BL O/0378/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NOS. UK00003619321 AND UK00003619335 BY VIRIDI PARENTE, INC. TO REGISTER:

VOLTA ENERGY PRODUCTS

AND THE FOLLOWING SERIES OF MARKS

AS TRADE MARKS IN CLASSES 9, 11 AND 25

AND

IN THE MATTER OF OPPOSITIONS THERETO UNDER NOS. 426927 AND 426928 BY VOLTA CHARGING, LLC

BACKGROUND AND PLEADINGS

1. On 31 March 2021, Viridi Parente, Inc. ("the applicant") applied to register the word mark (trade mark application number 3619321) and the series of figurative marks (trade mark application number 3619335) shown on the cover page of this decision in the UK. The applications were both published for opposition purposes on 16 July 2021. The applicant seeks registration for the following goods for both marks:

   Class 9: Energy storage systems comprised primarily of electricity storage batteries, batteries.

   Class 11: Energy storage systems comprised primarily of energy storage plants.

   Class 25: Clothing, namely, shirts, hats, and jackets.

2. The applications were both partially opposed by VOLTA CHARGING, LLC ("the opponent") on 22 September 2021. The oppositions are based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act")[1] and directed at all goods in classes 9 and 11. The opponent relies upon the following marks:

UKTM no.	**Mark**	**Filing and registration dates**	**Goods/services relied upon**
3686667	**VOLTA** "The first earlier mark"	Priority date: 14/05/2019 (US)[2] Registration date:	Classes 9, 35 and 37 – see Annex A

[1] 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.

[2]The first and second earlier marks were filed pursuant to Article 59 of the Withdrawal Agreement between the UK and EU, and applied for on 26 August 2021, i.e. within nine months of the end of the transition period. As such, they were given the same filing dates as their international registrations designating the EU (numbers 1524552 and 1524142) and retained the same priority dates claimed by those EU designations.

		05/07/2024	
3686668	VOLTA "The second earlier mark"	Priority date: 03/06/2019 (US) Registration date: 05/07/2024	Classes 9, 35 and 37 – see Annex B
3677965	volta INDUSTRIES "The third earlier mark"	Priority date: 05/02/2021(US) Registration date: 05/07/2024	Classes 9, 35 and 37 – see Annex C
3677968[3]	**VOLTA FLEET** "The fourth earlier mark"	Priority date: 05/02/2021 (US)	Classes 9, 35 and 37 – see Annex C

3. The trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. As the earlier marks had not completed their registration process more than 5 years before the filing date of the applications in issue, they are not subject to the use provisions in section 6A of the Act. The opponent can, therefore, rely upon all of the goods and services identified.

4. The opponent claims that the marks at issue are highly similar and that the goods in classes 9 and 11 for which application is sought are highly similar to the relied upon goods/services. As a result, the opponent argues that there exists a likelihood of confusion between the marks.

5. The applicant filed counterstatements wherein it noted some similarities between the marks albeit limited to the shared presence of the word "VOLTA" and admitted some similarity between the goods which I will come to discuss later in this decision. However, overall, they denied that there would be any confusion between the respective marks.

[3] This earlier mark is currently subject to opposition under opposition number 430511.

6. The Tribunal, utilising the power granted to it by Rule 62 of the Trade Marks Rules 2008, consolidated the two proceedings. This was communicated to the parties via written correspondence on 4 March 2022.

7. The opponent is represented by Bear & Wolf (UK) LLP, and the applicant is represented by Forresters IP LLP. Both parties filed evidence and only the opponent filed submissions during the course of the proceedings. No hearing was requested and neither party elected to file written submissions in lieu of the same. This decision is taken after careful consideration of the papers.

EVIDENCE

8. The opponent's evidence came in the form of the witness statement of Mark Heritage dated 6 January 2023. Mr Heritage is a partner at Bear and Wolf (UK) LLP. Mr Heritage's evidence is accompanied by 26 exhibits, being MH1 to MH26. The evidence was adduced to support the opponent's submissions including *inter alia* that lightning bolt imagery is commonly used in relation to goods or services associated with electricity.

