device.

62. I accept that cars are fitted with various heat regulation devices as part of their air-conditioning systems. Consequently, there is an overlap in trade channels and user with the opponent's goods. I consider these goods to be similar to a low degree.

Holograms; Animation.

63. Mr Bajjon submitted that there are "examples where holograms have been fitted to the interior display of cars to give them more aesthetic appeal. It looks like the image is deeply embedded within the dashboard, but it is just a trick of the eye based on a hologram, so holograms as part of the décor of the interior of a car". Mr Bajjon also submitted that the term "animation" would include such holograms. He acknowledged that no evidence had been filed to support this contention. In the absence of such evidence, I am not prepared to make a finding that these goods are typically included within cars. I can see no obvious point of overlap, nature, purpose, method of use or trade channels. There is no competition or complementarity. Even if there would be an overlap in user, that is not sufficient on its own for a finding of similarity. I consider the goods and services to be dissimilar.

Fire extinguisher.

64. Mr Bajjon submitted that certain types of motor vehicle might have fire extinguishers fitted within them. This is not a matter that I consider to be a notorious fact of which I can take judicial notice, nor have I been provided with any evidence. Even if it is the case that some vehicle users might carry fire extinguishers (perhaps smaller versions adapted to be more easily carried in the vehicle), I consider it unlikely that they would be sold by the same undertakings that make vehicle parts or offer vehicle repair services. There is no overlap in nature, method of use or purpose. There is no competition or complementarity. Any overlap in user is not sufficient on its own for a finding of similarity. I consider the goods and services to be dissimilar.

Industrial radiological equipment.

65. I asked Mr Bajjon to explain to me why these goods should be considered similar to the opponent's goods and services. He was unable to provide any explanation. I can see no point of overlap in nature, method of use, trade channels or purpose. There is no competition or complementarity. Even if there is an overlap in user at a very general level, that is not sufficient on its own for a finding of similarity. I consider the goods and services to be dissimilar.

Glasses.

66. Mr Bajjon acknowledged that if this term was intended to refer to spectacles then it was difficult to explain how similarity might arise. His submissions were more focused on 'glass' being a type of material. However, that type of glass would not be in class 9 and would not be described as 'glasses'. With that in mind, I can see no point of overlap in nature, method of use, trade channels or purpose. There is no competition or complementarity. Even if there is an overlap in user at a very general level, this is not sufficient on its own for a finding of similarity. I consider the goods and services to be dissimilar.

Downloadable mobile phone application software; Computer software (recorded).

67. I accept that these goods could include software for use with motor vehicles (or parts of motor vehicles). For example, it could include software that enables a driver to turn on the heating system within a car prior to entry. It could also include software which enables a viewer to review the current charge levels of the battery within an electric vehicle from a mobile application. Consequently, I accept that there may be an overlap in trade channels and user with the opponent's goods. There may also be complementarity. Plainly, the goods have different natures, purposes and methods of use. Consequently, I consider the goods to be similar to a medium degree.

Class 12

Trolley; Cable car.

68. I do not consider that either of these goods would be termed “motor vehicles”. Consequently, I can see no reason for there to be an overlap in trade channels, method of use, purpose or nature with the opponent’s goods and services. There is no complementarity or competition. Any overlap in user is not sufficient on its own to give rise to a finding of similarity. I consider the goods to be dissimilar.

Motorized vehicles for land, [...], none being electric powered bicycles; Sports car; Electric vehicles, none being electric bicycles; Driverless cars; Self-driving cars; Motorcycle.

69. These goods are all types of motor vehicles. Consequently, there will be an overlap in trade channels and user with the opponent’s goods. They are also important or indispensable for each other, and the average consumer would expect them to originate from the same undertaking, meaning that they are complementary. I consider the goods to be similar to a medium degree.

Motorized vehicles for [...] air, water or railway, none being electric powered bicycles;

70. These goods are all motorized vehicles, but they are not what is naturally meant by the term “motor vehicle” which typically refers to road vehicles. It seems to me that businesses that offer these goods in the applicant’s specification are likely to be specialist businesses and are unlikely to overlap with the opponent’s goods and services. There is no overlap in nature, method of use or purpose. There is clearly no competition, and I can see no reason for there to be complementarity given that the same undertaking would not be perceived as responsible for the goods/services. Even if there was an overlap in user (which I consider unlikely), this would not be sufficient on its own for a finding of similarity. I consider the goods and services to be dissimilar.

Class 37

Construction equipment rental.

