

O/0616/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003933983

TO REGISTER THE TRADE MARK



IN CLASSES 9 AND 37

AND IN THE MATTER OF APPLICATION NO. UK00003933980

TO REGISTER THE TRADE MARK



IN CLASSES 9 AND 37

BY J SAINSBURY PLC

AND

THE OPPOSITIONS THERETO UNDER NOS. 444915 AND 444586

BY

SMART AUTOMOBILE CO., LTD.

BACKGROUND AND PLEADINGS

1. On 14 July 2023 J Sainsbury plc (“***the Applicant***”) applied to register in the UK the trade marks shown on the cover page of this decision, under number UK00003933980 (“***the ‘980 mark’***”) and number UK00003933983 (“***the ‘983 mark’***”). On 7 and 8 September 2023, respectively, the ‘983 and the ‘980 marks were accepted and published in the Trade Marks Journal in respect of the following goods and services:

Class 9 Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity; apparatus and instruments for storing, monitoring and measuring electricity; apparatus, instruments and cables for electricity; electricity measuring instruments; data collection apparatus; electricity meters; meters for electrical monitoring; electric control apparatus, systems, devices and installations; electricity storage apparatus; batteries; grids for batteries; battery boxes; battery packs; battery chargers; battery charging devices for motor vehicles; electric vehicle charging points; chargers; electric chargers; electric vehicle chargers; charging stations for electric vehicles; charging docks; solar panels; solar cells; portable solar panels for generating electricity; energy monitoring equipment; energy control apparatus; computer hardware; computer software; computer hardware and software for charging electric vehicles and electric vehicle batteries; computer software for data acquisition, data transmission and data analysis in energy supply and electric vehicle charging networks; computer software for energy supply networks; computer software relating to charging of electric vehicles; computer software to monitor the storing of electricity in relation to batteries; software applications for charging electric vehicles; application software for use with electric vehicle chargers; software for management of electrical systems and infrastructure, including solar panels, wind turbines, batteries, chargers and electric vehicle charging stations; software for monitoring, analysing, coordinating, and controlling electrical chargers, vehicle charging stations, electrical storage

batteries, electrical systems and infrastructure; payment software; payment software for use with electric vehicle chargers; electronic payment terminals; electronic payment terminals for use with electric vehicle chargers; apparatus for reading encoded cards; downloadable electronic publications; downloadable electronic publications relating to electric vehicles and vehicle charging; data storage media; computer databases; electronic databases; data carriers and computer software encoded to contain pre-payment data; encoded pre-paid payment cards; electronic cards containing information; plastic cards containing machine readable information; parts and fittings for all of the aforementioned goods.

Class 37 Construction services; installation and repair services connected with electrical generation and power supply apparatus; installation and repair services connected with electric and electronic apparatus for conducting, regulating, storing, monitoring, measuring and controlling electricity; installation and repair services connected with solar panels, battery chargers, and electric vehicle charging equipment; installation, maintenance and repair of energy monitoring equipment; building construction; installation, maintenance and repair of power infrastructure; installation, maintenance and repair of equipment and facilities for the collection, storage, distribution, processing of renewable energy; installation, maintenance, servicing and repair of electricity distribution and supply apparatus; installation, repair and maintenance of electricity supply apparatus and of fixtures thereof and of electrical and electronic apparatus and instruments; electrical repairs, installation and contracting services for residential and commercial wiring or electrical apparatus; installation, refurbishment, inspection, repair, maintenance and decommissioning of energy supply installations and energy production plants; installation, repair and maintenance of electrical appliances or instruments using electricity; vehicle repair, maintenance, refuelling and charging; vehicle battery charging; installation, maintenance, repair of electrical charging stations and electrical vehicle charging stations; recharging services for electric

vehicles; construction of stations for charging vehicle batteries on public roads; installation, maintenance and repair services for chargers, electric chargers, electric vehicle chargers, charging stations for electric vehicles, charging docks, battery charging equipment; rental of vehicle maintenance equipment; rental of electric vehicle chargers; technical consulting services in the field of installation, maintenance and repair of electrical charging stations for electric vehicles; information, research, advisory and consultancy services relating to all of the aforesaid services.

