O/0511/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003995689

BY UR TRANZIT LTD

TO REGISTER THE TRADE MARK:

IN CLASSES 9, 12, 37 AND 39

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 446972

BY FORD MOTOR COMPANY

BACKGROUND AND PLEADINGS

1. On 26 December 2023, UR TRANZIT LTD ("the applicant") applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 19 January 2024. The applicant seeks registration for the following goods and services under the above application:

Class 9 Electric batteries; Batteries for electric vehicles; Electric batteries for vehicles; Batteries, electric, for vehicles; Solar panels; Solar batteries; Solar cells; Solar cell panels; Electric batteries for powering electric vehicles.

Class 12 Fuel cell electric cars; Electric cars; Electric vehicles; Vehicles (Electric -); Autonomous cars.

Class 37 Charging of electric vehicles.

Class 39 Consultancy services relating to transportation; Transportation.

2. The application was opposed by Ford Motor Company ("the opponent") on 18 April 2024. The application was partially opposed under section 5(2)(b),[1] and fully opposed under section 5(3) of the Trade Marks Act 1994 ("the Act").

3. Under section 5(2)(b), the opponent relies upon the following marks:

UK registration no. UK00003772029
Filing date 30 March 2022; Registration date 24 June 2022.
(the First Earlier Mark)

[1] These opposed goods and services under section 5(2)(b) are listed in the table at paragraph 38 to this decision.

TRANSIT

Comparable UK trade mark (EU) registration no. UK00918051801[2]
Filing date 12 April 2019; Registration date 24 June 2020.
(the Second Earlier Mark)

4. Under section 5(2)(b), the opponent relies upon all of the goods for which its First and Second Earlier Marks are registered, listed in paragraph 38 of this decision. The opponent claims that there is a likelihood of confusion because the goods and services are identical and similar, the marks are visually, phonetically and conceptually similar and the marks are "identical in their distinctive elements".

5. Under section 5(3), the opponent relies upon its Second Earlier Mark, claiming that it has a reputation for its "motor land vehicles", "trucks" and "vans", and that use of the parties' similar marks and identical or closely similar goods, would result in consumers believing that the parties are economically linked. The opponent claims that the applicant "will benefit from the opponent's investment in its advertising and promotion of its trade mark leading to advantage to the applicant without investment", and that use of the applicant's mark will be detrimental to the distinctive character and reputation of the opponent. The opponent also claims that there will be damage to the opponent's reputation if "inferior or different goods are provided to those expected by the public". Lastly, the opponent states that its mark "will be diluted by concurrent use of a similar mark for the same or similar goods/service", it "will cease to indicate exclusive origin" and that there "is no due cause for adoption of the opposed mark".

6. The applicant filed a counterstatement denying the claims made in regard to the similarity of the goods and marks, and a likelihood of confusion. However, I note that the applicant does not rebut or make any submissions in relation to the opponent's claimed reputation.

[2] Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

7. The opponent is represented by HGF Limited and the applicant is unrepresented. Both parties filed evidence in chief. Neither party requested a hearing, however, both parties filed submissions in lieu.[3] I make this decision having taken full account of all the papers and evidence, and I will refer to them where necessary below.

RELEVANCE OF EU LAW

8. 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 PRELIMINARY ISSUE

9. The opponent's evidence consists of the witness statement of Sharon C Sorkin dated 26 September 2024. Ms Sorkin is Chief Trademark Counsel for the opponent, a position she has held since August 2019. Ms Sorkin's statement is accompanied by 28 exhibits (SCS1-SCS28). Ms Sorkin's evidence has been filed in support of showing use of its marks, and in regard to the opponent's reputation.

10. The applicant's evidence consists of the witness statement of Abdelrahman Mousa dated 25 November 2024. Mr Mousa is Chief Executive Officer of the applicant, a position he has held since 5 April 2023. Mr Mousa's statement is accompanied by 18 exhibits (ARM1-ARM18). Mr Mousa's evidence has been filed to "refuse the witness statement submission of Ford Motor Company".

11. I note that Mr Mousa's witness statement also contains submissions; however, I do not consider it too onerous a task to separate the opinions of Mr Mousa from his

[3] On 28 February 2026, the applicant asked the Registry to disregard the opponent's submissions on the basis that they were filed at 6:32pm on 26 February 2026 (the day of the deadline) and therefore they felt they were deprived of an opportunity to respond. However, as per our email of 4 March 2026, the submissions were filed on the day of the deadline and thus were filed in time, and accepted into the proceedings.

statements of fact. Therefore, I will adopt a pragmatic approach, treating the submissions as legal arguments and/or opinions rather than factual statements, even though they are conveyed in a witness statement accompanied by a statement of truth.

12. The submissions contained in Mr Mousa's witness statement includes that the opponent has "*failed to provide sufficient or convincing evidence of goodwill, misrepresentation, and damage*". These are the factors which are assessed in relation to a section 5(4)(a) claim, i.e. passing off. However, the opponent does not rely upon this section. As highlighted above, it is pursuing an opposition relying upon sections 5(2)(b) and 5(3) of the Act only. On this basis, any submissions in regard to goodwill, misrepresentation and damage do not assist the applicant.

DECISION

Section 5(2)(b)

13. Section 5(2)(b) reads as follows:

> "5(2) A trade mark shall not be registered if because –
>
> (a)…
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

14. The opponent's marks qualify as earlier marks in accordance with section 6(1)(a) and (aa) of the Act as their filing dates are earlier than the filing date of the applicant's mark. The opponent's First and Second Earlier Marks had not completed their registration processes more than five years before the relevant date (the filing date of the mark in issue). Accordingly, the use provisions at section 6A of the Act do not

apply. The opponent may rely upon all of its goods without demonstrating that it has used its marks.

Section 5(2)(b) - case law

15. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

> (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, in certain circumstances, be dominated by one or more of its components;
>
> (f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 greater 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; and

(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.

Distinctive character of the earlier trade marks

16. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the Court of Justice of the European Union ("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 C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR 1-2779, 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 promotion of 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)."

17. 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 services, 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.

18. I will first assess the inherent distinctive character of the opponent's marks.

19. The First Earlier Mark consists of the slightly stylised wording "E TRANSIT". While the opponent has not provided any submissions as to the meaning which will be evoked by the letter "E" at the beginning of its mark, I find that the average consumer will understand that the letter "E" is typically used as a shorthand of, or to denote that the goods are "electric".

20. In regard to the meaning of the ordinary dictionary word "TRANSIT", the opponent submits that it conveys "the idea of movement, transportation or passage from one place to another".[4] I note that this is reflected in the Collins Dictionary definition of transit, being "the carrying of goods or people by vehicle from one place to another".[5] Therefore, as a whole, the wording "E TRANSIT" will evoke the meaning of electric transportation.

[4] Paragraph 23 of the opponent's written submissions in lieu.
[5] https://www.collinsdictionary.com/dictionary/english/transit accessed 10 June 2026.

21. In the applicant's counterstatement, they submit that the term "transit" is "widely utilized across the transportation and automotive sectors, diminishing its distinctiveness and association with any single entity. This widespread use supports our assertion that the term has become generic and is used by various businesses to denote transportation services and vehicles".

