O/0631/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003776301

IN THE NAME OF ILLINOIS TOOL WORKS INC.

TO REGISTER THE FOLLOWING TRADE MARK:

ERG COMPONENTS

IN CLASS 9

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. OP000435263

BY ERG S.P.A.

Background and pleadings

1. On 11 April 2022, Illinois Tool Works Inc. ("the applicant") applied to register the trade mark shown on the cover page of this decision in the UK. The application was accepted and published in the Trade Marks Journal on 29 April 2022 in respect of the following goods:

   Class 9: Electric switches; dual in-line package switches; custom electrical switches and switch components therefor.

2. On 27 July 2022, ERG S.P.A. ("the opponent") opposed the application under Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all of the goods in the application. The Opponent relies upon the following mark:

   UK registration no. UK00917776634[1]
   Filing date: 6 February 2018
   Date of registration: 21 July 2018
   Relying upon the following goods and services:

   Class 9: Apparatus and instruments for transforming, accumulating, regulating or controlling electricity and energy; Photovoltaic cells or modules; Photovoltaic apparatus; Photovoltaic installations for generating

[1] The earlier mark was initially registered at the European Union Intellectual Property Office (EUIPO). The opponent's mark is a comparable mark based on the opponent's pre-existing EUTM, being EUTM 16943565. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM.

The mark was revoked with effect from 22 July 2023 following an undefended decision in case number CA000507012, but it was a valid earlier right at the time of the opposition being filed.

electricity [photovoltaic power plants]; Photovoltaic apparatus for generating electricity; Batteries; Battery chargers.

Class 39: Storage, distribution and supply of energy; Supply of electricity.

Class 40: Generation of electricity and energy, for others; Energy production.

3. The Opponent submits that the marks are highly similar and that the goods are identical or highly similar.

4. The applicant filed a counterstatement within which it denied the claims made. The applicant submits that the marks are visually and aurally similar to a low degree but are conceptually dissimilar. The applicant also submits that the opponent's Class 9 goods are only similar to a low degree to the applicant's goods, arguing that they have different relevant publics and distribution channels.[2]

5. Neither party filed evidence, nor did they request a hearing or file submissions in lieu.

6. The applicant is represented by Finnegan Europe LLP and the opponent is represented by Marks & Clerk LLP.

7. 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] Applicant's Form TM8 and counterstatement, paragraphs 7-12.

DECISION

Section 5(2)

8. The opposition is based upon Sections 5(2)(b) of the Act, which read 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".

9. By virtue of its earlier filing date, the opponent's above registration constitutes an earlier mark within the meaning of section 6 of the Act. As the earlier mark had not completed the registration process more than five years before the filing date of the application 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.

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

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa; Page 8 of 20

(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 the goods and services

11. The goods and services for comparison are as follows:

Opponent's goods and services	**Applicant's goods**
Class 9: Apparatus and instruments for transforming, accumulating, regulating or controlling electricity and energy; Photovoltaic cells or modules; Photovoltaic apparatus; Photovoltaic installations for generating electricity [photovoltaic power plants]; Photovoltaic apparatus for generating electricity; Batteries; Battery chargers. Class 39: Storage, distribution and supply of energy; Supply of electricity. Class 40: Generation of electricity and energy, for others; Energy production.	Class 9: Electric switches; dual in-line package switches; custom electrical switches and switch components therefor.

12. In *Gérard Meric v OHIM,* Case T-133/05, the General Court stated that:

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

13. Neither party has provided submissions or evidence as to the precise meaning of the applicant's "dual in-line package switches", but the term is sandwiched between two terms that refer to electrical switches in its specification. Furthermore, the applicant refers to its goods collectively in its counterstatement as "electrical switches". I therefore take "dual in-line package switches" to be a form of electrical switch.

14. In its statement of grounds, the opponent argues that its Class 9 goods "encompass electric components such as the electric switches and components covered by the Application. Therefore, we submit that all of the goods covered by the Application are identical to the aforementioned class 9 goods covered by the Registered Marks."[3]

15. In response to the opponent's claim the applicant says: "The Applicant denies this allegation. The Opponent's Earlier Goods in Class 9 are only similar to a low degree to the Applicant's Goods, given that they have different relevant public and distribution channels."[4]

16. The applicant does not elaborate on what it means by the goods having different relevant publics and distribution channels. However, later in its counterstatement, at paragraph 14, the applicant says the same things when comparing its goods with the opponent's Class 39 and Class 40 electricity services: "The Applicant submits that the Opponent's Earlier Services are

[3] Opponent's statement of grounds, paragraph 5. The opponent refers to marks in the plural because in earlier iterations of the opponent's Form TM7 mark UK00905733019 was also cited. However, this mark was dropped from the opposition when the final version of the Form TM7 was filed.
[4] Applicant's counterstatement, paragraph 12.

dissimilar from the Applicant's Goods in Class 9 as they have different relevant public and distribution channels. Energy and electricity providers (such as the Opponent} are likely to be in a commercial relationship with utility companies who send power to household consumers, whereas the electric switches produced by the Applicant are for use in industrial automation and machinery, testing equipment, and small kitchen appliances and therefore, they are unlikely to overlap. It is also unlikely or not typical, that a generator of energy would also provide electrical switches."