9. The applicant's evidence in reply came in the form of the witness statement of Kathryn Louise Cruse dated 28 March 2024. Ms Cruse is a chartered trade mark attorney at Forresters IP LLP. Ms Cruse's evidence is accompanied by three exhibits, being KLC1 to KLC3. The evidence included copies of the examination reports for both contested trade mark applications and a copy of a response filed by the opponent to the USPTO in relation to a citation against an application to register "VOLTA FLEET".

10. I do not intend to summarise the evidence filed by the parties in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

My approach

11. The opponent has relied upon four earlier marks in respect of both oppositions. In its submissions, the opponent identifies its first earlier mark as its strongest case.[4] For reasons that will become apparent, I am also of the view that the first earlier mark represents the opponent's strongest case. I will, therefore, focus my assessment on the opponent's first earlier mark for both oppositions, returning to the other earlier marks relied on only if necessary. For the avoidance of doubt, I shall refer to the opponent's first earlier mark as "the earlier mark" throughout the remainder of this decision.

DECISION

12. 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."

13. Section 5A states:

"5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

[4] Paragraphs 70 and 71 of the opponent's submissions.

14. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) ("OHIM")*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods and services

15. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

> "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".

16. 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 users of the respective goods or services;

b) The physical nature of the goods or acts of services;

c) The respective trade channels through which the goods or services reach the market;

d) 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;

e) 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.

17. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin set out the proper approach to considering terms in specifications:

"365. […] The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] RPC 40, at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specifications of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be

interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case."

18. 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".[5] Complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity.[6]

19. The goods and services to be compared are as follows:

Opponent's goods and services	Applicant's goods
Class 9: Charging stations for electric vehicles; charging stations for plug-in hybrid vehicles; electric vehicle supply equipment (EVSE), namely, charging stations, battery and electrical power charging connectors, charging cables, communication antennas, radio frequency identification (RFID) readers, screen displays, contactors, circuit breakers, printed circuit boards, communication modems, and connection cables sold as a unit; downloadable computer application software for mobile phones and tablets, namely, software for locating and navigating to electric vehicle charging stations; downloadable software to manage EVSEs and EVSE networks, to monitor EVSE activity, and to collect	Class 9: Energy storage systems comprised primarily of electricity storage batteries, batteries. Class 11: Energy storage systems comprised primarily of energy storage plants.

[5] *Boston Scientific Ltd v OHIM,* Case T-325/06, paragraph 82
[6] *Kurt Hesse v OHIM*, Case C-50/15 P

and report data on EVSE usage; downloadable computer application software for mobile phones and tablets, namely, software for locating and navigating to electric vehicle charging stations; battery charge devices; all of the foregoing excluding laptop chargers. Class 35: Electric vehicle charging equipment placement services, namely, consulting services relating to physical placement of electric vehicle charging stations, namely, assistance with business planning. Class 37: Charging station services for electric vehicles; electric vehicle charging services; plug-in hybrid vehicle charging services; installation maintenance, and repair of electric vehicle charging stations and charging equipment; vehicle fueling services.	

Class 9 goods

20. I first wish to address how the applicant's specification in class 9 should be interpreted. I note the opponent's submissions in this regard:

> "The wording of the specification in Class 9 of the Applications is a little unusual, insofar as it includes two apparently separate terms ("…*energy storage systems comprised primarily of electricity storage batteries*…" versus

"…*batteries*…") separated not by a semi-colon, but a comma. However the Opponent submits the plain English reading of the specification is that it contains both as separate goods (i.e. as if separated by a semi-colon)."[7]

21. The applicant has not provided any clarification on this point however, I note part 2.17 of the Classification Information in the IPO's Manual of Trade Mark Practice[8] which states the following:

"The following guidelines are intended to help examiners assess whether the punctuation is clear and offers advice on improving punctuation if necessary. In specifications which list a number of goods or services without uses or other qualifications, either commas or semi-colons may be used between the goods/services for example:

"Coffee, tea, rice, bread, salt." or "Coffee; tea; rice; bread; salt."

or combinations of the two for example:

"Coffee, tea, rice; bread; salt." or "Coffee; tea; rice, bread and salt"."

22. In light of the above, I agree with the opponent that the applicant's specification in class 9 should be interpreted as separate goods being *Energy storage systems comprised primarily of electricity storage batteries* and *batteries.* I shall therefore proceed on that basis.

