

**O/1096/25**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NUMBER UK00004001223  
BY GREEN ENERGY ORIGIN TECHNOLOGY (JIANGSU) CO., LTD.  
TO REGISTER THE FOLLOWING TRADE MARK:**



**IN CLASSES 1 AND 9**

**AND**

**AN OPPOSITION THERETO UNDER NUMBER OP000448415  
BY GEO SPECIALTY CHEMICALS, INC.**

## BACKGROUND AND PLEADINGS

1. On 12 January 2024, Green Energy Origin Technology (Jiangsu) Co., Ltd. (“the applicant”) applied to register in the UK the trade mark shown on the cover page of this decision (“the contested mark”). The application was accepted and published for opposition purposes on 5 April 2024 and registration is sought for the following goods:

Class 1 Adhesives for industrial use; Graphite for industrial purposes; Graphene; Artificial graphite for secondary cell batteries; Manganate; Lithium phosphate; Battery electrolytes; Hydrogen; Ammonia for industrial purposes; Esters; Solvents for use in manufacturing processes; Industrial chemicals; Chemical additives for motor fuels; Industrial salts.

Class 9 Semiconductors; Lithium ion batteries; Batteries; Lithium secondary batteries; Solar batteries; Graphite electrodes; Nickel-cadmium storage batteries; Plates for batteries.

2. On 3 July 2024, GEO Specialty Chemicals, Inc. (“the opponent”) opposed the application in full under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following UK trade mark:

UK902415222<sup>1</sup>



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<sup>1</sup> Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing EUTM. As a result of the opponent’s EUTM number 2740546 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.

Filing date: 24 September 2001

Registration date: 16 January 2004

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

Class 1 Additives for use in building materials, oil field production and drilling materials, inks, polymers, paints and other coating materials; chemicals used in the manufacture of inks, resins, coatings and polymers; chemicals for use in the treatment of waste materials; and chemicals for use in crosslinking rubbers and polymers; gallium metal.

3. By virtue of its earlier filing date of 24 September 2001, the above mark constitutes an earlier mark in accordance with section 6 of the Act. As it was registered on 16 January 2004, more than five years prior to the date the contested mark was filed, this mark is subject to proof of use in accordance with section 6A of the Act.
4. Under section 5(2)(b), the opponent claims that in view of the high level of similarity between the respective marks and the identity, similarity and complementarity between the goods, there exists a strong likelihood of confusion including a likelihood of association.
5. The applicant filed a defence and counterstatement denying all the grounds of the opposition.
6. The applicant is represented by LCW Law Associate Ltd, and the opponent is represented by Adamson Jones. During the evidence rounds, the opponent filed evidence. Neither party requested a hearing. However, the opponent filed written submissions in lieu.
7. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying

assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

## **Evidence**

8. The opponent filed a witness statement of Simon Haythornthwaite, signed and dated 24 October 2024. Simon Haythornthwaite is the Managing Director of GEO Specialty Chemicals UK Limited (GEO UK), a subsidiary of GEO Specialty Chemicals Inc (GEO Inc), a position held since July 2023. The witness statement is accompanied by 4 exhibits, SH1 – SH4.

## **DECISION**

### **Proof of use**

9. By virtue of its earlier filing date of 19 August 2005, the registration set out in paragraph 5 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 contested mark, it is, in principle, subject to the use provisions set out in section 6A of the Act.
10. 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.”

11. Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

12. Consequently, the onus is upon the opponent to prove that genuine use of the registered trade mark was made in the relevant period. The relevant period in which use must be established is the five-year period ending on the date of filing of the Contested Mark, i.e. 13 January 2019 to 12 January 2024. By virtue of paragraph 7 of Part 1, Schedule 2A of the Act, use within the EU is relevant up to IP Completion Day which is 31 December 2020.

13. 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 Bunderversvereinigung 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].”

14. Arnold LJ followed his summary of the principles to be applied when assessing proof of use with the following paragraph:

“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.”

#### Form of the mark

15. The mark appears as registered on the invoices offered in evidence in Exhibit SH4.

16. It also appears as registered in the corporate brochures and product data sheets offered in evidence in Exhibits SH1 and SH2 save for the device part of the mark being in orange and white and the letters “G E O” being in dark brown:



17. Although different single colours are used in the device and in the letters, they are single colours substituted for the black in a mark registered in black and white and I consider this to be normal and fair use. However, if I am wrong, per *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, the addition of the colours to the mark do not alter the mark’s distinctive character and so this is acceptable variant use.

