O/1036/25

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF INTERNATION REGISTRATION NUMBER WO0000001712601
BY NEXT.E.GO MOBILE SE
TO REGISTER THE FOLLOWING TRADE MARK:

e.wave

IN CLASSES 9, 12, 35, 37, 39, 40, AND 42

AND

IN THE MATTER OF INTERNATION REGISTRATION NUMBER WO0000001712152
BY NEXT.E.GO MOBILE SE
TO REGISTER THE TRADE MARK:

e.wave X

IN CLASSES 9, 12, 35, 37, 39, 40, AND 42

AND

IN THE MATTER OF INTERNATION REGISTRATION NUMBER WO0000001712607

BY NEXT.E.GO MOBILE SE

TO REGISTER THE TRADE MARK:

wave X

IN CLASSES 9, 12, 35, 37, 39, 40, AND 42

AND

IN THE MATTER OF INTERNATION REGISTRATION NUMBER WO0000001715897

BY NEXT.E.GO MOBILE SE

TO REGISTER THE TRADE MARK:

wave

IN CLASSES 9, 12, 35, 37, 39, 40, AND 42

AND

IN THE MATTER OF INTERNATION REGISTRATION NUMBER

WO0000001713255

BY NEXT.E.GO MOBILE SE

TO REGISTER THE TRADE MARK:

e.wave S

IN CLASSES 9, 12, 35, 37, 39, 40, AND 42

AND

IN THE MATTER OF INTERNATION REGISTRATION NUMBER

WO0000001713256

BY NEXT.E.GO MOBILE SE

TO REGISTER THE TRADE MARK:

wave S

IN CLASSES 9, 12, 35, 37, 39, 40, AND 42

AND

IN THE MATTER OF INTERNATION REGISTRATION NUMBER

WO0000001719201

BY NEXT.E.GO MOBILE SE

TO REGISTER THE TRADE MARK:

wave

IN CLASSES 9, 12, 35, 37, 39, 40, AND 42

AND

IN THE MATTER OF INTERNATION REGISTRATION NUMBER WO0000001721370
BY NEXT.E.GO MOBILE SE
TO REGISTER THE TRADE MARK:

e wave S

IN CLASSES 9, 12, 35, 37, 39, 40, AND 42

AND

IN THE MATTER OF INTERNATION REGISTRATION NUMBER WO0000001721365
BY NEXT.E.GO MOBILE SE
TO REGISTER THE TRADE MARK:

wave S

IN CLASSES 9, 12, 35, 37, 39, 40, AND 42

AND

IN THE MATTER OF INTERNATION REGISTRATION NUMBER

WO0000001720018

BY NEXT.E.GO MOBILE SE

TO REGISTER THE TRADE MARK:

IN CLASSES 9, 12, 35, 37, 39, 40, AND 42

AND

IN THE MATTER OF INTERNATION REGISTRATION NUMBER

WO0000001732557

BY NEXT.E.GO MOBILE SE

TO REGISTER THE TRADE MARK:

IN CLASSES 9, 12, 35, 37, 39, 40, AND 42

AND

AN OPPOSITION THERETO UNDER NUMBERS

OP442453, OP442629, OP442630, OP442788, OP442904, OP442905, OP442906, OP443181, OP443184, OP443311 AND OP443463

BY CROWN EQUIPMENT CORPORATION

Background and pleadings

1. Next.e.GO Mobile SE ("*the holder*") is the proprietor of the international registrations ("the IR's") shown on the cover page of this decision ("*the contested marks*"). The following IR's were registered on the 26 October 2022 with a priority date of 26 April 2022, No. WO0000001712601 ("the 601 mark"), No. WO0000001712152 ("the 152 mark"), No. WO0000001712607 ("the 607 mark"), No. WO0000001715897 ("the 897 mark"), No. WO0000001713255 ("the 255 mark"), No. WO0000001713256 ("the 256 mark"), No. WO0000001719201 ("the 201 mark"), No. WO0000001732557 ("the 557 mark"). The following IR's were registered on the 27 October 2022 with a priority date of 29 April 2022, No. WO0000001721370 ("the 370 mark"), No. WO0000001721365 ("the 365 mark"), No. WO0000001720018 ("the 018 mark"). With effect from the respective dates of registration, the holder designated the UK as a territory in which it seeks to protect the IR's under the terms of the Protocol of the Madrid Agreement. Following which the IR's were published for opposition purposes.[1]

2. The holder seeks protection of the same goods and services for each of the IR's, these being in classes 9, 12, 35, 37, 39, 40 and 42.[2]

3. Crown Equipment Corporation ("*the opponent*") fully opposes the protection of the IR's in the UK on the basis of section 5(2)(b) of the Trade Marks Act 1994 ("the Act"), except for the 201 mark which is contested on the basis of sections 5(1) and 5(2)(a).

4. The opponent relies upon the following earlier right, detailed below:

[1] The following marks having the following publication date: the 601 mark - 12 May 2023, the 152 and 607 marks -19 May 2023, the 897 mark - 2 June 2023, the 201, 255 and 256 marks - 9 June 2023, the 365 & 370 marks - 23 June 2023, the 018 mark - 30 June 2023, and finally the 557 mark – 7 July 2023.
[2] See the goods and services comparison

UK00800862723,[3] filed on 19 August 2005, registered on 18 December 2006.

WAVE

5. For the purpose of these proceedings, the opponent is reliant upon all of the goods for which the earlier mark is registered, namely:

    Class 12: Land vehicles, namely, self-propelled vehicles for use in materials handling and maintenance.

6. In relation to IR's contested under section 5(2)(b), the opponent claims that the applications are virtually identical to the earlier mark and that the holder's goods and services are identical and highly similar to the opponent's class 12 goods. And as a result, there exists a likelihood of confusion on the part of the public, which includes a likelihood of association. As for the 201 mark which is opposed under sections 5(1) and 5(2)(a), it is claimed that the marks are identical, as are the class 12 goods contrary to section 5(1) and that the marks are identical and the goods and services are highly similar with respect of the remaining classes.

7. The holder filed 11 separate Form TM8's and counterstatements denying the grounds for the opposition and putting the opponent's mark to proof of use.

8. The 11 oppositions were consolidated under the lead case, opposition number 442453, on 27 June 2024.[4]

[3] Under Article 56 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all right holders with an existing IR(EU). As a result of the opponent's IR(EU) being protected as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark now recorded on the UK trade mark register has the same legal status as if it had been applied for and registered under UK law, and retains its original international registration date as its filing date.
[4] This was directed under Rule 62(g) of the Trade Marks Rules 2008.

9. The holder is represented by Bird & Bird LLP and the opponent is represented by Keltie LLP. During the evidence rounds, only the opponent filed evidence. Neither party requested a hearing, and only the opponent filed written submissions in lieu.

Relevance of EU law

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

Evidence and submissions

11. The opponent filed evidence in the form of a witness statement of Rodney J Hinders, signed and dated 15 August 2024. Rodney J Hinders is an Associate General Counsel of Crown Equipment Corporation. The witness statement is accompanied by 8 exhibits, RJH1 to RJH8. The purpose of this evidence was to demonstrate use of the mark and the extent and scale of said use.

12. The opponent also filed written submissions dated 19 December 2024. I have read and considered all the evidence and submissions filed and taken them into account in coming to this decision. While I have not summarised these documents, I shall refer to them below to the extent I consider necessary.

DECISION

Legislation

Section 5(1)

13. Section 5(1) of the Act states:

"A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected."

14. Sections 5(2) and 5A of the Act read as follows:

"5(2) A trade mark shall not be registered if because-

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the 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".

(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".

