

O/0632/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3957789

IN THE NAME OF BOTANIC ENERGY LIMITED  
TO REGISTER THE FOLLOWING TRADE MARK:

**botanic solar**

IN CLASSES 7, 9, 11, 21, 31, 37, 39, 40 & 44

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 444954

BY

SOLARBOTANIC TREES LIMITED

## Background and pleadings

1. Botanic Energy Limited (“the applicant”) applied to register the trade mark ‘botanic solar’ in the UK on 18 September 2023 (application number: UK00003957789). It was accepted and published in the Trade Marks Journal on 29 September 2023<sup>1</sup> in respect of the goods and services in classes 7, 9, 11, 21, 31, 37, 39, 40 and 44 as set out in full later in my decision<sup>2</sup>.

2. On 28 December 2023, SolarBotanic Trees Limited (“the opponent”) opposed the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its earlier UK Trade Marks (“UKTM”):

UKTM no. 3778225

SolarBotanic

Filing date 16 April 2022; registration date 15 July 2022. The following goods and services are relied upon in this opposition:

Class 4 - Electrical energy from renewable sources.

Class 39 - Storage of energy and fuels.

Class 40 - Production of energy.

Class 42 - Development of energy and power management systems.

(“the first earlier mark”)

UKTM no. 3952895 (series of two)<sup>3</sup>

SOLARBOTANIC

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<sup>1</sup> An amendment was subsequently published in the Trade Marks Journal on 15 December 2023.

<sup>2</sup> A TM21B was filed on 08 December 2023 which considerably limited the terms upon which the applicant sought to rely. I will, therefore, only deal with the terms that are left within this decision. I note that the opponent still considers there is overlap between the goods and services such that the opposition must continue.

<sup>3</sup> I shall refer to them in the singular unless it becomes necessary to distinguish between them.

SolarBotanic

Filing date 04 September 2023; registration date 01 December 2023.

The goods and services relied upon in this opposition are as set out in full later in my decision.

(“the second earlier mark”)

3. Under section 5(2)(b) of the Act, the opponent claims that there is a likelihood of confusion on the basis that the marks are similar, and the goods are either identical or highly similar leading to a likelihood of confusion, including a likelihood of association, and that the contested mark should be refused registration.

4. The applicant filed a counterstatement submitting as follows:

“11. There is, arguably, a degree of visual similarity between the Applicant’s Mark and the Opponent’s Mark, because they are all formed from the same pair of words. The degree of visual similarity is low, however, because:

a. The words are reversed. The most visually striking and memorable element of a trade mark is the first element, The first element of the Applicant’s Mark is the word ‘botanic’ and the first element of each of the Opponent’s Marks is the word ‘solar’. These words are visually very different, having only the second and fourth letters in common.

b. The lack of a space in the Opponent’s Mark is unusual and therefore noticeable. This is a visually striking stylistic choice, which the Applicant’s Mark does not share.

12. There is, arguably, a degree of aural similarity between the Applicant’s Mark and the Opponent’s Marks, because they are all formed of the same pair of words. Both words are common enough that members of the relevant public can reasonably be expected to know their accepted pronunciations. The degree of aural similarity is low, however, because:

a. The words are reversed. The most striking and memorable element of a word or phrase in speech is its first element. The first element of the

Applicant's Mark is the word 'botanic' and the first element of each of the Opponent's Marks is the word 'solar'.

- b. The lack of a space in the Opponent's Marks will indicate to the speaker that the syllables of the mark should be run together more quickly, without the usual fraction-of-a-second pause between distinct words. The Applicant's Mark is likely to be spoken at a more ordinary pace, because each known word is presented separately.

13. There is arguably a degree of conceptual similarity between the Applicant's Mark and the Opponent's Marks, because they are all formed from the same pair of commonly understood words. The degree of conceptual similarity is low, however..."

5. Further, the applicant also denies that the goods and services are identical or similar.

### **Representation**

6. The opponent is represented by Barker Brettell LLP. The applicant is represented by Robertson IP Limited. No evidence/submissions were filed during the evidence rounds and no hearing was requested, however both parties filed written submissions in lieu of a hearing, which will not be summarised but will be referred to as and where appropriate during this decision. This decision is taken following a careful perusal of the papers.

### **Relevance of EU Law**

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.

## **Preliminary Issue**

8. I note that within their submissions in lieu, the applicant has argued that the opponent has not set out the similarities between the marks. Having considered the pleadings, I note that the opponent set out at the relevant question in the TM7 that the marks are similar. I note that the respective marks both consist of the same two words which are presented in a different order, and that the applicant has conceded within their submissions in lieu that the marks are similar visually, aurally and conceptually, albeit to a low degree. Pleadings serve a simple function: to identify the issues between the parties and outline a party's case in general terms, sufficient for the other party to understand the case against it. Therefore, the applicant's submissions in regard to the opponent failing to specify the similarities between the marks in its pleadings are irrelevant in this instance and will not be considered further.

## **Decision**

### **Section 5(2)(b)**

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

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

10. Section 5A of the Act states as follows:

“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.”

## Relevant law

11. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) 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 C120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

- (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**

12. The parties' competing goods and services are set out as follows<sup>4</sup>:

<b>The earlier marks</b>	<b>The contested mark</b>
Class 4 - Electrical energy; Electrical energy from renewable sources; electrical energy from solar power; fuel; hydrogen fuel; biofuel; non-chemical additives for fuels	

<sup>4</sup> The first earlier mark's class 4 and 39 terms are included within the second mark's specification. I have therefore only reproduced them once. Any additional terms not common to both specifications have been outlined in full.

<p>Class 6 - Metal materials for building and construction; buildings and support structures of metal; prefabricated metal constructions and buildings; roofs and roof support structures of metal; metal shelters; canopies [building structures] of metal; canopies of metal incorporating photovoltaic cells; metal posts and columns for supporting photovoltaic installations; metal supporting structures for photovoltaic installations; parts and fittings for all of the aforesaid goods.</p>	
	<p>Class 7 - Electric garden pumps; Electric apparatus for the care of gardens; Electric garden scythes; Electric garden shredders.</p>
<p>Class 9 - Apparatus and instruments for generating, conserving and storing energy, power and electricity; electric vehicle charging apparatus and instruments; chargers; electric battery chargers; solar-powered battery chargers; chargers and charging stations for electric vehicles; electric control devices for energy management; electric batteries for powering electric vehicles; electrical storage batteries; solar batteries; fuel cells; photovoltaic apparatus and installations for generating solar electricity; photovoltaic solar modules; solar cells for electricity generation; solar panels for electricity generation; solar energy collectors for</p>	<p>Class 9 - Crystalline silicon solar power cells; Solar wafers; Crystalline silicon solar cells; Solar powered telephones; Solar powered radios; Wafers for solar cells; Electronic sensors for measuring solar radiation; Electronical sensors for measuring solar radiation.</p>

<p>electricity generation; solar panel arrays; power supply units; electric convertors and transformers; electronic and infrared control devices; electric cables and wires; battery testing apparatus; electric control panels; panel connectors [electric]; parts and fittings for all of the aforesaid goods; downloadable computer software for use in the energy sector; mobile application software for use in the energy sector; downloadable computer software for monitoring electricity generation and consumption; mobile application software for monitoring electricity generation and consumption; downloadable computer software for controlling energy storage and generation apparatus; mobile application software for controlling energy storage and generation apparatus; downloadable computer software relating to the control, regulation, interconnectivity and monitoring of solar energy systems; mobile application software relating to the control, regulation, interconnectivity and monitoring of solar energy systems.</p>	
	<p>Class 11 - Solar thermal collectors [heating]; Solar energy collectors for heating; Solar collectors for heating; Solar furnaces; Solar heating panels; Solar panels for use in heating; Solar heat collection panels; Solar heating</p>

