# O/0373/25

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**
**UK REGISTRATION NO. 3862217**
**IN THE NAME OF VIRIDI PARENTE, INC.**
**IN RESPECT OF THE TRADE MARK**

# VIRIDI

**IN CLASSES 7, 9 AND 12**

**AND**

**AN APPLICATION FOR A DECLARATION OF**
**INVALIDITY THEREOF**
**UNDER NO. 506430**
**BY PROMOVEC GROUP A/S**

**BACKGROUND AND PLEADINGS**

1. Trade mark No. 3862217 for the trade mark "**VIRIDI**" stands registered in the UK in the name of Viridi Parente, Inc. ("the proprietor"). The application for registration was filed on 23 December 2022, and the trade mark was registered on 14 April 2023, in respect of goods in classes 7, 9 and 12, as listed under paragraph 20 of this decision.

2. On 16 August 2023, Viridus Manufacturing A/S ("Viridus") filed an application to have the above trade mark declared invalid under the provisions of section 47(2) of the Trade Marks Act 1994 ("the Act"). The application for invalidation was filed in respect of all of the goods as registered and is based on section 5(2)(b) of the Act. Viridus relied upon the following earlier comparable mark:

## VIRIDUS

UK Trade Mark ("UKTM") No. 918042893
Filing date: 29 March 2019
Registration date: 15 August 2019
Registered in classes 9, 12 and 35
Relying on all goods and services, as listed under paragraph 20 of this decision.

3. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Trade Mark designating the EU. As a result, Viridus's mark was converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.[1]

4. Viridus claims that the marks at issue are visually and phonetically very similar, and that the disputed goods are identical and similar to the goods and services covered by the earlier registration. It requests that, since there exists a likelihood of confusion

[1] See also Tribunal Practice Notice ("TPN") 2/2020 End of Transition Period – impact on tribunal proceeding; and TPN 1/2021: Legal changes to the end of Transition Period transitional arrangements.
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between the marks, the contested mark be declared invalid and the registration deemed never to have been made.

5. The proprietor filed a counterstatement denying the claims, and requests that the application for invalidation be denied in full, that the contested trade mark remain on the register, and that an award of costs be made in favour of the proprietor.

6. On 3 October 2024, legal representative Stevens Hewlett & Perkins, on behalf of Viridus, filed form TM16 requesting the transfer of ownership of UK918042893 to Promovec Group A/S, (who from this point forward will be referred to as "the cancellation applicant"), with effect from 7 August 2024. Confirmation of the recordal of the assignment was issued on 10 October 2024.[2]

7. Only the proprietor filed evidence during the evidence rounds and neither party filed written submissions at this stage of the proceedings. Neither party requested a hearing, although both parties filed written submissions in lieu of a hearing, which will be referred to as and where appropriate in the decision. This decision has been taken following careful consideration of the papers on file.

8. In these proceedings, the cancellation applicant is represented by Stevens Hewlett & Perkins and the proprietor is represented by Forresters IP LLP.

**EVIDENCE**

9. The proprietor filed evidence in support of its defence of the application for invalidation by way of a witness statement in the name of Kathryn Louise Cruse, a Chartered Trade Mark Attorney and Partner of the proprietor's representative. The statement is dated 4 April 2024, and is accompanied by two exhibits, labelled KLC1 to KLC2. The exhibits comprise the following:

[2] On 14 November 2024, the Tribunal wrote to request confirmation that the new owner of the earlier mark had had sight of the relevant forms and that it agreed to the undertakings. Confirmation that the cancellation application was aware of and accepted the liability for costs for the whole proceedings in the event that it was not successful was also requested. Such confirmation was received via the email in response sent on 14 November 2024.

- A copy of the examination report from the UKIPO in relation to the mark at issue (KLC1); and
- Details of trade mark registrations on the UK trade marks register for VIRIDI* formative trade marks, with excerpts of those trade marks taken from the online register (KLC2).

10. Although the copy of the examination report shows that the examiner of the contested registration did not raise the earlier mark relied upon as an earlier right at the application stage, this in itself is insufficient for a finding of no likelihood of confusion between the marks. Neither is the examination report binding on me in relation to the decision before me.