22. Whilst I note that the applicant has not provided any evidence in support of this assertion, I find that the meaning of the word "transit" clearly describes the purpose of the opponent's class 12 vehicles, which are used to transport people and objects from one place to another. The word electric, which is represented by the letter "E", is also clearly descriptive of the opponent's vehicles which are electric in nature.[6] I also note that the minimal stylisation of the mark (including the underline) also does not add to its distinctiveness.

23. As per *Formula One Licensing BV v OHIM*,[7] the earlier mark must be considered to have at least some distinctive character, and on this basis, I find that the First Earlier Mark is inherently distinctive to a very low degree for its vehicle goods. In regard to the First Earlier Mark's structural parts and fittings for motor vehicles, which would encompass structural parts and fittings for *electric* motor vehicles, the word "electric" which is represented by the letter "E" would be descriptive of such goods. I also find that the word "transit" being used on parts and fittings for electric vehicles is descriptive of their end purpose (i.e. the vehicles and their parts being used for transportation). On this basis, I find that the mark is also inherently distinctive to a very low degree for parts and fittings of motor land vehicles.[8]

24. The Second Earlier Mark consists of the word "TRANSIT". I find that this word is descriptive of the purpose of motor land vehicles, and its parts, fittings and accessories. Nevertheless, bearing in mind *Formula One*, I find that the Second Earlier Mark is inherently distinctive to a very low degree for all of its goods.

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[6] The First Earlier Mark's specification contains the term "electrically powered motor vehicles", and its remaining vehicle terms will also include and cover electric vehicles.
[7] Case C-196/11P
[8] This approach is supported by *Fourneaux De France Trade Mark,* BL O/240/02. Whilst this is indeed a section 3(1) case, it highlighted that cooker hoods and extractor fans are closely connected items of commerce with cookers, and that it would be unrealistic to treat the words FOURNEAUX DE FRANCE (meaning "cookers of France") as descriptive of the character of the latter but not the former.

25. I will now assess whether the evidence filed by the opponent is sufficient to demonstrate enhanced distinctiveness. The relevant market for assessing this is the UK market.

26. In her witness statement, Ms Sorkin highlights that the "Ford Transit Vans" come in "four main models to accommodate different load capacities and different types of transport", including the Ford Transit 350, the Ford Transit Custom, the Ford Transit Courier and the Ford Transit Connect.[9] I note that all of these vans were listed in the top 10 list of best-selling vans of 2023 in the Howden Insurance Brochure published on 23 February 2024.[10]

27. Ms Sorkin states that as of 2015, "8 million Transit vans and 1 million Transit connect vans have been sold worldwide".[11] I have also been provided with the following total unit sales of TRANSIT vehicles in the UK for the years 2018 to 2022:

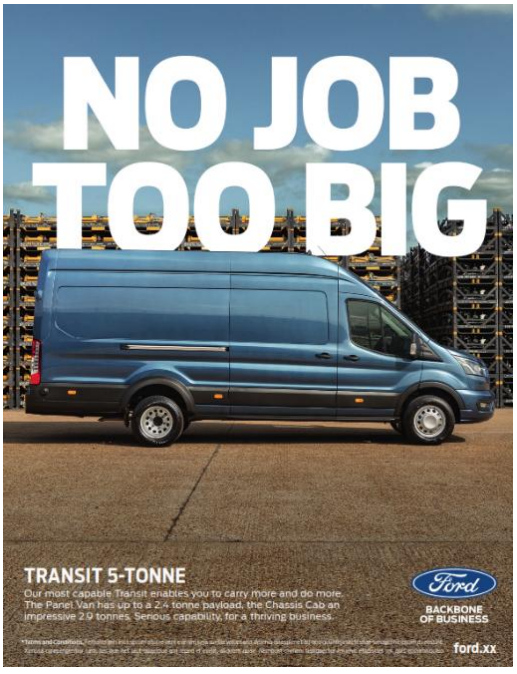
	2018	2019	2020	2021	2022
TRANSIT	34,715	27,456	22,980	34,933	34,561
TRANSIT CONNECT	17,503	15,477	11,344	11,498	8,218
TRANSIT COURIER	4,594	4,666	3,522	3,664	4,539
TRANSIT CUSTOM	55,065	52,998	43,741	53,883	42,762
Total	**111,877**	**100,597**	**81,587**	**103,978**	**90,080**

28. In paragraph 7 of her witness statement, Ms Sorkin says that in 2023, 40,865 Ford Transit Custom vans were sold, making it the best-selling commercial vehicle that year. This is supported by an article from selectcarleasing.co.uk contained in **exhibit SCS3**, titled "Ford Transit Custom tops UK sales chart for 10th year running". The article highlights that in 2023, Ford Transit Custom vans recorded 28,280 registrations, while the compact Ford Transit Connect sold 10,856 units. The article also states that "an all-electric E-Transit Custom will join the range in the second half of the year". At paragraph 5 of her statement, Ms Sorkin highlights that the "E-Transit is the electric version of the van".

[9] **Exhibit SCS2**, the Howden Insurance Brochure refers to all Transit goods using the FORD mark.
[10] **Exhibit SCS2**
[11] Paragraph 4 of her witness statement

29. To support the above, an article contained in **exhibit SCS4**, from the "Ford Media Centre", dated 5 January 2023, states that the "Ford Transit Custom is the best-selling vehicle in the UK for 2022, representing more than one in three one-tonne commercial vehicles sold in the year". The opponent sold "more than double that of its closest competitor- achieving 36.3 per cent of the one-tonne van segment". It also comments on the E-Transit, stating that it has "quickly become the UK's best-selling electric van in the two-tonne segment, with over 1,750 orders received last year". The E-Transit also was "named overall best van by seven outlets" and "received a total of 11 UK awards" in 2022. Lastly, the article mentions the "E-Transit Custom", with production starting in late 2023, being an all-electric van, supported by "Ford Pro software".

30. While in paragraph 10 of Ms Sorkin's witness statement, she confirms that "Ford's local team estimates that around £40 million is spent each year on marketing the brand to the public", she does not confirm if all of this marketing is in relation to goods using the First and Second Earlier Marks. Nevertheless, I have been provided with a variety of advertising examples in **exhibits SCS5** to **SCS8**, such as; Landing page headers and sponsored social media posts from 2020, marketing proofs of posters from 2017 to 2020, posters and vans used at the Commercial Vehicle Show from 2012 to 2023, and posters and vans used for electric roadshows since 2020. Examples of this marketing include:



31. Whilst the majority of the posters above clearly use the word “Ford” followed by the word “Transit”, the bottom two posters in paragraph 30 presents the word “TRANSIT” in large letters in the body of the advertisement, alongside the descriptive wording “5-TONNE”. I also note that all of the above advertising appears to use the following mark in the bottom right hand corner of all the posters:

32. In regard to the above advertising, Ms Sorkin has confirmed that the Commercial Vehicle Show "is the UK's ultimate event for road freight, transport, distribution, and logistics", and that it has "evolved into the largest and most influential gathering of commercial vehicle manufacturers, dealers, distributors and suppliers". At paragraph 13 of her statement, she confirms that the show in 2022 and 2023 attracted over 11,100 and 11,480 visitors respectively.