23. The opponent has set out a schedule in its statement of grounds outlining the respective goods and services that it submits are either highly similar or similar. It carries this argument forward in its submissions and submits that *battery charge devices* are its strongest comparator to the applicant's goods in class 9 and that they should be regarded as highly similar.

[7] Paragraph 58 of the opponent's submissions.
[8] https://www.gov.uk/guidance/trade-marks-manual/classification-information

24. Within its counterstatements, the applicant has conceded that there is some similarity between the respective goods and services however, they disagree with the opponent regarding the level of similarity. I note the following from their counterstatements:

> "We disagree with the opinion of the opponent that the goods and services covered by the earlier trade marks are either highly similar or similar when considered in terms of their uses, users, nature, routes to market and distribution channels, typical trade origin and complementary nature. We instead identify them as similar to a very low degree."

25. As the parties have not agreed upon the degree of similarity between the applicant's goods in class 9 and the opponent's *battery charge devices,* it is open to me to assess the similarity of these goods finding at least a very low level of similarity between the same.

Batteries

26. *Batteries* and *battery charge devices* have a different nature, intended purpose and method of use. I say this because the applicant's goods include the batteries themselves which power electronic devices/machines/vehicles, whereas the opponent's goods are chargers for the same which are typically plugged into the mains to provide a reserve of power for the batteries. The respective goods do not enjoy a competitive relationship due to their different purposes and methods of use. There is an overlap in users and trade channels. I also find the goods to share a complementary relationship as *batteries* are important and indispensable to *battery charge devices* to the extent that users would believe that they are derived from the same undertaking. Overall, I consider these goods to be similar to a medium degree.

Energy storage systems comprised primarily of electricity storage batteries

27. Within its submissions, the opponent states, "…energy storage systems comprised primarily of electricity storage batteries…" means literally that - i.e. a series of batteries joined together to form a larger battery "system" - and nothing more or more special than that." Without any submissions to the contrary and being mindful of the approach taken in *Skykick,*[9] I agree with the opponent's interpretation of this term. As such, I consider the above term has a different nature, purpose and method of use to the opponent's *battery charge devices.* However, there is a shared customer base, and the goods would be distributed through the same trade channels. I also consider there would be a degree of complementarity as *battery charge devices* are important or indispensable to the above term to the extent that consumers would believe they are derived from the same undertaking. On balance, these goods are similar to a medium degree.

Class 11

Energy storage systems comprised primarily of energy storage plants

28. The opponent in its submissions seeks to compare the above term to *charging stations for electric vehicles,* believing them to hold a high degree of similarity. I note that the applicant has stated in its counterstatements "As concerns the remaining goods: *Charging stations for electric vehicles*. We consider those goods are similar to a medium degree." As such, it is open to me to determine what level of similarity there is between these goods, finding at least a medium level of similarity between the same.

29. The opponent submits that the applicant's term encompasses any plant used to provide an "energy storage system", in the sense of any machinery or apparatus, either fixed or moveable; and including to power a vehicle.[10] They have also provided evidence to demonstrate this. Whilst this evidence is dated after the

[9] [2024] UKSC 36.
[10] Paragraph 77 of the opponent's submissions

filing date of the contested trade mark applications it still has relevance in assisting to interpret the applicant's term and I agree with this submission and the supporting evidence – I also note that the applicant has not disputed this point nor its supporting evidence. I consider the applicant's term differs in nature, purpose and method of use to *charging stations for electric vehicles*. However, the respective goods are nonetheless important to one another, especially in the context of the applicant's goods being used to provide power to a vehicle, and I find this would be why consumers would believe they are derived from the same undertaking. The competing terms are therefore similar solely on the basis of complementary. Keeping in mind the applicant's concession, I find these goods similar to a medium degree.

The average consumer and the purchasing act

30. Trade mark questions, including the likelihood of confusion, must be viewed through the eyes of the average consumer of the goods and services in question. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. The word "average" merely denotes that the person is typical,[11] which in substance means that they are neither deficient in the requisite characteristics of being well informed, observant and circumspect, nor top performers in the demonstration of those characteristics.[12] It is therefore necessary to determine who the average consumer of the respective goods and services is, and how the consumer is likely to select those goods and services.