2. The '983 and the '980 marks, jointly hereafter defined as the **Contested Marks**.
3. On 8 December 2023 and 28 December 2023, smart Automobile Co., Ltd. ("**the Opponent**") opposed, respectively, the applications for the '980 mark and the '983 mark in their totality under section 5(2)(b) of the Trade Marks Act 1994 ("**the Act**"). For both oppositions the Opponent relies upon the following trade mark ("**the Earlier Mark**"):

Trade mark number: UK00003804823

Filing date: 30 June 2022

Registration date: 25 November 2022



Representation:

Relying upon the following goods and services:

Class 9 Battery chargers; Apparatus, instruments and cables for electricity;
Software applications for mobile devices.

Class 37 Motor vehicle maintenance and repair; Vehicle battery charging; Installation, repair and maintenance services relating to electric vehicle chargers and electric vehicle charging points and stations; Installation, maintenance and repair of batteries; Information, advice and consultancy in relation to all the aforesaid services.

4. By virtue of its earlier filing date, the registration qualifies as an earlier mark under section 6(1) of the Act. As the Earlier Mark had not completed its registration process more than five years before the filing date of the applications in issue, it is not subject to proof of use pursuant to section 6A of the Act. The Opponent can, therefore, rely upon all of the goods and services it has identified without having to demonstrate use.
5. In its notices of opposition, the Opponent states that the competing goods and services are identical or highly similar and the respective marks are visually and phonetically highly similar leading to a likelihood of confusion including a likelihood of economic association. Thus, the Opponent requests the applications be refused for all the applied-for goods and services.
6. The Applicant filed a defence and counterstatement for both oppositions denying the Opponent's claims.
7. On 29 November 2024, the Tribunal wrote to the parties informing them that the two opposition proceedings had been consolidated, pursuant to rule 62(1)(g) of the Trade Marks Rules 2008.
8. The Applicant is represented by CMS Cameron McKenna Nabarro Olswang LLP. The Opponent is represented by PAPYRUS IP LTD.

RELEVANCE OF EU LAW

9. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE AND SUBMISSIONS

10. During the evidence rounds the Opponent filed written submissions, dated 27 January 2025, as well as evidence in chief in the form of a witness statement from Marine Body, Chartered Trade Mark Attorney of Bromhead Johnson, dated 25 January 2025 and Exhibits MB1 – MB10.¹ The Applicant filed evidence in chief in the form of a witness statement from Tania Smith, Commercial Lawyer in the Corporate Services department at J Sainsbury plc (i.e., the Applicant), dated 26 March 2025, and Exhibits TS1 – TS24. All the witnesses are duly authorised to provide evidence.
11. A hearing took place before me, by videoconference, on 25 June 2026. Prior to the hearing, the parties filed skeleton arguments. The Opponent was represented by Marine Body of PAPYRUS IP LTD. The Applicant was represented by Simon Malynicz KC of Hogarth Chambers.
12. The parties' evidence and submissions (both in writing and made at the hearing) will not be summarised here but will be referred to as and where appropriate during this decision. This decision is taken following careful consideration of all the papers as well as of the submissions presented in writing and at the hearing.

DECISION

Section 5(2)(b)

13. Sections 5(2)(b) and 5A of the Act state:

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

[...]

(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,

¹ With Form TM33P of 16 May 2025, the Opponent informed the Office of a change in representative from Bromhead Johnson to Papyrus IP Limited.

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

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.”

The principles

14. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25:

(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 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; and

(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 comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, where 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. The relevant factors identified by Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

17. The goods and services in question are indicated above in this decision at paragraphs [1] and [3].

18. The Applicant concedes that its goods “*battery chargers*” and “*apparatus, instruments and cables for electricity*” in class 9 are identical to those of the Opponent. The Applicant also concedes that its services “*installation and repair services connected with solar panels, battery chargers, and electric vehicle charging equipment; vehicle battery charging; recharging services for electric vehicles; vehicle repair, maintenance, refuelling and charging; installation, maintenance, repair of electrical charging stations and electrical vehicle charging stations; installation, maintenance and repair services for chargers, electric chargers, electric vehicle chargers, charging stations for electric vehicles, charging docks, battery charging equipment; technical consulting services in the field of*

installation, maintenance and repair of electrical charging stations for electric vehicles” in class 37 are identical to the Opponent’s services in the same class.²

19. In light of these findings, and for reasons which will later become apparent, I will first assess the likelihood of confusion where the respective marks are used in relation to identical goods and services.