	<p>installations; Thermal storage instruments [solar energy] for heating; Solar water heaters; Solar energy powered heating apparatus; Thermal storage apparatus [solar energy] for heating; Desalination plants; Nuclear cogeneration plants; Solar heating apparatus; Water desalination plants; Nuclear power plant installations; Solar powered ventilation apparatus; Garden lighting; Sea water desalination plants; Garden lights; Industrial waste water purification plants; Electric vegetable steamer.</p>
<p>Class 19 - Non-metallic materials for building and construction; non-metallic buildings and support structures; prefabricated constructions and buildings not of metal; cladding materials and components, not of metal; non-metallic roofs and roof support structures; non-metallic supporting structures for photovoltaic installations; parts and fittings for all of the aforesaid goods.</p>	
	<p>Class 21 - Terrariums (Indoor -) [plant cultivation]; Indoor terrariums [plant cultivation]; Indoor terrariums for plants.</p>
	<p>Class 31 - Natural flowering plants; Natural plants; Natural plants and flowers; Hydroponic plants; Plant bulbs for horticultural use; Bulbs (Plant -) for horticultural use; House plants; Live</p>

	<p>plants used as aquarium landscapes; Seed germ for botanical purposes; Germ (Seed -) for botanical purposes; Plants; Flowering plants; Bulbs (Plant -) for agricultural use; Nursery plants; Fruit plants.</p>
<p>Class 36 - Financial services; real estate affairs; leasing of land for energy projects; financial consultancy in the energy sector; consultancy concerning financing of energy projects; project financing in the energy sector; financing and funding of energy storage and generation apparatus; financing and funding of solar energy systems; financing and funding of solar-powered battery chargers; financing and funding of chargers and charging stations for electric vehicles; advisory, information and consultancy services relating to all of the aforesaid services.</p>	
<p>Class 37 - Construction services; construction project management services; on site building project management; construction, installation, repair and maintenance of apparatus and instruments for generating, conserving or storing energy, power and electricity; construction, installation, repair and maintenance of solar powered systems; construction, installation, repair and maintenance of photovoltaic installations; construction, installation,</p>	<p>Class 37 - Construction of geothermal power plants; Construction of geothermal power plants; Construction of geothermal energy installations; Construction of geothermal community heating installations; Construction of wave energy power plants; Construction of geothermal power installations; Renovation of nuclear plant; Cleaning of nuclear plant; Installation of industrial plant.</p>

<p>repair and maintenance of solar charging stations; construction, installation, repair and maintenance of solar carports; construction, installation, repair and maintenance of solar car parks; solar charging of electric vehicles; charging of batteries and power storage devices, and rental of equipment therefore; charging of electric vehicles; battery charging service for motor vehicles; mobile phone battery charging services; advisory, information and consultancy services relating to all of the aforesaid services.</p>	
<p>Class 39 - Supply, transport, storage and distribution of energy; electricity supply, transmission and distribution; storage of energy and fuels; electricity storage; distribution of renewable energy; rental of energy storage equipment; provision of solar car park services; rental of solar car parking spaces; solar car parking facilities; advisory, information and consultancy services relating to all of the aforesaid services.</p>	<p>Class 39 - Transport; Tram transport; Bus transport; Taxi transport; Railway transport; Transport and storage; Transport of goods; Monorail transport; Ambulance transport; Barge transport; Tanker transport; Transport of passengers; Passenger transport; Transport services; Air transport; Rail transport services; Transport of food; Cable-car transport; Ferryboat transport; Helicopter transport; Bus transport services; Car transport; Ferry transport services; Truck transport; Railway transport services; Ship transport; Transport of parcels; Air cargo transport services; Boat transport; Air cargo transport; Streetcar transport; Arranging of transport; Minibus transport services; Marine transport; Vessel transport;</p>

	<p>Ferry-boat transport; Freight train transport; Chartering of transport; Transport and storage of goods; Road transport services; Air transport services; Hire of rail transport; Container transport services; Airline transport; Arranging of passenger transport; Waste transport; Armored-car transport; Passenger transport services; Arranging for the transport of air freight; Vehicle transport services; Booking of transport; Transport of valuables; Car transport services; River transport; Transport of travellers; Travellers (Transport of -); Ship transport services; Railway passenger transport; Freight ship transport; Arranging of transport and travel; Arrangement of taxi transport; Road transport services for passengers; Transport of travelers; Transport of packages; Transportation; Water transport services; Air transport of passengers; Transport and delivery of goods; Transport of furniture; Transport of oil; River transport services; Reservation of rail transport; Arrangement of transport; Passenger road transport services; Services for chartering railway transport; Arranging of air transport; Air passenger transport services; Transport of pets; Passenger train transport; Transport of money; Road rescue [transport] services; Rescue [transport] services; Transport</p>
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	<p>reservation; Reservation (Transport -); Marine transport services; Air transport of valuables; Transport brokerage; Brokerage (Transport -); Transport of persons; Transport of goods by rail; Coach transport; Cargo ship transport; Rescue [transport] of vehicles in the air; Hire of transport vehicles; Cargo transportation; Transportation of cargo; Transport and storage of waste; Arrangement of passenger transport; Omnibus transport services; Reservation of ferry transport; Hire of road transport; Transport by ferry; Transport by rail; Rescue [transport] of vehicles in the water; Transport of freight by rail; Guarded transport of goods; Passenger ship transport; Guarded transport; Transport of cargo by air; Rental of vehicles for transport; Rental of transport vehicles; Transport of crantage; Rental of horses for transport; Freight and transport brokerage; Transport and freight brokerage; Transportation of freight; Freight transportation; Refrigerated transport of food; Armoured vehicle transport; Road transport services for persons; Transport of freight containers by rail; Arranging transport of passengers by rail; Coach transport services; Reservation of air transport; Armoured car transport; Travel and transport reservation services; Transport</p>
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	<p>of freight by air; Transport and storage of trash; Transport of passengers by rail; Arranging transport for travelers; Air transportation services for cargo; Hiring of transport vehicles; Transportation logistics; Handling [transport] of rubbish; Transport of motor vehicles; Armoured-car transport; Motor car transport services; Motor vehicle transport services.</p>
<p>Class 40 - Production of energy (First earlier mark))</p> <p>Class 40 - Generation of energy; production of electrical power from renewable sources; leasing of energy generating equipment; rental of energy generating equipment; advisory, information and consultancy services relating to all of the aforesaid services (UKTM 3952895)</p>	<p>Class 40- Production of energy by nuclear power plants; Generation of electricity from geothermal energy.</p>
<p>Class 42 - Development of energy and power management systems (First earlier mark)</p> <p>Class 42 - Scientific and technological services and research and design relating thereto; preparation of reports; industrial research and industrial design</p>	

services; energy monitoring services; energy management services; provision of information concerning research and technical project studies relating to the use of renewable energy; research in the field of hydrogen fuel cells; research in the field of solar energy; research in the field of renewable energy; design and development of energy and power management, storage and distribution systems; design services relating to energy and power generation; design and development of energy distribution networks; design of solar car parks; design of solar carports; design of solar panels; design of solar mounting structures; computer programming; software design and development; leasing of computer software; software as a service [SaaS] featuring software for use in the energy sector; platform as a Service [PaaS], namely, a platform for use in the energy sector; software as a service [SaaS] featuring software for monitoring electricity generation and consumption; software as a service [SaaS] featuring software for controlling energy storage and generation apparatus; software as a service [SaaS] featuring software relating to the control, regulation, interconnectivity and monitoring of solar energy systems; platform as a Service [PaaS], namely, a

<p>platform for monitoring electricity generation and consumption; platform as a Service [PaaS], namely, a platform for controlling energy storage and generation apparatus; platform as a Service [PaaS], namely, a platform facilitating the control, regulation, interconnectivity and monitoring of solar energy systems; advisory, information and consultancy services relating to all of the aforesaid services (UKTM 3952895)</p>	
	<p>Class 44 - Nurseries (Plant -); Plant nurseries; Horticulture, gardening and landscaping; Garden tree planting; Planting of flora; Landscape gardening.</p>

13. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International

Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979.”<sup>5</sup>

14. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account, as per *Canon*, where the CJEU stated at paragraph 23 of its judgement:

“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.”

15. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [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;

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<sup>5</sup> As per Miss Emma Himsworth KC in *Everest Dairies Limited v Everest Food Products Private Limited*, [23] O/0107/23. where she stated, “the question of whether goods are ‘complementary’ is to be distinguished from use in combination, where goods are merely used together, whether for choice or convenience.”

(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.

16. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. 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.”

17. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “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.”

18. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected

undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited* BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

19. I also bear in mind that it is permissible to group goods/services together for the purposes of the assessment<sup>6</sup>. Further I note the comments of Ms Emma Himsworth, sitting as the Appointed Person in *Everest Dairies Limited v Everest Food Products Private Limited*, on Appeal [O/0107/23], where she stated that:

“23. It is also clear from the case law that:

(1) The fact that goods may fall under the same class under the Nice Classification does not mean that they are to be regarded as ‘similar’. Likewise, the fact that the goods may fall under a different class under the Nice Classification system does not mean that such goods should be classed as ‘dissimilar’. See Case T-118/07 P.P.TV v. OHIM [2011] ETMR 738; and the decision of Ms Anna Carboni sitting as the Appointed Person in SK.4 TM Application (O-176-08) at [31] to [40].

(2) It is the goods covered by the specifications of the marks in issue that must be considered by the decision taker and not the goods actually marketed under the marks. See Case T-66/11 Present-Service Ullrich GmbH & Co KG v. OHIM [2013] ETMR 29 at [45].

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<sup>6</sup> *Separode Trade Mark* O/399/10

(3) The question of whether goods are ‘complementary’ is to be distinguished from use in combination, where goods are merely used together, whether for choice or convenience. Goods are ‘complementary’, as the Hearing Officer correctly identified from the case law in paragraph [43] of the Decision, where *‘there is a close connection between them, in the sense that once is indispensable of 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’*.

20. Both parties have submitted lengthy submissions regarding the similarity or otherwise of the goods/services which I will reference where appropriate. However, whilst the opponent has provided a table setting out those goods/services it considers to be identical or similar to those of the applicant, neither party has sought to provide a detailed explanation or any evidence of their respective terms. In going through the assessment, I also note the comments of Mr Ian Purvis sitting as the Appointed Person in *SmartX O/0911/24* “it is for the Opponent to put forward the combinations of goods on which it relies for similarity (or identity). If it fails to identify a particular combination, it cannot expect the Hearing Officer to do the job for it”.

20. I must also consider the terms from the perspective of the ordinary meaning attributed to them by the average consumer.

#### Class 7

*Electric garden pumps; Electric apparatus for the care of gardens; Electric garden scythes; Electric garden shredders.*

21. The opponent submits that these goods must be considered identical to their goods in class 9, including “apparatus and instruments for generating, conserving and storing energy, power and electricity” and “parts and fittings for all of the aforesaid goods” as their electric goods are not limited to a particular application or field. For example, they argue that “electric convertors are designed to work with or power machinery like pumps. Electric convertors transform electrical power into a usage form, often to operate machinery including pumps, garden scythes and electric garden shredders” and that “electronic and control devices regulate the operation of machinery, including pumps, garden scythes and electric garden shredders (for

example, controlling speed / flow rates, timing or other aspects of performance. Since these devices directly influence how the garden pump operates, they can be considered complimentary and therefore similar”. They also submit that “electric control panels are often used to manage and monitor the operation of complex systems, including pumps, garden scythes and electric garden shredders. The interdependence of the respective goods must lead to a finding of complementarity (and therefore similarity)”. The applicant submits that “there is no similarity between the goods in classes 7...and that those goods and services are in the field of gardening and horticulture”.

22. I consider that the applicant’s goods are specific and relate to garden apparatus, for the purpose of garden care, which will be powered by electricity or if handheld by rechargeable battery. The opponent’s specification in class 9 includes *electric control panels* and *electric battery chargers*, which are apparatus and instruments for charging, connecting, controlling and testing of batteries and chargers etc. The applied for goods are connected to the electric mains or will have some rechargeable power unit to allow them to be wireless. Whilst I consider that the respective goods differ in nature and purpose, are not in competition, I agree with the opponent that there is a complementary relationship between them. I consider that as such there is a close connection between the applicant’s electronic goods and the electric control panels and battery chargers that power them, that one is indispensable to the other, which would lead consumers to believe that the responsibility for the goods lies with the same undertaking. In light of the above, I find the parties’ goods to be similar to a low degree.

#### Class 9

*Crystalline silicon solar power cells; Solar wafers; Crystalline silicon solar cells; Wafers for solar cells;*

23. The opponent submits that the applicant’s above listed goods are identical to the opponent’s goods because “all solar cells and solar wafers are devices used to generate energy, specifically from solar power...therefore, solar cells, solar wafers and electronic sensors for measuring solar radiation fall under the Applicant’s [sic] umbrella term “*Apparatus and instruments for generating, conserving and storing energy, power*

*and electricity*”. The applicant submits that these are “components or elements of a solar power generating system (such as crystalline wafers or sensors)”. I agree with the opponent’s submissions and find that the applicant’s terms are encompassed by the opponent’s wider term “*apparatus and instruments for generating, conserving and storing energy, power and electricity*” and as such these are identical on the principles outlined in *Meric*.

*Electronic sensors for measuring solar radiation; Electronical sensors for measuring solar radiation*

24. I understand solar radiation sensors to be devices designed to measure solar radiation levels and the opponent has submitted that “electronic sensors for measuring solar radiation serve a functional role in energy management systems by monitoring or optimising electricity generation” and thus are identical, falling under its umbrella term “apparatus and instruments for generating, conserving and storing energy, power and electricity”. However, I consider that the opponent’s goods will have a different purpose and nature to the *electronic sensors for measuring solar radiation* listed above, as the opponent’s apparatus is used to generate, conserve and store energy, whereas the applicant’s goods are used to measure solar radiation. I consider that users may overlap, as those who are generating and conserving solar energy may wish to measure solar radiation, and I also consider that trade channels may overlap, as it is foreseeable that both may be sold by the same enterprise. I do find complementarity, as one may be used to measure the solar radiation of the other. Therefore, I find the respective goods are similar to a medium degree.

*Solar powered telephones; Solar powered radios;*

25. The above are telephones and radios that are run on solar power. I note that the opponent submits that:

“Solar powered telephones and solar powered radios use solar power to operate and hence use photovoltaic solar modules...This is clearly not a common source of energy for these types of devices. To this extent, they are related to at least the Opponent’s Class 9 goods which are linked to solar

technology such as the following: “*photovoltaic apparatus and installations for generating solar electricity*”, “*solar batteries*”, “*solar battery chargers*” and “*apparatus and instruments for generating, conserving and storing energy, power and electricity...*”. They can, at least, have the same usual origin and coincide in target public and distribution channels. Moreover, solar panels for electricity generation which include small and portable ones can even be considered complimentary (in other words, the respective goods need each other to function). As a result, they must all be considered highly similar”.

Both solar powered telephones and radios will include components, such as the opponent’s *photovoltaic apparatus* and will require *solar batteries* to operate. However, in *Les Éditions Albert René v OHIM*, Case T-336/03, the GC found that:

“61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

26. I consider that the nature and purpose of the goods is different as the applicant’s goods will be used for communication, and whilst they may include components such as *solar batteries* or rechargeable battery packs, users are also likely to be different. I do not consider that trade channels will overlap. Whilst solar powered telephones and radios will include a solar component, I do not consider that they are similar goods and therefore do not find complementarity<sup>7</sup>. I therefore find the goods to be dissimilar.