33. I have been provided with the opponent's Facebook, X, Instagram and YouTube social media pages, all being labelled as "Ford UK" and using the above oval Ford mark as their profile pictures. I have been provided with the amount of followers for these accounts via undated screenshots contained in **exhibits SCS9** to **SCS12**, and therefore I am unable to ascertain how many followers the opponent had before the relevant date. Ms Sorkin states that since the accounts "primarily target UK-based customers, it can be inferred that the majority of people viewing these posts will be located in the UK".[12] Whilst I agree the pages labelled as being for the "UK" is likely to attract UK customers, I also remind myself that such a label does not prevent users from other regions viewing and following this page. I also bear in mind that the majority of the posts within **exhibit SCS10** do not show high user engagement on their Facebook and X posts in regard to their Transit vans. For example, on one of the Facebook posts in regard to a Ford Transit Van, it shows that it received 15 likes, 38 comments and 1 share.[13] I note that this shows very low user engagement. However, the Instagram posts show that between 128 and 235 followers had liked their posts in 2023, (which is still relatively low), in which they referred to the "#FordETransit" courier or the "#FordTransitCustomNugget".[14]

34. In regard to the YouTube videos, I note that all of the titles refer to the goods as "Ford Transit", "Ford Transit Trail", "Ford Transit Custom" or "All-Electric Ford E-Transit".[15] While I have also been provided with independent reviewers on YouTube discussing the opponent's vehicles, the reviews always refer to the opponent's goods

[12] Paragraph 16 of her witness statement
[13] Page 7 of **exhibit SCS9**
[14] **Exhibit SCS11**
[15] **Exhibit SCS12**

by firstly using the word “FORD”, for example, “Ford Transit” or “Ford Transit Connect”.[16]

35. Lastly, the opponent has provided evidence of the awards it has won between 2020 and 2024 for its Transit vehicles in **exhibits SCS14** to **SCS24**. This includes:

1. Auto Express Van of the Year 2020 (Ford Transit Custom)
2. Great British Fleet Awards 2020 (Small Van of the Year - Ford Transit Courier) (Green Van of the Year - Ford Transit PHEV, VFW) (Van of the Year - Ford Transit PHEV)
3. Parkers Awards 2020 - Medium Van of the Year (Ford Transit Custom)
4. Parkers Awards 2021 - Van of the Year (Ford Transit Custom)
5. Parkers Awards 2022 - Van of the Year (Ford Transit Custom)
6. Auto Express Electric Van of the Year 2022 (Ford E-Transit)
7. Top Gear Magazine April 2023- best Electric Van (Ford E-Transit)
8. International Van of the Year for 2024 (Ford Transit) (this was awarded in November 2023, and this is the fifth time that the Ford Transit has won this award, previously winning in 2001, 2007, 2013, 2014 and 2020)
9. Parkers Van and Pickup Awards 2024 – (which was awarded in November 2023) (commercial vehicle of the year, the Best Medium Van and the best Large Van- Ford Transit Custom) (Best Electric Van- Ford E-Transit)
10. What Van? Awards 2024 – (which was awarded in December 2023) (Used Van of the Year and Medium Van of the Year- Ford Transit Custom) (Large Van of the Year and Van of the Year- Ford E-Transit)

36. Whilst the opponent has provided some evidence of use in regard to its First Earlier Mark, that being “E TRANSIT”, it is clear from the above that the E TRANSIT van was produced and winning awards in late 2023. Therefore, the evidence of use is not longstanding. Moreover, and importantly, I bear in mind that the opponent has not provided any UK unit or sales figures for “E TRANSIT” vans, nor have I been provided with any specific marketing figures for the promotion of E TRANSIT goods. I also do not have any invoice evidence to ascertain the geographical spread of sales in the UK.

[16] **Exhibit SCS13**

On this basis, I am unable to ascertain how significant the use of the First Earlier Mark was in the UK, and therefore, I find that the evidence is insufficient to establish enhanced distinctiveness of the First Earlier Mark.

37. In regard to the opponent's Second Earlier Mark, in its Form TM7 they pleaded that "the earlier mark is strongly distinctive both inherently and by virtue of its use".[17] However, this pleading was made under its section 5(3) claim. Nevertheless, I note that this pleading was never rebutted or denied by the applicant in its counterstatement.[18] I also bear in mind that all of the above evidence shows that the word "FORD" or the blue oval "Ford" element has been used in conjunction with the Second Earlier Mark, and the Ford elements are more distinctive than the word "TRANSIT" which is descriptive of the purpose of the opponent's vehicles. It is therefore my view that that "FORD" will be viewed as the house brand. I also find that the distinctive character of the word "TRANSIT" has been acquired due to its use in conjunction with the "FORD" marks, on the basis that it identifies the origin of a product, i.e. the Second Earlier Mark has been used for the purposes of identifying a van called "TRANSIT", which originates from the undertaking Ford. Consequently, the word "TRANSIT" performs the essential function of a trade mark, albeit as a secondary identifier of origin. Nevertheless, the above evidence clearly shows that the opponent has sold a significant amount of vans from at least 2018 in the UK, under the "TRANSIT" mark. I have also been provided with ample evidence showing that the Transit vans have been advertised in the UK, and that they have won multiple awards, making them the "best van of the year" on many occasions. Whilst I have not been provided with the opponent's market share, I note that the 2022 article states that the Ford Transit Custom sold more than double that of its closest competitor, "achieving 36.3 per cent of the one-tonne van segment". Based on this evidence in conjunction with the significant sales figures provided, I find that the opponent would have held a notable share of the van market before the relevant date. However, I bear in mind that use of the "TRANSIT" mark has not been on electrically powered vans.[19] I therefore

[17] Question 13 of Section B
[18] The applicant has also not directly rebutted the statement within its submissions contained in Mr Mousa's witness statement.
[19] Instead, the "E TRANSIT" mark has been used on vans which are electrically powered, but as I have found above, there is not enough evidence of use of this mark to show that the distinctiveness of the First Earlier Mark has been enhanced.

find that the opponent's evidence is sufficient to establish that the Second Earlier Mark's distinctiveness has been enhanced to a medium degree, but only in relation to "vans (excluding electrically powered vans)".

Comparison of goods and services

38. The parties' competing goods and services are as follows:

Opponent's goods	**Applicant's goods and services**
The First Earlier Mark Class 12 Motor vehicles, namely, electrically powered motor vehicles, passenger automobiles, four-wheeled motor vehicles, vans, trucks, off-road vehicles, structural parts and fittings therefor. **The Second Earlier Mark** Class 12 Motor land vehicles; parts, fittings and accessories for motor land vehicles; trucks; passenger automobiles; electric vehicles; sport utility vehicles; vans.	Class 9 Electric batteries; Batteries for electric vehicles; Electric batteries for vehicles; Batteries, electric, for vehicles; Solar panels; Solar batteries; Solar cells; Solar cell panels; Electric batteries for powering electric vehicles. Class 12 Fuel cell electric cars; Electric cars; Electric vehicles; Vehicles (Electric -); Autonomous cars. Class 37 Charging of electric vehicles.

39. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

> "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."

40. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(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.

41. 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."

42. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

43. In *Kurt Hesse v OHIM,* Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that "complementary" means:

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

44. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. (as he then was) noted, as the Appointed Person, in *Sandra Amalia Mary Elliot v LRC Holdings Limited*, BL O/255/13:

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

Whilst on the other hand:

> "… it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together." Whilst on the

other hand: "… it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

Class 9

Electric batteries; Batteries for electric vehicles; Electric batteries for vehicles; Batteries, electric, for vehicles; Electric batteries for powering electric vehicles.