The average consumer and the purchasing act

20. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect.

21. In *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

(a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion,

² See the table in the schedule “Comparison of goods and services” to the Applicant’s skeleton arguments at pages 13 and 14.

by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question;³ and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

22. The Opponent provided evidence and submissions to argue that the respective goods and services are directed at the public at large since the markets for both electric vehicles and electric-vehicle charging infrastructure are widespread in the UK.⁴ It is also contended that the relevant public will pay a very low level of attention⁵ in that the goods and services can be defined as "everyday consumer goods/services" with the price for charging electric vehicles ranging from £17 to £26 to fully charge a vehicle and the charging taking place regularly from once a week to once a month according to the vehicle's usage.⁶

23. The Applicant argues that the relevant consumer for electric vehicles and charging goods and services pays a relatively high degree of attention in that vehicles are a high-cost purchase and consumers will pay attention to the compatibility of the goods and services to their vehicles.⁷ At the hearing Mr Malynicz also contended that as the market for charging stations is crowded, the consumers will have to pay more attention to find the correct charging point and visual considerations are predominant when selecting the correct charging station.

24. The goods in class 9 for which I found identity, can encompass a variety of goods from chargers for rechargeable batteries for domestic use as well as instruments, apparatuses, and cables for electricity for domestic applications (e.g., DIY works) to chargers for electric vehicles and apparatuses, instruments and cables for electricity for professional applications. The former will be purchased by the

³ *Lloyd Schuhfabrik Meyer*, Case C-342/97.

⁴ Opponent's written submissions at [22] and exhibit MB3.

⁵ Opponent's skeleton arguments at [12].

⁶ Opponent's written submissions at [23].

⁷ Applicant's skeleton arguments at [13].

general public whereas the professional public will purchase the latter goods such as, for example, electricians, electrical engineers, mechanics for electric vehicles or businesses in the field of electricity distribution.

25. The goods purchased by the general public are likely to be purchased quite often (although not being an everyday purchase), and they are commonly available in a wide variety of shops and/or online marketplaces (including specialised shops). None of these goods are of particularly high value. The goods purchased by the professionals are likely to be purchased more frequently and be of higher value. The general public, when purchasing these goods, will consider different technical specifics such as, for example, voltage, resistance, and compatibility according to their needs. I find a medium degree of attention will be paid. Where the average consumer is a business or a professional, they will pay a higher degree of attention during the purchasing process due to safety implications and the impact that poor quality (or incompatible) goods could have on their work and the reputation of their business.
26. The goods may be purchased following perusal of advertisements (whether physical such as leaflets or online). Visual considerations are, therefore, likely to dominate the selection process although I do not discount that there may also be an aural component to the purchase through advice sought from a sales assistant or representative.
27. Regarding the relevant consumers for vehicle battery charging services in class 37, these are purchased by all the owners (or users) of an electric vehicle that requires charging encompassing the general public, using electric vehicles for personal use, as well as professionals using such vehicles for their profession. When purchasing these services, I agree with the Opponent that both categories of consumers are likely to take various factors into account such as, for example, the proximity of the charging station to their homes or places of work and the cost of the charge. I also find that the consumers will take into account the compatibility of the charging station with their vehicle. I agree with the Opponent that the purchase of these services will vary according to the usage of the vehicle and it is likely to be frequent spanning from weekly to monthly. The cost for these services is likely to be fairly low (as also submitted by the Opponent), however not the lowest. I disagree with the Opponent that the degree of attention paid for these

services will be low.⁸ I find that both the general public and the professionals will pay a medium degree of attention during the purchasing process.

