BL O/0377/24

ON APPEAL FROM

THE UK INTELLECTUAL PROPERTY OFFICE

Tuesday, 23rd April 2024

Before:

MR. GEOFFREY HOBBS KC
(Sitting as the Appointed Person)
(VIA MS TEAMS)

In the Matter of the Trade Marks Act 1994 (as amended)

- and -

IN THE MATTER OF Trade Mark Application No. 3685348 kerb-e in Class 9 in the name of Haroon Shaikh

(Respondent)

- and –

IN THE MATTER OF Opposition No. 429590 in the name of Grid Smarter Cities Limited

(Appellant)

IN THE MATTER OF AN APPEAL of Opposition Decision No. O/0835/23 to the Appointed Person

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(Transcript of the Stenograph Notes of Marten Walsh Cherer Ltd.,
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Ms Eleanor Coates (of Murgitroyd & Company) appeared for the Appellant.

The Respondent did not appear and was not represented.

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APPROVED DECISION

- -

THE APPOINTED PERSON:

1. On 23rd December 2021, Grid Smarter Cities Limited opposed Mr. Haroon Shaikh's application number 3685348, filed on 24th August 2021, to register the designation **kerb-e** as a trade mark for use in relation to "car charger; electric-car charger; charging stations for electric vehicles" in Class 9.

2. The Opponent objected to the application for registration on the basis of the rights to which it was entitled under section 5(2)(b) of the Trade Marks Act 1994 as proprietor of the earlier trade mark **KERB** registered under number 3270228 on 30th September 2018, with a filing date of 13th November 2017, for use in relation to "vehicle parking and storage; parking services; parking space rental" in Class 39.

3. The question raised by the objection to registration under section 5(2)(b) was whether there were similarities in terms of the marks in issue and the services and goods in issue which in August 2021 would have combined to give rise to the existence of a likelihood of confusion if the marks had been used concurrently in the United Kingdom for services and goods of the kind for which they were respectively registered and sought to be registered.

4. No evidence of use was filed in relation to either mark. Evidence relating to the provision of electric vehicle charging facilities, as an adjunct to public and private vehicle parking facilities, was provided by Mr. Neil Herron, founder and director of the Opponent, in a witness statement dated 6th February 2023 in which he stated:

> "2. Now shown to me and marked Exhibit NH1 is pages 1 to 7 of a UK Government consultation entitled 'electric vehicle charging in residential and non-residential buildings' issued in

2018. In the executive summary of this document on page 7, it is stated that the Government proposes that every new non-residential building undergoing a major renovation with more than ten car parking spaces is to have one charge point and cable routes for an electric vehicle charge point for one in five spaces. Furthermore, the Government proposes a requirement of at least one charge point in existing non-residential buildings of more than 20 car parking spaces, applicable from 2025.

3. Now shown to me and marked Exhibit NH2 is an extract from the web page pod-point.com dated 16 December 2022 discussing how the requirements of exhibit NH1 entered into law in England as of June 2022. In particular, the legislation in England relating to building regulations stipulates that residential buildings undergoing a major renovation which will have more than ten parking spaces must have at least one EV charge point per dwelling with associated parking along with cable routes in all spaces without charge points. Furthermore, all new non-residential buildings with more than ten parking spaces must have a minimum of one charge point and cable routes for one in five of the total number of spaces.

4. Now shown to me and marked Exhibit NH3 is an extract from the UK Government website www.gov.uk discussing the award of £20 million to UK local authorities to boost the number of on-street electric vehicle charge points in towns and cities across the UK.

5. Now shown to me and marked Exhibit NH4 is a document issued in August 2019 by the Energy Saving Trust providing guidance for local authorities on how to provide electric vehicle charging provision in parking spaces.

6. Now shown to me and marked Exhibit NH5 is an extract from the website of the parking provider UKCPS Limited discussing the fact that it is now a problem that charge points in car parks for electric vehicles across the country are regularly and deliberately occupied by conventional vehicles not requiring electric charging".