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

15. By virtue of its earlier filing date of 19 August 2005, the registration set out in paragraph 4 above, constitutes an earlier mark within the meaning of section 6(1) of the Act. As the earlier mark completed its registration procedure more than five years before the filing date of the opposed contested marks, it is, in principle, subject to the use provisions set out in section 6A of the Act.

Proof of use legislation and case law.

16. The proof of use provisions are set out in section 6A of the Act, the relevant parts of which state:

"(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services."

17. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It is as follows:

"(1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the 'five-year period') has expired before IP completion day-

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day-

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A to the United Kingdom include the European Union."

18. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 W.F. *Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a subcategory of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: Ansul at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial raison d'être of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods

and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].

107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and *Ferrari* at [73]-[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City*

Council [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

> '19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know.
>
> […]
>
> 22. … it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal … comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said the public.'"

19. For use to be genuine, it must have been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the relevant territory during the relevant five-year period. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real" because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark" is, therefore, not genuine use.

20. Consequently, the onus is upon the opponent to prove genuine use of the registered trade in the relevant period. The relevant period in which genuine use must be established is the five-year period ending on the filing date or priority date of the contested marks. The 11 contested marks share one of two priority dates, being either 26 April 2022 or 29 April 2022. Therefore, there are two relevant periods to consider for the purposes of proof of use of the earlier mark. i.e. 27 April 2017 to 26 April 2022 and 30 April 2017 to 29 April 2022.

21. By virtue of paragraph 7 of Part 1, Schedule 2A of the Act, use within the EU is relevant prior to IP Completion Day (i.e., 1 January 2021). With regard to assessing use within the EU, I also bear in mind that in *Leno Merken BV* v *Hagelkruis Beheer BV*, Case C-149/11, the Court of Justice of the European Union ("CJEU") held that while use of a Community trade mark in one Member State could suffice to establish genuine use in the Community, "all facts and circumstances" should be considered: see paragraph 55. These include the characteristics of the market concerned, the nature of the goods or services protected by the mark and the territorial extent and the scale of the use, as well as its frequency and regularity: see also *The London Taxi Corporation Limited* v *Frazer-Nash Research Limited & Anor* [2016] EWHC 52, paragraphs 228-230, and *TVR Automotive Ltd v OHIM*, Case T-398/13.

22. I further observe that since *Leno* the General Court ("GC") has held that genuine use may apply to a contested mark in circumstances where genuine use has been made in relation to services in the London and Thames Valley area,[5] and where genuine use concerned national use of a EUTM in only one member state.[6] Consequently, I accept that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM.

[5] Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* upheld at [47]
[6] Case T-398/13, *TVR Automotive Ltd v OHIM*

Evidence of use

History and background of the Wave brand

23. As referenced above, Rodney J Hinders is an Associate General Counsel of the opponent. He states that Crown formed in 1945, however entered the material handling equipment industry in 1959,[7] earning itself a reputation as a leading innovator in world-class forklift and material handling equipment.[8] However, Crown has used the brand WAVE since 1997 in relation to its work assist vehicle, with its first sales in the UK being in 1998.[9] Within the evidence are screenshots taken from the Crown website of a machine that is described as "The Wave, Crown's Work Assist Vehicle" that is available for purchase along with product information.[10] Whilst it is difficult from this evidence to see the WAVE mark on the product on some of the pages, there is a further enlarged image of the Work Assist Vehicle with the WAVE mark at Exhibit RJH3. I have replicated the WAVE mark presented on the Work Assist Vehicle below:

Brochures

24. Current and historical brochures dating back to 2004 are also provided.[11] These brochures include information about the WAVE product, and the word WAVE which

[7] Witness statement of Rodney J Hinders, paragraph 7
[8] Ibid, paragraph 8
[9] Ibid, paragraph 12
[10] Exhibit RJH2
[11] Exhibits RJH4 and RJH5

is referred to throughout the brochures to describe the goods. However, I acknowledge that on the cover page of the brochure, whilst it contains a picture of the goods with the word WAVE written on them, this appears beside the words and letters “WAV 60 series” rather than the word WAVE, as can be seen below:

Sales and advertising

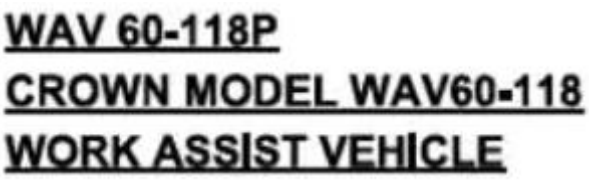
25. Mr Hinders provides UK sales figures for 2021 to 2023 from Crown Lift Truck Limited which he confirms is a wholly owned subsidiary of Crown. These are replicated below:

Year	Products Sold	Revenue - GBP
2021	268	£2,245,488
2022	187	£1,855,686
2023	266	£3,127,586

It is unclear from these figures whether this is revenue and product numbers generated solely from products sold under the WAVE brand or whether this includes other products under the Crown brand. Further, I observe that the relevant

periods span April 2017 to April 2022, and, as such, the above figures only cover the latter portion of this period, 16 months in total.

26. That said, invoices have also been provided in support of the opponent's claim to have used its mark.[12] Having examined these invoices, although not all of these are provided within the relevant dates, some are. Moreover, the WAVE mark is not present anywhere within the invoices. Instead, the invoices contain the CROWN mark in the top corner and refer to the products sold as:



27. Nevertheless, I observe from the brochures that the line model for the WAVE goods is described as WAV 60 SERIES. Therefore, I am willing to accept that these invoices relate to goods sold under the mark. The invoices show that a number of goods have been repeatedly purchased by business users, including national businesses within the UK. Further, whilst I do not have specific evidence regarding market share, these figures are not insignificant; of the seven invoices that are dated within the relevant period, the lowest value amounts to £43,166.00 with the highest being for £548,051.00. Although I have no invoices for 2017, I can see from the invoices the following sales figures for the goods relied upon for the remaining years within the relevant period:

2018 = £50,800.00
2019 = £324,945.20
2020 = £76,961.00
2021 = £826,721.00
(to April) 2022 = £173,065.50

28. As for advertising Mr Hinders confirms in his witness statement that "Crown does not have dedicated allocations for UK advertising, but rather operates from a global

[12] Exhibit RJH7

advertising platform, mainly through the various Crown websites which Crown creates and maintains. In particular, Crown creates and owns all the content it posts on the various Crown websites, most of which is created by Crown employees in their course of employment."[13] Therefore I have no understanding of how much is spent advertising the WAVE branded product. Neither do I have any understanding of how far reaching the brand is in the UK due to any advertising. However, the website analytics for the UK has been provided and is replicated below:

EN-UK Unique Site Users			
Year	Homepage	Wave product page	All visits to Crown's UK web pages
2019	17706	5100	136,194
2020	15866	4057	112,012
2021	7932	2273	70,383
2022	5952	1974	69,380
2023	13695	1808	65,090
2024 YTD (Jan-May)	3556	745	25,438

Whilst I note the number of visits to all UK Crown websites reaches hundreds of thousands, the numbers visiting the WAVE branded products are far lower.

Awards and third party evidence

29. Finally in support of its claim are numerous awards or award nominations that Mr Hinders asserts are for Crown's WAVE product. These are mostly dated prior to the relevant period, however, there are two that are dated within the relevant period. First, an award nomination, referring to Crown's "WAV 60 - "Wave" Work Assist Vehicle" as can be seen:

[13] Witness statement of Rodney J Hinders, paragraphs 19 and 20.

14

This shows industry recognition of Crown's Wave Assist Vehicle under the WAVE mark. The narrative evidence confirms that it is a European award,[15] and therefore, it can be taken into account given it was awarded prior to IP completion date. Whilst I have no information in relation to WAVE products for sale in the EU, the presence of this award shows that the goods under the mark have established acclaim within the EU market, which could only have realistically happened through sales and consumer use.