28. Turning to the installation, maintenance and repair services for electric vehicle chargers, charging stations for electric vehicles and batteries in class 37, these are more specialised services that are purchased by the general public having chargers installed at their homes as well as businesses that own or manage charging stations for vehicles (including batteries). The purchase of these services by the professional public, although not everyday, is likely to be quite frequent especially taking into account routine maintenance activities. The purchase of these services by the general public is likely to be infrequent. The services are likely to be fairly expensive, especially if they apply to numerous charging stations. The businesses purchasing these services are likely to consider the cost, geographical coverage and the provider's reputation as these services can directly impact their business. The general public will take into account the suitability of the charger to be installed at their homes and the charger's compatibility with their car. I find that a high degree of attention will be paid by both the general and professional public when purchasing these services.

29. The services are likely to be obtained from a website, mobile applications or other online means as well as specialised retailers following online research or after perusal of advertising material (either physical or online). Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component.

30. For the sake of completeness, the Opponent also contends that:

“[given] the fact that the Applicant is the owner of a well-known supermarket food chain, we can predict that the Applicant Intends to install charging stations at their supermarket car parks and that the electric vehicles can be charged while the consumers are doing their food shopping which largely facilitates the selection process of the consumer. Therefore, there is a restricted selection process in that the average consumer would be used to go to the same

⁸ Opponent's written submissions at [25].

supermarket chain and not analyse in details the charging stations located there.”⁹

31. With this argument the Opponent contends that the relevant public for the vehicle battery charging services will pay a lower degree of attention. First, I remind myself that I must carry out my assessment with regard to the services solely on the basis of those registered irrespective of how the services may be used in the market.¹⁰ Second, I do not see any merit in the argument that consumers who charge their cars at a supermarket would pay less attention when purchasing this kind of service. It is my view that irrespective of where a charging station is located, the relevant public will nonetheless carry out some considerations (e.g., cost and compatibility) before charging their vehicles.

Comparison of trade marks

32. It is clear from *Sabel BV v Puma AG, Case C-251/95* 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. The CJEU states at paragraph [34] of its judgment in *Bimbo SA v OHIM, Case C-591/12P*, 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 relevant 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.”

33. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the

⁹ Opponent’s written submissions at [24].

¹⁰ On the notional assessment of the specifications, see the AP decision in BL O/0065/24.

trade 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.

34. The marks to be compared are as follows:

Opponent's mark	Applicant's marks
	<i>the '983 mark</i> 
	<i>the '980 mark</i> 

Overall impression

35. The Earlier Mark features a stylised device that may be perceived either as a letter C in combination with a stylised arrowhead or overall as an abstract device. Underneath the figurative element the mark features the word “smart” in lower-case letters. The Contested Marks consist of the words “Smart Charge”, arranged one above the other. In addition, to the left of the word elements and extending to approximately the same height as the stacked words, the ‘983 mark features a figurative device depicting a location pin containing a thunderbolt, whereas the ‘980 mark features two charging cords with plugs at their extremities. In both Contested Marks, the figurative devices are presented in green shading darker at the bottom and lighter at the top and cast a small shadow beneath them.

36. The Opponent contends that the main distinctive element in the Earlier Mark is the word “smart” with the figurative device having a minimal impact on the mark’s

overall impression.¹¹ At the hearing Mr Malynicz stated that the figurative device in the Earlier Mark is dominant and distinctive. Since the eye is naturally drawn to the elements of the mark that can be read,¹² I agree with the Opponent that the word “smart” is the more distinctive element in the Earlier Mark. However, given the device’s position and size, I find it also contributes to the mark’s overall impression although to a lesser extent.