### Class 11

*Solar thermal collectors [heating]; Solar energy collectors for heating; Solar collectors for heating; Solar heat collection panels; Solar furnaces; Solar heating panels; Solar panels for use in heating; Solar heating installations; Thermal storage instruments [solar energy] for heating; Solar energy powered heating apparatus; Thermal storage*

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<sup>7</sup> *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13

*apparatus [solar energy] for heating; Solar heating apparatus; Solar water heaters; Solar powered ventilation apparatus;*

27. To my mind, I consider that these goods all relate to solar powered apparatus for environmental temperature control. The opponent submits that all of their power energy, electricity generated and solar related goods in Class 9 of their specification, such as “*apparatus and instruments for generating, conserving and storing energy, power and electricity*”, “*solar powered battery chargers*”, “*solar batteries*”, “*photovoltaic apparatus and installations for generating solar electricity*”, “*photovoltaic solar modules*”, “*solar cells for electricity generation*”, “*solar energy collectors for electricity generation*” and “*solar panel arrays*” are highly similar to the applied for renewable energy solar related goods in class 11. Regarding the applied for goods in this class, the opponent submits “the opponent’s term “*apparatus and instruments for generating, conserving and storing energy, power and electricity...; parts and fittings for all of the aforesaid goods*” is extremely broad and would be seen by the consumer as closely related to all the applicant’s heating devices which all require solar energy (or at least a form of renewable energy) to operate”.

28. I understand solar powered apparatus for environmental temperature control to use sunlight to heat water or air in buildings. The applicant has conceded that:

“there is a prima facie case for similarity between the solar powered apparatus for temperature control of the application and the particular machines which are solar powered of the registration of the opponent’s second mark, but we note that none of the particular machines listed for the opponent relate directly to temperature control, and we submit once again that the mere fact that two otherwise dissimilar machines happen to be powered by solar cells would not lead consumers to believe that they originate from the same undertaking or related undertakings”.

I note that the opponent’s term *apparatus and instruments for generating, conserving and storing energy, power and electricity* is broad and could reasonably include solar powered heating apparatus as per the applicant’s specification. As such, I consider that the above goods do share some similarity with the opponent’s goods, such as “*apparatus and instruments for generating, conserving and storing energy, power and*

*electricity...*, in Class 9, on the basis that the opponent's goods will be an essential component of the applicant's contested goods. I also consider that producers of *apparatus and instruments for generating, conserving and storing energy, power and electricity* may also be responsible for the production of the contested goods. As such, I find that there is likely to be an overlap in trade channels and user. The opponent has submitted that "the Applicant's goods...can depend on the Opponent's goods...to operate they have the same distribution channels, they are offered and set up by the same fitters and they are typically manufactured by the same producers". I accept this submission and therefore find complementarity for the goods, as I accept that consumers could expect the applicant's goods to come from the same economic undertaking as the opponent. Overall, I find the goods to be similar to a medium degree.

*Nuclear cogeneration plants; Nuclear power plant installations;*

29. Nuclear power plants generate energy to provide electricity. Nuclear fuels are non-renewable energy sources. The opponent submits that the applicant's terms are considered "highly similar to at the very least the Opponent's class 9 goods ("apparatus and instruments for generating, conserving and storing energy, power and electricity" and "parts and fittings for all of the aforesaid goods") and similar to their "Class 40 services ("Generation of energy; production of electrical power from renewable sources") and Class 4 goods ("Electrical energy; Electrical energy from renewable sources"). All the products and services relate to the production of energy and power. The manufacturers and service providers are the same. The goods and services are in competition. The addressed public does not differ". I note that goods and services may be regarded as 'complementary'<sup>8</sup>. I consider that the applicant's above terms are highly similar to the opponent's wider terms *generation of energy* and *production of energy*. I consider that the applicant's terms relate to the production of energy and power and that manufacturers and service providers may overlap. As such trade channels will overlap. I find that nuclear plants are used for the generation of energy and as such there is complementarity. I therefore find these goods and services to be similar to a high degree.

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<sup>8</sup> *Sanco SA v OHIM*, Case T-249/11

*Desalination plants; Sea water desalination plants; Industrial waste water purification plants; Water desalination plants;*

30. The above are types of water desalination and purification plants, the purpose of which, I understand, is to turn salt or brackish water into clean water. The opponent has submitted that there is complementarity between these goods and their renewable energy systems, the likes of which are listed within Class 9 of their specification. The opponent has argued that “desalination is an energy intensive process and powering desalination plants with renewable energy is commonplace”. Whilst submitting that they are similar to those of the opponent’s goods in class 9, the opponent hasn’t specified which goods in particular are similar, and further, I do not consider that the goods are similar to any of the opponent’s services in other classes. In the absence of evidence to the contrary, I see no obvious similarity and find the goods/services dissimilar.

*Garden lights; Garden lighting;*

31. Garden lighting provides outdoor illumination of private gardens and public landscapes. It is generally used for enhancement and the purposes of safety, nighttime aesthetics, accessibility and security. The applicant submits that there is no similarity between the above goods and the opponent’s goods. I agree with this. Garden lights have a number of uses, as I have set out above. The opponent has not set out specifically which terms the above are similar to in their own specification, and as per the decision of Mr Ian Purvis KC in *SmartX O/0911/24*, it is not for the Hearing Officer to identify particular combinations. The opponent submits that the above are similar to their Class 40 services based on complementarity. I do not agree with this contention. I consider that the nature and purpose of the goods and services are different to those in the opponent’s specification, and whilst garden lights will require a form of energy to work, I do not consider that these terms share any similarity with the opponent’s terms, and I do not find them indispensable to one another. Whilst on a high level of generality there may be an overlap in users, this is insufficient to find similarity on the basis of this factor alone. I therefore find the goods to be dissimilar.

*Electric vegetable steamer.*

32. An electric vegetable steamer is a domestic appliance which is used for cooking, steaming, and heating a variety of foods, either in a person's home, or in a restaurant. I do not consider that there is any similarity with these goods and the goods/services of the opponent's specification. The purpose of the goods is different to those in the opponent's specification. Users will not overlap, trade channels will not overlap, and I do not consider that there is any competition between the goods. I do not find complementarity. The Opponent has not given any specific submissions regarding the similarity or otherwise of these goods with any of its goods/services, in absence of which, I find the parties' goods/services to be dissimilar.

#### Class 21

*Terrariums (Indoor -) [plant cultivation]; Indoor terrariums [plant cultivation]; Indoor terrariums for plants.*

33. A terrarium is a glass container containing soil and plants in an environment different from the surroundings. The opponent has submitted that "goods and services in Classes 7, 21, 31 and 44" are intended for use in the field of renewable energy so there is an argument that they are complementary to the goods and services covered by classes 4, 6, 9, 19, 36, 37, 39, 40 and 42 of the Opponent's earlier mark". Without further submissions I see no obvious similarity between these goods and the Opponent's goods/services relied upon other than on a high level of generality. I therefore find the parties' goods to be dissimilar.

#### Class 31

*Natural flowering plants; Natural plants; Natural plants and flowers; Hydroponic plants; Plant bulbs for horticultural use; Bulbs (Plant -) for horticultural use; House plants; Live plants used as aquarium landscapes; Seed germ for botanical purposes; Germ (Seed -) for botanical purposes; Plants; Flowering plants; Bulbs (Plant -) for agricultural use; Nursery plants; Fruit plants.*

34. The applicant submits that these goods "are in the field of gardening and horticulture, which is not covered in any way by the registration of the opponent's marks". I agree that the applicant's goods in this class are horticultural. The opponent

has made no specific submissions regarding these goods, and the onus is on the opponent to identify which goods/services are alleged to be similar to the goods of the application<sup>9</sup>. I see no obvious similarity between these goods and the Opponent's goods/services relied upon. In light of the above, I find the goods to be dissimilar.