45. In paragraph 31 of its written submissions in lieu, the opponent submits that the applicant's above goods are identical with its "parts, fittings and accessories for motor land vehicles" in its Second Earlier Mark's specification. I bear in mind that I am entitled to treat the class number as relevant to the interpretation of the scope of application,[20] and in this case, class 12 of the NICE classification clearly does not include electric batteries. However, the fact that the parties' goods are in different classes does not, in itself, mean they cannot be identical. In this instance, I consider that parts, fittings and accessories for motor land vehicles, by virtue of its wording, would encompass electric batteries. On this basis, the goods are identical on the principle outlined in *Meric.*

46. However, if I am wrong in my above finding, I nevertheless consider that all of the applicant's electric batteries for vehicles in class 9 would overlap with the opponent's "motor vehicles, namely, electrically powered motor vehicles […]" in its First Earlier Mark's specification and its "electric vehicles" in the Second Earlier Mark's specification.

47. I find that the parties' goods would overlap in trade channels, with the same undertaking producing the electric battery that is to be used within its electric vehicle. The goods are also complementary, on the basis that they are important and indispensable to one another, and the user would believe that the goods derive from the same undertaking. There will also clearly be an overlap in user. Consequently, taking all of the above into account, I find that the parties' goods are similar to a medium degree.

[20] *Altecnic Ltd's Trade Mark Application* [2002] RPC 34

Solar panels; Solar batteries; Solar cells; Solar cell panels.

48. At paragraph 32 of its submissions in lieu, the opponent submits that the applicant's above "solar batteries" is a broad term that would encompass vehicle batteries. However, there is no evidence before me to show that electric vehicles use, or are powered by, solar batteries, solar panels or solar cells. I therefore do not consider that "solar batteries" would typically be used in vehicles.

49. Whilst I bear in mind that "parts, fittings and accessories for motor land vehicles" in the opponent's Second Earlier Mark's specification would encompass batteries, these are only to be used in vehicles and therefore differ in method of use to the applicant's above goods. Whilst all of the parties' goods can be broadly described as being used to generate and store power, the applicant's goods are all solar powered and therefore differ in nature to the opponent's goods. The purpose will also differ as opponent's batteries are used to power cars whereas the applicant's goods would be used to power houses, for example.

50. I also do not consider there to be an overlap in trade channels as the applicant's goods would be sold by solar specialists, whereas the opponent's goods would be sold by vehicle undertakings. The goods are clearly not in competition, nor do I consider them to be complementary in the way described by the case law cited above. Therefore, taking all of the above into account, I find that the applicant's and the opponent's goods are dissimilar.

Class 12

Electric vehicles.

51. The above term appears identically in the Second Earlier Mark's and applicant's marks specifications.

52. Although expressed slightly differently, the applicant's above goods are self-evidently identical to "electrically powered motor vehicles" in the First Earlier Mark.

Vehicles (Electric -).

53. Although expressed slightly differently, the applicant's above goods are self-evidently identical to "electric vehicles" in the Second Earlier Mark's specification and "electrically powered motor vehicles" in the First Earlier Mark's specification.

Fuel cell electric cars; Electric cars.

54. I find that the applicant's above goods fall within the broader category of "electric vehicles" in the Second Earlier Mark's specification and "electrically powered motor vehicles" in the First Earlier Mark's specification. The goods are identical on the principle outlined in *Meric*.

Autonomous cars.

55. The applicant's above goods would also encompass autonomous cars which are electric. Therefore, these goods would fall within the broader term "electric vehicles" in the Second Earlier Mark's specification and "electrically powered motor vehicles" in the First Earlier Mark's specification, and I find that the goods are identical on the principle outlined in *Meric*. Moreover, I also find that the applicant's above goods overlap in nature and purpose with the opponent's "motor vehicles, namely, electrically powered motor vehicles, passenger automobiles, four-wheeled motor vehicles […]" in its First Earlier Mark's specification and its "electric vehicles" in the Second Earlier Mark's specification. This is on the basis that all of the goods are types of vehicles, that transport people and objects via land. However, I appreciate that the method of use of the applicant's goods will slightly differ, on the basis that autonomous cars are driverless vehicles that use AI to navigate, whereas the opponent's goods would need a human to operate and drive them. The goods are not complementary in the way described by the case law cited above, however, they may be in competition (with the user potentially choosing one over the other). I also find that, without any evidence on the contrary before me, the goods are likely to overlap in trade channels. Consequently, I find that the parties' goods are similar to between a medium and high degree.

Class 37

Charging of electric vehicles.

56. The only submission made by the opponent in regard to the applicant's above goods is contained at paragraph 34 of its written submissions in lieu. The opponent claims that the applicant's services and the opponent's electric vehicle goods in class 12 are "clearly similar to and/or complementary".

57. Whilst I note that the parties' goods and services can be used with one another, in the sense that the applicant's services would be used to charge the opponent's "electric vehicles"/" electrically powered motor vehicles", I do not consider that the user of these goods and services would believe that the goods and services are provided by the same or economically linked undertakings. This is on the basis that the applicant's services would be provided by charging points placed at, for example, service stations or car parks. I also do not have any evidence before me to show that makers of electric vehicles provide charging services.

58. Whilst I appreciate that undertakings that produce electric vehicles may provide chargers for their cars, the chargers are goods, and in contention is the service of charging electric vehicles. I therefore do not consider that the goods and services are complementary, nor is there an overlap in trade channels. The goods and services clearly do not overlap in nature and method of use, and they do not overlap in purpose (the vehicles transport whereas the charging services powers the vehicle). The goods and services are also not in competition. I therefore find that the parties' goods and services are dissimilar.

A further consideration

59. Given the field in which the opponent operates, I also consider it necessary to make a finding in relation to the term "vans (excluding electrically powered vans)", for which the Second Earlier Mark has enhanced distinctiveness (which has been explored above).

Class 9

Electric batteries; Batteries for electric vehicles; Electric batteries for vehicles; Batteries, electric, for vehicles; Electric batteries for powering electric vehicles.

60. I have found that the opponent's Second Earlier Mark has enhanced distinctiveness for the term "vans (excluding electrically powered vans)", and I acknowledge that the applicant's above goods will include batteries that are used in non-electric vehicles. Consequently, I remind myself that *Les Éditions Albert René v OHIM*[21] sets out that just because a particular good is used as a part, element or component of another, it should not result in a finding of identity/similarity between those goods. It does not mean that there can never be similarity between such goods where there is overlap in the factors identified in *Treat*. While I find that the parties' goods clearly do not overlap in nature, method of use or purpose, there will be an overlap in trade channels (as the same vehicle undertaking is likely to produce electric and non-electric cars and their parts such as batteries). There will also be an overlap in user. However, the goods are neither in competition nor complementary. Taking all of the above into account, I find that the parties' goods are similar, but only to a very low degree.

Solar panels; Solar batteries; Solar cells; Solar cell panels.

61. I consider that the same comparison applies in paragraphs 48 to 50 above. Without any evidence before me, I am unable to conclude that the applicant's goods are used in "vans (excluding electrically powered vans)". Therefore these goods are not complementary, nor would there be an overlap in trade channels. They also do not overlap in nature, method of use or purpose, nor are they in competition. I therefore find them to be dissimilar.