37. Turning to the Contested Marks, the Opponent argues that “charge” in both marks is descriptive of the goods and services and, therefore, non-distinctive with “Smart” being the distinctive element.¹³ It is also argued that “Smart” is the dominant and distinctive element in that it is placed on top of “Charge”.¹⁴ At the hearing Mr Malynicz argued that although “Smart” is placed on top of “Charge”, the consumers will read both words together resulting in “Smart Charge” forming a single unit. I agree that “Smart” defines “Charge” and that the relevant consumers will perceive the word combination “Smart Charge” as a unit with both words equally contributing to the marks’ overall impression. The Opponent submits that the figurative devices in both Contested Marks do not dominate the marks’ overall impression because they are smaller than the text and are descriptive of the goods/services in that they represent, respectively, a plug and wire of a charging cable and a generic lightning bolt symbol.¹⁵ Although I appreciate that word elements must generally be regarded as more distinctive than the figurative elements, due to the size and position of both figurative devices in the Contested Marks I find that they contribute to the marks’ overall impression although to a lesser degree than the text.

Visual similarity

38. I have already described the respective marks’ visual representations at paragraph [35].

39. The Opponent contends that the respective marks overlap in the word “smart” and have a highly similar font.¹⁶ The Applicant argues that the respective marks’

¹¹ Opponent’s skeleton arguments at [29].

¹² *MigrosGenossenschafts-Bund v EUIPO*, T-189/16.

¹³ Opponent’s skeleton arguments at [25] and [33].

¹⁴ Opponent’s skeleton arguments at [20].

¹⁵ Opponent’s skeleton arguments at [27].

¹⁶ Opponent’s skeleton arguments at [20].

similarity exclusively concerns the common element “smart” that is low in distinctiveness being represented in lower capitals in the Earlier Mark and with capital “S” in the Contested Marks.¹⁷ The Applicant also submits that the respective marks differ in the additional elements contained in the Contested Marks, namely the respective figurative devices and the word “charge” that is not reproduced in the Earlier Mark.¹⁸ At the hearing Mr Malynicz stated that although the respective marks are not completely dissimilar in that they share the word “smart”, there is a very low visual similarity due to their respective differences.

40. Although I appreciate that the marks share the same word “smart”, they differ in the additional “charge” in the Contested Marks along with having different figurative devices that, although they contribute less to the respective marks’ overall impression, are a further point of visual difference, especially taking into account their size and position. Therefore, overall, I find the marks have a below-medium degree of visual similarity.

Aural similarity

41. I agree with the Opponent that the respective figurative devices in the marks do not count towards the marks’ aural similarity in that they will not be voiced. The Opponent also argues that consumers will read “Smart Charge” in the Contested Marks as two separate terms since they are placed on two lines one above the other and that “Smart” in the Contested Marks dominates aurally as it is placed at the beginning.¹⁹ The Applicant neither in its written submissions nor at the hearing filed specific submissions on this point.

42. Turning to the Opponent’s arguments, I note that consumers read from left to right as well as from top to bottom. I do not see how the mere fact that two words are arranged one on top of the other would lead the consumers to read them separately if they form a unitary meaning as stated above at paragraph [37]. Furthermore, although I note that consumers are likely to pay more attention to the beginnings of marks,²⁰ I must remind myself that the principle laid down in *El Corte Inglés* (and

¹⁷ Applicant’s skeleton arguments at [49].

¹⁸ *Idem*.

¹⁹ Opponent’s skeleton arguments at [24].

²⁰ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

other case law) is not a hard and fast rule of law. Rather, it is a practical rule of thumb, based on experience and observation. It amounts to no more than “All else being equal, the average consumer will tend to pay more attention to the beginnings of marks than other parts of marks [...]”.²¹

43. At the hearing Ms Body also argued that “Charge” in the Contested Marks is descriptive. Although not clearly contended, for the sake of completeness, I remind myself that the descriptiveness of an element does not render it aurally invisible.²² In any case, as I found that “Smart Charge” forms a unit, consumers are likely to pronounce the expression in full. Therefore, notwithstanding the fact that “Charge” may be perceived as descriptive, this does not detract from the fact that the addition of “charge” creates a point of aural dissimilarity.