30. The other, a design award, refers to the product description under the Crown brand, i.e. "Crown WAV60 Series Work Assist Vehicle", seen below:

[14] Exhibit RJH8, page 5
[15] Witness statement of Rodney J Hinders, paragraph 22.

[16]

As such, I accept that this award will not necessarily be considered as referring to the WAVE brand but the Crown brand, unlike the award nomination above.

31. Found within the evidence are what Mr Hinders describes within his witness statement as 'customer results'.[17] These are essentially testimonies from companies that have purchased the product, describing what they use the product for and how it has provided a solution to a problem. However, I note from the content and addresses of these testimonials that two out of three are provided by consumers that are based in America. However, the remaining one appears to be from a customer based in Spain and appears from the content to be referring to purchases of the goods within the relevant period referring to both the WAV 50 and WAV 60 series.

[16] Exhibit RJH8, page 6
[17] Witness statement of Rodney J Hinders, paragraph 16 and exhibit RJH6.

Form of the mark

32. For the sake of completeness, before I move on to assess if the opponent has shown genuine use, I must first consider if I find the use of the mark as shown in the evidence to be use of the mark as registered. As outlined in *Lactalis McLelland Limited v Arla Foods AMBA*, Case BL O/265/22,[18] the use of the mark in a different form may also constitute use of the mark as registered. Phillip Johnson, sitting as the Appointed Person, considered the correct approach. He said:

> "13. […] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).
>
> 14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.
>
> 15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hyphen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.
>
> 16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or, it is supposed, figurative elements) is unlikely to change the distinctive

[18] At [13 - 15]. See also *Hyphen GmbH v EUIPO*, Case T-146/15, at [28-32].

character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word "MEDIA" would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still."

33. The plain word WAVE appears on company's webpages and within its brochures, when describing the goods. This is clearly an acceptable form of the registered word only trade mark WAVE.

34. However, the mark on the goods is displayed as follows:

I note that the holder has not challenged the use of the mark in this form, nevertheless, I still have to consider whether the mark as used alters the distinctive character of the mark as registered. I note that the goods themselves are referred to as 'Work Assist Vehicles', and therefore, in light of the size of the letters WAV compared with the letter E, I have considered whether consumers would recognise

the mark as being an initialism for the name of the product “Work Assist Vehicles” with the smaller letter E referring to the fact that they are electric. Whilst I acknowledge that some consumers will perceive the mark in this way, it is my view that those consumers will understand this as a clever play on the fact that the product is called WAVE. Notwithstanding this, the word WAVE is clearly visible within the mark. Further, the manner in which the yellow horizontal arch is positioned around the end of the word could be perceived as a wave, therefore, reinforcing the meaning of the mark. There is nothing present in the mark depicted above that, to my mind, would alter the distinctiveness of the mark as registered. Therefore, I am satisfied that this is an acceptable variant form of the registered mark.

Assessment of evidence of use

35. For use to be genuine, it must have been real commercial exploitation of the mark in the course of trade, sufficient to create or maintain a market for the goods at issue during the relevant period, (within the EU prior to 1 January 2021, and in the UK following that date). In making my assessment I am required to consider all the relevant factors listed above, i.e. the scale and frequency of the use shown, the nature of the use shown, the goods and services for which use had been shown, the nature of the goods and services and the markets for them, and the geographical extent of the use shown. I remind myself that an assessment of genuine use is a global assessment, which involves looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.[19] Furthermore, as indicated by the case law above, use does not need to be quantitively significant to be genuine.

36. The evidence shows that there has been some use of the WAVE brand, however, as indicated above, not every commercial use of a mark may automatically be deemed to constitute genuine use. As previously stated, the evidence is not without its limitations: for instance, the turnover figures have only been provided in relation to the UK for the years 2021 to 2023 and they are provided from Crown

[19] *New Yorker SHK Jeans GmbH & Co KG v OHIM*, Case T-415/09

Lift Truck Limited. From this evidence, I am unable to ascertain the proportion of figures that are generated from the WAVE brand as these figures are likely to include other Crown products not sold under the WAVE mark. Furthermore, without evidence relating to the size of the EU and UK markets for the relevant periods, it is impossible to determine the opponent's share of the same. Neither do I have any evidence of any advertising expenditure.

37. Despite these shortcomings, I am prepared to accept through a combination of the unchallenged promotional brochure evidence and unchallenged invoice evidence that sales were made within the relevant period on a scale sufficient to show genuine use. I am prepared to infer that the invoices relate to goods sold under the WAVE mark. I make this finding on the basis that "WAV 60-118P Crown Model WAV60-118 WORK ASSIST VEHICLE" which is found within the invoices, is an alternative way of expressing WAVE's product line name "WAV 60 Series" which is referred to within the brochures alongside pictures of the goods with the WAVE mark on them. The amounts shown within the invoices (which I have set out according to the relevant years at paragraph 27 above) are not insignificant ranging from over £50,000 to over £800,000. Furthermore, I acknowledge that the invoices do not represent the entire picture as within the narrative evidence they are described as 'examples'. Notwithstanding the absence of information relating to the size of the relevant markets, I do not consider these figures to be trivial and indeed the invoices show that there have been repeat sales, including to national retailers such as B & Q. In addition to this evidence there is also website evidence, including UK viewing figures which shows that the mark will have reached a number of businesses in the UK. Moreover, the evidence of awards demonstrates that the goods have received industry recognition within the relevant period within the EU. As for the third party testimonials in the form of 'customer results', whilst these appear to be from third parties based predominantly in America, there is one from a Spanish based hotel company, which would indicate some sales activity within the EU, particularly when considered alongside the EU awards.

38. From the overall evidential picture, I am prepared to accept that the opponent has demonstrated genuine use of its WAVE mark within the relevant territories throughout the relevant period.

Fair specification

39. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, as follows:

> "245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.
>
> 246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.
>
> 247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.
>
> 248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.
>
> 249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. […] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the

legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered."

40. In assessing whether, or the extent to which, the evidence shows use of the registered marks in relation to the goods relied upon I bear in mind that fair protection is not to be achieved by identifying and defining particular examples of goods and services for which there has been genuine use, but, rather, the particular categories of goods and services they should realistically be taken to exemplify. For that purpose, the terminology of the resulting specification should accord with the perceptions of the average consumer for the goods and services concerned.[20] In arriving at a fair specification, I must consider how the average consumer would fairly describe the goods shown in evidence; the task is not to describe the use made of the registered mark in the narrowest possible terms, unless that is what an average consumer would do. I remind myself that a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registrations.[21]

41. I have no submissions from either party in relation to fair specification, however, having considered the nature of the goods for which genuine use has been shown within the evidence, the current specification appears to be a fair and accurate description, I have considered whether the goods could be more fairly described as "Work Assist Vehicles", however in my view, this would have the effect of broadening the specification and the description is relatively vague. I have also considered whether the goods would be best described as "forklift vehicles", however I do not consider this to be an accurate description of the nature of the goods. As such, I am satisfied that the term "Land vehicles, namely, self-propelled vehicles for use in materials handling and maintenance" coincides with the perception the average consumer will have of the goods.

[20] *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10
[21] *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch)

Relevant section 5(2) case law

42. The following principles are gleaned from the decisions of the 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 C-120/04, *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

43. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the CJEU stated at paragraph 23 of its judgment:

"In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

44. 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;
>
> (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.

45. Further, in *Kurt Hesse v OHIM*,[22] the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*,[23] the General Court ("GC") stated that "complementary" means:

> "…there is 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."