31. The goods at issue in these proceedings are likely to be purchased by the general public and businesses/professionals. I accept that the term 'batteries' is broad and would include batteries such as standard AA batteries or batteries for an electric vehicle or power tool. I therefore find that some of the goods, such as standard batteries are likely to be relatively frequent, inexpensive purchases. Batteries that are required for a more technical purpose such as for use for an electronic vehicle are likely to be occasional purchases which attract a much

[11] *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), paragraph 60
[12] *Schutz (UK) Ltd v Delta Containers Ltd* [2011] EWHC 1712, paragraph 98

greater outlay. The same can be said for the remaining goods in the applicant's specification which will also likely be occasional purchases that will attract a much greater outlay. The required thought process will vary considerably, with some being more casual purchases (such as the kind of batteries one would use for a television remote control – which goes to show the immense breadth of the term 'batteries') and others being (in some cases) highly considered purchases. Accordingly, the level of attention exhibited by relevant consumers during the purchasing process will vary considerably; a lower level of attentiveness will be shown for the lower cost, frequent purchases, whereas a higher level of attention will be demonstrated for the occasional, expensive and (in some cases) specialised goods.

32. The goods are likely to be purchased from retailers, dealerships and suppliers, or their online equivalents. They are typically purchased after a visual inspection of the goods, or after viewing information in brochures, catalogues or websites. As a result, it is my view that the purchasing process is predominantly visual in nature. However, I do not discount that there may be an aural component in the form of word-of-mouth recommendations or discussions with sales representatives.

Comparison of the marks

33. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

34. 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."

35. 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.

36. The respective trade marks are shown below:

The earlier mark	The applicant's marks
VOLTA	"The word mark" **VOLTA ENERGY PRODUCTS** "The figurative mark"  

37. The earlier mark is a word only mark that consists of the word 'VOLTA'. There are no other elements that contribute to the overall impression of the mark, which lies in the word itself.

38. The applicant's word mark consists of the words "VOLTA ENERGY PRODUCTS". Due to the descriptive nature of the words "ENERGY" and "PRODUCTS", I find the word "VOLTA" to be the dominant and distinctive element in the overall impression of the mark. I find the words "ENERGY" and "PRODUCTS" will play a lesser role in the overall impression.

39. The applicant's figurative mark consists of a series of two marks. The device element in the first of the series of marks is green whereas it is grey in the second of the series mark. However, nothing turns on this difference so I shall refer to these marks in the singular. The mark consists of the word "VOLTA" in a large greyscale font with the words "ENERGY PRODUCTS" sat below in a smaller, lighter grey font. To the left of the wording is a figurative device of a lightning bolt sat within a hexagonal shape.

40. Due in part to its size, in addition to it being the largest verbal element of the mark, I consider the word "VOLTA" to be the dominant and distinctive element of the mark. The opponent submits that there is nothing particularly striking about the figurative element in the applicant's mark as it will be merely seen as decorative as electricity bolts are commonly used in relation to various goods that can be or are associated with electricity or energy.[13] They have also filed evidence in support of this. I agree with the opponent's submissions that the figurative device is not particularly striking however, I find that due to its size and position in the mark, it plays a secondary role in the overall impression. The wording "ENERGY" and "PRODUCTS", though not negligible, play a lesser role due to their descriptive nature and the fact that they appear in a smaller, lighter font in comparison to the word "VOLTA".

Visual Comparison

41. The earlier mark and the applicant's word mark coincide through use of the word "VOLTA". This is the sole element of the earlier mark and it is the first element of

[13] Paragraph 16 of the opponent's submissions.

the later mark, (the first part of a mark being a position to which the average consumer pays more attention to),[14] the marks are therefore identical with regard to that element. The words "ENERGY PRODUCTS" in the applicant's mark create a point of visual difference as they do not appear in the earlier mark, however, I remind myself that I have found this wording to be descriptive and play a lesser role in the overall impression. On balance, I consider there to be a medium degree of similarity.

42. The earlier mark and the applicant's figurative mark also coincide through use of the word "VOLTA", and I remind myself that I found this word to be the dominant and distinctive element of the applicant's figurate mark. There are points of difference created by the figurative device and the wording "ENERGY PRODUCTS". Taking into consideration what I have said about the dominant and distinctive parts of the marks in my assessment of the overall impression, I find there is a medium degree of similarity between these marks.