44. Considering all of the above, I find that the marks have a medium degree of aural similarity.

Conceptual similarity

45. It is settled case law that for a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.²³

46. The Opponent contends that “smart” in the Earlier Mark refers to something that is technically advanced, clear, intelligent (e.g., “smart card”), and the logo features the letter “C” with an arrow that will be understood by the relevant consumer as meaning “charge this way”. Such meaning is contended to be the same as the one conveyed by the figurative devices featured in the Contested Marks.²⁴

47. At the hearing Mr Malynicz stated that “smart charging” generally means “intelligent charging” and that the evidence provided by Ms Smith shows that “smart charging” is used to indicate a charging method that taps into the electricity grid at certain times to impact less on the electricity demand and be cheaper.

²¹ See decision from the Appointed Person (AP) in BL O/0976/23 at [22].

²² BL O/115/22.

²³ *The Picasso Estate v OHIM*, Case C-361/04 P.

²⁴ Opponent’s written submissions at [57] and [58]. For the sake of completeness, in the Opponent’s written submissions at [27] it is argued that car consumers and automotive enthusiasts will understand SMART as deriving from the combination of the first letters of Swatch and Mercedes along with “ART”. I do not find that the relevant consumers will readily understand “smart” with such meaning.

48. From the parties' submissions and evidence, I derive that they agree that "smart" is generally understood as meaning something that is "intelligent" or "technically advanced" when referred to technology. Regarding the meaning of "smart charging", although some consumers may understand it with the meaning evidenced by Ms Smith, I find that a significant proportion of the relevant public may not be familiar with the specific technical meaning of "smart charge". It is my view that "smart charge" will be generally understood as "intelligent charge/charging" or "technologically advanced charge/charging" notwithstanding the understanding of the specific features of the charging.
49. Turning to the figurative devices in the respective marks, I do not find that the relevant consumers will understand the Earlier Mark's logo as meaning "charge this way". Even if consumers will see the logo as the letter "C" with an arrow (or arrowhead), they will perceive it merely as the alphabet letter "c" devoid of any clear meaning (apart from the meaning of the letter "c"). Thus, I do not find that the logo in the Earlier Mark will affect the mark's meaning.
50. Regarding the figurative devices in the Contested Marks, I agree with the Opponent that they both contribute to the "charge/charging" meaning of both marks.²⁵
51. Overall, the respective marks share at least a low degree of conceptual similarity in that they both convey the meaning of something that is "intelligent" with the Contested Marks conveying the more specific meaning of a "technologically advanced charge/charging system".

Distinctive character of the earlier trade mark

52. 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

²⁵ Opponent's written submissions at [57].

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)."

53. Registered trade marks possess varying degrees of inherent distinctive character.

These range from the very low, such as those which are suggestive or allusive of the services, to those with high inherent distinctive character, such as invented words.

54. As a preliminary point, the Applicant contends that the Opponent cannot rely on any evidence to show enhanced distinctiveness of the Earlier Mark because it has not been registered for more than five years.²⁶ I remind myself that enhanced distinctiveness through use must be assessed at the relevant date (the filing date of the Contested Marks) and is not affected by the date on which the Earlier Mark was registered. Therefore, I can take into account the evidence filed by Ms Body to determine whether the Earlier Mark has been enhanced through use.

55. The Opponent submitted that "smart" is highly inherently distinctive in that it has several meanings (e.g., clever, stylish or intelligent for devices).²⁷ The Opponent also provided evidence to show the Earlier Mark's enhanced distinctiveness.

56. Dealing first with the inherent distinctiveness of the Earlier Mark, it involves the common and ordinary dictionary word "smart" which may be considered to be

²⁶ Applicant's skeleton arguments at [43].

²⁷ Opponent's written submissions at [36].

allusive to a quality of the goods and/or services for which the mark has been registered. The mark also features a stylised logo depicting either the combination of “C” with an arrowhead or an abstract combination of a thick semicircle and a rounded triangle. The figurative device contributes, in part, to the mark’s distinctiveness irrespective of how it will be perceived. Overall, the Earlier Mark possesses a between low and medium degree of inherent distinctive character.