[22] Case C-50/15 P
[23] Case T-325/06

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

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

47. In YouView TV Ltd v Total Ltd [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

> "[…] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR) [2012] ETMR 42 at [47]- [49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

48. In Avnet Incorporated v Isoact Limited [1998] FSR 16, Jacob J (as he then was) said at [19]:

> "[…] definitions of services … are inherently less precise than specifications of goods. […] In my view, 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."

49. I bear in mind that it is permissible to group goods together for the purposes of assessment: *Separode Trade Mark*:[24]

> "The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision."

50. In Gérard Meric v OHIM, 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."

51. The goods/services to be compared are shown in the table below:

[24] BL O/399/10

Opponent's goods	Holder's goods and services
	("the 601 mark") Class 9: Chargers; charging stations for electric vehicles; batteries for electric vehicles; battery charging devices for motor vehicles.
Class 12: Land vehicles, namely, self-propelled vehicles for use in materials handling and maintenance.	Class 12: Electric vehicles, automotive vehicles; parts and fittings for vehicles, included in the class.
	Class 35: Retail store services in the field of electric vehicles, automotive vehicles, vehicle accessories, chargers, charging stations for electric vehicles, batteries for electric vehicles, battery charging devices for motor vehicles; advertising; business management; business administration; clerical services; rental of advertising space, also in form of banner advertising; sponsorship; advertising services related to goods and services of others, via contractual agreements; professional business consultancy and advisory services relating to motor vehicles and electric vehicles.
	Class 37: Installation, maintenance, servicing, repair and dismantling of electric

	vehicles, motor vehicles, machinery and plant; installation and maintenance of electric battery systems for electric vehicles for use in storage, dispensing, delivery, transmission and stabilisation of electricity; vehicle battery charging; services for arranging on-time assembly [installation] and dismantling of electric vehicles, motor vehicles, machinery and plant.
	Class 39: Transport; car sharing services; vehicle parking and storage; rental of car parking facilities for vehicles; providing information relating to car parking facilities for vehicles; navigation [positioning, and route and course plotting]; providing information and planning and booking services relating to transport; hire, rental and lease of motor vehicles, cars, garages, pitches parking spaces, car parking facilities, vehicles and navigational systems; rental of vehicle accessories, in particular luggage carriers, safety seats for children, trailers [vehicles], snow chains.
	Class 40: Rental of electric battery systems for electric vehicles for use in storage,

	dispensing, delivery, transmission and stabilisation of electricity.
	Class 42: Scientific and technological services and research and related design services in the field of electric vehicles and motor vehicles; industrial analysis and research services relating to electric vehicles and motor vehicles; design and development of computer hardware and computer software for electric vehicles and motor vehicles; vehicle design services; product development for motor vehicle construction and electric vehicle construction; technical development of motor vehicles and electric vehicles; consultancy relating to technical and scientific analysis relating to product planning and product manufacture; technological planning services; product design and development in relation to electric vehicles, motor vehicles, machinery and industrial plants.

52. Before I conduct the goods and services comparison, I note that there is a slight variation in the wording with the specifications of the 11 IRs. For example: in class 12, the specification reads either “Electric vehicles, automotive vehicles; parts and fittings for vehicles, included in the class” or “Electric vehicles, automotive vehicles; parts and fittings for vehicles, included in this class”. Differences are underlined. However, nothing turns on the minor difference in the wording used as it does not

have the effect of altering the core meaning of the terms. This is also true of the differences in the class 42 services.

Goods

53. In relation to the comparison between the goods, the opponent states within its submissions:

> "It is submitted that the Class 9 goods covered by the Opposed Application are similar to the Class 12 goods covered by the Opponent's Earlier Mark. These goods are complementary and may be produced by the same manufacturers, sold through the same trade channels and target the same relevant public."[25]

54. The opponent has also provided the following detailed submissions in relation to the competing class 9 and 12 goods:

> "In this regard, the Board of Appeal in Case R 1653/2023-2 Ford Motor Company v Mustang New Energy Technology (Shanghai) Co., Ltd confirmed at paragraph 36 of its decision dated 6 May 2024 that identical / highly similar Class 9 goods to those of the Opposed Application ("Charging appliances for rechargeable equipment; battery charging devices for motor vehicles; chargers for electric batteries; battery charge devices; chargers for electric accumulators") "are important if not indispensable for the earlier Class 12 goods such as (electric) vehicles and vice versa. Since these charging devices include not only charging terminals at petrol stations or otherwise on public roads, but also charging stations that belong to the users themselves and are installed in particular in private garages". Paragraph 38 of this decision also stated that such "goods may be advertised and sold through the same specialised distribution channels".[26]

[25] This is found at paragraph 33 of the opponent's submissions provided at the evidence rounds, and repeated within its submissions in lieu, at paragraph 18.
[26] Opponent's submissions submitted in the evidence rounds dated 21 August 2024, at paragraph 34.

55. As for the holder, I have received no comments in relation to the opposing goods other than a denial of identity or similarity found within its counterstatement.

Class 9

- *Chargers; charging stations for electric vehicles; battery charging devices for motor vehicles*

56. I acknowledge the decision relied upon above by the opponent. However, although EU case law may be persuasive, I am not necessarily bound by it. Further, I note that in the case relied on by the opponent and cited above, evidence was provided to show that in the EU, class 9 goods, i.e. charging stations bore the same trade marks as electric vehicles in class 12. I have not had the benefit of such evidence to demonstrate the same is true for the UK market. In any event, the opponent's vehicles are more specialised than vehicles used by the public which were considered within the above case. For these reasons, I will proceed to conduct my own comparison.

57. The term '*chargers'* is a broad term, given that it has not been limited in any way such as, for example, by phone or laptop, I consider the term '*chargers*' would include chargers such as those for electronic vehicles, particularly when read together alongside terms within the holder's specification. The goods clearly differ in nature, use and intended purpose; the opponent's class 12 goods are self-propelled vehicles, including of the electric variety, that are driven and used for the purpose of either moving goods/handling materials or preforming maintenance tasks, such as, painting or cleaning inside tall buildings (as shown within the evidence), whilst the holder's goods are charging devices/stations which are used for the purpose of charging electric vehicles. As for trade channels, absent of any evidence to the contrary, I would expect the same company that provides the opponent's specialist vehicles to also provide the charging devices or charging stations for those vehicles. This is because the opponent's vehicles are not standard electric vehicles, such as a family car and as a result probably requires specific compatible charging technology. When considering complementarity, the opponent's vehicles need charging ports/stations or battery chargers in order for

them to operate, and it is reasonable for consumers to expect that the competing goods would be provided by the same undertaking for the reasons given above. Users will also inevitably overlap as users of electric vehicles such as the opponent's will also seek use of charging stations for those said vehicles. Overall, I find that the goods are *similar to at least a low degree.*

- *Batteries for electric vehicles*

58. The opponent's goods differ in nature, method of use and purpose to the above goods. As discussed above the opponent's goods can include vehicles of the electric kind and have the method of use and purpose previously discussed, i.e. driven for the purpose of transporting and moving goods, and/or maintenance. In contrast, '*batteries for electric vehicles'* are goods that store power and are installed within electric vehicles to provide energy and power them. Without any evidence to the contrary, it is my understanding that the trade channels may overlap, particularly for specialist vehicles such as the opponent's. Consequently, as batteries for electric vehicles are essential to the use of electric vehicles, such as the opponent's, consumers would reasonably believe that they are provided by the same undertaking, leading to complementarity. End users may also coincide. Taking all the above factors into consideration, I consider the competing goods to be *similar to a medium degree.*

Class 12

- *Electric vehicles, automotive vehicles*

59. The opponent's goods "land vehicles, namely, self-propelled vehicles for use in materials handling and maintenance" would encompass the holder's above vehicles as such I consider these goods to be *identical.*