#### Evidence of use

18. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.<sup>2</sup>

19. I remind myself that the relevant period is 13 January 2019 to 12 January 2024, any use within the EU being of relevance up to IP Completion Day.

20. Mr Haythornthwaite says, at paragraph 6 of his witness statement, that the opponent:

“... is recognised as a leading global supplier of specialty chemicals serving a diverse range of markets which include: coating and resin additives; specialty acrylic monomers; consumer additives. In addition, GEO offers a broad range of dispersants, surfactants, and other additives for the concrete admixtures, synthetic rubber polymerization, gypsum processing and oil well drilling markets.”

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<sup>2</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

21. He goes on to say:

“7. GEO is also a leading supplier of specialty ingredients for eye-care and nutrition end-uses. GEO partners with customers to supply silicone, methacrylate and other targeted chemistries for use as key ingredients for contact lens manufacture. In nutrition, GEO is the largest supplier of glycine, a key amino acid used in numerous end-uses including human supplements and pet food.

...

9. From our site in the UK, GEO produces and supplies materials for the manufacture of contact lenses, a range of specialty methacrylate monomers, used in coating, adhesive and polymer applications, and a range of Polyalkylene Glycols (PAGs) used as for synthetic lubricants, foam control agents, metal working fluids and other industrial end-uses.”

22. Mr Haythornthwaite then says that the opponent uses its mark in relation to its entire product range and that example extracts from its website and brochures directed at the UK are shown in Exhibit SH2. In point of fact, the corporate brochures which constitute a detailed breakdown of the opponent’s product range including the composition of these products and their industrial applications are exhibited at Exhibit SH1 and the product data sheets which provide further technical detail are exhibited at Exhibit SH2.

23. Mr Haythornthwaite then quantifies the opponent’s activities in the UK as per the extract from his witness statement below covering the relevant period.

12. GEO has sold its products under the **GEO Specialty Chemicals** mark in the UK (and EU) for decades on an impressive scale and there is provided below a listing of sales figures for GEO branded products in the UK in metric tonnes:

Year	Tonnes
2024 (Jan – August)	1964
2023	3066
2022	3065
2021	3296
2020	3128
2019	3225

13. GEO undertakes significant marketing and promotional activities in the EU, including the UK. In particular its approximate overall UK marketing and advertising expenditure figures for all GEO Specialty Chemicals branded products in the UK on an annual basis are as follows:

Year	Advertising and Marketing expenditure (€)
2024	24940
2023	27227
2022	16836
2021	2704
2020	5290
2019	97517

24. While it is unusual to quote tonnage in respect of UK sales as opposed to pounds sterling, the figures supplied serve to indicate the level of the opponent’s economic activity during the relevant period.

25. The opponent’s marketing expenditure during the relevant period, while not large, is not insignificant.

26. Mr Haythornthwaite also cites global sales of the opponent’s Class 1 goods as follows:

Year	Sales in euros
2024	2,769,000
2023	10,530,000
2022	13,805,000
2021	10,896,000
2020	8,245,000
2019	9,967,000

27. Because these are global figures, it is not possible to tell what proportion of the sales are to the UK.

28. Exhibit SH3 features an article from “the business magazine” dated 13 August 2021 referencing the opponent’s partnership with Siemens Digital Industries. I am not told what the circulation of this publication is.

29. The only other exhibit in Exhibit SH3 is the opponent’s entry on the American ImportGenius website, a website that documents import/export activity. As of 6 October 2024, the entry shows that the opponent exports goods to its sister plant in New Jersey as well to other American companies and to Puerto Rico. This exhibit is of limited value as it says nothing about the opponent’s sales of goods in either the EU up to IP Completion Day or the UK.