Class 12

Electric vehicles; Vehicles (Electric -); Fuel cell electric cars; Electric cars.

[21] Case T-336/03

62. The applicant's above goods will overlap in trade channels with the opponent's "vans (excluding electrically powered vans)". There will also be some overlap in purpose and method of use to the extent that all of the goods are used for transportation. Whilst they overlap in nature to the extent that they are all vehicles, the applicants are electric whereas the opponent's vans are not. The goods are not complementary, but they may be in competition. There will also be an overlap in user. On this basis, I find that the goods are similar to a high degree.

Autonomous cars.

63. Without any evidence to the contrary, I find that the applicant's above goods are likely to overlap in trade channels with the opponent's "vans (excluding electrically powered vans)", all of which would be sold by vehicle undertakings. There will also be some overlap in nature and purpose as all of the parties' goods are all types of vehicles, that transport people and objects via land. However, the method of use of the applicant's goods will slightly differ, on the basis that autonomous cars are driverless vehicles that use AI to navigate, whereas the opponent's goods would need a human to operate and drive them. The goods are clearly not complementary, but they may be in competition. I therefore find that the goods are similar to between a medium and high degree.

Class 37

Charging of electric vehicles.

64. I do not consider that the opponent's "vans (excluding electrically powered vans)" are similar to the applicant's above services. The goods and services clearly do not overlap in nature, method of use and purpose, nor are they in competition nor complementary. I also do not consider there to be an overlap in trade channels, as the services are likely to be provided by charging points placed at, for example, service stations or car parks, and the opponent's goods would be provided by vehicle undertakings. Whilst there may be an overlap in user, this is not enough on its own to establish similarity. I find that the parties' goods and services are dissimilar.

65. It is a prerequisite of section 5(2)(b) that the goods and services be identical or at least similar. The opposition will, therefore, fail in respect of the goods and services that I have found to be dissimilar.[22]

66. The opposition under section 5(2)(b) fails for the following goods and services:

Class 9 Solar panels; Solar batteries; Solar cells; Solar cell panels.

Class 37 Charging of electric vehicles.

The average consumer and the nature of the purchasing act

67. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

> (a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;
>
> (b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;
>
> (c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average

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

consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by and enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

68. The average consumer for the goods will be members of the general public, however, I do not discount professional users such as garages which repair and service vehicles. The cost of the vehicle goods is likely to be high, but infrequently purchased. The average consumer will take various factors into consideration, such as the cost, size, their safety features, the reputational standing of the provider and the suitability of the vehicles for their specific needs.

69. For the battery goods which are used within vehicles, whilst these will attract a lower cost, there will still be considerable attention paid by the average consumer to ensure compatibility with their vehicle (particularly given the potential safety/cost implications of installing a part/fitting which is not compatible). I therefore find that a between a medium and high degree of attention will be paid during the purchasing process for all of the goods.

67. The goods are likely to be obtained by self-selection from car dealerships, and their online equivalents. They are also likely to be selected following the perusal of signage on physical premises. Visual considerations are, therefore, likely to dominate

the selection process. However, I do not discount that there may also be an aural component to the purchase of the goods through advice sought from a sales assistant, or via recommendations given through word-of-mouth.

Comparison of the trade marks

71. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) 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 stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

72. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

73. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
 **(the First Earlier Mark)**	

TRANSIT **(the Second Earlier Mark)**	

Overall impression

74. The First Earlier Mark consists of the letter "E" followed by the ordinary dictionary word "TRANSIT", all of which are presented in a minimally stylised, capitalised, black typeface. These elements are also underlined. I find that the letter "E" and the word "TRANSIT" play a greater role in the overall impression, with the stylisation playing a lesser role.

75. The Second Earlier Mark consists of the word "TRANSIT". There are no other elements to contribute to the overall impression which lies in the word itself.

76. The applicant's mark begins with a device which consists of 5 parallelograms, presented in a blue to green gradient, which connect in the middle to create the outline of a star, the centre of which is white. The letters "TM" appear in a very small typeface above the device, which simply denote to the consumer that the mark is a trade mark. Therefore, bearing in mind its meaning, very small size and position, I find that this device plays very little (if any) role in the overall impression. To the right hand side of the device, are the words "UR TRANZIT". Although the eye is naturally drawn to the element of the mark that can be read, as I will come to discuss in the conceptual comparison, the wording "UR TRANZIT" (specifically "TRANZIT") is either descriptive or allusive of the applicant's goods. I therefore find that the star device will play a roughly equal role in the overall impression with the words "UR TRANZIT".

Visual Comparison

The First Earlier Mark and the applicant's mark

77. The word “TRANSIT” in the First Earlier Mark and the word “TRANZIT” in the applicant’s mark overlap in the first, second, third, fourth, sixth and seventh letters. These, therefore, act as visual points of similarity. However, they differ in their fifth letters (S vs Z). This acts as a visual point of difference. I also bear in mind that the First Earlier Mark as a whole is underlined, and begins with the letter “E”. The applicant’s mark also contains the star device, and the “UR” element at the beginning of the mark, a position to which the average consumer usually pays more attention.[23] These all act as visual points of difference. Consequently, I consider that the parties’ marks are visually similar to between a low and medium degree.

The Second Earlier Mark and the applicant’s mark

78. The word “TRANSIT” in the Second Earlier Mark and the word “TRANZIT” in the applicant’s mark overlap in the first, second, third, fourth, sixth and seventh letters. These act as visual points of similarity. However, they differ in their fifth letters (S vs Z). This acts as a visual point of difference. The applicant’s mark also begins with the star device, and the “UR” element which act as additional points of difference. The parties’ marks are, therefore, visually similar to no more than a medium degree.

Aural Comparison

The First Earlier Mark and the applicant’s mark

79. Aurally, the stylisation and underline in the First Earlier Mark, and the star device at the beginning of the applicant’s mark, will not be articulated. The letter “E” and the dictionary word “TRANSIT” in the First Earlier Mark will be given their usual pronunciation.

80. At paragraph 18 of their written submissions in lieu, the opponent submits that “the verbal element ‘UR’ in the Opposed Mark will almost certainly be pronounced ‘Your’, as UR is commonly used as shorthand for ‘your’ or ‘you’re’ in texting and informal online communications.” However, at paragraph 24 of its written submissions in lieu,

[23] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

the opponent also submits that "'UR' may either be viewed as a meaningless term or as an informal shorthand for the word 'Your'". Whilst the first submission was made under the heading "aural analysis" and the second submission was made under the heading "conceptual analysis", the opponent must nevertheless consider that there is a proportion of consumers who may see "UR" as the shorthand of "your" and there is another proportion of consumers who may see "UR" as a meaningless combination of 2 letters. I agree. I also find that both sets of consumers would amount to a significant proportion. For those who see "UR" as a shorthand for "your", they will pronounce it as such. For those who see "UR" as a meaningless combination of 2 letters, they are more likely to pronounce the letters "U" and "R" separately (as an acronym).

81. The "UR" element is followed by the word "TRANZIT", which I consider will be pronounced in the same way as the ordinary dictionary word "transit", as the letters "S" and "Z" have near identical pronunciations. Therefore, on the basis that the words "TRANSIT" and "TRANZIT" in the parties' marks are aurally identical, irrespective of how the "UR" element is articulated in the applicant's mark, I find that as a whole, the First Earlier Mark and the applicant's mark is aurally similar to at least a medium degree.