- *Parts and fittings for vehicles, included in the class*

60. The contested term would cover parts and fittings for the type of vehicle covered within the opponent's specification. Whilst the nature, method of use and intended

purpose of the competing goods inevitably differ, the respective goods are indispensable to one another as without the parts such as wheels, breaks, etc. the opponent's vehicles would be unable to function. Further, it is reasonable for consumers to expect them to derive from the same undertaking. i.e. the vehicle manufacturer. Moreover, the end consumer of the goods would be the same and I consider that there is likely to be at least some overlap in trade channels as companies selling vehicles will often also provide the aftercare services which includes fixing vehicles and selling and fitting new parts for those vehicles. However, the goods are clearly not competitive as they cannot perform the function of the other. Overall, I consider the competing goods to share a ***medium level of similarity.***

Services

61. In relation to the comparison of the opponent's goods against the holder's services, the opponent provides the following broad submissions:

> "With regard to the Class 35, 37, 39, 40 and 42 services covered by the Opposed Application, it is submitted that these are also highly similar to the Class 12 goods covered by the Opponent's Earlier Mark given that they relate to vehicles and target the same relevant public. Indeed, many of the services covered under these classes can only be performed using vehicles. Therefore, these services are considered to be complementary."[27]

However, I do not have any further detail regarding why the specific contested services found within the holder's specification are similar to the opponent's goods and keep in mind the principles of *SmartX*.[28]

[27] This is found at paragraph 35 of the Opponent's submissions provided at the evidence rounds, and repeated within its submissions in lieu at paragraph 19.
[28] BL O/0911/24

Class 35

- *Retail store services in the field of electric vehicles, automotive vehicles, […]*

62. The opponent's goods are a specific type of vehicle, whilst the goods may differ in nature, purpose and method of use to the holder's retail services, the goods and the retail services for those goods may be provided by the same undertaking and the end users may coincide. Furthermore, in accordance with *Oakley, Inc v OHIM,*[29] and *Tony Van Gulck v Wasabi Frog Ltd*,[30] I find that the goods and the retail services in question are complementary as the goods are important to the retail services of those goods, and it is reasonable for consumers to expect them to be provided by the same undertakings. Overall, I consider the goods and services to be *similar to a medium degree*.

- *Retail store services in the field of […] vehicle accessories, chargers, charging stations for electric vehicles, batteries for electric vehicles, battery charging devices for motor vehicles.*

63. I have found the goods subject to the retail services above to be similar to the opponent's vehicles to at least a low or medium degree. These services may share the same trade channels and users as the opponent's vehicles. However, there will not necessarily be any complementarity between the opponent's vehicles and retail services as the vehicles themselves are not the goods being retailed. Neither do the goods and services share the same nature, method of use or purpose. Nevertheless, I find the competing goods and services to be *similar to somewhere between a low and medium degree*.

- *Professional business consultancy and advisory services relating to motor vehicles and electric vehicles*

[29] Case T-116/06, paragraphs 46-57
[30] Case BL O/391/14,

64. The above services clearly differ in nature, method of use and purpose from the opponent's goods. I understand these services to be business services provided to businesses in the vehicle trade, such as a vehicle manufacturer, rather than consultations or advice offered by vehicle companies to its users. As such, the trade channels and users will differ despite the services being in relation to motor vehicles and electric vehicles. Further, I do not consider the competing goods and services to be complementary, although vehicles may be the subject matter of the above services and therefore considered relatively important, in my view, given the reasons above, consumers would not believe them to be offered by the same undertakings. Neither are the respective goods and services competitive as the services cannot satisfy the users need for a car and vice versa. Consequently, I find the goods and services to be ***dissimilar***.

- *Advertising; business management; business administration; clerical services; rental of advertising space, also in form of banner advertising; sponsorship; advertising services related to goods and services of others, via contractual agreements*

65. I do not consider advertising and business related services to be similar to the opponent's goods as they differ in nature, method of use and intended purpose. Trade channels would also differ as companies that offer advertising and/or business services to third parties do not also produce and sell vehicles. Whilst there may be some overlap in users as business users may require both the opponent's goods and the holder's services this is to such a broad degree that it does not engage with similarity. Further, I do not consider the goods to be complementary, as they are not important or essential to the use of one another, neither would consumers reasonably believe that the competing goods and services were provided by the same undertaking. Therefore, the goods and services are ***dissimilar.***

Class 37

- *Installation, maintenance, servicing, repair and dismantling of electric vehicles, motor vehicles, […]; Services for arranging on-time assembly [installation] and dismantling of electric vehicles, motor vehicles, […]*

66. I consider these goods and services to be similar as although the nature, purpose and method of use differs, without evidence to the contrary I find that the same undertaking that provides the opponent's vehicles is likely to provide the installation, maintenance, servicing, repair and when the time comes dismantling of the opponent's vehicles which could include both electric and motor vehicles. Furthermore, the respective goods and services are complementary as the holder's services are indispensable to the proper function of the goods and consumers are likely to expect them to be provided by the same or economically linked undertakings. Consequently, they will be *similar to a medium degree*.

- *Installation, maintenance, servicing, repair and dismantling of […] machinery and plant; Services for arranging on-time assembly [installation] and dismantling of […] machinery and plant*

67. As for the Holder's above services in relation to machinery and plant, I do not have any specific submissions explaining where the similarity would rest for these competing goods and services, other than a broad reference to users and complementarity as set out above at paragraph 61. In my view, the services do not appear to have any relation to the opponent's self-propelled vehicles and therefore cannot be considered complementary. Neither would users overlap. It follows that *I do not consider the applied for services to be similar* in any way to the opponent's class 12 goods.

- *Installation and maintenance of electric battery systems for electric vehicles for use in storage, dispensing, delivery, transmission and stabilisation of electricity*

68. I consider trade channels are likely to overlap as it is reasonable to expect the same undertaking that provides the opponent's particular vehicles (which includes the electric variety) to also be responsible for the services relating to the installation and maintenance of the electric battery system responsible for those vehicles to operate. Furthermore, the respective services are indispensable to the proper function of the goods leading them to be complementary as consumers are likely to expect them to be provided by the same or economically linked undertakings. Consequently, they will be *similar to somewhere between a low and medium degree*.

- *Vehicle battery charging*

69. Typically, services available to the public for charging car batteries are often provided by different undertakings to those that provide the cars themselves. In the same way that, for example, car manufacturers of petrol and diesel cars do not also provide the fuelling services needed for running those cars. However, given the specific nature of the goods and the fact that they are not the type to be used by the public, I accept that vehicle battery charging services, of the type that would be used in relation to the opponent's goods, may be offered by the same undertaking that is responsible for the goods themselves. Vehicle battery charging services are clearly essential to electric vehicles that would fall within the opponent's goods, and it would be reasonable for consumers to expect them to be offered by the same undertaking, consequently, the goods and services are complementary. Users will also certainly overlap. Yet, the nature, purpose and method of use differ, and there is no competition. Overall, I consider the competing goods and services to be *similar to a low degree.*

Class 39

- *Transport; car sharing services; providing information and planning and booking services relating to transport; hire, rental and lease of motor vehicles, cars, […] vehicles […]*

70. Whilst vehicles are needed to provide transportation services, I do not consider the respective goods and services to be complementary. This is because the trade channels for the goods and services would differ, as companies that provide vehicles do not also provide transportation and hire services, and vice versa. As such, although the goods are important for the services, consumers would not expect them to be provided by the same undertaking. Further, by virtue of the fact that one is a good and the other is a service the nature differs, as does the use and purpose. The opponent's vehicles are specialised and specifically used for an employee to move materials from one place to another, or for maintaining buildings, whereas transportation services are typically services offered to the public for moving many passengers from place A to B. Users will also differ as the opponent's goods are typically targeted at businesses for staff to use in the course of business, whereas transportation services are typically offered to the general public. Although transportation services may also be provided to businesses, this overlap is too general to engage with similarity. Neither are the goods and services in competition. Overall, I do not find that the goods and services are similar. Further, the services related to transportation, such as providing information in relation to transportation or the related planning and booking services are also dissimilar to the opponent's goods as they differ in nature, method of use, purpose, trade channels, complementarity and competition, and are therefore *dissimilar*.