70. The same argument was made in respect of these services as made in relation to the class 7 goods, discussed at paragraph 55 above. These are services that are unrelated to motor vehicles. I consider it unlikely that a vehicle repair centre would actually be a user of construction equipment rental services, because they are not themselves engaged in construction, but even if they were, the best possible case for the opponent on that basis is an overlap in user. Plainly, the nature, method of use, purpose and trade channels of the goods and services differ. There is no competition or complementarity. I find them to be dissimilar.

Installation and repair of medical equipment.

71. Mr Bajjon submitted that the opponent's best case in relation to this term was in circumstances where there was medical equipment fitted as part of a vehicle itself. For example, he submitted that vehicles that are specifically adapted to enable wheelchair users to access them are likely to have medical equipment installed within them. Even if that is the case, I consider it unlikely that they would be installed or repaired by the same businesses that undertake repairs of the actual cars (or their parts) themselves. They are likely to be installed and repaired by specialist businesses. The user may overlap, but the goods and services would differ in purpose, method of use, nature and trade channels. There is no competition or complementarity. I consider them to be dissimilar.

Furniture maintenance.

72. Mr Bajjon argued that this term was broad enough to cover maintenance of car seats, for example. I disagree. I agree with Ms Husslein that the core meaning of furniture maintenance would not include the maintenance of parts of motor vehicles (seats or otherwise). The nature, method of use, purpose and trade channels of the services differ. There is no competition or complementarity. The users may be the same, but that is not sufficient on its own for a finding of similarity. I consider the services to be dissimilar.

Leather care, cleaning and repair.

73. The opponent submitted that these services would include repair work undertaken to the leather seats of a car. I agree. Consequently, they are identical on the principle outlined in *Merix* to “repair of motor vehicles” in the opponent’s specification.

Interior decoration repair.

74. The opponent made very similar submissions in relation to these services i.e. that they could cover services for the repair of the interior of cars. However, in my view, the term “interior decoration” typically refers to home interiors (such as interior design etc.). I consider it unlikely that this term is broad enough to cover repairs to the interior of a car. As such, I do not consider it likely that there will be any overlap in trade channels. The method of use and purpose of the services will differ. Whilst I accept that there may be some overlap at a very broad level in terms of nature, to the extent that both parties have ‘repair’ services, their specific natures are different. Any overlap in user is at a very broad level. There is no competition or complementarity. I consider the services to be dissimilar. The opponent’s goods do not put it in any stronger position.

Disinfection.

74. This relates to a cleaning service, typically one targeted at eliminating germs. I do not consider this to be similar in purpose to the opponent’s repair services, nor do I consider it to be similar in method of use or nature. The user of the services may clearly overlap. However, I consider it unlikely that there would be any overlap in trade channels. It is important to consider the core meaning of the term, and I do not consider the service of “disinfection” likely to be something that is applied to motor vehicles. Whilst motor vehicles may be cleaned by businesses that offer a repair service, disinfection suggests a specialised cleaning process targeted at the elimination of germs. Even if a motor vehicle was disinfected, it is unlikely to be done by the same business as those providing the opponent’s goods and services. I do not consider this to be in competition or complementary to the opponent’s goods and services. They are dissimilar.

Motor vehicle charging service; Vehicle battery charging service; Electric vehicle charging service.

75. In my experience, it is not uncommon for businesses that sell electric vehicles (and their replacement parts) to also provide re-charging stations for use post-sale. Consequently, I consider these services to overlap in trade channels and user with the opponent's goods. There is no overlap in nature, method of use or purpose. I also do not consider them to be in competition or complementary. I consider the goods and services to be similar to a low degree.

Class 39

Racing car rental; Cargo storage; Parcel delivery.

76. I can see no reason for these services to overlap in nature, purpose, method of use, trade channels or user with the opponent's goods and services. There is no competition or complementarity. Consequently, I consider them to be dissimilar.

Energy Distribution.

77. I have considered whether this term might be linked with the opponent's arguments regarding the provision of charging stations for electrical vehicles, provided by car manufacturers. However, in my view, this term covers the distribution of the energy itself. For example, it would relate to businesses that are responsible for supplying the electricity used at electric charging stations. There is, therefore, no overlap in nature, method of use, purpose or trade channels. There is no competition or complementarity. Any overlap in user is not sufficient on its own for a finding of similarity. I consider the goods and services to be dissimilar.

Navigation system rental.