11. The details of the VIRIDI* marks taken from the online register have no real bearing on my assessment. They do not show how many of those trade marks are effectively used in the market.[3] Further, the exhibit does not evidence whether the average consumer of the overlapping goods and services in the case before me would or would not find the competing marks to be confusingly similar. As such, exhibit KLC2 carries very little weight.

12. I find nothing within the witness statement or exhibits which has any real probative value which will assist me in reaching my decision on the likelihood of confusion between the marks at hand. Accordingly, I consider it unnecessary to make any further reference to the evidence in my decision.

**DECISION**

13. 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.

[3] See *Zero Industry Srl v OHIM*, Case T-400/06, at [73].

**Statutory provision**

14. The application to invalidate the holder's mark is based on section 5(2)(b), pursuant to section 47 of the Act. So far as is relevant, section 47 of the Act is as follows

> "…
>
> (2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground –
>
> (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
>
> (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,
>
> unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.
>
> …
>
> (2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –
>
> (a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,
>
> (b) the registration procedure for the earlier trade mark was not completed before that date, or
>
> (c) the use conditions are met.

…

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are –

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

…

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

…

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed."

15. As the earlier mark is a comparable mark, paragraph 9 of part 1, Schedule 2A of the Act is also relevant.

**Section 5(2)(b) –**

16. Section 5(2)(b) of the Act is as follows:

"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".

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

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

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

…"

18. The registration upon which the cancellation applicant relies qualifies as an earlier trade mark under the above provision. As the earlier trade mark had not completed the registration procedure five years or more before the date on which the application for a declaration of invalidity was filed, it is not subject to the use conditions contained in section 47(2A) of the Act. The cancellation applicant is, therefore, entitled to rely upon it in relation to all of the goods and/or services for which the mark stands registered without having to prove that genuine use has been made of it.

19. In considering the application for invalidity under this section, I am guided by the following principles which 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 Office for Harmonisation in the Internal Market (Trade Marks and Designs) ("OHIM")*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing

in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

**Comparison of goods and services**

20. The goods and services to be compared are:

| **Cancellation applicant's goods and services** | **Proprietor's goods** |
|---|---|
| | Class 7<br>*Earth moving machines; earth moving machines, namely, backhoes; earth moving machines, namely, excavators.* |
| Class 9<br>*Batteries; batteries for electric vehicles; electrochemical cells; lithium ion batteries; power supply devices; battery chargers; battery testers; power monitoring and control devices; battery jars; battery mounts; computers for use with bicycles and vehicles; global positioning systems for use with vehicles; parts and fittings for the aforementioned goods, not included in other classes* | Class 9<br>*Battery packs; battery packs for energy requirements of 50kWh to 1 megawatt; battery packs for stationary, point of use storage technology; battery packs for instantaneous backup, demand response, peak shaving, and energy load balancing.* |
| Class 12<br>*Vehicles; apparatus for locomotion by land, air or water; electric bicycles; pedal-assisted bicycles; bicycles; saddlebags adapted for bicycles; parts and fittings for the aforementioned goods, not included in other classes.* | Class 12<br>*Electric vehicles, namely, off highway vehicles and on highway vehicles, namely, utility vehicles and delivery trucks.* |
| Class 35<br>*Retail and wholesale services, also via the Internet, in connection with batteries, batteries for electric vehicles, electrochemical cells, lithium ion batteries, power supply devices, battery chargers, battery testers, power monitoring and control devices, battery jars, battery* | |

| | |
|---|---|
| *mounts, computers for use with bicycles and vehicles, global positioning systems for use with vehicles, parts and fittings for the aforementioned goods; Retail and wholesale services, also via the Internet, in connection with vehicles, apparatus for locomotion by land, air or water, electric bicycles, pedal-assisted bicycles, bicycles, saddlebags adapted for bicycles, parts and fittings for the aforementioned goods*. | |

21. Where the goods (or services) in the specification of one party are included in a broader term from the other party's specification, those goods (or services) are considered to be identical: See *Gérard Meric v OHIM,* Case T-133/05 at [29].