- *Vehicle parking and storage; rental of car parking facilities for vehicles; providing information relating to car parking facilities for vehicles; hire, rental and lease of […] garages, pitches parking spaces, car parking facilities, […]*

71. The opponent claims that there is similarity between its goods and the above services based on complementarity, however, whilst the services are for the purposes of providing vehicle parking, or information relating to those services, consumers would not reasonably expect the goods and services to derive from the same undertaking as vehicle manufacturers do not typically provide vehicle parking or storage of those vehicles. The trade channels would also differ. Further, the goods and services differ in nature, method of use and intended purpose as the services are used by vehicle owners for the purpose of parking or storing vehicles

whereas the goods themselves are driven around warehouses or buildings to move materials from one place to another. Users may overlap to the degree that businesses may use both the goods and industrial vehicle parking services, but the overlap is too broad for a finding of similarity. Overall, I find the goods and services are *dissimilar*.

- *Navigation [positioning, and route and course plotting]*

72. I understand navigational services to be in relation to air or sea travel, where it is important for traffic control to understand the exact position and course of route to ensure safe air or sea travel across the globe, rather than services for use with vehicles. Therefore, these services clearly differ in nature, method of use, purpose, trade channels, and users. Further they are not in competition nor are they complementary. Consequently, the goods and services are *dissimilar*. However, even if I am wrong about the scope of these services and they do in fact relate to vehicles, from the evidence provided, it is clear that the opponent's particular vehicles do not require navigational services as they are typically used within a warehouse, store or building, rather than to travel across roads from one place to another.

- *Hire, rental and lease of […] navigational systems; rental of vehicle accessories, in particular luggage carriers, safety seats for children, trailers [vehicles], snow chains*

73. The above services are all for the hire, rental or lease of various vehicle accessories. However, having consulted the evidence, none of the above accessories such as navigational systems, luggage carriers, safety seats for children or snow chains would be compatible with the opponent's particular vehicle. Equally, there is nothing to suggest that trailers would be compatible either. As such, there is no reason why the goods subject to the services would be produced by the same undertaking as the opponent, and accordingly, no reason why the hire, rental and lease services for these goods would be provided by the same undertakings. Further, I do not consider the goods and services to be complementary; not only because they are not important to one another as the

opponent's goods are not those offered under the services, but for the reasons outlined above, consumers would not expect them to derive from the same undertakings. Neither are the nature, method of use or purpose the same. Users will also differ as users of these services are more likely to be the general public. Therefore, I consider the goods and services to be *dissimilar.*

Class 40

- *Rental of electric battery systems for electric vehicles for use in storage, dispensing, delivery, transmission and stabilisation of electricity*

74. I understand these services to be provided by companies to users that are worried about the lifespan of the battery within an electric vehicle. The purpose of the services is so that if the battery life decreases beyond a certain point they can be renewed without cost to the user, as such they would be provided by the same undertaking that is responsible for providing the electric vehicles. The goods are also important to the provision of the services. Consequently, there may be an element of complementarity, and users could overlap. However, the nature, method of use and purpose differ. There may also be an element of competition as users can buy an electrical vehicle (such as the opponent's) with a battery included, or they can choose to buy an electrical vehicle with a rented battery. Overall, I find that the goods and services are *similar to a low degree.*

Class 42

- *Scientific and technological services and research and related design services in the field of electric vehicles and motor vehicles; industrial analysis and research services relating to electric vehicles and motor vehicles; technological planning services; Vehicle design services; product development for motor vehicle construction and electric vehicle construction; technical development of motor vehicles and electric vehicles; product design and development in relation to electric vehicles, motor vehicles, […]; Consultancy relating to technical and scientific analysis relating to product planning and product manufacture*

75. The above services are all services for the application of scientific, technological and industrial knowledge of vehicles in their design and development. These are broad terms that may include a range of activities that contribute to the research and knowledge behind the design and development, of new products and systems as well as the quality and reliability of vehicles. Whilst vehicle manufacturers may invest in their own scientific, technological and industrial research and analysis to improve their own product lines, it is highly unlikely that they would then provide the information, knowledge and research gained to their competitors and lose the advantage they have invested in. Instead, the above services describe those offered by third parties to manufacturers. As such, users would differ as will the trade channels. Further, the goods and services are unlikely to be complementary as although the goods and services are important to one another, consumers will not believe that the opponent would be offering these innovative knowledge and research services to third party manufactures. The goods and services clearly differ in nature, method of use an intended purpose. Neither are they in competition as the services cannot perform the function of the goods. Therefore, it follows that the goods and services are *dissimilar.*

- *Design and development of computer hardware and computer software for electric vehicles and motor vehicles.*

76. Although computer hardware and software is becoming increasingly essential to vehicles, without evidence to the contrary, I do not consider the services to be provided by the same undertakings that provide vehicles to users. Neither do I find that consumers would reasonably expect them to be provided by the same undertakings. Therefore, I do not find these services to be complementary to the goods. Moreover, the nature, method of use and purpose differ. Users also differ as the users of the services will be vehicle manufacturers unlike the users of the goods. As such, I consider the goods and services to be *dissimilar.*

- *Product design and development in relation to […] machinery and industrial plants*

77. As for the Holder's above services in relation to machinery and industrial plants, *I do not consider these to be similar* in any way to the opponent's class 12 goods. Neither do I have any specific submissions explaining why there would be similarity for these competing goods, other than a suggestion of complementarity, which I do not agree. This is because the final product resulting from these services are not vehicles, but machinery and industrial plants, therefore the services are not important to one another, and there is no reason why consumers would expect the opponent's vehicle goods to be provided by the same company that offers product and design services for machinery and industrial plants.

78. As some degree of similarity between the goods and services is necessary to engage the test for a likelihood of confusion under sections 5(2)(a) and 5(2)(b) grounds, my findings above mean that the opposition must fail against goods and services of the registered mark that I have found to be dissimilar, namely:[31]

Class 35: *Professional business consultancy and advisory services relating to motor vehicles and electric vehicles; Advertising; business management; business administration; clerical services; rental of advertising space, also in form of banner advertising; sponsorship; advertising services related to goods and services of others, via contractual agreements.*

Class 37: *Installation, maintenance, servicing, repair and dismantling of […] machinery and plant; Services for arranging on-time assembly [installation] and dismantling of […] machinery and plant.*

Class 39: *All of the applied for services.*

Class 42: *All of the applied for services.*

[31] *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA

79. Therefore, I will go on to assess whether there is a likelihood of confusion for the following goods and services only:

Class 9: *Chargers; charging stations for electric vehicles; Batteries for electric vehicles; battery charging devices for motor vehicles.*

Class 12: *Electric vehicles, automotive vehicles; parts and fittings for vehicles, included in the class.*

Class 35: *Retail store services in the field of electric vehicles, automotive vehicles, vehicle accessories, chargers, charging stations for electric vehicles, batteries for electric vehicles, battery charging devices for motor vehicles.*

Class 37: *Installation, maintenance, servicing, repair and dismantling of electric vehicles, motor vehicles, […]; Services for arranging on-time assembly [installation] and dismantling of electric vehicles, motor vehicles, […]; Installation and maintenance of electric battery systems for electric vehicles for use in storage, dispensing, delivery, transmission and stabilisation of electricity; Vehicle battery charging*

Class 40*: Rental of electric battery systems for electric vehicles for use in storage, dispensing, delivery, transmission and stabilisation of electricity*

The average consumer and the purchasing act

80. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and 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."