The Second Earlier Mark and the applicant's mark

82. The Second Earlier Mark consists of the ordinary dictionary word "TRANSIT", which will be given its usual pronunciation. This is aurally identical to the "TRANZIT" element at the end of the applicant's mark. The same considerations in paragraph 80 above in relation to the "UR" element at the beginning of the applicant's mark will apply, and act as an aural point of difference. I therefore find that the parties' marks are aurally similar to between a medium and high degree.

Conceptual Comparison

The First Earlier Mark and the applicant's mark

83. As noted above, I agree with the opponent that the ordinary dictionary word "TRANSIT" in the First Earlier Mark conveys "the idea of movement, transportation or

passage from one place to another".[24] In regard to the letter "E" at the beginning of the mark, I find that it will be understood by the average consumer as a shorthand of, or to denote that the goods are "electric".

84. I bear in mind that in *LIGHT VITAMIN* (word mark) BL O/1174/25, Mr Thomas Mitcheson KC sitting as the Appointed Person stated that the assessment of a conceptual meaning should take place with reference to the parties' goods where there is a potential link between the conceptual meaning of the mark and the goods to which it is affixed. In this case, the letter "E" being affixed to electric vehicles will, of course, evoke the meaning of the word "electric".

85. I also note that the stylisation of the First Earlier Mark does not contribute to its conceptual message.

86. As highlighted above, the opponent submits that the "UR" at the beginning of the applicant's mark will "either be viewed as a meaningless term or as an informal shorthand for the word 'Your'". The opponent also submits that the word "TRANZIT" at the end of the applicant's mark evokes the meaning of movement, transportation or passage from one place to another, especially as the letters "S" and "Z" are often interchangeable.[25] I also remind myself that in *Usinor SA v OHIM*, Case T-189/05, the GC found that:

> "62. In the third place, as regards the conceptual comparison, it must be noted that while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (Lloyd Schuhfabrik Meyer, paragraph 25), he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him (Case T-356/02 *Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT)* [2004] ECR II-3445, paragraph 51, and Case T-256/04

[24] Paragraph 23 of the opponent's written submissions in lieu.
[25] In paragraph 11 of the opponent's written submissions in lieu, they provide multiple examples of the letters "S" and "Z" being interchangeable, including in the words "cosy" and "cozy" and "recognise" and "recognize".

Mundipharma v OHIM – Altana Pharma (RESPICUR) [2007] ECR II-0000, paragraph 57).

87. I therefore agree with the opponent that, due to the aural identity of the words "TRANSIT" and "TRANZIT", and on the basis that these words closely resemble each other (the only difference being the letters "S" and "Z" which are often interchangeable), the average consumer would perceive the word "TRANZIT" at the end of the applicant's mark as evoking the meaning of "TRANSIT". This meaning which is evoked by the word "TRANZIT" is weakly distinctive of the applicant's class 9 and 12 vehicle goods and its parts/fittings.

88. If the "UR" element is seen as the shorthand of "your", this in combination with the word "TRANZIT" will evoke the meaning of "your transit". However, if the "UR" element is seen as a combination of the letters "U" and "R", it will not be assigned any conceptual meaning, nor will it form a unit with the word "TRANZIT". I also bear in mind that the applicant's mark consists of the star device, and will therefore, to some extent, evoke the meaning of a star. Nevertheless, as both of the parties' marks evoke the meaning of "transit", they are conceptually similar to a medium degree.

The Second Earlier Mark and the applicant's mark

89. The Second Earlier Mark is the ordinary dictionary word "TRANSIT". As this meaning is also evoked by the applicant's mark, (with the star device and the "UR" element in the applicant's mark acting as conceptual points of difference), I find that the parties' marks are conceptually similar to a medium degree.

No evidence of actual confusion and honest concurrent use

90. In the applicant's Form TM8, they submitted that "given the distinct nature of our goods and services and our focus on the electric vehicle sector, we believe that *the coexistence of our marks in the marketplace does not pose a tangible risk of confusion amounts the relevant public*". In Mr Mousa's witness statement, he states that the third purpose of filing its evidence is to "prove why UR Tranzit Ltd deserves its rightful registration and subsequent trademark protection. The distinction in brand identity,

product, market segments, and global footprint compared to Ford's "Transit" and "E-Transit" offerings in unequivocally clear and *free of any purported confusion*". To support this, Mr Mousa has provided the applicant's Certificate of Incorporation from Companies House, England and Wales, dated 15 May 2023.[26] Mr Mousa has also provided Certificates of Incorporation for Dubai, the State of Delaware and India dated between 5 April 2023 and 15 April 2024.[27] The evidence also shows that the applicant made agreements with 1 Egyptian and 6 Chinese third party companies "to support [the applicant's] plans and growth strategy globally"[28] which are dated between 9 August 2023 and 16 November 2024. Mr Mousa also provides the applicant's business plan for the next 3 years in paragraph 6 of his witness statement, including 3 prospective clients in the Philippines and Egypt with their estimated project sizes and values.

91. I appreciate that in proceedings before the Tribunal, the applicant can plead the defence of honest concurrent use. To support this, the applicant would need to provide evidence showing the parties' use of their marks side by side in comparable market environments,[29] and, as a result, if the pleading is successful, any likelihood of confusion may be diminished. The evidence to support this defence must be use in the UK, and would typically include sales figures, website screenshots showing the goods for sale, marketing figures and evidence of marketing to show longstanding use in the UK[30] before the relevant date. However, the applicant's claim itself is that the use of their mark "*does not pose a tangible risk of confusion*", and therefore suggests that the applicant believes that its <u>future</u> use does not pose a risk of confusion. On this basis, I find that the defence of honest concurrent use has not been actively pleaded. Nevertheless, even if I was wrong in this finding, I note that the above evidence mainly falls after the relevant date, that being 26 December 2023, and the only evidence provided which pertains to the UK is the Companies House certificate dated May 2023. I am, therefore, unable to determine if UK customer were exposed to, or aware of, the applicant's mark and its services before the relevant date. On this basis, I find that the

[26] **Exhibit ARM1**
[27] **Exhibits ARM2, ARM3** and **ARM5**
[28] Paragraph 5 of Mr Mousa's statement and exhibits **ARM6 to ARM12**
[29] *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 and *Roger Maier and Another v ASOS* [2015] EWCA Civ 220
[30] *Budejovicky Budvar NP v Anheuser-Busch Inc* Case C-482/09, EU:C:2011:605 and *Match Group, LLC & Ors v Muzmatch Ltd & Anor* [2023] EWCA Civ 454 at [115] to [117]

evidence does not establish that the parties' goods and services have been sold side by side in the UK, and as a result, it cannot be shown that the average consumer in the UK is accustomed to distinguishing between the parties' marks without confusing them. Therefore, taking all of the above into account, I reject the applicant's claim of honest concurrent use.

Likelihood of confusion

92. 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. Nevertheless, the standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor* [2025] UKSC 25, as listed in paragraph 15 above.

The First Earlier Mark and the applicant's mark

93. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to between a low and medium degree.
- I have found the marks to be aurally similar to at least a medium degree.
- I have found the marks to be conceptually similar to a medium degree.
- I have found the First Earlier Mark to be inherently distinctive to a very low degree.
- I have identified the average consumer of the goods to be members of the general public and professionals who will select the goods primarily by visual means, although I do not discount an aural component.