### Class 37

*Construction of geothermal power plants; Construction of geothermal power plants; Construction of geothermal energy installations; Construction of geothermal community heating installations; Construction of wave energy power plants; Construction of geothermal power installations;*

35. The applicant's above terms all relate to the construction of geothermal plants and power installations. Geothermal power plants convert geothermal energy, heat from the Earth's interior, into electricity. The opponent submits that these services are identical to their "*construction services*" and "*construction, installation, repair and maintenance of apparatus and instruments for generating, conserving or storing energy, power and electricity*". The opponent submits "broad construction services would include constructing any structure or building. This could include any kind of geothermal power plant or energy/heating installation, or a wave energy power plant. In any case, the Opponent's term "*construction and installation of apparatus and instruments for generating, conserving or storing energy, power and electricity*" would of course include any kind of geothermal power plant or energy/heating installation, or a wave energy power plant". I find that the applicant's above terms are encompassed by the opponent's wider term "*construction services*" and as such these are identical on the principle outlined in *Meric*.

*Renovation of nuclear plant;*

36. The applicant's above term relates to the renovation of nuclear plants which, as explained above, is an industrial facility which generates energy to provide electricity. The opponent's Class 37 terms include *construction, installation, repair and*

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<sup>9</sup> Smartx O/0911/24

*maintenance of apparatus and instruments for generating, conserving or storing energy, power and electricity*, which is a wide-ranging term. I consider that this term could include renovation works and that therefore the opponent's term encompasses the applicant's term in this instance. I therefore find that these services are identical on the principle outlined in *Meric*. If I am wrong about that, I find that the nature and purpose of the terms will be the same, as *construction, installation, repair and maintenance* will encompass *renovation*. I consider that there will be an overlap in both uses and users, and there will also be a level of competition between them. I therefore find them similar to a high degree.

*Cleaning of nuclear plant;*

37. The opponent has submitted that their *construction, installation, repair and maintenance of apparatus and instruments for generating, conserving or storing energy, power and electricity*, "would of course include...cleaning a nuclear plant". Cleaning is the process of removing dirt, dust, and other unwanted substances from a space and is focused on preserving hygiene. I consider maintenance services to be the act of keeping the plant in good working condition, which I agree could involve cleaning. In this instance, whilst I do not find that the services are in competition, I do consider that they are complementary, as cleaning of nuclear plants will assist with any repairs and maintenance and will ensure that the plant is functioning as it should. I consider that users will overlap, as may trade channels. Overall, I find these services to be similar to the opponent's to a medium degree.

*Installation of industrial plant.*

38. Industrial plants are facilities designed for industrial production, assembly, or processing activities. These facilities typically house machinery, equipment, and systems used for a range of activities including energy, such as power plants generating electricity or processing fuels. Within their specification, the opponent has terms such as *construction, installation, repair and maintenance of apparatus and instruments for generating, conserving or storing energy, power and electricity*. I consider that the applicant's term is a wide term which encompasses that of the

opponent's, as set out, and I therefore find that these are identical on the principles outlined in *Meric*.

### Class 39

*Transport; Transport services; Transportation;*

39. The applicant's above terms are broad and relate to transportation generally. The opponent's terms in the same class include *supply, transport, storage and distribution of energy*. I consider that the applicant's above terms will encompass the transportation of energy and as such these are identical on the principles outlined in *Meric*.

*Transport of oil;*

40. Oil is a form of energy. As such, I consider that this will be encompassed by the opponent's term *supply, transport, storage and distribution of energy*. I therefore find that these are identical on the principle outlined in *Meric*.

*Transport and storage;*

41. I note that the opponent's specification includes the terms *storage of energy and fuels* and *supply, transport, storage and distribution of energy*. These terms will fall within the applicant's broader category of *transport and storage* and are therefore identical on the principle outlined in *Meric*.

*Tram transport; Bus transport; Taxi transport; Railway transport; Monorail transport; Freight transportation; Ambulance transport; Barge transport; Waste transport; Tanker transport; Air transport; Rail transport services; Cable-car transport; Ferryboat transport; Helicopter transport; Guarded transport of goods; Bus transport services; Car transport; Ferry transport services; Truck transport; Railway transport services; Ship transport; Boat transport; Streetcar transport; Minibus transport services; Marine transport; Vessel transport; Ferry-boat transport; Freight train transport; Airline transport; Armored-car transport; River transport; Air cargo transport; Railway*

*passenger transport; Freight ship transport; Passenger train transport; Coach transport; Cargo ship transport; Rescue [transport] of vehicles in the air; Cargo transportation; Transport by ferry; Transport by rail; Rescue [transport] of vehicles in the water; Passenger ship transport; Guarded transport; Transport of crantage; Armoured vehicle transport; Armoured car transport; Armoured-car transport; Passenger transport;*

42. The opponent submits that:

“the applicant’s broad transport terms must be considered as identical to at least the opponent’s term “transport of energy” in class 39. The term energy is extremely broad and includes fossil fuels (gasoline, diesel jet fuel), natural gas (compressed or liquid), hydrogen (gas or liquid form), high density batteries, radioactive materials and renewable fuels (biodiesel and ethanol) which are transported by an array of vehicles including planes, cars, trucks and boats. The applicant has not limited their specification away from the field of energy so could be involved in transporting the above cargo”.

I consider the opponent’s term in this instance to be specific, and whilst I accept that the term *energy* is broad, it is clear that the term is limited to the transport of energy, and not transport generally. The applicant’s terms relate to different methods or modes of transport. The opponent has submitted that energy can be transported by an array of vehicles and that, as such, the terms should be found to be *Meric* identical. As no evidence has been filed, I must make my decision based on notional and fair use of the specification. I note that in the matter of *Avnet Inc v Isoact Ltd* [1998] F.S.R. 16, Jacob LJ held at p.19 that:

“specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase”.

In this instance, I do not agree with the opponent’s submission, as I find that the applicant’s services relate to different types of transport vehicles. I consider that the

above modes of transport will have different uses and users and are not in competition. I do not find complementarity and as such I find the services are dissimilar.

*Transportation of freight; Refrigerated transport of food; Transport of food; Transport of parcels; Transport of valuables; Transport of packages; Transport and delivery of goods; Transport of furniture; Transport of money; Air transport of valuables; Transport of goods by rail; Transportation of cargo; Transport of freight by rail; Transport of cargo by air; Transport of goods; Handling [transport] of rubbish; Transport of motor vehicles; Transport of freight by air; Transport and storage of trash; Transport of freight containers by rail; Transport and storage of goods; Transport and storage of waste;*

43. The above terms all relate to the transport (and in some instances, storage) of freight and other specific items. Freight refers items that are transported by air, land or sea. I note that the applicant's terms also include *transport and storage of waste*, which in this instance, I would consider could either mean general rubbish, such as objects that are being discarded, or renewable waste, such as that generated during the production, use, and decommissioning of renewable energy infrastructure. The opponent states that these terms must all be identical to their *transport of energy* because it is broad. However, I have no specific submissions regarding the similarity of these terms. In the instance of *transport and storage of waste*, even if this does include by-products of renewable waste, I do not consider that this is similar to opponent's term *transport of energy* as I find that transporting items for disposable is different to the *transport of energy*. I do not consider that the above items are related to the transportation or storage of energy and as such I consider that the above will have different uses and users to the opponent's *supply, transport, storage and distribution of energy* and are not in competition. I do not find complementarity and as such I find the services are dissimilar.

*Transport of passengers; Transport of travellers; Travellers (Transport of -); Air transport of passengers; Transport of persons; Transport of passengers by rail; Transport of travelers; Transport of pets;*

44. The above terms relate to transportation of passengers and pets and are patently different to the terms contained within the opponent's specification. I have no specific

submissions on the point, and in the absence of which I see no obvious similarity between these services and any of the Opponent's goods/services. As such I find the services are dissimilar.

