

O/0362/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003932363

BY SHENZHEN CUBENERGY CO., LTD.

TO REGISTER THE TRADE MARK:



IN CLASSES 9 AND 42

AND

OPPOSITION THERETO UNDER NO. OP000443848

BY

GROUPE CANAL +

Background and pleadings

1. ShenZhen Cubenergy Co., Ltd. (“the applicant”) applied to register the trade mark below in the UK on 11 July 2023.



2. It was accepted and published in the Trade Marks Journal on 28 July 2023 in respect of the following goods and services:

Class 9 *Computer software, recorded; Measuring instruments; Transformers; Converters, electric; Control panels [electricity]; Climate control digital thermostats; Electric control devices for energy management; Distribution boxes [electricity]; Distribution consoles [electricity]; Inverters [electricity]; Voltage stabilizing power supply; Battery boxes; Electric installations for the remote control of industrial operations; Regulating apparatus, electric; Remote control apparatus; Protection devices for personal use against accidents; Connectors [electricity]; Battery packs; Software for monitoring energy storage systems; Electric control devices for energy management.*

Class 42 *Computer programming; Computer software design; Updating of computer software; Conversion of data or documents from physical to electronic media; Installation of computer software; Computer software consultancy; Off-site data backup; Electronic data storage; Cloud computing services; Monitoring of computer systems by remote access; Consultancy in the field of energy-saving; Research and development of new products for others;*

Quality control; Design and development of energy storage systems.

3. Groupe Canal + (“the opponent”) having filed a Form TM7 which was received by the Registry on 27 October 2023, opposed the above trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is reliant upon the mark detailed below.
4. Comparable mark UK00908699291 filed on 19 November 2009, registered on 27 May 2010.



5. The opponent is reliant upon the following goods and services:

Class 9 Decoders; Remote controls; antennas satellite dishes.

Class 35 Retailing and wholesaling of set-top boxes; Retail sale of aerials; Arranging subscriptions to audiovisual programmes; Arranging subscriptions to a television channel.

Class 38 Television communication; Transmission of images and videos; Television broadcasting; Broadcasting of programmes via satellite, via cable, via computer networks (in particular via the internet), and via radio waves; Audiovisual and cinematographic broadcasting, whether or not for interactive purposes; Rental of aerials and satellite dishes; Transmission of programmes and selection of television channels.

Class 41 Rental of decoders.

Class 42 Online downloading of films and other audiovisual programmes.

6. The opponent opposes the applicant's Class 9 goods and Class 42 services that are italicised at paragraph 2.
7. In its notice of opposition, the opponent argues that the respective goods and services are identical or similar and that the marks are highly similar.
8. The applicant filed a Form TM8 and counterstatement denying that the marks are similar and denying that the applicant's goods and services, with the exception of "remote control apparatus", are similar or identical to the opponent's goods and services.
9. The applicant requested proof of use of the goods and services relied upon by the opponent.
10. The opponent filed evidence which is summarised below.
11. The opponent filed submissions in lieu of a hearing.
12. The applicant is represented by Handsome I.P. Ltd and the opponent is represented by D Young & Co LLP.

Evidence

13. The opponent filed evidence in the form of a witness statement of Camille Jeuneux- Henky, the legal manager at Groupe Canal+. The witness statement is signed and dated 21 February 2024.
14. The opponent also filed a witness statement of Emma Rachel Broxholme, a translator at Priory Translations Ltd. The witness statement is signed and dated 21 February 2024. The witness statement is accompanied by Exhibit ERB1.
15. The opponent also filed a witness statement of Clément Hellich Praquin, Corporate General Counsel of Canal+. The witness statement is signed and

dated 20 February 2024. The witness statement is accompanied by Exhibit CHP1-CHP21

My Approach

16. 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 before the application date of the mark in issue, it is subject to proof of use pursuant to section 6A of the Act. However, for reasons that will become apparent later in this decision, I do not consider that the issue of proof of use will be determinative in these proceedings, and I will conduct my assessment on the basis that the opponent can rely upon the full breadth of its specification. I will further proceed on the basis that the goods and services are identical.

DECISION

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

“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.”

18. Given its earlier filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark for the purposes of section 6 of the Act.

Section 5(2)(b) – case law

19. Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

20. 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 the trade marks



21. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind

their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

22. It would be wrong, therefore, to artificially dissect the trade marks, 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.