Aural Comparison

43. The word "VOLTA" will be pronounced identically in the respective marks in two syllables as "VOL-TAH". However, the words "ENERGY PRODUCTS" in both the applicant's marks have no counterpart in the earlier mark, though I note this element is purely descriptive and may not even be voiced by the average consumer. If the descriptive words in the applicant's marks were to be voiced, the competing marks would be aurally similar overall to a low to medium degree. If the descriptive words were not voiced, each of the applicant's marks would be aurally identical to the earlier mark.

Conceptual Comparison

44. As regards the conceptual comparison, I note the opponent's submissions in respect of the word "VOLTA":

[14] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

"However, that most distinctive and dominant component of all of the marks on either side VOLTA - has no meaning to UK consumers. While VOLT buried within VOLTA might be suggestive of the "electric volt" (i.e. the standard unit of electromotive force or "electric potential") VOLTA taken as a whole is meaningless to the UK public, since there is no such word in the English language."[15]

45. I also note that 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] ECR I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

46. Whilst I agree with opponent's assertions that the word VOLTA might be suggestive of "electric volts", I do not agree that the word Volta would have no meaning to the average consumer. I say this because volts and voltage are common words in the English language used to describe units of electricity therefore, this concept especially when viewed in the context of the goods at issue that are electrically powered would be easily grasped by the average consumer. Consequently, I find that consumers will view the word VOLTA in all marks as an invented word albeit, one that alludes to volts/voltage.

47. The additional wording "ENERGY PRODUCTS" in each of the applicant's marks is entirely descriptive and non-distinctive. As explained above in my assessment of the overall impression of the marks, I find the lightning bolt device in the applicant's figurative mark to be merely decorative and it serves to reinforce the concept of energy products. Accordingly, I find that these points do not materially alter the conceptual message derived from VOLTA as they merely serve to reinforce that message.

[15] Paragraph 37 of the opponent's submissions

Distinctive character of the earlier mark

48. 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)."

49. 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.

50. While I note that the opponent has filed evidence, this was for the purpose of supporting its submissions and not for the purpose of proving an enhanced degree of distinctive character. As such, there is no evidence pointing to any

actual use of its mark in the UK prior to the relevant date. As a result, I have only the inherent position to consider.

51. The earlier mark "Volta", as previously outlined in my conceptual comparison will be understood by consumers as an invented word however, they will recognise the word "Volt" within the mark. While this is not descriptive of the goods and services relied upon, it does allude to the fact that many of the goods and services relate to energy and power, particularly the opponent's goods which I have found to be similar to the applied-for goods (i.e. *'battery charge devices'* and *'charging stations for electric vehicles'*). I am therefore of the view that there is some degree of allusiveness to the mark. Albeit the mark is an invented word, given its allusive qualities, I am of the view that the mark is distinctive to a medium degree.

Likelihood of confusion

52. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.[16] I must also consider the average consumer of the services, the nature of the purchasing process and bear in mind that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa.[17]

53. Making an assessment as to the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. The global assessment is supposed to emulate what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.[18] The

[16] *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, Case C-342/97, paragraph 27

[17] *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 17

[18] *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81

relative weight of the factors is not laid down by law but is a matter of judgement for the tribunal on the particular facts of each case.[19]

54. It is well established that confusion can be direct, which is a simple matter of the consumer mistaking one mark for another, or indirect. Indirect confusion arises where the consumer recognises that one mark is different from the other, but because of the marks' similarities, believes that the goods or services bearing the later mark come from the same undertaking or from an economically linked undertaking.[20] For example, they conclude that the later mark is another brand of the owner of the earlier mark because they share a common element.[21] In *L.A. Sugar Limited v By Back Beat Inc*,[22] Mr Iain Purvis Q.C., as the Appointed Person, explained that instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:[23]

> "(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)."

[19] See paragraph 33 of the Appointed Person's decision in Case No. O/049/17, (*Rochester Trade Mark*).

[20] *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, paragraph 10

[21] *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, paragraphs 16-17

[22] Ibid.

[23] In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis's formulation but added at [12] that it is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.