*Transportation logistics; Freight and transport brokerage; Transport and freight brokerage; Arranging of transport; Hire of rail transport; Arranging of transport and travel; Arrangement of taxi transport; Road transport services for passengers; Arranging for the transport of air freight; Arrangement of transport; Arranging transport for travelers; Arranging transport of passengers by rail; Arranging of air transport; Arrangement of passenger transport; Road transport services; Air transport services; Container transport services; Vehicle transport services; Car transport services; Booking of transport; Chartering of transport; Air transportation services for cargo; Air cargo transport services; Ship transport services; Water transport services; River transport services; Reservation of rail transport; Passenger road transport services; Services for chartering railway transport; Air passenger transport services; Road rescue [transport] services; Rescue [transport] services; Transport reservation; Reservation (Transport -); Marine transport services; Transport brokerage; Brokerage (Transport -); Hire of transport vehicles; Omnibus transport services; Reservation of ferry transport; Hire of road transport; Rental of vehicles for transport; Rental of transport vehicles; Rental of horses for transport; Road transport services for persons; Coach transport services; Reservation of air transport; Travel and transport reservation services; Hiring of transport vehicles; Motor car transport services; Motor vehicle transport services. Passenger transport services; Arranging of passenger transport;*

45. The above terms relate to the provision of transport services including the arranging of transport and hiring of transport vehicles for different uses. I have no specific submissions from the opponent but note that their specification includes *information consultancy services relating to all of the aforesaid services* which I note would include the provision of information consultancy services for the *supply, transport, storage and distribution of energy*. I consider that the applicant's terms have a different use and purpose to that of the opponent, as they are arrangement of transport for various different methods of transportation, as opposed to providing information services relating to the supply, transport, storage and distribution of

energy, which I consider to be specific. I have no specific submissions in respect of this, and therefore, in the absence of such, I see no similarity. I consider that the nature of the services is different, as are the users, and even if there is some overlap I find this to be minimal. Trade channels will also be different, and the services are not in competition. I do not find complementarity and as such I find the services are dissimilar.

#### Class 40

*Production of energy by nuclear power plants; Generation of electricity from geothermal energy.*

46. It is my understanding that nuclear power plants generate energy to provide electricity, and nuclear fuels are non-renewable energy sources. The opponent submits that these are identical to their Class 40 services namely *generation of energy* and *production of electrical power from renewable sources*. The opponent states that their “terms extend to the production and generation of any energy, and this includes nuclear power and geothermal energy”. I consider that the applicant’s above terms are encompassed by the opponent’s wider terms *production of electrical power from renewable sources* and *generation of energy* and therefore are identical under the principles outlined in *Meric*.

#### Class 44

*Nurseries (Plant -); Plant nurseries; Horticulture, gardening and landscaping; Garden tree planting; Planting of flora; Landscape gardening.*

47. The applicant submits that the services in this field are related to gardening and horticultural services. The Opponent did not advance any specific submissions regarding similarity other than submitting in its TM7 that these terms were either identical or similar to its class 4, 39, 40 and 42 goods/services. In my view the applied for services do not overlap in nature with the goods and services in the opponent’s specification. The purpose of the goods is different. Users will not overlap, trade channels will not overlap, and I do not consider that there is any competition between

the goods and services. I do not find complementarity. In light of the above, and in absence of any submissions to the contrary, I do not find that the Applicant's services are similar to any of the Opponent's goods/services. I find them to be dissimilar.

48. As some degree of similarity between goods and services is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition aimed against those goods and services that I have found to be dissimilar will fail<sup>10</sup>. Therefore, the opposition under section 5(2)(b) fails for the following goods and services:

- Class 9        Solar powered telephones; Solar powered radios;
  
- Class 11      Desalination plants; Sea water desalination plants; Industrial waste water purification plants; Water desalination plants; Electric vegetable steamer; Garden lights; Garden lighting;
  
- Class 21      Terrariums (Indoor -) [plant cultivation]; Indoor terrariums [plant cultivation]; Indoor terrariums for plants.
  
- Class 31      Natural flowering plants; Natural plants; Natural plants and flowers; Hydroponic plants; Plant bulbs for horticultural use; Bulbs (Plant -) for horticultural use; House plants; Live plants used as aquarium landscapes; Seed germ for botanical purposes; Germ (Seed -) for botanical purposes; Plants; Flowering plants; Bulbs (Plant -) for agricultural use; Nursery plants; Fruit plants.
  
- Class 39      Tram transport; Bus transport; Taxi transport; Railway transport; Monorail transport; Freight transportation; Ambulance transport; Barge transport; Waste transport; Tanker transport; Air transport; Rail transport services; Cable-car transport; Ferryboat transport; Helicopter transport; Guarded transport of goods; Bus transport services; Car transport; Ferry transport services; Truck transport; Railway transport services; Ship

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<sup>10</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

transport; Boat transport; Streetcar transport; Minibus transport services; Marine transport; Vessel transport; Ferry-boat transport; Freight train transport; Airline transport; Armored-car transport; River transport; Air cargo transport; Railway passenger transport; Freight ship transport; Passenger train transport; Coach transport; Cargo ship transport; Rescue [transport] of vehicles in the air; Cargo transportation; Transport by ferry; Transport by rail; Rescue [transport] of vehicles in the water; Passenger ship transport; Guarded transport; Transport of cramage; Armoured vehicle transport; Armoured car transport; Armoured-car transport; Passenger transport; Transportation of freight; Refrigerated transport of food; Transport of food; Transport of parcels; Transport of valuables; Transport of packages; Transport and delivery of goods; Transport of furniture; Transport of money; Air transport of valuables; Transport of goods by rail; Transportation of cargo; Transport of freight by rail; Transport of cargo by air; Transport of goods; Handling [transport] of rubbish; Transport of motor vehicles; Transport of freight by air; Transport and storage of trash; Transport of freight containers by rail; Transport and storage of goods; Transport and storage of waste; Transport of passengers; Transport of travellers; Travellers (Transport of -); Air transport of passengers; Transport of persons; Transport of passengers by rail; Transport of travelers; Transport of pets; Transportation logistics; Freight and transport brokerage; Transport and freight brokerage; Arranging of transport; Hire of rail transport; Arranging of transport and travel; Arrangement of taxi transport; Road transport services for passengers; Arranging for the transport of air freight; Arrangement of transport; Arranging transport for travelers; Arranging transport of passengers by rail; Arranging of air transport; Arrangement of passenger transport; Road transport services; Air transport services; Container transport services; Vehicle transport services; Car transport services; Booking of transport; Chartering of transport; Air transportation services for cargo; Air cargo transport services; Ship transport services; Water transport services; River transport services; Reservation of rail transport; Passenger road transport services; Services for chartering railway transport; Air passenger transport services; Road rescue

[transport] services; Rescue [transport] services; Transport reservation; Reservation (Transport -); Marine transport services; Transport brokerage; Brokerage (Transport -); Hire of transport vehicles; Omnibus transport services; Reservation of ferry transport; Hire of road transport; Rental of vehicles for transport; Rental of transport vehicles; Rental of horses for transport; Road transport services for persons; Coach transport services; Reservation of air transport; Travel and transport reservation services; Hiring of transport vehicles; Motor car transport services; Motor vehicle transport services. Passenger transport services; Arranging of passenger transport;

Class 44 Nurseries (Plant -); Plant nurseries; Horticulture, gardening and landscaping; Garden tree planting; Planting of flora; Landscape gardening.

### **Average consumer and the purchasing act**

49. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods/services. I must then determine the manner in which the goods/services are likely to be selected by the average consumer. 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:

“60. 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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

50. The applicant has not advanced any submissions in respect of this. The opponent has made the following submissions:

“The average consumer’s level of attention is likely to vary according to the category of the goods or services in question (Lloyd Schuhfabrik Meyer). The goods and services in question target the public at large and professionals with specific professional knowledge or expertise, such as those in the field of renewable energy. The average consumer’s degree of attentiveness may vary depending on the price, sophistication, or terms and conditions of the goods and services purchased”.