- I have concluded that between a medium and high degree of attention will be paid during the purchasing process for the goods.
- I have found the parties' goods to range from being identical to similar to a medium degree.

94. I bear in mind the decision *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch) in which the court confirmed that if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion. Therefore, taking all of the above case law into account, I consider that it is important to ask, 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

95. In this case, the common element shared by the parties' marks is the meaning conveyed by the words "TRANSIT" and "TRANZIT"; being the meaning of movement, transportation or passage from one place to another. This meaning is descriptive of the purpose of the parties' vehicles and their parts and fittings thereof in classes 12 and 9. Consequently, the common conceptual meaning conveyed by the marks is low in distinctiveness, and therefore, even bearing in mind the principle of imperfect recollection, the differences between the two marks take on a greater significance for the average consumer than they might have otherwise.[31] This is especially the case as the common conceptual meaning is conveyed by two differently spelt words; "TRANSIT" vs "TRANZIT" and therefore, I find it unlikely that the average consumer would overlook the difference in spelling between these two descriptive elements.

96. Furthermore, the opponent's mark includes the letter "E" at the beginning of it, and the applicant's mark contains the star device and the letters "UR" at the beginning of the mark. Whilst these elements are not very remarkable, on the basis that the letter "E" evokes the meaning of electric, the star device is not particularly complex, and the letters "UR" either denote the meaning of the ordinary dictionary word "your" or it will be seen as the simple combination of the letters "U" and "R", the fact remains that

[31] *Nicoventures Holdings Ltd v. The London Vape Co Ltd* [2017] EWHC 3393 (Ch) Paragraph 36

these aspects are entirely different".[32] All of these elements also play an equal role in the overall impression of the mark. Moreover, the beginning of the marks tend to make more of an impact than the ends, and the average consumer will be paying a between a medium and high degree of attention when selecting the goods. Therefore, regardless of the identity and similarity of the parties' goods, I do not consider that the average consumer would misremember or overlook these elements, especially as they all create visual and conceptual points of difference between the marks.

97. As highlighted above, the marks have distinguishing features between them which become more significant due to both of the marks and their common elements being lower in distinctiveness. Therefore, taking all of the above into account, I do not consider that there is a likelihood of direct confusion for any of the parties' goods.

98. I will also assess if there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C. sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10:

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

99. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor Q.C. (as he then was),

[32] *Nicoventures Holdings Ltd v. The London Vape Co Ltd* [2017] EWHC 3393 (Ch) Paragraph 36

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.

100. Mr Purvis KC in *L.A Sugar Limited* sets out that there are three main categories of indirect confusion and that indirect confusion 'tends' to fall in one of them. The examples set out by Mr Purvis are not exhaustive. I also note that in regard to indirect confusion, at paragraphs 38 to 43 of its submissions in lieu, the opponent provides the following submissions:

1. The opponent has already created brand extensions of TRANSIT, including E-Transit used on its electric vehicles, and the evidence shows the use of the TRANSIT name in combination with the words CONNECT, COURIER and CUSTOM.

2. It is therefore logical to interpret UR TRANZIT as a brand extension of TRANSIT vehicles.

3. The "UR" prefix may suggest a vehicle that has been tailored to the customer in some way, i.e. a personalised range of vehicles.

4. "When a mark is very well-known, the public pays less attention to surrounding detail relying upon the well-known element and giving less weight to embellishment or non-distinctive elements". "The TRANSIT brand is highly distinctive and famous", and has been "extensively used throughout the UK", and that this "enhanced distinctiveness means there is an increased likelihood of confusion between the marks".

101. The above submissions appear to pertain to the opponent's Second Earlier Mark (the word "TRANSIT" solus) rather than its First Earlier "E TRANSIT" Mark. In particular, point 1 says that the First Earlier Mark is being used as a brand extension of the Second Earlier Mark, and point 2 makes no reference to "E TRANSIT". I also note that the evidence provided by the opponent was not sufficient in establishing

enhanced distinctiveness of the First Earlier Mark, and therefore point 4 does not assist the opponent.

102. Having noticed that the competing trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. Even though the marks share the common conceptual element, being the meaning of the word transit, as highlighted above, this element is descriptive of the purpose of the parties' class 12 vehicles, and the parts and fittings thereof in classes 12 and 9. This results in the First Earlier Mark being inherently distinctive to a very low degree. Therefore the common conceptual element is not so strikingly distinctive that the average consumer would believe that only one undertaking would use it in relation to vehicles and their parts.

103. I bear in mind the opponent's argument in paragraph 100(3) above, being that the "UR" element of the applicant's mark may suggest that it has been tailored in some way, and therefore the addition of this element could indicate a sub-brand of personalised "E TRANSIT" vehicles. However, I find that it is more likely to be viewed as a coincidence that both of the parties' marks contain similarly spelt words that evoke such a descriptive meaning (which results in the First Earlier Mark being inherently distinctive to a very low degree). Consequently, I do not consider that the average consumer would think that the applicant's mark was connected with the opponent, and vice versa. Even if the First Earlier Mark is brought to mind by the applicant's mark, this is mere association, not confusion: see *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81. I find there is no likelihood of indirect confusion.

The Second Earlier Mark and the applicant's mark

104. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to no more than a medium degree.
- I have found the marks to be aurally similar to between a medium and high degree.

- I have found the marks to be conceptually similar to a medium degree.
- I have identified the average consumer of the goods to be members of the general public and professionals who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a between a medium and high degree of attention will be paid during the purchasing process for the goods.
- I have found the Second Earlier Mark to be inherently distinctive to a very low degree.
- I have found that the distinctiveness of the Second Earlier Mark has been enhanced to a medium degree, but only in relation to "vans (excluding electrically powered vans)".
- I have found the parties' goods to be identical to similar to a medium degree.
- I have also conducted my own assessment in relation to the similarity of the parties' goods and services in relation to only the goods for which the Second Earlier Mark has been enhanced, finding the parties' goods to be similar to either a very low degree, between a medium and high degree, or similar to a high degree.

105. I recognise that the distinctiveness of the word "TRANSIT" has been enhanced to a medium degree for "vans (excluding electrically powered vans)", which is a factor in favour of the opponent. I also bear in mind that the applicant's class 12 goods are similar to a high or between a medium and high degree to these goods. This is also a factor in favour of the opponent. However, as noted above, the average consumer will be paying between a medium and high degree of attention to the goods, which not only are expensive in nature, but concern the safety of the driver and passengers of the vehicles. Consequently, the average consumer is less prone to the effects of imperfect recollection. On this basis, I am satisfied that the parties' marks are unlikely to be mistakenly recalled or misremembered as each other. The average consumer is likely to notice the difference in spelling between the words "TRANSIT" vs "TRANZIT". Furthermore, bearing in mind that the beginning of the marks tend to make more of an impact than the ends, the average consumer will not overlook the "UR" element or the star element at the beginning of the applicant's mark, which plays an equal role in the overall impression. Consequently, I do not consider there to be a likelihood of direct

confusion between the parties' marks, even for those goods which are identical, similar to a high degree, or similar to between a medium and high degree.