22. In *Canon*, Case C-39/97, the Court of Justice of the European Union ("CJEU") stated that:

> ""23. In assessing the similarity of the goods or services concerned, … 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".

23. Additionally, the factors for assessing similarity between goods and services identified in *British Sugar Plc v James Robertson & Sons Limited* ("*Treat* ") [1996] R.P.C. 281 include an assessment of the users and the channels of trade of the respective goods or services.

24. 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 OHIM*, Case T-325/06, the General Court ("GC") stated that "complementary" means:

> “82. ...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”.

25. For the purposes of considering the issue of similarity of the goods and/or services, it is permissible to consider groups of terms collectively, where appropriate: *Separode Trade Mark*, BL O-399-10.[4]

26. While making my comparison, I bear in mind the comments of Floyd J. (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

> "12. … Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise. … Nevertheless the principle should not be taken too far. ... Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

27. Pursuant to section 60A of the Act, goods and/or services are not to be automatically regarded as being similar to each other on the ground that they appear in the same class, nor automatically regarded as dissimilar from each other on the ground that they appear in different classes.

28. I note that in its counterstatement, and also in the written submissions in lieu of a hearing, the proprietor has conceded that there is some overlap in relation to the goods, being a mixture of identical and similar to varying degrees. I will proceed to make a full comparison of similarity between the contested goods and the most pertinent goods or services of the cancellation applicant.

[4] Paragraph 5

The contested goods in class 7

*Earth moving machines; earth moving machines, namely, backhoes; earth moving machines, namely, excavators.*

29. In its Statement of Grounds, and as referred to in its final written submissions, the cancellation applicant submits that in so far as the proprietor's class 7 goods are concerned, the later mark broadly covers "earth moving machines" which are roadworthy and can be driven from place to place. It continues that in that sense, they can be considered as vehicles and are therefore similar to the term "*vehicles"* and "*apparatus for locomotion by land"* which are specifically protected under the earlier right. I construe the word "locomotion" in the term "*apparatus for locomotion by land"* as referring to the movement of the apparatus itself across land and not the movement of the earth which is the principal function of the proprietor's goods. I agree with the cancellation applicant that in the very broadest of interpretations, the proprietor's goods could be classified as vehicles. However, although I accept the cancellation applicant's submissions that the proprietor's "*earth moving machines/ excavators"* involves a two-step process, being excavation and transportation, i.e. they will need to be driven to a specific location in order for them to be utilised, unlike vehicles at large, transportation per se is not the main purpose of such goods.

30. Although the Nice Classification is purely administrative,[5] I also note that in *Altecnic Ltd's Trade Mark Application*, the Court of Appeal ("COA") decided that "the registrar is entitled to treat the class number in the application as relevant to the interpretation of the scope of the application, for example, in the case of an ambiguity in the list of the specification of goods."[6] In this instance, unlike the cancellation applicant's broad terms "*vehicles*" and "*apparatus for locomotion by land"* in class 12, I consider that the proprietor's class 7 goods would be targeted towards a particular type of consumer, such as farmers or building developers, for the very specific purpose of earth moving, albeit that they may need to be driven along the public highway before reaching the target destination. The channels of trade will be

[5] See *Mould Pro* decision Case T-794/21 at {22-28].
[6] *Altecnic Ltd's Trade Mark Application* [2002] RPC 34 (COA) at [42].

different: the proprietor's goods are likely to be sourced from specialist providers, while the cancellation applicant's goods will be sourced by the public at large from general motor traders. Pragmatically, the goods at issue will have different users and are different in nature and purpose, although there may, at a superficial level, be an overlap in the basic method of use. I do not consider the goods at issue to be either complementary or in competition. I consider it unlikely that the consumer of the respective goods would mistakenly believe that the goods had been provided by the same or economically linked undertakings. In *Unicorn Studio Inc v Veronese* Case CH-2023-000214, Iain Purvis, KC, sitting as deputy High Court judge, stated that any finding of similarity requires the exercise of common sense.[7] Accordingly, taking a realistic approach to the comparison of these particular goods, I find them to be dissimilar. If I am wrong in this, then I find them to be, at best, similar to only a very low degree.