30. Exhibit SH4 consists of 31 invoices in euros and pounds sterling for a range of additives and chemicals that were shipped to a variety of UK addresses, covering the period 7 January 2019 to 9 January 2024. Apart from one invoice which documented the provision of free samples, the invoices range in value from £2630.40 to 319,254.53 euros, and 5 of the invoices are for in excess of 250,000 euros/£220,000. Further, if the sample invoices are representative of the opponent’s sales as a whole, the price per kilo ranges from the equivalent of £1.79 to £7.76 and hence on the basis of £1,790 per tonne the opponent’s revenue figures would extrapolate to:

<b>Year</b>	<b>Sales in £</b>
2024	3,515,560
2023	5,488,140
2022	5,486,350
2021	5,899,840
2020	5,599,120
2019	5,772,750

Sufficient use

31. The opponent’s marketing spend is modest. Evidence of its media presence only extends to one magazine article. I have not been provided with any data as to the

reach of its corporate brochures or its technical data sheets, nor have I been supplied with information as to market share or the size of the relevant market.

32. Notwithstanding the limitations of the evidence noted above, the opponent has filed evidence of significant UK sales activity during the relevant period in the form of metric tonnage sold and in respect of sample invoices. Although I have not been provided directly with annual revenue figures, these would appear to be in the millions of pounds per year, and so, looking at the evidential picture as a whole, I am satisfied that the opponent has demonstrated genuine use of its mark across the UK. Its sales are voluminous and consistent during the relevant period, and I consider there to have been real commercial exploitation of the mark on the market for a range of additives and chemicals.

### **Fair specification**

33. Having determined that the opponent has shown use of its goods under its mark for a range of additives and chemicals, I must now set out what I consider to be a fair specification having reviewed the use shown against its current specification.

34. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or 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 of the goods or services concerned.”

35. 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 (which also applies to proof of use cases), 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.”

36. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) at [47], the late Carr J pointed out that it is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do; for example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally.

37. The approach in *Merck* was endorsed by the Supreme Court in *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36:

“261. ... save that it must now be seen in light of the more recent guidance given by the CJEU in, for example: *Ferrari SpA v DU* (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106, at paras 36-53. There the CJEU explained, at para 40, that the essential criterion to apply for the purposes of identifying a coherent subcategory of goods or services capable of being viewed independently is their purpose and intended use.”

38. I remind myself that the opponent’s mark stands registered for:

Class 1      Additives for use in building materials, oil field production and drilling materials, inks, polymers, paints and other coating materials; chemicals used in the manufacture of inks, resins, coatings and polymers; chemicals for use in the treatment of waste materials; and chemicals for use in crosslinking rubbers and polymers; gallium metal.

Additives for use in building materials, oil field production and drilling materials, inks, polymers, paints and other coating materials

39. Having reviewed the opponent’s narrative evidence and cross-checked its brochures and technical data sheets against the specific products listed in its sample invoices, I do not find sufficient evidence to support its retention of additives for use in “building materials” at large. Rather, I can only find evidence of additives

in relation to concrete and to gypsum processing. With regard to “oil field production and drilling materials”, there are a number of references in the evidence to lubricants and to foam control that warrant the retention of this element of the term. As far as “inks, polymers, paints and other coating materials” are concerned, there are numerous references in the evidence to the opponent’s products being used in relation to inks, polymers and paints and to coatings of various types, such that it would be equitable to allow it to retain this element of its term.

#### Chemicals used in the manufacture of inks, resins, coatings and polymers

40. Having reviewed the opponent’s narrative evidence and cross-checked its brochures and technical data sheets against the specific products listed in its sample invoices, I find that there are numerous references the opponent’s products being used in relation to inks and resins, to coatings of various types, and to polymers, such that it would be equitable to allow it to retain this term.

#### Chemicals for use in the treatment of waste materials

41. Having reviewed the opponent’s narrative evidence and cross-checked its brochures and technical data sheets against the specific products listed in its sample invoices, I cannot find any references to the opponent selling chemicals for use in the treatment of waste materials and so I do not consider that it should retain this term.

#### Chemicals for use in crosslinking rubbers and polymers

42. The opponent attests to its goods being used in “rubber polymerization” and the supporting evidence contains references to the opponent’s goods having applications for rubber. I find this to be sufficient evidence for the retention of this term.

## Gallium metal

43. Having reviewed the opponent's narrative evidence and cross-checked its brochures and technical data sheets against the specific products listed in its sample invoices, I cannot find any references to the opponent selling gallium metal and so I do not consider that it should retain this term.