78. I accept that navigation systems may include goods such as satnavs which are typically used within cars. Mr Bajjon suggested that these may be rented out along

with a courtesy car. However, I have no evidence before me to suggest that businesses that sell motor vehicle parts (or provide repair services for motor vehicles) also offer the rental of navigation systems. It seems more likely to me that these will be provided by distinct undertakings. I accept that the users may overlap. However, the nature, method of use and purpose will differ. There is no competition or complementarity. Consequently, I consider them to be dissimilar.

Car driving service.

79. Mr Bajjon submitted that the point of similarity between these services and the services of the opponent is that car repair businesses sometimes offer a service by which they collect the customer's car from their home and drive it to the repair centre for the necessary work to be undertaken. I accept that this term is broad enough to cover the driving of a car for a customer, whether the customer is a passenger in that car or not. Consequently, I consider there to be an overlap in trade channels and user. The services are similar to a low degree.

The average consumer and the nature of the purchasing act

80. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. 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 (as he then was) 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.”

81. The average consumer for the goods and services will be either a member of the general public or a business user (such as a car rental company looking to repair one of its cars). Whilst the goods and services will range in price, they are likely to be reasonably considered purchases, taking account of factors such as functionality, suitability for requirements and customers service standards. Consequently, I consider that at least a medium degree of attention will be paid during the purchasing process. However, I bear in mind that the level of attention is likely to be higher for many of the goods and services, as the customer may be concerned with the safety of their vehicle after repairs have been completed (depending on the issue that needs resolving) so is likely to ensure that a reputable service provider or suitable car part is purchased.

82. The goods and services are likely to be selected following perusal of signage at physical premises, on advertisements or on websites. Consequently, I consider that the purchasing process will be predominantly visual. However, I do not discount an aural component to the purchase given that advice may be sought from suppliers and orders/bookings may be placed by telephone.

Comparison of trade marks

83. As above, the marks are identical.

Distinctive character of the earlier mark

84. 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 1-2779, 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)."

85. 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 distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

86. I will begin by considering the inherent distinctiveness of the earlier mark. The word HALO is an ordinary dictionary word. However, it has no connection with the goods and services in issue. In my view, it is distinctive to an average (or medium) degree.

87. I have summarised the opponent's evidence of use above. I do not consider that the opponent's mark has acquired enhanced distinctiveness through use. This is because, whilst the opponent's turnover figures are not insignificant, the advertising spend invested in the mark is very small and I have no market share figures. Further, I do not know which of the opponent's centres were open prior to the relevant date, so it is difficult for me to assess the geographic spread of the use at that time.

Likelihood of confusion

88. 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 respective goods and services down to the responsible undertaking 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 marks may be offset by a greater degree of similarity between the goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing act. 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 he has retained in his mind.

89. I have found as follows:

- a) The goods and services vary from being similar to a low degree to identical (except where I have found them to be dissimilar).
- b) The average consumer for the goods and services will be a member of the general public or a business user who will pay at least a medium degree of attention during the purchasing process (but it will be higher for most of the goods and services).
- c) The purchasing process is predominantly visual, although I do not discount an aural component.
- d) The marks are identical.
- e) The earlier mark is inherently distinctive to a medium (or average) degree.

90. For those goods and services that I have found to be dissimilar, the opposition under section 5(2)(a) of the Act cannot succeed.¹⁰ However, taking all of the above factors into account, I consider there to be a likelihood of direct confusion where the marks are used on goods and services that I have found to be similar. The marks are identical and so there is nothing to enable the average consumer to distinguish between them, and the application of the interdependency principle means that even where there is greater distance between the goods and services this will be offset by the identity of the marks.

91. In reaching this conclusion, I have borne in mind Ms Husslein's submission that there is no evidence of actual confusion in the marketplace. However, there is no evidence before me to show that the applicant is actually trading (or the extent to which it has been trading, if indeed it has). Consequently, it is not surprising that there is no evidence of actual confusion in the marketplace. I do not, therefore, consider that this line of argument assists the applicant.

92. The opposition based upon section 5(2)(a) of the Act succeeds in relation to the following goods and services:

Class 7 Air filter (engine parts); Pistons for vehicle engines; mufflers for motors and engines; Automobile engine exhaust gas recirculation system; Automobile engine exhaust purification device (catalytic reactor); Cylinders for motors and engines; Hydraulic engine and motor; Radiator for automobile engine cooling; Generator Set; Motor and engine starter; Cylinder heads for engines; Alternator; Compressors (machines); Valves (machine, engine or motor parts); Hydraulic pumps; Pressure regulating valve; Electric door openers; Vehicle bearings; Automobile engine crank shaft; Electric window closers; Machine linkage; shock absorber plungers [parts of machines].