81. Given the specific nature of the opponent's earlier vehicles, the average consumer for the goods and services at issue are likely to be business users.

82. The goods and services will vary in price as will the frequency of purchase depending on the business's needs, however they could potentially be rather expensive, for example vehicles. Equally, the importance of the selection and the required thought process is fairly significant, even for goods such as parts and fittings for vehicles which are typically less expensive purchases, therefore to my mind, these purchases will not be merely casual. For these reasons, the level of attentiveness exhibited during the purchasing process will vary between a medium level for parts and fittings of vehicles, to a high level for vehicles and charging stations. However, overall, consumers are likely to demonstrate an above medium level of attention in respect of the goods and services at issue, not least because there will be many factors at play such as, the choice of product design, safety features, suitability for purpose and performance, cost and reliability, which will all be at the forefront of consumer's minds during the selection process. There will also be a greater degree of attention paid for repair and maintenance services in class 37 as there are additional safety considerations at stake.

83. The goods and services are likely to be purchased by these consumers from physical premises, manufacturers or provider after viewing information in brochures, on the internet, or after a visual inspection of the product. Therefore, I

find that visual considerations will dominate. Nevertheless, I do not discount an aural component forming part of the process, particularly as parts and fittings can be ordered via the telephone or advice may be sought from technical sales or repair staff during purchase.

Identity of the 201 mark.

84. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the CJEU held that:

> "54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.

85. The earlier mark and the contested 201 mark are both word-only marks consisting of the word "WAVE" with no additional elements. As such, they are self-evidently identical. In relation to the goods under the 201 mark that I have found above to be identical to those under the earlier mark, namely: "*Electric vehicles, automotive vehicles",* these terms are prohibited from registration under section 5(1) of the act.

Comparison of trade marks

86. It is clear from *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU states at paragraph 34 of its judgment in *Bimbo*, that:

> "…it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relevant weight in the perception of the target public, and then, in

the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

87. 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 trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

88. The remaining marks to be compared are as follows:

The Opponent's earlier mark	The Holder's contested marks
WAVE	("the 601 mark") e.wave ("the 152 mark") e.wave X ("the 607 mark") wave X ("the 897 mark") wave

	(“the 255 mark”)  (“the 256 mark”)  (“the 370 mark”)  (“the 365 mark”)  (“the 018 mark”)

	 (“the 557 mark”) 

Overall impression

89. The opponent’s earlier mark is a word only mark containing the single word “WAVE”. As such, the overall impression lies within the word itself.

90. As for the holder’s remaining marks, five of them are word only marks. These are marks 601, 152, 607, 255, and 256. They all have the word “WAVE” in them with either “e.” preceding the word “WAVE”, the word “WAVE” followed by either the letter “X” or “S”, or a combination of the word “WAVE” with “e.” preceding it and either the letter “X” or “S” at the end of the mark. Regardless, the overall impression of all of these marks rests predominantly in the word “WAVE” whilst the additional letters at either the beginning and/or end of the marks, will play a lesser role.

91. As for the figurative IR’s, taking first the 897 mark, this contains the word “WAVE” in a highly stylised font, nevertheless, the overall impression lies in the word “WAVE”, with the stylisation providing a contribution.

92. The holder’s 370 and 557 marks both include the word “WAVE” with either the letter “S” or “X” following it. Whilst the 370 and 018 marks, comprise of the word “WAVE” preceded by “e.” and either the letter “X” or “S” at the end of the mark. All are in highly stylised font. For these marks, the overall impression rests in the word “WAVE” with the stylisation and additional letters at the end and/or beginning of the marks playing a lesser role.

Visual similarity

93. The 607 and 256 marks are both word only marks that encompass the word "wave" followed by a letter in upper case. The 607 mark being "wave X" and the 256 mark being "wave S". I consider these marks to be *highly similar* to the earlier word only mark, "WAVE".

94. Taking the 601 mark which consists of "e. wave". This mark and the earlier mark are both word only marks containing the word "WAVE", with the only difference other than the title case being the additional letter "e" and full stop preceding the word "wave".[32] As such, I consider the competing marks to be *highly similar*.

95. As for the 152 and 255 marks, these both word only marks contain the word wave preceded by the letter "e" and a full stop and ending with either the letter X or S. The 152 mark being "e.wave X" and the 255 mark being "e.wave S". Consequently, I consider these marks to be similar to the earlier mark to somewhere between *a medium and high degree*.

96. Turning to the figurative marks, taking the 897 mark which consists of the word "WAVE" in a highly stylised font, despite the stylisation, I consider this mark to be *highly similar* to the earlier mark.

97. Next, the 365 and 557 marks, these both comprise of the word "wave" in a highly stylised font followed by either the letter "X" or "S". Whilst I acknowledge the visual differences between the respective marks with the contested marks containing highly stylised font and the addition of another letter, I nevertheless consider these marks to be *highly similar* to the opponent's word only mark "WAVE".

98. Finally, the 370 and 018 marks. These encompass the highly stylised word "wave" with the element "e." preceding it and either the letters "X" or "S" at the end of the

[32] Registration of a word mark gives protection irrespective of the title case: see *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17.

mark. I consider these to be similar to *somewhere between a medium and high degree* to the earlier mark.

Aural similarity

99. The 897 mark is aurally *identical* to the earlier mark as they both contain the single syllable word "wave", with no other elements.

100. As for the 607, 256, 365 and 557 marks, these all consist of two syllables, the first stemming from the word "wave" and the second being either the sounds "EX" or "ES". Therefore, the marks contain an identical first syllable, however, I accept that the second syllable differs. Nevertheless, I consider these marks to be *highly similar* to the opponent's earlier mark.

101. Turning to the 601 mark. In my view, consumers will not pronounce the full stop after the letter "e", as such, the mark comprises of two syllables, the first being the sound "EE" and the second from the usual English pronunciation of the word wave. In contrast, the earlier mark contains the single syllable word "WAVE". The marks share an identical syllable which derives from the shared identical word, however the additional syllable within the contested marks creates a point of difference. Despite this, I consider the marks to be *highly similar*.

102. For the remaining marks, the 152, 255, 370 and 018 marks. As with the 601 mark, the dot in these marks will not be pronounced, therefore they both consist of three syllables, i.e. "EE-WAVE-EX" or "EE-WAVE-ES". Whereas the earlier mark contains the single syllable, "WAVE". Consequently, the overlap is due to the shared identical word. Overall, the holder's marks and the opponent's mark are similar to *at least a medium degree*.

Conceptual similarity

103. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.[33] All of the applied for marks and the earlier mark contain the word "wave" which is dictionary defined and has several meanings.

[33] *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29

However, regardless of which meaning consumers attribute to the word “wave”, they will apply the same meaning to all marks containing the word. Therefore, I consider that the 897 mark which contains the word “wave” solus is conceptually *identical* to the earlier mark.

104. As for the additional letters positioned after the word “wave”, these will be seen as such, perhaps signalling the “X” or “S” series of the “wave” mark. The “e.” element found at the beginning of some of the applied for marks may be considered by some consumers, in the context of the goods and services, as signifying that they are of the electric variety. Despite the additional elements within the holder’s remaining marks, I consider the applied for marks with the word “wave” followed by a single letter, i.e. the 607, 256, 365 and 557 marks, are conceptually *highly similar, if not identical* to the earlier mark. As for the 601 mark, “e. wave”, and the remaining applied for marks which contain both the “e.” element at the beginning of the mark and an additional letter at the end of the mark, these are conceptually similar to *somewhere between an above medium and a high degree,* with the only difference being that the IR’s conjure an additional concept of electric which in any event is highly allusive of the goods and services.