44. Having reviewed the evidence, I consider a fair specification to be:

Class 1      Additives for use in concrete, gypsum processing, oil field production and drilling materials, inks, polymers, paints and other coating materials; chemicals used in the manufacture of inks, resins, coatings and polymers; chemicals for use in crosslinking rubbers and polymers.

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

45. Sections 5(2)(b) and 5A of the Act reads as follows:

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

[...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

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.”

## Relevant law

46. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case 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 the goods**

47. 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.”

48. 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.

49. 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.”

50. Further, in *Kurt Hesse v OHIM*,<sup>3</sup> 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*,<sup>4</sup> 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.”

51. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

52. 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

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<sup>3</sup> Case C-50/15 P

<sup>4</sup> Case T-325/06

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.”

53. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“...the applicable principles of interpretation are as follows: (1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services. (2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms. (3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers. (4) A term which cannot be interpreted is to be disregarded.”

54. 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.”

55. I bear in mind that it is permissible to group goods together for the purposes of assessment: *Separode Trade Mark*.<sup>5</sup>

“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

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<sup>5</sup> BL O/399/10

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.”

56. The goods to be compared are shown in the table below:

<b>Opponent's goods</b>	<b>Applicant's goods</b>
<p><u>Class 1</u> Additives for use in concrete, gypsum processing, oil field production and drilling materials, inks, polymers, paints and other coating materials; chemicals used in the manufacture of inks, resins, coatings and polymers; chemicals for use in crosslinking rubbers and polymers.</p>	<p><u>Class 1</u> Adhesives for industrial use; Graphite for industrial purposes; Graphene; Artificial graphite for secondary cell batteries; Manganate; Lithium phosphate; Battery electrolytes; Hydrogen; Ammonia for industrial purposes; Esters; Solvents for use in manufacturing processes; Industrial chemicals; Chemical additives for motor fuels; Industrial salts.</p>
	<p><u>Class 9</u> Semiconductors; Lithium ion batteries; Batteries; Lithium secondary batteries; Solar batteries; Graphite electrodes; Nickel-cadmium storage batteries; Plates for batteries.</p>

The opponent's submissions

57. The opponent's submissions in respect of the goods are as follows:

40. The products described as: "Additives for use in building materials, oil field production and drilling materials, inks, polymers, paints and other coating materials" as well as "chemicals used in the manufacture of inks, resins, coatings and polymers" covered by the Opponent's earlier trade mark in class 1 can be identified within Mr Simon Haythornthwaite's Witness Statement exhibit **SH1** (see pages 14 to 30 and also pages 32, 39 and 57) and are loosely described as:

- **“Lubricants - Basefluids”** which can be used as an additive and/or soluble lubricant additive for use in many fields, but particularly in the automotive and industrial fields such as:
  - i. Gear lubricants;
  - ii. Compressor lubricant;
  - iii. Transmission lubricant and
  - iv. Engine oil.
- **“Chemical Intermediaries”** which can be used as an additive and/or soluble lubricants additives and hydrogen bonding providing polymers with compatibility for water or polar solvents for use in a vast range of industrial applications.

As such, the Opponent’s products are used in the industrial manufacturing processes and therefore are the same, highly similar or complementary to the Applicant’s specification in class 1 under “Solvents for use in manufacturing processes; Industrial chemicals; Chemical additives for motor fuels; Industrial salts”.

41. The Applicant’s goods covered in class 1: “Graphite for industrial purposes; Graphene; Artificial graphite for secondary cell batteries” are to be considered similar to the Opponent’s products protected in class 1 because they are complementary, since the Opponent’s products could be used as part of the industrial process manufacture involving graphite or graphene as a material.
42. In this context, all of the products described in class 1 of the Applicant’s trade mark, but in particular “Solvents for use in manufacturing processes; Industrial chemicals; Chemical additives for motor fuels” are identical, similar or complementary to the products for which the Opponent owns registered rights under registration No. UK00902415222.
43. Similarly, the goods covered in class 9 of the Applicant’s trade mark are similar to the Opponent’s products protected in class 1 because they are complementary, since the Opponent’s products could be used as part of the manufacture of “Semiconductors; Lithium-ion batteries; Batteries; Lithium secondary batteries; Solar batteries; Graphite electrodes; Nickel-cadmium storage batteries; Plates for batteries” potentially creating the incorrect impression that these products are an extension of the Opponent’s field of application of its class 1 products.