23. The respective trade marks are shown below.

Opponent's trade mark	Applicant's trade mark
	

24. I have submissions from both parties in respect of the comparison of these marks. While I confirm that I have taken these into account, I will not reproduce those here.

Overall Impression

25. The opponent's mark comprises a figurative element of a white plus symbol placed on a black square background, with the words 'LE CUBE' presented directly to the right of it, in standard grey capitalised typeface. The figurative

element is slightly larger in height. I am of the view that the eye will naturally be drawn to the element of a mark that can be read. This means that, while it will be noticed, due to its position in the mark, the device element will play a lesser role in the overall impression. Furthermore, I keep in mind *MigrosGenossenschafts-Bund v EUIPO*, T-68/17, where it was stated that:

“...in the case of a mark consisting of both word and figurative elements, the word elements must generally be regarded as more distinctive than the figurative elements, or even as dominant, since the relevant public will keep in mind the word elements to identify the mark concerned, the figurative elements being perceived more as decorative elements...”

26. As such, the words ‘LE CUBE’ will play a greater role in the overall impression of the opponent’s mark with the device element playing a lesser role.

27. The applicant’s mark has a figurative element representing a grey disconnected square shaped device surrounding one diagonal line, positioned through the centre. The figurative element is slightly taller than the word and is presented to its left. The single invented word ‘CUBENERGY’, is partially presented in black uppercase letters, with the exception of the letter ‘N’, which is formed by three white disconnected lines, stylistically echoing the figurative element. The word ‘CUBENERGY’ is of significant length and size and I am of the view that the eye will be naturally drawn to the element of the mark that can be read¹. While the device, placed to the left of the word, will be noticed due to its position in the mark, it will play a lesser role in the overall impression of the applicant’s mark.

28. The second device element in the applicant’s mark is a grey rectangular shape presented as the outline of a battery, with round edges and a small nodule on top. This battery shaped device is positioned behind the letter ‘N’ within the word, ‘CUBENERGY’. This device is allusive of the word ‘ENERGY’. Taking these factors into account, I find that the invented word, ‘CUBENERGY’ will

¹ *MigrosGenossenschafts-Bund v EUIPO*, T-68/17

play a greater role in the overall impression of the applicant's mark, with the devices playing a lesser role.

Visual Comparison

29. Visually, the marks coincide insofar as they share the same four letters 'CUBE', albeit in different positions within the respective marks, being at the beginning in the applicant's mark and at the end of the opponent's mark. While there are figurative devices at the beginning of both marks, they are very different, the opponent's being a solid black square shape and the applicant's being a grey disconnected outline of a square: the opponent's device contains a white 'PLUS' sign and the applicant's device contains a single grey diagonal line. The marks differ further in that the opponent's mark comprises of two words 'LE CUBE', containing six letters, in comparison to the applicant's mark, 'CUBENERGY', which comprises of one invented word, containing nine letters. Furthermore, the applicant's mark contains a stylised letter 'N', within its word, that is made up of three disconnected white lines, positioned on top of a grey device, representing the shape of a battery. Accordingly, weighing up the similarities with the differences, I consider the marks to be visually similar to a low degree.

Aural Comparison

30. Whilst I recognise that the device in the opponent's mark is capable of being articulated as the word 'PLUS', I am not of the view that the average consumer will pronounce it. Therefore, the opponent's mark is likely to be pronounced with two syllables, as 'LE-KYOOB'. The devices in the applicant's mark will not be articulated therefore the applicant's mark will likely be pronounced with four syllables, as 'KYOOB-EN-UR-GEE'. I consider the marks to be aurally similar to a low to medium degree.

Conceptual Comparison

31. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.
32. I am of the view that the device in the opponent's mark will have no conceptual impact, for the reasons discussed above in paragraph [25]. I consider the conceptual message lies entirely in the words 'LE CUBE'. I do not consider that there would be any conceptual impact on the average consumer who see the word 'LE' as meaning 'THE' in French. Therefore, the average consumer will see 'CUBE' as the only element of the opponent's mark that has any conceptual meaning, that being, a symmetrical three-dimensional shape, either solid or hollow, contained by six equal squares.
33. The applicant's mark is an invented word, but will be perceived as the words 'CUBE' and 'ENERGY', the former word alluding to the idea of a symmetrical three-dimensional shape, either solid or hollow, contained by six equal squares. The latter word gives rise to the concept of power. This concept is further supported by the 'battery shaped' device that lies beneath the letter 'N' in the applicant's mark, a battery being a container that consists of cells that converts chemical energy into electricity to be used as a power source. The concept of the applicant's mark is not altered by the addition of the device to the left of the word, as the average consumer will consider this to be decorative and will not necessarily assign this any concept or meaning.
34. While the concept of a 'cube' is shared by both marks, the addition of the idea of 'energy' in the applicant's mark and the battery shaped device, signals a significant difference between them. Accordingly, I find that the marks are conceptually similar to a low degree.