55. Confusion can also be 'right way round' or 'wrong way round', which in essence is nothing more meaningful than the order in which the consumer happened to come across the earlier mark and the later mark,[24] i.e. 'wrong way round' confusion embraces situations where the average consumer comes across the later mark first and believes that the services denoted by the earlier trade mark come from the same undertaking.[25]

56. I have found the goods in play to be similar to a medium degree. I have found the average consumer will comprise of both members of the general public and professional/business users. For both user groups, visual considerations will dominate during the purchasing process however, I do not discount an aural component. The level of attention paid during the purchasing process will vary between low and high depending on the particular goods being purchased. I have found the earlier mark to be visually similar to both of the applicant's marks to a medium degree. I have found the earlier mark to be aurally similar to a low to medium degree to both applicant's marks if the descriptive words in the applicant's marks are voiced. If the descriptive words are not voiced, each of the applicant's marks are aurally identical to the earlier mark. I have found that a significant proportion of consumers would perceive the word "VOLTA" in all marks as an invented word that alludes to volts/voltage rendering this element of the marks conceptually identical. I have found that the additional wording and figurative elements in the applicant's marks do not alter the conceptual message of VOLTA and merely service to reinforce it. I have found that the earlier mark has a medium degree of inherent distinctiveness.

The applicant's word mark

57. I am conscious not to artificially dissect the competing marks and I acknowledge that the average consumer tends to perceive trade marks as wholes. I first note that the respective marks share the same dominant and distinctive element ("VOLTA") with the only difference between the marks being the presence of the

[24] *Comic Enterprises v Twentieth Century Fox* [2016] EWCA 41, paragraph 80.
[25] *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207 paragraph 14.

descriptive wording “Energy Products” in the applicant’s mark. The word “VOLTA” is the sole element of the opponent’s mark and appears at the beginning of the applicant’s mark, a position which is generally considered to have more impact. During the purchasing process, visual elements are likely to dominate, though I acknowledge that aural considerations also apply, and I have already noted that some consumers may only articulate the “VOLTA” element of the applicant’s mark which would render the parties’ marks aurally identical. Even for goods which command a higher level of attention and are of a medium level of similarity, I find that there will be a likelihood of confusion because there is so little to tell the marks apart; the additional wording is descriptive and is therefore unlikely to do the job of distinguishing the parties’ marks from one another, The marks will be imperfectly recalled as the “VOLTA” marks.

58. If I am wrong about that and the average consumer does recognise the differences between the marks, I remind myself that I have found that the overall impression of the earlier mark lies solely in the word “VOLTA”, and I have found this word possesses a medium degree of distinctiveness. The word “VOLTA” also plays a more dominant and distinctive role in the overall impression of the applicant’s word mark with the additional wording being descriptive of the goods at issue. On that basis, it is my view that category (b) as set out in *L.A Sugar* applies here. If consumers recognise the differences between the marks, they will not, in this case, be put down to coincidence. Rather, they will attribute the additional wording as denoting a sub-brand or a brand extension. Taking all the above factors into account whilst bearing in mind the principle of interdependency, I consider there to be a likelihood of indirect confusion.

The applicant’s figurative mark

59. The respective marks share a dominant and distinctive element (“VOLTA”) with the only difference being the stylisation of the wording in the applicant’s mark. During the purchasing process, visual elements are likely to dominate though I acknowledge that aural considerations also apply, and I have already noted that some consumers may only articulate the “VOLTA” element of the applicant’s mark which would render the parties’ marks aurally identical. There is a figurative

element in the applicant's mark which does have any counterpart in the earlier mark however, I found this element to play a secondary role in the overall impression. Taking this into consideration along with all of the relevant factors, notwithstanding the average consumers medium level of attentiveness, the marks may be misremembered by way of imperfect recollection, and it is my view that the figurative element and the stylisation in the applicant's mark may be forgotten or go unnoticed. I therefore find that it is likely that the consumer may mistake one mark for the other and there is a likelihood of direct confusion.

60. I also consider there to be a likelihood of indirect confusion between the applicant's figurative mark and the opponent's earlier mark because the later mark simply adds the non-distinctive wording "ENERGY PRODUCTS" and the figurative lightning bolt device. I have found the wording to play a non-distinctive role in the overall impression and I remind myself that the lightning bolt device is not particularly distinctive in relation to energy related goods. In the present case, I find that consumers would regard the addition of the non-distinctive elements as denoting a sub-brand or brand extension, all under the main "VOLTA" brand.