51. I agree with the opponent’s above submissions. I consider that the average consumer for the goods and services will either be a member of the general public or professionals, including more specialised commercial customers. In my view, a greater proportion of consumers will be business consumers with a specialist knowledge of the goods and services, such as the building trade and installers of solar systems for the generation of energy. Furthermore, businesses and more specialised commercial consumers may take part in a tendering process to select the goods and services or attend trade shows to view and discuss in-person the services available, to ensure their specific requirements or business needs are met. The goods and services will also be sold through a range of channels, including from physical premises as well as via the internet, and may be sourced through specialist providers or from more general builder’s merchants. Therefore, for business consumers, purchase of the goods and services at issue will be an equally visual and aural process. Due to the nature of the goods and services at issue, the price and frequency of purchase is likely to vary. Considerations such as costs, efficiency and contract terms will be a factor in business consumers decision making. A business or specialised commercial customer is likely to pay a medium to high degree of attention as a result.

52. For the general public, the goods and services will also be sold through a range of channels, including from physical premises as well as via the internet. The costs of the purchase will vary, but they are likely to be at the lower end of the scale, and various factors will be taken into account such as the item’s capacity and capabilities, as well as delivery methods. The consumer will want to ensure that the goods and services are appropriate to their own needs, taking into account reviews, quality and suitability. I consider that, in this instance, the selection process would be predominantly visual, although aural considerations will play a part, for example, if advice is obtained from

sales assistants. Cost considerations will play a part; however, I expect these to be at the lower end of the scale, i.e. for items such as garden apparatus. When selecting the goods and services prior to purchase, the consumer will want to ensure that they are appropriate to their own specific needs, taking into account reviews, quality, ease of use, suitability of the product and the reputation of the provider. I would expect members of the general public to pay a medium degree of attention to the purchasing process.

### **Comparison of marks**

53. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

54. 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 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.

55. The respective trade marks are shown below:

Earlier trade marks	Contested trade mark
<p style="text-align: center;">SolarBotanic (the first earlier mark)</p> <p style="text-align: center;">SOLARBOTANIC</p> <p style="text-align: center;">SolarBotanic (the second earlier mark)</p>	<p style="text-align: center;">botanic solar</p>

**Overall impression**

56. For the purposes of the comparison, I will proceed to assess the opponent’s mark in the singular as SOLARBOTANIC on the basis that their three marks all comprise of the same words in differing letter casing. There is no difference in the comparison assessment between the variation in the casing, because a word trade mark registration protects the word itself, irrespective of the font, capitalisation or otherwise<sup>11</sup>. Therefore, a trade mark in capital letters covers notional use in lower case and vice versa. If it becomes necessary to differentiate between them, I shall return to this position later in my decision.

57. Both parties’ marks are word only marks. The opponent’s mark consists of the word SOLARBOTANIC and is presented in upper case lettering. The mark is presented as one word, without a space between SOLAR and BOTANIC. However, despite being presented as one word, the eye will be drawn naturally to the elements it recognises and therefore it will be perceived by the average consumer as being devised of two words. The applicant’s mark consists of the words ‘botanic solar’ in lower case. In my view, neither word can be said to be truly dominant in either mark,

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<sup>11</sup> *Migros-Genossenschafts-Bund v EUIPO*, Case T-189/16

and as such I find that the overall impression of both marks resides in the combination of these words.

### **Visual impression**

58. Visually, the competing marks both share the use of the words SOLAR and BOTANIC albeit in an inverted sequence. The applicant submits “there is, arguably, a degree of visual similarity between the Applicant’s Mark and the Opponent’s Mark, because they are all formed from the same pair of words. The degree of visual similarity is low”. The opponent submits that “the Earlier Registrations consist of an invented combination of the words “SOLAR” and “BOTANIC” so the overall visual impression of the Application must be held as visually similar to a high degree”. In the opponent’s mark the words are conjoined whereas in the applicant’s they are presented as one word. Since trade marks registered as word marks may be used in any standard font or case, these differences will have no bearing on the similarity assessment. There is no space between the words in the opponent’s mark, which constitutes a point of difference between the marks. Further the first word in each differs. Whilst ordinarily the beginning of a mark has greater impact, this is not true on every occasion. Despite the words being inverted and therefore each mark begins with a different word, I consider that because the marks consist of the same two words overall, the marks are visually similar to a high degree.

### **Aural comparison**

59. Aurally the opponent’s mark will be pronounced as soh-luh-bot-an-ik, whereas the applicant’s mark will be pronounced as bot-an-ik-soh-luh. Within their counterstatement, the applicant submits “there is arguably a degree of aural similarity between the applicant’s mark and the opponent’s mark because they are all formed from the same pair of words. Both words are common enough that members of the relevant public can reasonably be expected to know their accepted pronunciations”. However, the applicant goes on to submit that any aural similarity between the marks is low because the words are reversed and there is a lack of space between the opponent’s mark. Whilst the opponent’s mark is presented without a space, I consider that this will make minimal difference to the way that the words are articulated. Taking account of the transposition of the common elements and the differences between the

respective marks, I nevertheless consider that overall, the marks share a high degree of aural similarity.

### **Conceptual comparison**

60. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer, as highlighted in numerous judgments of the GC and the CJEU<sup>12</sup>.

61. The applicant submits:

“13. There is, arguably, a degree of conceptual similarity between the applicant’s mark and the opponent’s marks because they are all formed from the same pair of commonly understood words. The degree of conceptual similarity is low, however, for the reasons given in the following paragraphs.

14. Botanic can be an adjective (‘pertaining to botany’) or a noun (‘a substance of botanical origin’). When it is placed first in a pair of words, it would ordinarily be taken as an adjective and when placed after a string of adjectives it would ordinarily be taken as a noun.

15. ‘Solar’ on its own is ordinarily an adjective (‘of the sun’). In ordinary use it is only a noun when combined with another word, for example, ‘solar panel’ is a noun.

16. We submit, therefore, that the applicant’s mark, botanic solar, will be understood by the relevant public to relate to solar things, which have botanic qualities. That is, the word ‘solar’, being second in the arrangement, will be understood to be intended, unusually, as a noun, qualified by the adjective ‘botanic’.

17. On the other hand, we submit that the opponent’s marks, ‘solarbotanic’, will be understood by the relevant public to relate to botanics having solar qualities. The word, ‘botanic’, being second in the arrangement, will be understood to be intended as a noun, qualified by the adjective ‘solar’.”

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<sup>12</sup> *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29

62. The opponent submits as follows:

“20. The applicant argues that the application would be understood as relating to “solar things which have botanic qualities” and the earlier registration as relating to “botanics which have solar qualities”. Firstly, the opponent reiterates that the applicant has artificially dissected the marks which is incorrect in the context of the similarity assessment. Secondly, the words “SOLAR” and “BOTANIC” are not commonly used nouns so it is strongly disputed that the above meanings would ever be reached by the consumer. The respective marks consist of the same unusual combination of the adjectives “SOLAR” and “BOTANIC” and at most the consumer would think that the respective marks were both related in some way to the sun and plants/botany. The two words mean nothing in combination, and it would take the consumer a long time to dissect the marks to derive any concrete meaning. Considering all the above, the respective marks must be considered conceptually similar to a high degree”.

63. Having considered the parties submissions, I am of the opinion that the average consumer is likely to understand BOTANIC as being related to plants and SOLAR as being related to the sun or using the sun to produce power. I do not consider that the average consumer would proceed to dissect the meanings any further, as contended by the applicant, as I consider this to be artificial. I agree with the opponent’s submissions that the average consumer would interpret the respective marks as related to the sun and plants. When the words are placed together, either by way of SOLAR BOTANIC or BOTANIC SOLAR, the meaning is not easily understood. I do not consider that this is impacted when the words are inverted, and therefore I do not find one mark has more meaning / is more easily understood than the other. I consider that overall, the marks share a high degree of conceptual similarity.

#### **Distinctive character of the earlier trade mark**

64. 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).”

65. 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, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The opponent has submitted as follows:

“...the earlier registrations contain an unusual combination of the two words “SOLAR” and “BOTANIC” which are clearly distinctive for the goods and services covered by the same. The word “BOTANIC” means nothing in this particular context and is unique to the opponent”

As no evidence has been filed in support of this, I only have the inherent position to consider.