5. The Applicant filed a witness statement dated 5th April 2023 in which he stated:

"2. Now shown to me and marked Exhibit HS1 is a summary of a White Paper presenting a case for the implementation of an 'Electric Road System' (ERS) in the United Kingdom in order to reduce carbon emissions from road traffic. The discussion focuses on one particular form of ERS; overhead catenary systems. A photograph of such a system already implemented in Germany is given as Figure i. Thus, there exist electric vehicle

> charging systems which are in no way associated with vehicle parking spaces.
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> 3. Now shown to me and marked Exhibit HS2 is the UK Government's 'Vehicle licensing statistics: July to September 2022', according to which there were 40.8 million licensed vehicles in the UK at the end of September 2022, of which 1,003,000 were plug-in electric vehicles. Thus, less than 2.5% of licensed vehicles in the UK require charging by external electric power supplies."

6. The Opposition proceeded to determination on the basis of the papers on file, without recourse to a hearing.

7. It was rejected for the reasons given in a decision issued by Ms. Claire Boucher on behalf of the Registrar of Trade Marks under reference BL O/0835/23 on 4th September 2023. The Hearing Officer ordered the Opponent to pay £1,000 to the Applicant in respect of his costs of the Registry proceedings.

8. She rejected the Opposition entirely on the basis that it was unmaintainable for lack of similarity between the services and goods in issue. In paragraph 15 of her decision she set out for comparison the wording of the Applicant's Class 9 specification of goods and the wording of the Opponent's Class 39 specification of services. Moving forward on that basis, she determined as follows:

> "16. I consider there to be a degree of overlap in the end-users of the goods and services: people who use the opponent's goods to charge their vehicles will also be users of the applicant's parking services. There will also be some overlap in the purchaser of the goods, as owners of electric vehicles will buy parking services and may also buy charging points to install at their homes or business premises. The purpose, nature and method of use of the goods and services are different. I also consider that the goods and services will be distributed through different trade channels. One would not expect to acquire a car charger or charging station (as opposed to charging services) through the same distribution channels as parking services. The goods and services are also not in competition with each other.

17. This leaves the question of complementarity, and it is on this point that the opponent's case for similarity between the goods and services rests. The General Court ("GC") said in *Boston Scientific Ltd v OHIM*, Case T-325/06, that goods and services are complementary when: "… there is a close connection between them in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking."

18. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as complementary and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, as they are here. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that responsibility for the goods and services lies with the same undertaking.

19. Mr Daniel Alexander QC, sitting as the Appointed Person, noted in *Sandra Amalia Mary Elliot v LRC Holdings (LUV/LOVE Trade Marks)*, BL O-255-13, that:

'18. … the concept of complementarity is itself not without difficulty. In a number of cases, reference to it does not make the assessment of similarity easier. If tribunals take the explanation of the concept in *Boston* as akin to a statutory definition, it can lead to unprofitable excursions into matters such as the frequency with which certain goods are used with other goods and whether it is possible for one to be used without the other. That analysis is sometimes of limited value because the purpose of the test, taken as a whole, is to determine similarity of the respective goods in the specific context of trade mark law. It may well be the case that wine glasses are almost always used with wine — and are, on any normal view, complementary in that sense — but it does not follow that wine and glassware are similar goods for trade mark purposes.'

…

'20. … It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.'

20. The opponent submits that, to the owners and drivers of electric vehicles, electric vehicle chargers are essential for vehicle parking services. When undertaking a long journey, such a driver would need to plan ahead to make sure that they could

> stop at various points to use charging stations in car parks, for instance at motorway service stations. I accept that the goods and the services would be used together. That, in itself, is not enough for me to find complementarity, as the case law quoted above makes clear. It does not seem to me likely that the average consumer would believe that the goods and services come from the same undertaking, given their difference in nature and the differences in distribution channels.
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> 21. The overlap in user is not, in my view, sufficient for me to find that the goods and services are similar. Where there is no similarity between the goods and services, there can be no likelihood of confusion under section 5(2)(b) of the Act: See *eSure Insurance limited v Direct Line Insurance Plc* [2008] EWCA Civ 842 CA at paragraph [49]. The opposition therefore fails."