Class 9 Navigation instruments; Signal lights; Measuring tools; Interactive touch screen terminals; Computer peripheral equipment; Downloadable

¹⁰ *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA

mobile phone application software; Computer software (recorded); Batteries for vehicles; Battery; Charging stations for electric vehicles; Alarm; Heat regulation device; Video display screen; Sensor; Semiconductor devices; Chip (integrated circuit); Semiconductor; Cable; Mirror (optical); Measuring device; Radio equipment for vehicles; Camera (photography) for vehicles, not for use in the professional film and television industry; Driving recorder; Rear-view camera for vehicle; none of the aforementioned goods being for use in the healthcare or hygiene sector, with the exception of goods that monitor the health of a vehicle driver and vehicle passengers.

Class 12 Motorized vehicles for land, [...] none being electric powered bicycles; Sports car; Electric vehicles, none being electric bicycles; Driverless cars; Self-driving cars; Motorcycle; Fittings for vehicles, none being [...] fittings for bicycles.

Class 37 Leather care, cleaning and repair; Motor vehicle charging service; Vehicle battery charging service; Electric vehicle charging service; Vehicle service station (refueling and maintenance); Customized installation of car interiors.

Class 39 Transportation; Towing service for vehicle failure; Motor transportation; Car driving service.

CONCLUSION

93. The opposition is successful in relation to the following goods and services for which the application is refused:

Class 7 Air filter (engine parts); Pistons for vehicle engines; mufflers for motors and engines; Automobile engine exhaust gas recirculation system; Automobile engine exhaust purification device (catalytic reactor); Cylinders for motors and engines; Hydraulic engine and motor; Radiator for automobile engine cooling; Generator Set; Motor and engine starter;

Cylinder heads for engines; Alternator; Compressors (machines); Valves (machine, engine or motor parts); Hydraulic pumps; Pressure regulating valve; Electric door openers; Vehicle bearings; Automobile engine crank shaft; Electric window closers; Machine linkage; shock absorber plungers [parts of machines].

Class 9 Navigation instruments; Signal lights; Measuring tools; Interactive touch screen terminals; Computer peripheral equipment; Downloadable mobile phone application software; Computer software (recorded); Batteries for vehicles; Battery; Charging stations for electric vehicles; Alarm; Heat regulation device; Video display screen; Sensor; Semiconductor devices; Chip (integrated circuit); Semiconductor; Cable; Mirror (optical); Measuring device; Radio equipment for vehicles; Camera (photography) for vehicles, not for use in the professional film and television industry; Driving recorder; Rear-view camera for vehicle; none of the aforementioned goods being for use in the healthcare or hygiene sector, with the exception of goods that monitor the health of a vehicle driver and vehicle passengers.

Class 12 Motorized vehicles for land, [...] none being electric powered bicycles; Sports car; Tires for vehicles, none being tyres for bicycles; Electric vehicles, none being electric bicycles; Driverless cars; Self-driving cars; steering wheels for vehicles; Motorcycle; Parts and fittings for vehicles, none being parts and fittings for bicycles; clips adapted for fastening automobile parts to automobile bodies.

Class 37 Installation and repair of heating equipment; Mechanical installation, maintenance and repair; Installation and repair of anti-theft alarm system; Leather care, cleaning and repair; Motor vehicle charging service; Vehicle battery charging service; Electric vehicle charging service; Car maintenance and repair; Vehicle service station (refueling and maintenance); Delivery vehicle repair service; Repair and maintenance of electric vehicles; Car body repair; Customized installation of car interiors; Vehicle battery replacement.

Class 39 Transportation; Towing service for vehicle failure; Motor transportation; Car driving service.

94. The opposition is unsuccessful for the remaining challenged goods and services for which the application may proceed to registration, along with those goods and services that were unopposed:

Class 7 Lifting device; Three-dimensional garage with lifting equipment; metalworking machines; Handling machines, automatic [manipulators]; Industrial Robot; Cutting Machine; dust removing installations for cleaning purposes.