The contested goods in class 9

*Battery packs; battery packs for energy requirements of 50kWh to 1 megawatt; battery packs for stationary, point of use storage technology; battery packs for instantaneous backup, demand response, peak shaving, and energy load balancing.*

31. I note the proprietor's submissions on this front.[8] I consider that the cancellation applicant's broad term "*Batteries"* encompasses the proprietor's various battery packs and, as such, the goods are identical as per the principle outlined in *Meric*.

The contested goods in class 12

*Electric vehicles, namely, off highway vehicles and on highway vehicles, namely, utility vehicles and delivery trucks.*

32. The cancellation applicant's broad term "*vehicles"* encompasses the proprietor's various types of electric vehicles and, as such, the goods are identical as per *Meric*.

[7] At [24].
[8] Points 22 – 25 of the proprietor's written submissions in lieu of a hearing.

I note that this was admitted by the proprietor in its written submissions in lieu of a hearing.[9]

**The average consumer and the nature of the purchasing act**

33. The average consumer is a legal construct, deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97, at [26].

34. In its written submissions in lieu of a hearing, the proprietor submits that the value of its goods are very high and that the goods are targeted at a niche market where the average consumer will be highly circumspect and knowledgeable and will pay a high degree of attention during the purchasing process. I note the cancellation applicant's comments that the proprietor has offered no evidence to support its submissions.

35. In relation to the class 9 goods, I would expect the average consumer to include both the general public and businesses. Depending on the exact nature of the goods, being various types of batteries/battery packs, these may be sold through general stores or their online equivalents, or may be sourced from a specialist provider. Overall, I would expect an average degree of attention to be paid to what I consider would be a predominantly visual purchase, although oral considerations may also apply.

36. The proprietor's class 7 goods will most likely be sold through specialist providers of plant machinery to business consumers such as farmers or building developers. The average consumer of the overlapping class 12 goods will include the general public, with the goods sold through dedicated motor dealerships. For both sets of goods, their selection will be by predominantly visual means, through visiting physical showrooms and from the perusal of printed brochures, as well as through online

[9] At point 27.

research prior to purchase. I acknowledge that oral considerations will play a part during the selection of the goods, for example by way of verbal recommendations and discussions with sales representatives. The purchase of these goods is likely to be infrequent and highly considered. Such considerations will include, inter alia, the initial cost and ongoing running and maintenance costs, and the performance and reliability of the goods, as well as their aesthetic appearance. For the class 7 goods, capacity, power and availability of accessories will also play a part. Overall, I consider a high degree of attention will be paid during the purchasing process for both the class 7 and class 12 goods.

**Comparison of marks**

37. 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 in *Bimbo SA v OHIM* Case C-591/12P, that:

> "34. ....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."

38. 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.

39. The respective trade marks each consist of a single word: "**VIRIDI**" vs "**VIRIDUS**". Both marks are presented in capital letters in a standard black typeface, with no other elements to contribute to the overall impression. The overall impression of each of the

marks therefore rests in the word itself. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginning of words tend to have more visual and aural impact than the ends, however, I accept that this is not always the case.

40. Visually, the competing marks are both single words of six and seven letters in length, respectively. They share in common five of those letters, being the letters "V I R I D" and which are placed in the same position at the beginning of each word. The proprietor's mark is completed with the letter "I", while the cancellation applicant's mark is completed by the letters "U S". Due to these differences coming at the end of the words to be compared, I do not consider that this makes much of a visual impact on the marks as a whole. Overall, I find there to be at least a medium degree of visual similarity between them.

41. Aurally, both marks would be articulated as three syllables, the proprietor's mark would be voiced as either "VEE-REED-EE" or "VI-RI-DEE", while the cancellation applicant's mark will be voiced as either "VEE-REED-US" or "VI-RI-DUS", meaning aural commonality between the first two syllables of the competing marks. Overall, I consider the marks to be aurally similar to a high degree.

42. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer - Case C-361/04 P *Ruiz-Picasso and others v OHIM* [2006][10].

43. In its statement of grounds, the cancellation applicant submits that both marks have Latin origin with no direct English meaning and would not be understood by the average consumer. The proprietor has offered no submissions with regard to any possible concept of either mark.

44. To my knowledge, neither of the competing marks has a defined meaning in British English, and they are each likely to be perceived by a significant proportion of the average UK consumer as invented words with no conceptual meaning, although I

[10] Paragraph 56.

accept that some consumers may assume that either one or both marks are derived from Latin. Even where consumers recognise that the marks originate from Latin, as neither mark has any clear and identifiable semantic content, a conceptual comparison cannot be made.

**Distinctive character of the earlier mark**

45. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. The factors I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97:

> "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)."

46. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and services, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. As the cancellation applicant has filed no evidence regarding the distinctiveness of the earlier trade mark, I have only the inherent characteristics of its trade mark to consider.

47. Earlier in my decision, I found that the cancellation applicant's mark would be perceived as an invented word by a significant proportion of the relevant consumer. I do not consider it to be allusive of the goods at issue. Consequently, I find the earlier mark to be inherently distinctive to a high degree.

**Likelihood of confusion**

48. There is no simple formula for determining whether there is a likelihood of confusion. It is clear that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa (*Canon* at [17]). I must consider the various factors from the perspective of the average consumer, bearing in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

49. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different, but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the

common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark."

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

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

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

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

50. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

51. Earlier in this decision, I found that the goods to be compared ranged between identical as per the principle outlined in *Meric* to dissimilar[11] (or as an alternative, at best similar to only a very low degree). I found the level of attention of the general public and businesses as the average consumer of the class 9 goods to be average, while the business consumer of the class 7 goods and the general public as consumer of the class 12 goods would each pay a high degree of attention to the selection of the overlapping goods during the purchasing process. I considered that the goods would

[11] Under section 5(2)(b), a degree of similarity between the goods is essential for there to be a finding of likelihood of confusion: at [49] *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA.

all be selected by predominantly visual means, although aural considerations would play a part.

52. I found the marks to be visually similar to at least a medium degree and aurally similar to a high degree, although a conceptual comparison of the competing marks could not be made. I considered the earlier mark to be inherently distinctive to a high degree.

53. I have weighed up each of the competing factors in my decision, including the differences as well as the similarities between the competing marks. The average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind. Given the high degree of inherent distinctive character of the earlier mark, as well as the degree of visual and aural similarity between the marks, in my view, the similarities between the marks are such that they are likely to be mistakenly recalled as each other. Consequently, I consider there to be a likelihood of direct confusion in relation to all the goods which I have found to be *Meric* identical. Realistically, I do not consider there to be any likelihood of confusion for those goods for which only a very low degree of similarity, at best, was found.

**CONCLUSION**

54. The application for a declaration of invalidity under section 47(2) of the Act, based on section 5(2)(b) grounds, has been successful in respect of some of the goods against which it is directed. Subject to any successful appeal, under section 47(6) of the Act, UK trade mark No. 3862217 is deemed never to have been made in respect of classes 9 and 12 in their entirety.

55. The contested mark will remain registered for the remaining goods, being class 7 in its entirety.

**COSTS**

56. Both parties have enjoyed a share of success, with the greater degree of success on the part of the cancellation applicant who is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice ("TPN") 1/2023. I have made a reduction to the costs to reflect the partial extent of the success. Applying the guidance in the TPN, I consider the following to be fair:

| | |
|---|---|
| Official fee: | £200 |
| Preparing the application for invalidation, and considering the counterstatement: | £300 |
| Preparing written submissions in lieu of a hearing: | £400 |
| **Total:** | **£900** |

57. I therefore order Viridi Parente, Inc. to pay Promovec Group A/S the sum of £900. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 23rd day of April 2025**

**Suzanne Hitchings**
**For the Registrar,**
**the Comptroller-General**