17. I can understand the applicant's arguments when comparing its goods with the opponent's services, but in respect of the opponent's "Apparatus and instruments for transforming, accumulating, regulating or controlling electricity and energy", these goods, such as fuze boxes, could be used in a domestic setting as could electrical switches. The average consumer for both sets of goods would be an electrical contractor who would purchase the goods through the same trade channels – DIY outlets and electrical suppliers.

18. Both sets of goods could also be used in a commercial setting when the same users – businesses – would purchase electrical apparatus and switches from the same commercial suppliers.

19. To sum up, I agree with the opponent's analysis and find that the applicant's "electric switches", "dual in-line package switches" and "custom electrical switches and switch components therefor" are *Meric* identical to the opponent's "Apparatus and instruments for transforming, accumulating, regulating or controlling electricity and energy".

Comparison of the marks

20. The respective marks are shown below:

Earlier trade mark	Contested trade mark
	ERG COMPONENTS

21. The opponent says that "The word COMPONENTS in the mark subject of the Application lacks distinctiveness and is descriptive in the context of the goods covered by the Application, namely, electric switches and their components. Therefore, we submit that the letters ERG are the dominant and distinctive element in the Application. The letters ERG are also the distinctive and dominant element of the Registered Marks, therefore the Application is visually, phonetically and conceptually similar to the Registered Marks to a high degree".[5]

22. The applicant "admits that the word COMPONENTS can be used descriptively in relation [to] the parts of machines or other apparatus, however the Applicant denies that the dominant and distinctive element of the Applied for Mark is the element ERG. The Applied for Mark is made up of two words, neither of which is visually or aurally outstanding or conceptually significant in the overall mark. It is submitted that the Applied for Mark does not have a dominant and distinctive portion, and that the two word elements in the mark should be considered together as a whole, with the elements ERG and COMPONENTS given equal weight."[6]

23. The applicant further argues that the marks are visually and aurally similar to a low degree.

24. In respect of the conceptual comparison, the applicant says that "The marks have the letters ERG in common, although these letters are unlikely to trigger any

[5] Opponent's statement of grounds, paragraph 3
[6] Applicant's counterstatement, paragraph 5

conceptual association in the mind of the consumer, particularly given that there are not the distinctive element in the Applied for Mark. For some parts of the public, the term ERG will be understood as a unit of work or energy, equal to the work done by a force of one dyne when its point of application moves one centimeter in the direction of action of the force … It is therefore submitted that the marks either have no conceptual associations or are conceptually dissimilar."[7]

Overall impression

25. The opponent's mark is a figurative mark that consists of the letters "ERG" slanted slightly forwards, in navy. To the left of the letters is a decorative device consisting of three decorative horizontal irregular shapes that are roughly in parallel to the horizontal branches of the letter "E" and whose ends follow the curve of the letter. The horizontal shapes are pale blue, green, and navy. The dominant and distinctive component of the mark is the letters "ERG", the stylistic elements playing a minor role in forming the overall impression made by the mark.

26. The applicant's mark is the word mark "ERG COMPONENTS". "ERG" is the more dominant of the two words, the word "COMPONENTS" being descriptive of the applicant's goods.

Visual comparison

27. Visually, the opponent's mark consists of the slightly stylised letters "ERG", in navy, together with a decorative device to its left, in pale blue, green, and navy. The applicant's mark begins with the same letters "ERG", but then has the additional word "COMPONENTS". I find the marks to be of a medium level of visual similarity.

[7] Applicant's counterstatement, paragraphs 9 and 10

Aural comparison

28. Aurally, the opponent's mark is "EE-AH-GEE", and the applicant's mark is "EE-AH-GEE KOM-PO-NENCE". I find the marks to be of a medium level of aural similarity.

Conceptual comparison

29. The decorative device in the opponent's mark does not contribute to its conceptual message. The applicant has said that some parts of the public will understand the letters "ERG" in both marks to mean a unit of work or energy and they provided a link to a collinsdictionary.com definition to that effect. However, in the absence of any evidence being filed as to the knowledge of consumers in this sector, I consider that those consumers that derive a concept from the letters on this basis will not form a significant proportion of average consumers. Rather, the average consumer will see "ERG" as a collection of letters that has no specific meaning. Therefore, that element of the marks is conceptually neutral. However, the applicant's mark has the additional word - "COMPONENTS" - which the average consumer will understand to mean "parts". This serves as a point of conceptual difference between the marks.