## The applicant's counterstatement

58. The applicant made the following comments in respect of the similarity of the goods in its counterstatement:

10. The Applicant, "Green Energy Origin (GEO)", is a global leader in innovative, environmentally-friendly energy materials. The Applicant is dedicated to Battery Materials and Specialty Chemicals, which includes Ultimate Manufacturing Division, Advanced Materials Division, and Green Recycle Division. GEO's Chemicals Division focuses on Green Hydrogen Ammonia Division and Wind Solar Energy Storage Systems Division. That is to say, the goods applied by the Applicant are mainly battery materials and battery-related products. These goods are mainly used in the field of green energy. As a multinational corporate, the Applicant has strategically positioned 9 factories and 3 R&D centers across Europe (Germany, Czech Republic), North America (The United States of America) and Asia Pacific (China).

11. The goods applied for by the Opponent are mainly used in construction, such as paints and other coating materials. These goods are widely used in all kinds of construction projects and are an indispensable material basis for construction projects. It is obviously different from the goods produced and sold by the Applicant.

12. After comparative analysis, the Applicant is engaged in the research and development of green energy, especially the research and development and sales of Battery Materials. However, the Opponent is mainly engaged in the production and sale of construction materials, especially additives for paints and other coating materials. Generally speaking, the goods sold by the Applicant and the Opponent are aimed at completely different consumer groups. In addition, the purposes of these goods are also different. Therefore, there is no realistic possibility of the two marks being confused.

59. In considering the applicant's comments, I remind myself that I must assess the respective goods on a notional basis and not on the basis of what the parties actually produce.

## My analysis

### Class 1

60. The applicant's "Industrial chemicals" are *Meric* identical to the opponent's "chemicals used in the manufacture of inks, resins, coatings and polymers".

61. I compare the applicant's "Solvents for use in manufacturing processes" with the opponent's "Additives for use in ... paints ...". As solvents can dilute paint, it is likely that they are used in the paint manufacturing process and so they have the

same method of use and would be purchased through the same trade channels. They are not in competition, but would be complementary, both being important to the paint manufacturing process such that customers may think that the responsibility for the goods lies with the same undertaking. Overall, I find these goods to be of medium similarity.

62. I compare the applicant's "Chemical additives for motor fuels" with the opponent's "additives for use in ... oil field production and drilling materials ...". Both sets of goods are additives. Additives for use in oil field production and drilling materials include lubricants and so both sets of goods have a use for machinery and would be purchased through the same trade channels. However, they are not in competition, nor are they complementary. Overall, I find these goods to be of medium similarity.

63. The Collins dictionary defines "Esters" as "... any of a class of compounds produced by reaction between acids and alcohols with the elimination of water."<sup>6</sup> The opponent makes no submissions in respect of esters, but its evidence shows that its lubricant products have an application for esters (lubricants being a subset of its additives for use in oil field production and drilling materials) and that esters can also be based on polymers (it having a registration for chemicals used in the manufacture of polymers). To that extent, the goods are not in competition, but they could be complementary. Further, the goods are all used in industrial processes and so they have a common method of use and could share the same trade channels. Overall, I find them to be similar to a medium degree.

64. The applicant has applied for "Hydrogen" and "Ammonia for industrial purposes" and both hydrogen and ammonia feature in the opponent's evidence as goods for which the opponent's goods have applications. Further, the opponent submits that its goods can be used for "hydrogen bonding" that provide polymers with compatibility with water. As such, the goods are not in competition but could be complementary. The goods are all used in industrial processes and so they have a common method of use and could share the same trade channels. Overall, I find them to be similar to a medium degree.