57. Turning to the question of whether the inherent distinctiveness of the Earlier Mark has been enhanced through use, I note that the Opponent has filed evidence in this regard. At the hearing Ms Body stated that the Opponent is a well-known car manufacturer and directed me to part of the evidence listing different types of car models that the Opponent has marketed between 1998 and 2017, including electric cars (retailed since 2007 and reaching almost 2 million units sold in 2023).²⁸ Ms Body also reported that between 2023 and 2024 the Opponent’s car sales increased by 152%, marking the third biggest increase of all car manufacturers after BYD and Jeep in that year.²⁹ I was also directed to part of the evidence showing a picture of a “Smart” car plugged into a charging station.³⁰ Neither the cable nor the charging totem carries the Earlier Mark. Ms Body also referred to part of the evidence listing standard equipment being sold with the Opponent’s “Smart” cars and including charging cables.³¹ At the hearing Ms Body stated that this evidence shows that every time a “Smart” car is sold, also “Smart”-branded battery chargers and instruments/cables for electricity are sold under the same mark. No evidence, however, was provided showing instances of such goods being retailed carrying the Earlier Mark. Evidence was also provided showing that “Smart” car users can download the “EQ Control App” to check different charging settings for their “Smart” cars.³²

58. Ms Body also provided evidence indicating that the Opponent invested in the IONITY charging network for electric vehicles in the UK.³³ Although this is noted,

²⁸ Exhibit MB4, page 57.

²⁹ Exhibit MB6, page 104.

³⁰ Exhibit MB5, page 65.

³¹ Exhibit MB5, page 86.

³² Exhibit MB5, pages 73 and 76.

³³ Exhibit MB9, pages 116 – 120 and page 124.

the evidence does not show the use of the Earlier Mark in relation to charging stations (or the charging network).

59. From the account of the evidence, this is clearly insufficient to show that the Earlier Mark has enhanced its distinctive character in relation to the goods and/or services for which it is registered. First, the evidence mostly concerns “Smart” cars which do not form part of the Earlier Mark’s specification. Second, although I appreciate Ms Body’s argument that accessories and services sold (or provided) in combination with or relating to “Smart” cars are offered under the same “Smart” mark, very little evidence was provided to show that this is the case (let alone to show enhanced distinctiveness for these goods and/or services). Therefore, whilst I acknowledge the Opponent’s evidence, I do not find that the Earlier Mark’s distinctive character has been enhanced through use.

Likelihood of confusion

60. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep 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]).

61. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other (*L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10).

62. I have already elected to proceed by considering the likelihood of confusion where the marks are used in relation to identical goods and services. The Earlier Mark has a between low and medium degree of inherent distinctiveness. I found the evidence provided to be insufficient to show that the Earlier Mark’s distinctiveness has been enhanced through use.

63. The relevant consumers for the goods at hand are comprised of both the general and the professional public. The former will pay a medium level of attention whereas the latter will pay a higher degree of attention. The relevant consumers for the services are the general public and businesses that will pay a high degree of attention. The purchasing process of the contested goods and services is considered to be mainly visual but the potential for aural use also bears some relevance.
64. I found the visual similarity to be below medium, the aural similarity to be medium and that the respective marks have at least a low degree of conceptual similarity.
65. I will now turn to consider the likelihood of direct confusion (or lack thereof) of the Earlier Mark in relation to the Contested Marks.
66. At the hearing Ms Body essentially argued that “smart” is the main, independent distinctive element in all the competing marks and that the relevant consumers, when confronted with the Contested Marks, will focus on “smart” and confuse them for the Earlier Mark. I do not find this to be the case. First, I found that “smart charge” in the Contested Marks will be perceived as a unit, therefore, the consumers will not exclusively extract “smart” from these marks. Second, the Earlier Mark and the Contested Marks all feature stylised figurative devices that, although contribute less to their respective marks’ overall impression, they are clearly visible by virtue of their size and position in the marks. Therefore, even bearing in mind that the relevant consumers pay a medium degree of attention for the goods, the identity between the goods and services and the principle of imperfect recollection, I nonetheless find it highly unlikely that the consumers will ignore all the additional elements in the Contested Marks, focus exclusively on the word “smart” and confuse these marks for the Earlier Mark, also misremembering the figurative device in the Earlier Mark. I reach this conclusion also bearing in mind that the Earlier Mark enjoys a between low and medium degree of inherent distinctiveness. As a result, I find that there is no likelihood of direct confusion.
67. It now falls to me to consider the likelihood of indirect confusion. The concept of indirect confusion was described in the following terms by Iain Purvis Q.C. sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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)”.

68. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of

Appeal.³⁴ I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.³⁵ The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a “proper basis” for finding indirect confusion.³⁶

69. At the hearing Ms Body stated that car manufacturers normally collaborate for the creation/financing of charging networks. Ms Body also pointed me to the part of the evidence where it is indicated that the Opponent collaborated for the creation of the IONITY charging network. As I already noted above, the evidence shows a picture of the IONITY charging stations which neither feature the Earlier Mark, nor carry any reference to the Opponent. The evidence exclusively shows the IONITY name and logo.

70. In essence, what Ms Body contended at the hearing was that car manufacturers are often involved in the provision of electric vehicle charging services with the result that the relevant consumers, when confronted with a “smart charge” station, will see the word “smart” and believe that the charging station is commercially associated with the Opponent. Mr Malynicz, at the hearing, counterargued that the Opponent is a car manufacturer using the Earlier Mark that is comprised of “smart” and the logo and for the Opponent to argue that any use of “smart” for anything in relation to vehicles (including electric vehicles) is unreasonable.

71. I found that the purchase of goods and services at hand is mainly visual and that the relevant consumers will read “smart charge” as a unit deriving the meaning of intelligent/technologically advanced charge/charging. From the evidence provided by Ms Body, I note that the charging networks (i.e., the apparatus for the distribution or use of electricity as well as the electric vehicle charging services) operate under different names from those of the car manufacturers marketing electric vehicles. In any case, even admitting that it is a common practice for electric vehicle manufacturers to also offer charging station services, I find it unlikely that the relevant consumers when confronted with the Contested Marks on

³⁴ *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.

³⁵ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17.

³⁶ *Liverpool Gin Distillery*.

contested goods/services will isolate “smart” from the other elements of the Contested Marks, ignore the marks’ meaning (namely, intelligent/technologically advanced charge/charging) and believe that “smart” exclusively stands to indicate the Opponent’s brand and a commercial association with the Opponent. In this regard, “smart” is a common English word that is often used in combination with other words to define them (the same Opponent provided the example “smart card” to illustrate the meaning of “smart”).³⁷ In addition to all this, I do not see any reason for the consumers to look at the Contested Marks and believe that the Opponent has opted to remove the figurative device in the Earlier Mark, which is clearly visible, to replace it with different devices (respectively a charging cord and a position pin with a thunderbolt). Therefore, notwithstanding the identity between the respective goods and services and the medium degree of attention by the general public (for the goods), I find that no indirect confusion is likely to occur between the Earlier Mark and any of the Contested Marks.

72. Having reached that conclusion in respect of identical goods and services, the Opponent would be in an inferior position were I to assess the likelihood of confusion based on similar goods and/or services. Therefore, it follows that there is no likelihood of confusion (both direct and indirect) for the remaining goods and services at hand.

CONCLUSION

73. The opposition number **OP000444586** under section 5(2)(b) fails in total and application number UK00003933980, subject to any appeal, can proceed to registration.

74. The opposition number **OP000444915** under section 5(2)(b) fails in total and application number UK00003933983, subject to any appeal, can proceed to registration.

³⁷ Opponent’s skeleton argument at [30].

COSTS

75. The Applicant is entitled to an award of costs. At the hearing Mr Malynicz requested costs on the scale.

76. The relevant scale is contained in Tribunal Practice Notice (“TPN”) 1/2023. Bearing that scale in mind, I award costs to the Applicant as follows:

Considering the notices of opposition and preparing the counterstatements	£500
Preparing evidence and considering and commenting on the other side’s evidence	£600
Preparing for and attending a hearing	£500
Total:	£1,600

77. I order smart Automobile Co., Ltd. to pay J Sainsbury plc the sum of **£1,600**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case, if any appeal against the decision is unsuccessful.

Dated this 17th day of July 2026

Andrea Rossi

For the Registrar