Class 9 Weighing instruments; Copying and fax machines; Facial recognition equipment; Holograms; Electronic terminal equipment for expressway toll collection; Time recording device; Humanoid robot with artificial intelligence; Animation; Glasses; Personal accident prevention device; Industrial radiological equipment; Fire extinguisher; Electrolysis device; Lightning rod; Optical fiber (optical fiber); Remote control device; Portable Media Player; none of the aforementioned goods being for use in the healthcare or hygiene sector, with the exception of goods that monitor the health of a vehicle driver and vehicle passengers.

Class 12 Motorized vehicles for [...] air, water or railway, none being electric powered bicycles; Trolley; Cable car; safety seats for children, for vehicles.

Class 22 Non-metallic tape for packaging or bundling; Camouflage Net; Vehicle non-dedicated cover; Sail; Wind barrier cloth; Textile awning; Gunny bags for transporting and storing bulk materials; Straw packaging for bottles; Non-rubber, non-plastic, non-paper or cardboard filling materials; Fiber textile raw materials; Tent; Camouflage nets used in hunting; none of the aforesaid goods being for angling or fishing.

- Class 25 Clothing, none being cyclists' apparel; T-shirts; Baby clothes; Motorist's clothing; Waterproof clothing, none being cyclists' apparel; Costumes; Shoes (things worn on the feet), none being cyclists' apparel; Cap; Socks; Gloves (clothing), none being cyclists' apparel; Bibs, none being cyclists' apparel; Waistbands; Garment Ribbon; Shower cap; Eye mask for sleep; Shawls for haircuts; Sweat bands for sports; none of the aforesaid goods being for angling or fishing.
- Class 28 Game equipment; Toys; Chess; Balls for sports activities; Exercise equipment; Archery equipment; Sports equipment; Whistle for hunting; Swimming pool (entertainment goods); Plastic track; Boxing gloves; skates; Christmas tree decorations (except lighting items and candy); twirling baton; Scratch card for lottery; Model cars; Toy cars; Scaled model car; none of the aforesaid goods being for angling or fishing.
- Class 37 Construction equipment rental; Furniture maintenance; Disinfection; Interior decoration repair; Elimination of interference of electronic equipment; Installation and repair of medical equipment.
- Class 39 Car rental; Travel and transportation arrangements; Navigation system rental; Racing car rental; Cargo storage; Energy Distribution; Parcel delivery.
- Class 40 Metal casting; dressmaking; Stripping processing; Rental of Generators; Fuel processing; Artwork framing; Energy production; Optical glass grinding; waste treatment [transformation]; Air purification; Water Treatment.
- Class 42 Technical Research; Measurement services; Weather information services; Industrial design; Architecture Services; Design of Clothing; Computer Programming; Computer Software Design; Computer Technology Consultancy; Conversion of data or files into electronic media format; Software as a Service (SaaS); Cloud Computing; Authenticating works of art; Graphic Art Design; Quality Control;

Mapping Services; vehicle roadworthiness testing; none of the aforementioned services being for use in the healthcare or hygiene sector, with the exception of services for the monitoring of the health of a vehicle driver and vehicle passengers.

COSTS

95. The opponent has enjoyed a greater degree of success and is, therefore, entitled to a contribution towards its costs. However, I consider it appropriate to make a reduction for the only partial success. In the circumstances, I award the opponent the sum of **£1,675**, calculated as follows:

Preparing a Notice of opposition and considering the applicant's counterstatement	£175
Preparing and filing evidence	£650
Preparing for and attending the hearing	£750
Official fee	£100
Total	£1,675

96. I therefore order NIO CO., LTD to pay Halo Accident Repair Centre Ltd the sum of **£1,675**. This sum is to be paid within 21 days of the conclusion of the appeal period, or if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 3rd day of April 2024

S WILSON

For the Registrar

ANNEX

Class 7

Lifting device; Three-dimensional garage with lifting equipment; metalworking machines; Handling machines, automatic [manipulators]; Industrial Robot; Cutting Machine; Air filter (engine parts); Pistons for vehicle engines; mufflers for motors and engines; Automobile engine exhaust gas recirculation system; Automobile engine exhaust purification device (catalytic reactor); Cylinders for motors and engines; Hydraulic engine and motor; Radiator for automobile engine cooling; Generator Set; Motor and engine starter; Cylinder heads for engines; Alternator; Compressors (machines); Valves (machine, engine or motor parts); Hydraulic pumps; Pressure regulating valve; Electric door openers; Vehicle bearings; Automobile engine crank shaft; Electric window closers; Machine linkage; shock absorber plungers [parts of machines]; dust removing installations for cleaning purposes.