Final remarks

61. Given that I have found a likelihood of confusion for both applications based on the opponent's first earlier mark, I do not consider it necessary to consider the remaining earlier marks on the basis that doing so will not improve the opponent's position.

CONCLUSION

62. The partial oppositions under sections 5(2)(b) have succeeded. Subject to any appeal, the applications will be refused for the goods in classes 9 and 11 and will proceed to registration solely in relation to the unopposed class 25 goods.

COSTS

63. In these consolidated proceedings, the opponent has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 and before 1 February 2023 are governed by Annex A of Tribunal Practice Notice ('TPN') 2 of 2016. Using the TPN as a guide, I award costs to the opponent as followings:

Official fee x 2:	£200
Preparing statements and considering the other side's statements x 2:	£800
Filing evidence and considering the applicant's evidence:	£500
Total:	**£1500**

64. I therefore order Viridi Parente, Inc to pay the sum of £1500 to VOLTA CHARGING, LLC. 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 24th day of April 2025

Catrin Williams
For the Registrar

Annex A

Class 9: Charging stations for electric vehicles; charging stations for plug-in hybrid vehicles; electric vehicle supply equipment (EVSE), namely, charging stations, battery and electrical power charging connectors, charging cables, communication antennas, radio frequency identification (RFID) readers, screen displays, contactors, circuit breakers, printed circuit boards, communication modems, and connection cables sold as a unit; downloadable computer application software for mobile phones and tablets, namely, software for locating and navigating to electric vehicle charging stations; downloadable software to manage EVSEs and EVSE networks, to monitor EVSE activity, and to collect and report data on EVSE usage; downloadable computer application software for mobile phones and tablets, namely, software for locating and navigating to electric vehicle charging stations; battery charge devices; all of the foregoing excluding laptop chargers.

Class 35: Electric vehicle charging equipment placement services, namely, consulting services relating to physical placement of electric vehicle charging stations, namely, assistance with business planning.

Class 37: Charging station services for electric vehicles; electric vehicle charging services; plug-in hybrid vehicle charging services; installation maintenance, and repair of electric vehicle charging stations and charging equipment; vehicle fueling services.

Annex B

Class 9: Charging stations for electric vehicles; charging stations for plug-in hybrid vehicles; electric vehicle supply equipment (EVSE), namely, charging stations, battery and electrical power charging connectors, charging cables, communication antennas, radio frequency identification (RFID) readers, screen displays, contactors, circuit breakers, printed circuit boards, communication modems, and connection cables sold as a unit; downloadable computer application software for mobile phones and tablets, namely, software for locating and navigating to electric vehicle charging stations; downloadable software to manage EVSEs and EVSE networks, to monitor EVSE activity, and to collect and report data on EVSE usage; downloadable computer application software for mobile phones and tablets, namely, software for locating and navigating to electric vehicle charging stations; all of the foregoing excluding laptop chargers.

Class 35: Electric vehicle charging equipment placement services, namely, consulting services relating to physical placement of electric vehicle charging stations, namely, assistance with business planning.

Class 37: Charging station services for electric vehicles; electric vehicle charging services; plug-in hybrid vehicle charging services; installation, maintenance, and repair of electric vehicle charging stations and charging equipment; vehicle fueling services.

Annex C

Class 9: Charging stations for electric vehicles; charging stations for plug-in hybrid vehicles; electric vehicle supply equipment (EVSE), namely, charging stations, battery and electrical power charging connectors, charging cables, communication antennas, radio frequency identification (RFID) readers, screen displays, contactors, circuit breakers, printed circuit boards, communication modems, and connection cables sold as a unit; downloadable computer application software for mobile phones and tablets, namely, software for locating and navigating to electric vehicle charging stations; downloadable software to manage EVSEs and EVSE networks, to monitor EVSE activity, and to collect and report data on EVSE usage; downloadable computer application software for mobile phones and tablets, namely, software for locating and navigating to electric vehicle charging stations.

Class 35: Electric vehicle charging equipment placement services, namely, consulting services relating to physical placement of electric vehicle charging stations, namely, assistance with business planning.

Class 37: Charging station services for electric vehicles; electric vehicle charging services; plug-in hybrid vehicle charging services; installation maintenance, and repair of electric vehicle charging stations and charging equipment; vehicle fueling services.