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<sup>6</sup> <https://www.collinsdictionary.com/dictionary/english/ester>

65. It would appear that the applicant's "Graphite for industrial purposes", "Graphene" and "Artificial graphite for secondary cell batteries" differ in specific nature from the opponent's goods. One of the terms indicates that these materials have a use for batteries, whereas the opponent's evidence makes no mention of these materials or indeed that its goods have an application for batteries. However, the opponent has submitted that its goods are complementary in that they "could be used as part of the industrial process manufacture involving graphite or graphene as a material." As such, it is saying that its goods *could* be used as part of a manufacturing process involving graphite or graphene rather than saying that they are routinely so used. I do not consider the fact that both sets of goods could theoretically form part of the same manufacturing process to be a sufficient basis for a finding of complementarity. However, the goods are all used in industrial processes and so they have a common method of use and could share the same trade channels. I do not consider the respective goods to be in competition. Overall, I find them to be similar to a low degree.

66. The Collins dictionary defines "Manganate" as "a salt of manganic acid".<sup>7</sup> The applicant has also applied for "Industrial salts". Neither manganate nor salts in general are mentioned in the opponent's evidence, but it submits that its products "are used in the industrial manufacturing processes and therefore are the same, highly similar or complementary to the Applicant's specification in class 1 under "...Industrial salts"." However, the opponent does not elaborate beyond these general statements. As such, while I have no specific submissions or evidence as to the characteristics or purpose of salts, I accept that all the goods are used in industrial processes and so they have a common method of use, and they could also share the same trade channels. I do not consider the respective goods to be in competition or to be complementary. Overall, I find them to be similar to a low degree.

67. In the absence of any submissions and evidence to the contrary, I have no reason to suppose that the applicant's "Lithium phosphate" and "Battery electrolytes", both used in batteries, have any connection to the additives and chemicals in the

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<sup>7</sup> <https://www.collinsdictionary.com/dictionary/english/manganate>

opponent's specification in terms of their composition and the uses to which the respective goods can be put. As such, the goods cannot be said to be similar in terms of their specific nature and purpose. However, the goods are all used in industrial processes and so they have a common method of use and could share the same trade channels. I do not consider the respective goods to be in competition or to be complementary. Overall, I find them to be similar to a low degree.

68. I compare the applicant's "Adhesives for industrial use" with the opponent's "chemicals used in the manufacture of ... resins ...". While the applicant's goods have adhesive properties and the opponent's goods are used to create something with adhesive properties, this is only a superficial point of similarity and is not a sufficient basis for an overall finding of similarity. While both are used in industry in very broad terms, the applicant's goods are the finished article whereas the opponent's goods form part of an industrial process. As such, their methods of use are different. The trade channels also differ, and the goods are not in competition, nor are they complementary. On this latter point, I remind myself that goods are not complementary on the grounds that one is used in the manufacture of another and so complementarity would not be established even if the opponent's goods were considered to be raw materials for the manufacture of adhesives: "... raw materials subject to a transformation process are essentially different from the finished products which incorporate, or are covered by, those raw materials...".<sup>8</sup> Overall, I find the goods to be dissimilar.

## Class 9

69. The opponent submits that the applicant's Class 9 goods "are similar to the Opponent's products protected in class 1 because they are complementary, since the Opponent's products could be used as part of the manufacture of [the listed Class 9 goods]". However, as previously stated, the opponent's evidence makes no reference to its goods having any application for batteries. I do not consider these goods to be complementary, nor do I consider them to be similar in terms of

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<sup>8</sup> T-288/12 *El du Pont de Nemours and Company v OHIM*, paragraph 43

nature, purpose and method of use. Further, they do not share the same trade channels, nor are they in competition. I find these goods to be dissimilar.

70. As some degree of similarity between the goods is required for there to be a likelihood of confusion<sup>9</sup>, the opposition must fail in respect of the following goods in the applicant's specification:

Class 1 Adhesives for industrial use.

Class 9 Semiconductors; Lithium ion batteries; Batteries; Lithium secondary batteries; Solar batteries; Graphite electrodes; Nickel-cadmium storage batteries; Plates for batteries.

### **The average consumer and the purchasing act**

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

72. The average consumer for the goods at issue will be an industrial manufacturer requiring a variety of additives, chemicals and compounds for use in producing

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<sup>9</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

goods such as paint, ink, and batteries. They will pay sufficient attention to ensure that these goods meet the specification for what they are intending to manufacture, and they will also consider how much these goods cost by volume. Overall, the level of attention paid by the average consumer will be medium. The consumer will study the products offered by companies that supply raw materials via their websites and catalogues and to that extent the purchasing process will be primarily visual. However, I do not rule out there being a verbal component to the purchasing process as prospective purchasers make enquiries of staff as to the detailed specifications and capabilities of the additives, chemicals and compounds on offer.