Average consumer and the purchasing act

30. It is necessary for me to determine who the average consumer is for the goods in question; I must then determine the manner in which the goods are likely to be selected by the average consumer in the course of trade.

31. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question: *Lloyd Schuhfabrik Meyer, Case C-342/97.* In *Hearst Holdings Inc, Fleischer Studios Inc v A. V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear*

Limited, J Fox Limited, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

> "The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

32. The average consumer for the competing goods is an electrical contractor carrying out work in domestic and commercial premises. They will give some thought to the specifications of the electrical apparatus and switches that they are purchasing. Generally, the cost of the goods will not be prohibitive. Overall, I find that the average consumer will pay a medium degree of attention during the purchasing process.

33. Visual considerations will predominate during the purchasing process as goods are selected from the shelves of a DIY outlet or electrical supplier, but verbal factors will come into play should a question need to be asked about the technical specifications of particular goods.

Distinctive character of the earlier trade mark

34. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In *Lloyd Schuhfabrik*, 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)."

35. The opponent makes reference to enhanced distinctiveness in its statement of grounds, but no evidence has been filed, so I will consider the earlier mark purely from the point of view of its inherent distinctiveness.

36. The earlier mark consists of the slightly stylised letters "ERG", together with a decorative device. "ERG" is a collection of letters that is not suggestive of the opponent's goods and services. I find the mark to be inherently distinctive to a high degree.

37. While the slight stylisation of the letters and the decorative device make a contribution to the inherent distinctiveness of the mark, I bear in mind that the degree of distinctiveness of the earlier mark is only likely to be significant to the extent that it relates to the point of commonality between the marks[8], the letters "ERG". In that respect, it is my view that the letters alone are inherently

[8] See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13

distinctive to a high degree.

Likelihood of confusion

38. I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V*).

39. There are two types of confusion that may occur. Direct confusion is where the average consumer mistakes one mark for the other, while indirect confusion is where the average consumer recognises that the marks are different, but for some reason assumes that the later mark also identifies the goods or services of the owner of the earlier mark, or that the two undertakings are related: see *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, paragraph 16.

40. I have found the dominant and distinctive component of the opponent's mark to be the letters "ERG", the stylistic elements playing a minor role in forming the overall impression made by the mark. "ERG" is the more dominant of the two words in the applicant's mark, the word "COMPONENTS" being descriptive of the applicant's goods.

41. The marks are visually and aurally similar to a medium degree. The shared element between the marks – "ERG" – is conceptually neutral, whereas the additional word "COMPONENTS" in the applicant's mark is a point of conceptual difference. The earlier mark is inherently distinctive to a high degree.

42. I have found the goods at issue to be *Meric* identical. The average consumer for these goods will be an electrical contractor who will pay a medium degree of

attention during the purchasing process. Visual considerations will predominate during the purchasing process, but verbal factors will come into play.

43. The letters "ERG" alone are highly distinctive. As such, the average consumer, for identical goods, will focus on the letters "ERG" and could easily overlook the slight stylisation and the decorative device in the opponent's mark or mis-recall them as belonging to the applicant's mark. By the same token, the average consumer could easily overlook the descriptive "COMPONENTS" in the applicant's mark or mis-recall it as belonging to the opponent's mark. There is therefore a likelihood of direct confusion in this case.

44. I will also consider the question of indirect confusion were the average consumer to notice the differences between the marks. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis QC, (as he then was) sitting as the Appointed Person, explained that:

> "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)."

45. 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. 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.[9]

46. Furthermore, in *Liverpool Gin*,[10] Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

[9] *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17
[10] *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

47. The average consumer would consider the competing goods to come from the same undertaking, the electrical goods in question being *Meric* identical. It would regard "ERG COMPONENTS" as a logical brand variant of the opponent's mark (notwithstanding the slight stylisation and the presence of the decorative device). The addition of the descriptive word "COMPONENTS" places the applicant's mark in category b) of the Purvis criteria and the mark would be seen as ERG's electrical components brand.

CONCLUSION

48. The opposition has succeeded in its entirety.

COSTS

49. As the successful party, the opponent is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice ("TPN") 2 of 2016. Applying the guidance in the TPN, I award costs as follows:

Official fees:	£100
Preparing a statement and considering the other side's statement:	£200
Total:	**£300**

50. I therefore order Illinois Tool Works Inc. to pay ERG S.P.A. the sum of £300. 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 11th day of July 2025

John Williams
For the Registrar