Distinctive character of the earlier mark

35. 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).

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).”

36. 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.

37. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it and although evidence of use has been filed, it has not been considered in relation to its mark. Consequently, I have only the inherent position to consider.

38. The opponent's mark is a black and white 'plus' device followed by the words 'LE CUBE', presented in a grey standard capitalised typeface. The average consumer will see the device as merely decorative with no conceptual meaning.
39. The average consumer will recognise the word 'LE' as being the French word for 'THE', a point on which I am in agreement with the opponent.² This only gives the mark a modicum of originality.
40. I find that the word 'CUBE' is an ordinary dictionary word which could be mildly allusive of the shape of some of the goods. Consequently, taking the mark as a whole into account, I find that the opponent's mark has a medium level of inherent distinctive character.

Likelihood of confusion

41. 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 or services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade 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

² TM7, Page 4, Q9

direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

42. As mentioned in paragraph [16], I have not conducted a comparison of the goods and services or considered proof of use evidence. However, in my comparison of the marks, the following factors must be considered to determine if a likelihood of confusion can be established:

- The 'plus' device in the opponent's mark plays a lesser role in the overall impression of the mark and the words 'LE CUBE' play the greater role.
- The invented word 'CUBENERGY' plays the greater role in the overall impression of the applicant's mark with the device elements playing a lesser role.
- I have found the marks to be visually similar to a low degree.
- I have found the marks to be aurally similar to a low to medium degree.
- I have found the marks to be conceptually similar to a low degree.
- I have found the opponent's mark to be inherently distinctive to a medium degree.

43. Therefore, taking all the factors listed in paragraph [42] into account, it is very clear that the average consumer would notice the differences between the marks and bearing in mind the principle of imperfect recollection, I am satisfied that the marks would not be mistakenly recalled or misremembered for each other. This is particularly the case given the low visual similarity between the marks. The invented word 'CUBENERGY' and the battery shaped device in the applicant's mark, clearly create a conceptual difference between the marks. I do not consider that the average consumer will overlook the figurative letter 'N' within the word element of the mark and the square shaped device at the beginning of the applicant's mark or the plus device and the word 'LE' at the beginning of the opponent's mark, especially as the beginning of the marks tend to have more impact than the ends. Consequently, I do not consider there to be a likelihood of direct confusion.

Having noticed the differences between the marks, the average consumer would not think that they come from the same or linked undertakings and the presence of the shared word 'CUBE' would be seen as a coincidence rather than an indication of economic connection. There is no coherence between the marks such that they would be thought to be brand variants of each other: the devices in the two marks do not hang together and the presence of the 'LE' in the opponent's mark means that 'CUBENERGY' could not be seen as a sub-brand of the house mark 'CUBE'. There is therefore no possibility of indirect confusion.

44. In conclusion, I have made the above findings having conducted my assessment on the basis that the opponent can rely upon the full breadth of its specification and on the assumption that the goods and services are identical.

45. For the avoidance of doubt, even if I had found there to be some enhancement to the distinctiveness of the earlier mark, I would have reached the same conclusions.

CONCLUSION

46. The opposition under Section 5(2)(b) of the Act has been unsuccessful and the application may proceed to registration.

COSTS

47. The applicant has been successful and is therefore entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice (TPN) 1/2023³. In the circumstances, I award the applicant the sum of £250 as a contribution towards the cost of proceedings. The sum is calculated as follows:

³ As the proceedings were commenced after 01 February 2023

Preparing a statement and considering the other side's statement £250

Total **£250**

48.I therefore order Groupe Canal + to pay ShenZhen Cubenergy Co., Ltd., the sum of £250. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, with 21 days of the conclusion of the appeal proceedings.

Dated this 15th day of April 2025

JOANNE ROBERTS

For the Registrar