9. The Opponent now appeals to this Tribunal under section 76 of the 1994 Act contending, in substance, that the Hearing Officer erred by adopting an over-simplistic 'missing ingredient' approach to the Opponent's objection under section 5(2)(b) which wrongly led to the rejection of it without full examination.

10. Both as between marks and as between goods and services, the evaluation of 'similarity' is a means to an end. It serves as a way of enabling the decision taker to gauge whether there is 'similarity' of a kind and to a degree which is liable to give rise to perceptions of relatedness in the mind of the average consumer of the goods or services concerned.

11. This calls for a realistic appraisal of the net effect of the similarities and differences between the marks and the goods or services in issue, giving the similarities and differences as much or as little significance as the relevant average consumer, who is taken to be reasonably well informed and reasonably observant and circumspect, would have attached to them at the relevant point in time.

12. The factors conventionally taken to have a particular bearing on the question of 'similarity' between goods and services are referred to indicatively and not exhaustively in Case C-39/97 *Canon KK* at paragraph [23] and paragraphs [44] to [47] of the Opinion of the Advocate General in that case.

13. More than just the physical attributes of the goods and services in issue must be taken into account when forming a view on whether there is a degree of relatedness between the consumer needs and requirements, fulfilled by the goods and services on one side of the issue, and those fulfilled by the goods and services on the other.

14. The relatedness or otherwise of the trading activities involved in the comparison is ultimately a matter of consumer perception. That is recognised in the case law relating to 'complementarity' as an element to be considered in the context of the overall assessment of 'similarity'.

15. There is 'complementarity' when the goods or services in issue are closely connected in the sense that one is indispensable or important for the use of the other in such a way that consumers may think that the same undertaking is responsible for manufacturing those goods or providing those services.

16. A finding of 'no similarity' may legitimately be made despite the existence of a degree of 'complementarity' if that 'complementarity' is not sufficiently pronounced for it to be accepted that from the consumer's point of view the goods or services concerned are 'similar' within the terms of section 5(2)(b).

17. It has been affirmed and reaffirmed in a number of cases, one being Case C-398/07P *Waterford Wedgwood PLC* at paragraph 34, that section 5(2)(b) is

inapplicable to situations in which the goods or services in issue are neither identical nor similar. However, an objection to registration under section 5(2)(b) can only be dismissed simply and solely on that ground when it is apparent that the nature and characteristics of the goods or services concerned and the nature and characteristics of commerce in such goods or services are not conducive to a single economic undertaking being reasonably and realistically regarded as responsible for providing them. That is brought out in the analysis of the pre-Brexit case law contained in the post-Brexit Judgment of the General Court in Case T-177/20 *Himmel v EUIPO (Hispano Suiza)*.

18. As contended on behalf of the Opponent on this appeal, it was necessary for the purposes of the comparison required by section 5(2)(b) to be clear as to what the wording of the Opponent's Class 39 specification of services covered relative to the Applicant's Class 9 specification of goods. By virtue of the width of the wording in which it was written, the Class 39 specification encompassed within it the following services: 'electric and plug-in hybrid electric vehicle parking and storage', 'parking services for electric and plug-in hybrid electric vehicles' and 'parking space rental for electric and plug-in hybrid electric vehicles'.

19. I do not see any real recognition of that in the Hearing Officer's decision and I do not accept that it was open to her on the evidence and materials before her to determine that there was 'no similarity' in the sense I have described between such services and the "car charger; electric-car charger; charging stations for electric vehicles" of the opposed application for registration in Class 9.

20. I consider that the decision under appeal wrongly short-circuited the required assessment on the basis of a legally and factually deficient determination of 'no similarity' between the services and goods in issue.

21. For the reasons I have given, the appeal is allowed and the Hearing Officer's decision and order for costs are set aside. The Opposition is remitted to the Registrar for further processing, in accordance with the provisions of the 1994 Act and the Trade Marks Rules 2008 with a view to determination by a different Hearing Officer in due course.

22. Since I consider that the usefulness of the proceedings before me is, from a practical point of view, liable to depend on the outcome of the proceedings as a whole, I direct that the costs of the appeal be treated as costs incurred in the Registry proceedings and dealt with by the Registrar in the usual way at the conclusion of the opposition.

23. That is my decision on this appeal.