### **Comparison of trade marks**

73. 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.”

74. 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.

75. The marks to be compared are as follows:

Opponent's mark	Applicant's mark
	

### Overall impression

76. The opponent's mark is a figurative mark. It has a black and white device with a series of curves that might be seen as containing a bottom left to top right arrow in white. To the right of the device are the spaced-out block capitals "G E O". Below these letters are the words "SPECIALTY CHEMICALS" in smaller block capitals. Being larger than the descriptive words below them, the letters "G E O" play the largest role in forming the overall impression made by the mark with the device playing a lesser role than the letters and the words.

77. The applicant's mark is a figurative mark which shades in colour from green to blue. It has a device in green consisting of three jagged lines with what might be leaves. To the right of the device is the word "GEO" in prominent block capitals which are stylised to the extent of the "G" and the "O" being squared off and the "E" having a broken line. While the device and the word are not markedly different in size (the device being taller than the word, but the word being wider than the device), the word is the more dominant of the two elements in forming the overall impression given that it is the element that will be read.

### Visual similarity

78. Visually, the devices in the marks are different, albeit neither device is particularly complex or noticeable. Both marks share the identical prominent letters "G" "E" and "O", but the opponent's mark has the additional words "SPECIALTY

CHEMICALS” in smaller text. Overall, the marks are visually similar to a medium degree.

#### Aural similarity

79. Notwithstanding the letters being spaced out, for a significant proportion of average consumers the letters in the opponent’s mark would resolve themselves into the word “GEO”, pronounced “GEE-O” and, if articulated, the smaller descriptive words “SPECIALITY CHEMICALS” would be voiced as “GEE-O SPESH-EE-AL-I-TEE KEM-I-KULS”. By the same token, the word “GEO” in the applicant’s mark would not be broken down into its constituent letters and would be voiced as “GEE-O”. If the descriptive words in the opponent’s mark were not voiced, the marks are aurally identical, but if they were to be articulated they still begin identically, but overall would be of medium aural similarity.

#### Conceptual similarity

80. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

81. The applicant says that “The applicant’s mark “GEO” stands for Green Energy Origin, which is also a combination of the initial letters of “Green Energy Origin” in the Applicant’s name. GEO is also in line with the Applicant’s mission “Continuous Innovation Powering Green Energy Transition. In this case, we submit that the trade marks do not “convey the same idea” but contain different ideas.”

82. The opponent says that “The Applicant’s mark does share a conceptual similarity with the Opponent’s earlier trademark despite GEO being a word existing in [sic] the English language as a prefix to mean “of or relating to the earth” (source: the Cambridge dictionary). The secondary element in the opponent’s sign

“SPECIALTY CHEMICALS” can be understood as “a particular chemical products which provide a wide variety of effects on which many other industry sectors rely”.

83. On encountering the applicant’s mark, the average consumer would not be aware of what the initial letters stand for or of the applicant’s mission. Rather, a significant proportion of average consumers would see the word “GEO”, not the constituent letters, and would, as defined by the opponent, derive the concept “of or relating to the earth” from it. The device in the applicant’s mark only contributes conceptually to the extent that the leaves (if seen) and the colour green reinforce the concept of being of the earth.

84. The letters “G E O” in the opponent’s mark would resolve themselves into the word “GEO” for a significant proportion of average consumers from which the identical concept – of or relating to the earth – would be derived. The descriptive words “SPECIALITY CHEMICALS” would be taken literally as chemicals for specialist use and are of secondary importance conceptually. The device in the opponent’s mark does not give rise to a particular concept.

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

85. 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 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been

registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

86. 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.

87. The device in the opponent’s mark has a negligible impact on level of distinctiveness. The distinctive element in the opponent’s mark – “G E O” – which, for a significant proportion of average consumers, would resolve themselves into the word “GEO”, meaning of or relating to the earth, is mildly allusive of the opponent’s goods to the extent that those goods could be said to originate from the earth. The words “SPECIALITY CHEMICALS” are wholly descriptive. Overall, I find the earlier mark to be of low inherent distinctiveness.