66. The earlier mark comprises of two English dictionary words, SOLAR and BOTANIC. The distinctiveness lies in the combination of these two words. For the reasons that I have set out above, I consider that the average consumer would interpret the opponent’s mark as related to the sun and plants. The word SOLAR in

isolation does allude to some of the goods and services at issue, however, in combination the meaning of the mark is not easily understood. I consider that when taken as a whole, the earlier mark is inherently distinctive to a medium degree.

### **Conclusions on Likelihood of Confusion**

67. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods/services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods/services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

I remind myself that I made the following findings:

- The goods/services at issue range from being identical upon the principles outlined in *Meric* to similar to a medium degree. I have also found some goods and services to be dissimilar, however, as I set out above, these will not factor into the following assessment;
- I have identified that the average consumer will be members of the general public and businesses. Business consumers will select the goods and services by both aural and visual means, whereas the general public will select the goods and services through primarily visual means, although I do not discount an aural component;

- I have concluded that a medium degree of attention will be paid by members of the general public, and between a medium and high degree of attention will be paid by professionals;
- The contested mark is visually similar to the earlier mark to a high degree;
- The contested mark is aurally similar to the earlier mark to a high degree;
- I have found the contested mark and the earlier mark to be conceptually similar to a high degree;
- I have found the earlier mark to be inherently distinctive to a medium degree;

68. Upon considering the above factors, and bearing in mind the principle of imperfect recollection, I consider this case represents an example of direct confusion. Given that the purchasing/selection process is predominantly a visual one, I consider that the consumer, upon seeing the later mark 'botanic solar', is unlikely to recall that the words are inverted in the opponent's mark and appear as SOLARBOTANIC. Even where the goods/services are requested aurally I still find this to be the case as the consumer will not recall which way around the words are presented. The lack of spacing between the words in the opponent's mark will be overlooked, and the words will be read as their normal dictionary words. Given the high levels of similarity between the marks visually, aurally, and conceptually, I consider that the consumer will misremember that the words appear in a different order in each mark and will instead rely upon the imperfect picture of them retained in its mind, even when between a medium and a high degree of attention is paid. When considering the contested mark in relation to the goods and services that I find identical or similar to a varying degree, I am satisfied that there is sufficient similarity for the marks to be mistaken for one another, even for those goods that I found to be similar only to a low degree due to the interdependency principle and the high similarity between the marks visually, aurally and conceptually, I consider that a likelihood of confusion would still apply. As a result, taking all the above into account in the global assessment, I consider that there exists a likelihood of direct confusion.

## Final Remarks

69. The opposition is partially successful. Therefore, subject to appeal, the application will be refused in relation to the following goods/services:

- Class 7      Electric garden pumps; Electric apparatus for the care of gardens; Electric garden scythes; Electric garden shredders.
- Class 9      Crystalline silicon solar power cells; Solar wafers; Crystalline silicon solar cells; Wafers for solar cells; Electronic sensors for measuring solar radiation; Electronical sensors for measuring solar radiation
- Class 11     Solar thermal collectors [heating]; Solar energy collectors for heating; Solar collectors for heating; Solar heat collection panels; Solar heating panels; Solar panels for use in heating; Solar heating installations; Thermal storage instruments [solar energy] for heating; Solar energy powered heating apparatus; Thermal storage apparatus [solar energy] for heating; Solar heating apparatus; Solar water heaters; Solar powered ventilation apparatus; Solar furnaces; Nuclear cogeneration plants; Nuclear power plant installations;
- Class 37     Construction of geothermal power plants; Construction of geothermal power plants; Construction of geothermal energy installations; Construction of geothermal community heating installations; Construction of wave energy power plants; Construction of geothermal power installations; Renovation of nuclear plant; Cleaning of nuclear plant; Installation of industrial plant.
- Class 39     Transport; Transport services; Transportation; Transport of oil; Transport and storage;
- Class 40     Production of energy by nuclear power plants; Generation of electricity from geothermal energy.

In light of my earlier findings the application will proceed to registration in relation to the following goods and services:

- Class 9        Solar powered telephones; Solar powered radios;
- Class 11       Desalination plants; Sea water desalination plants; Industrial waste water purification plants; Water desalination plants; Electric vegetable steamer; Garden lights; Garden lighting;
- Class 21       Terrariums (Indoor -) [plant cultivation]; Indoor terrariums [plant cultivation]; Indoor terrariums for plants.
- Class 31       Natural flowering plants; Natural plants; Natural plants and flowers; Hydroponic plants; Plant bulbs for horticultural use; Bulbs (Plant -) for horticultural use; House plants; Live plants used as aquarium landscapes; Seed germ for botanical purposes; Germ (Seed -) for botanical purposes; Plants; Flowering plants; Bulbs (Plant -) for agricultural use; Nursery plants; Fruit plants.
- Class 39       Tram transport; Bus transport; Taxi transport; Railway transport; Monorail transport; Freight transportation; Ambulance transport; Barge transport; Waste transport; Tanker transport; Air transport; Rail transport services; Cable-car transport; Ferryboat transport; Helicopter transport; Guarded transport of goods; Bus transport services; Car transport; Ferry transport services; Truck transport; Railway transport services; Ship transport; Boat transport; Streetcar transport; Minibus transport services; Marine transport; Vessel transport; Ferry-boat transport; Freight train transport; Airline transport; Armored-car transport; River transport; Air cargo transport; Railway passenger transport; Freight ship transport; Passenger train transport; Coach transport; Cargo ship transport; Rescue [transport] of vehicles in the air; Cargo transportation; Transport by ferry; Transport by rail; Rescue [transport] of vehicles in the water; Passenger ship transport; Guarded transport; Transport of crantage; Armoured vehicle transport; Armoured car transport; Armoured-car

transport; Passenger transport; Transportation of freight; Refrigerated transport of food; Transport of food; Transport of parcels; Transport of valuables; Transport of packages; Transport and delivery of goods; Transport of furniture; Transport of money; Air transport of valuables; Transport of goods by rail; Transportation of cargo; Transport of freight by rail; Transport of cargo by air; Transport of goods; Handling [transport] of rubbish; Transport of motor vehicles; Transport of freight by air; Transport and storage of trash; Transport of freight containers by rail; Transport and storage of goods; Transport and storage of waste; Transport of passengers; Transport of travellers; Travellers (Transport of -); Air transport of passengers; Transport of persons; Transport of passengers by rail; Transport of travelers; Transport of pets; Transportation logistics; Freight and transport brokerage; Transport and freight brokerage; Arranging of transport; Hire of rail transport; Arranging of transport and travel; Arrangement of taxi transport; Road transport services for passengers; Arranging for the transport of air freight; Arrangement of transport; Arranging transport for travelers; Arranging transport of passengers by rail; Arranging of air transport; Arrangement of passenger transport; Road transport services; Air transport services; Container transport services; Vehicle transport services; Car transport services; Booking of transport; Chartering of transport; Air transportation services for cargo; Air cargo transport services; Ship transport services; Water transport services; River transport services; Reservation of rail transport; Passenger road transport services; Services for chartering railway transport; Air passenger transport services; Road rescue [transport] services; Rescue [transport] services; Transport reservation; Reservation (Transport -); Marine transport services; Transport brokerage; Brokerage (Transport -); Hire of transport vehicles; Omnibus transport services; Reservation of ferry transport; Hire of road transport; Rental of vehicles for transport; Rental of transport vehicles; Rental of horses for transport; Road transport services for persons; Coach transport services; Reservation of air transport; Travel and transport reservation services; Hiring of transport vehicles; Motor car transport

services; Motor vehicle transport services. Passenger transport services; Arranging of passenger transport;

Class 44 Nurseries (Plant -); Plant nurseries; Horticulture, gardening and landscaping; Garden tree planting; Planting of flora; Landscape gardening.

### **Costs**

70. The parties have both achieved a measure of success and I find it appropriate that each party bears its own costs.

**Dated this 11<sup>th</sup> day of July 2025**

**L Bailey**

**For the Registrar**