Class 9

Navigation instruments; Signal lights; Measuring tools; Weighing instruments; Copying and fax machines; Facial recognition equipment; Holograms; Electronic terminal equipment for expressway toll collection; Time recording device; Interactive touch screen terminals; Computer peripheral equipment; Humanoid robot with artificial intelligence; Downloadable mobile phone application software; Computer software (recorded); Animation; Batteries for vehicles; Battery; Charging stations for electric vehicles; Glasses; Alarm; Personal accident prevention device; Industrial radiological equipment; Fire extinguisher; Electrolysis device; Lightning rod; Heat regulation device; Optical fiber (optical fiber); Remote control device; Video display screen; Sensor; Semiconductor devices; Chip (integrated circuit); Semiconductor; Cable; Mirror (optical); Measuring device; Radio equipment for vehicles; Camera (photography) for vehicles, not for use in the professional film and television industry; Driving recorder; Rear-view camera for vehicle; Portable Media Player; none of the aforementioned goods being for use in the healthcare or hygiene sector, with the exception of goods that monitor the health of a vehicle driver and vehicle passengers.

Class 12

Motorized vehicles for land, air, water or railway, none being electric powered bicycles; Sports car; Trolley; Tires for vehicles, none being tyres for bicycles; Electric vehicles, none being electric bicycles; Driverless cars; Self-driving cars; steering wheels for vehicles; Cable car; Motorcycle; safety seats for children, for vehicles; Parts and fittings for vehicles, none being parts and fittings for bicycles; clips adapted for fastening automobile parts to automobile bodies.

Class 22

Non-metallic tape for packaging or bundling; Camouflage Net; Vehicle non-dedicated cover; Sail; Wind barrier cloth; Textile awning; Gunny bags for transporting and storing bulk materials; Straw packaging for bottles; Non-rubber, non-plastic, non-paper or cardboard filling materials; Fiber textile raw materials; Tent; Camouflage nets used in hunting; none of the aforesaid goods being for angling or fishing.

Class 25

Clothing, none being cyclists' apparel; T-shirts; Baby clothes; Motorist's clothing; Waterproof clothing, none being cyclists' apparel; Costumes; Shoes (things worn on the feet), none being cyclists' apparel; Cap; Socks; Gloves (clothing), none being cyclists' apparel; Bibs, none being cyclists' apparel; Waistbands; Garment Ribbon; Shower cap; Eye mask for sleep; Shawls for haircuts; Sweat bands for sports; none of the aforesaid goods being for angling or fishing.

Class 28

Game equipment; Toys; Chess; Balls for sports activities; Exercise equipment; Archery equipment; Sports equipment; Whistle for hunting; Swimming pool (entertainment goods); Plastic track; Boxing gloves; skates; Christmas tree decorations (except lighting items and candy); twirling baton; Scratch card for lottery; Model cars; Toy cars; Scaled model car; none of the aforesaid goods being for angling or fishing.

Class 37

Construction equipment rental; Interior decoration repair; Installation and repair of heating equipment; Mechanical installation, maintenance and repair; Furniture

maintenance; Disinfection; Installation and repair of anti-theft alarm system; Elimination of interference of electronic equipment; Installation and repair of medical equipment; Leather care, cleaning and repair; Motor vehicle charging service; Vehicle battery charging service; Electric vehicle charging service; Car maintenance and repair; Vehicle service station (refueling and maintenance); Delivery vehicle repair service; Repair and maintenance of electric vehicles; Car body repair; Customized installation of car interiors; Vehicle battery replacement.

Class 39

Transportation; Navigation system rental; Towing service for vehicle failure; Motor transportation; Car Rental; Racing car rental; Car driving service; Cargo storage; Energy Distribution; Parcel delivery; Travel and transportation arrangements.

Class 40

Metal casting; dressmaking; Stripping processing; Rental of Generators; Fuel processing; Artwork framing; Energy production; Optical glass grinding; waste treatment [transformation]; Air purification; Water Treatment.

Class 42

Technical Research; Measurement services; Weather information services; Industrial design; Architecture Services; Design of Clothing; Computer Programming; Computer Software Design; Computer Technology Consultancy; Conversion of data or files into electronic media format; Software as a Service (SaaS); Cloud Computing; Authenticating works of art; Graphic Art Design; Quality Control; Mapping Services; vehicle roadworthiness testing; none of the aforementioned services being for use in the healthcare or hygiene sector, with the exception of services for the monitoring of the health of a vehicle driver and vehicle passengers.