88. I will now assess whether the evidence before is sufficient to justify giving the earlier mark an enhanced level of distinctiveness. I remind myself that the requirement for a finding of an enhanced level of distinctive character is considerably more onerous than that of what needs to be established for a finding of genuine use: a finding of an enhanced degree of distinctive character requires use at such a level that is capable of pointing to the fact that a proportion of consumers would identify the goods as originating from a particular undertaking.

89. While the opponent’s sales over the course of the relevant period are significant – amounting to what appears to equate to millions of pounds per year – I am not told what the size of the UK chemicals market is or what share the opponent has of it. Further, the marketing expenditure offered in evidence is modest. As such, I do not consider the evidence before to justify a finding of an enhanced level of

distinctiveness such that it would be at a higher level than the low level that I have found to be inherent.

### **Likelihood of confusion**

90. 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 vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the Party A's trade mark, the average consumer for the goods 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.

91. Except where I have found the goods to be dissimilar, they range from being of low similarity to being identical.

92. I have found the marks to be visually similar to a medium degree and aurally identical if the descriptive words in the opponent's mark were not voiced (or of medium aural similarity if the descriptive words were to be articulated). Conceptually, the marks share the identical concept of being of or related to the earth, the descriptive words in the opponent's mark being of secondary importance conceptually.

93. I have found the earlier mark to possess a low level of inherent distinctive character, the evidence before me not justifying a finding of enhanced distinctive character.

94. I have found that the average consumer for the goods at issue will be an industrial manufacturer who will pay a medium level of attention during the purchasing process. The process will be primarily visual, but I do not rule out there being a verbal component as prospective purchasers make enquiries of staff.

95. In accordance with the principle of normal and fair use, the opponent's black and white mark could be rendered in a solid colour that matched the shade of green or blue in the applicant's mark. Both marks would be seen by a significant proportion of average consumers as containing the identical and prominent shared word "GEO" (the stylisation of the block capitals in the applicant's mark not being so remarkable as to be recalled as belonging to one or other of the marks). The wholly descriptive "SPECIALITY CHEMICALS" could very easily be overlooked entirely or mis-recalled as belonging to the applicant's mark. Neither device is particularly complex or noticeable so as to be accurately recalled as distinguishing one mark from the other. Overall, I find that there is a likelihood of direct confusion in this case for any of the goods that I have found to have any degree of similarity.

96. I will also consider indirect confusion. 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*:<sup>10</sup>

"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

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<sup>10</sup> BL O/375/10

common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

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

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

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

97. 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.

98. In accordance with the principle of normal and fair use, the opponent’s black and white mark could be rendered in a solid colour that matched the shade of green or blue in the applicant’s mark. Were the average consumer to notice and recall the

presence of the descriptive words “SPECIALITY CHEMICALS” in the opponent’s mark (this being a non-distinctive element conforming to criterion (b) of the Purvis criteria), it could very easily be seen as the mark of the chemicals division of the “GEO” corporation, the differences between the devices (were those differences to be noticed and recalled so as to distinguish one mark from the other) being put down to branding considerations as between the corporation as a whole and the chemicals division. As such, there would be a likelihood of indirect confusion in this case for any of the goods that I have found to have any degree of similarity.

## **CONCLUSION**

99. Subject to appeal, the opposition has succeeded in relation to the following goods, for which the application is refused:

Class 1 Graphite for industrial purposes; Graphene; Artificial graphite for secondary cell batteries; Manganate; Lithium phosphate; Battery electrolytes; Hydrogen; Ammonia for industrial purposes; Esters; Solvents for use in manufacturing processes; Industrial chemicals; Chemical additives for motor fuels; Industrial salts.

100. The application will proceed to registration in respect of the following goods:

Class 1 Adhesives for industrial use.

Class 9 Semiconductors; Lithium ion batteries; Batteries; Lithium secondary batteries; Solar batteries; Graphite electrodes; Nickel-cadmium storage batteries; Plates for batteries.

## **COSTS**

101. As the parties have achieved a roughly equal level of success, I decline to make a costs award.

**Dated this 24<sup>th</sup> day of November 2025**

**John Williams  
For the Registrar**