Distinctive character of the earlier mark

105. In *Lloyd Schuhfabrik Meyer* 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 *WindsurfingChiemsee 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)."

106. 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 distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

107. I observe that the opponent claims enhanced distinctiveness through use. I have summarised the opponent's evidence of use above. The relevant market for assessing enhanced distinctiveness is the UK at the time of the application. Whilst I have some figures specifically relating to the goods that are shown in the invoices, these are limited. The award evidence is based on recognition from consumers within the EU market, and therefore cannot be taken into account. Equally the customer results also stem from those either in the USA or EU. I do not have promotional figures for the UK nor any third-party articles to demonstrate that the mark has enjoyed an enhanced reputation. Consequently, I have only the inherent position to consider.

108. The earlier mark is a single word only mark consisting of the word "WAVE". This is a dictionary defined word that does not appear to have any connection with the goods relied upon. In my view, it is *inherently distinctive to a medium degree.*

Likelihood of confusion

109. 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 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 goods and 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 and 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.

110. Indirect confusion was described in the following terms by Iain Purvis QC (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:[34]

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

[34] BL O/375/10

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

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

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

111. I acknowledge that a finding of indirect confusion should not be made merely because the two marks share a common element. Furthermore, it is not sufficient that a mark merely calls to mind another mark:[35] This is mere association not indirect confusion.

112. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

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

113. For all the applied for marks I have identified the average consumer to be business users that will pay, overall, an above medium level of attention during the purchasing process, which will be predominantly visual in nature. I have found that the goods and services range from identity for class 12 goods, to similar between a medium and low degree for the remaining goods and services at issue. I have also found the earlier mark to possess a medium degree of inherent distinctive character. Although the visual, aural and conceptual similarity differ for each of the marks which I will consider below.

The 201 mark

114. For the goods under this mark that I have not found to be identical and captured under section 5(1) above, I find that due to the identity of the competing marks, consumers will nevertheless clearly confuse these marks for one another. I find this even where consumers will be paying an above medium degree of attention, and the goods and services are similar to only a low degree. Consequently, there is a likelihood of direct confusion between the competing marks under section 5(2)(a).

The 897 mark

115. I have found the 897 mark and the earlier mark to be visually highly similar, and aurally and conceptually identical. As such, consumers will clearly confuse the competing marks for one another, even where consumers will be paying an above medium degree of attention, and the goods and services are similar to only a low degree. Where the difference in stylisation is recognised it will merely be viewed as a brand variation. Therefore, there is likely to be both direct and indirect confusion under section 5(2)(b).

The 607, 256, 365 and 557 marks

116. I have found these marks and the earlier mark to be visually and aurally highly similar, and conceptually highly similar if not identical. As a result, I find that consumers are likely to misremember the differences between the competing marks, as they will fail to remember the additional letter “X” or “S” at the end of the

applied for marks, and the stylisation in relation to the 365 and 557 marks. Consequently, this will lead to a likelihood of direct confusion. However, for those consumers that do notice the additional letter at the end of the holder's marks, they will presume that these relate to different series or models of the WAVE brand. As for the stylisation in the 365 and 557 marks, this will simply be seen as a brand variation or brand extension. There will, therefore, also be a likelihood of indirect confusion.

The 601 mark

117. I have found the above mark and the earlier mark to be visually and aurally highly similar, and conceptually similar to somewhere between an above medium and high degree. The competing marks are both word-only marks which contain the word "wave". I keep in mind that any difference between the title case is irrelevant as word only marks have protection for the words themselves irrespective of the case that they are in.[36] The difference in the element "e." found at the beginning of the holder's mark will easily be overlooked despite it being located at the beginning of the mark. This is because the dominant and distinctive element is the word "wave" and the "e." element is fairly non distinct; indeed, it is likely that it will be seen as alluding to the fact that the goods and services are either electric or related to such. Consequently, I find that there is direct confusion between the competing marks. However, even where consumers identify the "e." element at the beginning of the applied for mark, consumers will perceive this as being an electric related sub brand, resulting in a likelihood of indirect confusion.

The 152, 255, 370 and 018 marks

118. I have found these marks and the earlier mark to be visually, and conceptually similar to somewhere between an above medium and high degree, and aurally similar to at least a medium degree. Despite the holder's above marks having

[36] See *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17.

different beginnings and ends to the earlier mark, the dominant and distinctive element still remains the word “wave”. The “e.” element at the beginning of the mark, as discussed above may be seen as alluding to electric, and therefore, it will be perceived that the goods and services have an electric connection. As for the additional single letter at the end of the mark, these are equally non-distinct and as such, it is likely that consumers will overlook the additional elements and confuse the holder’s marks with the earlier mark. I find that this will result in a likelihood of direct confusion, even where consumers are paying an above medium degree of attention and there is only a low level of similarity between the goods and services.

119. However, if I am wrong, and consumers do in fact identify the differences between the respective marks, they will also identify the shared identical word “wave” which is the dominant and distinctive element of the holder’s marks and the only element of the earlier mark. The holder’s marks do not contain any other elements that are distinct that will lead consumers away from confusion. Indeed, the other elements of the holder’s marks are very weak and non-distinct and, in my view, will be seen as logical sub brands, brand variants or brand extensions. For example, the additional “e.” element may be understood as suggesting a line of electrical goods and services, whilst the additional letter, either “X” or “S” will be viewed as signifying a different series or model of the goods and services. As a result, I also find a likelihood of indirect confusion between the holder’s above marks and the earlier mark. Given the similarity between the marks, I make this finding despite the level of attention paid by consumers and even where there is only a low level of similarity between the goods and services.

CONCLUSION

120. The oppositions have all been partially successful under either sections 5(2)(a) or 5(2)(b) in relation to the following goods and services:

Class 9: *Chargers; charging stations for electric vehicles; batteries for electric vehicles; battery charging devices for motor vehicles*.

Class 12: *Electric vehicles, automotive vehicles; parts and fittings for vehicles, included in the class.*

Class 35: *Retail store services in the field of electric vehicles, automotive vehicles, vehicle accessories, chargers, charging stations for electric vehicles, batteries for electric vehicles, battery charging devices for motor vehicles.*

Class 37: *Installation, maintenance, servicing, repair and dismantling of electric vehicles, motor vehicles, […]; Services for arranging on-time assembly [installation] and dismantling of electric vehicles, motor vehicles, […]; Installation and maintenance of electric battery systems for electric vehicles for use in storage, dispensing, delivery, transmission and stabilisation of electricity; Vehicle battery charging.*

Class 40: *Rental of electric battery systems for electric vehicles for use in storage, dispensing, delivery, transmission and stabilisation of electricity.*

121. Therefore, these goods and services will not proceed to registration.

122. However, the oppositions fail against the following goods and services which may proceed to registration:

Class 35: P*rofessional business consultancy and advisory services relating to motor vehicles and electric vehicles; Advertising; business management; business administration; clerical services; rental of advertising space, also in form of banner advertising; sponsorship; advertising services related to goods and services of others, via contractual agreements*

Class 37: *Installation, maintenance, servicing, repair and dismantling of […] machinery and plant; Services for arranging on-time assembly [installation] and dismantling of […] machinery and plant.*

Class 39: *All the applied for services in this class*

Class 42: *All the applied for services in this class*

COSTS

123. In my view, the parties have enjoyed a fairly equal measure of success, and as such, I direct that the parties each bear their own costs.

Dated this 6th day of November 2025

Sarah Wallace
For the Registrar