106. In regard to a likelihood of indirect confusion, I consider that, having noticed that the competing trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. I do not consider that the average consumer, paying between a medium and high degree of attention during the purchasing process would think that the opponent's mark was connected with the applicant or vice versa. Even though the marks share the common conceptual element of the meaning of the word transit, as highlighted above, this ordinary dictionary word is descriptive of the purpose of the parties' class 12 vehicles, and the parts and fittings thereof in classes 12 and 9. Therefore, even though the word TRANSIT in the Second Earlier Mark has been enhanced to a medium degree, albeit only in relation to "vans (excluding electrically powered vans)", I still do not consider that the common conceptual element is of such a level of distinctiveness that the average consumer would believe that only one undertaking would use it in relation to vehicles and their parts. On this basis, the indirect confusion argument submitted by the opponent in paragraph 100(4) does not assist them. I also bear in mind the opponent's submissions in regard to indirect confusion contained in paragraph 100(1) to (3) above, including that the "UR" element of the applicant's mark may suggest that it has been tailored in some way, and therefore the addition of this element could indicate a sub-brand of personalised "TRANSIT" vehicles. However, I find that it is more likely to be viewed as a coincidence that both of the applicant and opponent's marks contain similarly spelt words that evoke such a descriptive meaning (which has only been enhanced from a very low degree to a medium degree within the Second Earlier Mark). I do not consider that the average consumer would think that the applicant's mark was connected with the opponent, and vice versa. Even if the Second Earlier Mark is brought to mind by the applicant's mark, this is mere association, not confusion: see *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81. Taking the above into account, I consider there is no likelihood of indirect confusion.

107. The opposition under section 5(2)(b) fails.

Section 5(3)

108. Section 5(3) of the Act states:

> "5(3) A trade mark which –
>
> (a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark."

109. Section 5(3A) of the Act states:

> "Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected."

110. The relevant case law can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case C-408/01), *L'Oréal SA & Ors v Bellure & Ors* (Case C-487/07), *Interflora Inc & Anor v Marks and Spencer plc & Anor* (Case C-323/09) and *Environmental Manufacturing LLP v OHIM* (Case C-383/12 P). The law appears to be as follows:

> a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24.*
>
> (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26.*

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63.*

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42.*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; Intel, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79.*

(f) The more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oréal*, paragraph 44.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34.*

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74.*

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oréal v Bellure NV, paragraph 40.*

(j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation; *Interflora,* paragraph 74, and the court's answer to question 1 in *L'Oréal*.

111. The conditions of section 5(3) are cumulative. Firstly, the opponent's Second Earlier Mark and applicant's marks must be identical or similar, and I have discussed their level of similarity in paragraphs 78, 82 and 89 above. Secondly, the opponent must show that its Second Earlier Mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must have established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the opponent's mark being brought to mind by the later mark. Fourthly, assuming that the first, second and third conditions have been met, section 5(3) requires that one or more types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

112. The relevant date for the assessment under section 5(3) is the date of application of the applicant's mark i.e. 26 December 2023.

Reputation

113. In *General Motors*, Case C-375/97, the CJEU held that:

> "25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.
>
> 26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.
>
> 27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.
>
> 28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

114. In determining whether the opponent has demonstrated a reputation for the goods in issue, it is necessary for me to consider whether its mark will be known by a significant part of the public concerned with the goods. In reaching this decision, I must take all of the evidence into account including "the market share held by the trade mark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertakings in promoting it."

115. In its counterstatement, the applicant does not make any reference to, nor deny, the opponent's submissions made in regard to its reputation, which it claims to have in relation to "motor land vehicles", "trucks" and "vans". On this basis, I find that the

applicant concedes that the opponent had a reputation for all of these goods at the relevant date.[33]

Link

116. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

> The degree of similarity between the conflicting marks
>
> As noted in paragraphs 78, 82 and 89 above, I have found the Second Earlier Mark and the applicant's mark to be visually similar to no more than a medium degree, aurally similar to between a medium and high degree, and conceptually similar to a medium degree.
>
> The nature of the goods and services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods, and the relevant section of the public
>
> I find that the opponent's "motor land vehicles", "trucks" and "vans" are all broader categories that could encompass electric motor land vehicles, electric trucks and electric vans. I therefore find that the same comparison with the applicant's class 9 electric battery goods conducted at paragraphs 46 and 47 above applies here. The parties' goods are similar to a medium degree.
>
> In regard to the applicant's remaining class 9 goods, that being solar panels, cells and batteries, as noted above, without any evidence before me, I am unable to conclude that these goods are used in vehicles. Therefore I find that the goods are not complementary, nor would there be an overlap in trade

[33] In any event, I note that I found enhanced distinctiveness for the opponent's "vans (excluding electrically powered vans"). I recognise that reputation is not the same as enhanced distinctive character, but the same factors are to be taken into account in both assessments as per *O2 Worldwide Limited v CX02.COM (UK) Limited*, BL O/393/19, paragraph 39. I therefore would have found a reputation in relation to these goods based on the evidence contained in paragraphs 26 and 35 above.

channels. They also do not overlap in nature, method of use or purpose. The goods are also not in competition. I therefore find them to be dissimilar.

The applicant's class 12 electric vehicles clearly overlap in user, method of use, purpose and trade channels with the opponent's "motor land vehicles", "trucks" and "vans". The goods are also in competition. I therefore find that they are similar to a high degree. The applicant's class 12 autonomous cars clearly overlap in user, purpose and trade channels with the opponent's "motor land vehicles", "trucks" and "vans". The goods will also be in competition. I find that they are similar between a medium and high degree.

The applicant's class 37 services are dissimilar to the opponent's "motor land vehicles", "trucks" and "vans" as per my findings at paragraph 56 to 58 above.

In regard to the applicant's class 39 transportation services, that being the movement of people (and goods) via either land, air or water, I find that these services would be provided by transportation specialists. Therefore these services, and the opponent's "motor land vehicles", "trucks" and "vans" clearly do not overlap in trade channels, nature or method of use. However, the goods and services overlap in purpose and user in that they are used to transport the general public, and consequently, they are likely to be in competition (with the user either choosing to purchase a vehicle or travel via transportation services). I therefore find that the goods and services are similar, but only to a low degree.

In regard to the applicant's class 39 consultancy services relating to transportation, they clearly do not overlap in nature or method of use with opponent's "motor land vehicles", "trucks" and "vans". I also do not consider that the goods and services overlap in trade channels (because transportation undertakings will provide consultancy services in relation to transportation, and vehicle undertakings would produce and sell the opponent's goods). The goods and services do not overlap in purpose, nor are they in competition nor complementary. I therefore find that the parties' goods and services are dissimilar.

I note that as per paragraph 68, the relevant section of the public purchasing the parties' goods will be members of the general public and professionals such as garages. The relevant section of the public purchasing the applicant's services will also be the general public.

The strength of the earlier marks' reputation

In its Form TM7, the opponent did not specify what level of reputation it has. Therefore, whilst I have found that the applicant concedes that the opponent's mark has a reputation for motor land vehicles, trucks and vans, I must assess what level of reputation the opponent had at the relevant date.

As summarised at paragraphs 26 to 35 above, I have been provided with the opponent's significant unit of sales made from its vans in the UK, from at least 2018. I have also been provided with examples of the opponent's advertising and the multiple awards won for its Transit vans. Based on this evidence, I found that the opponent's Second Earlier Mark has been enhanced to a medium degree in relation to vans. I recognise that reputation is not the same as enhanced distinctive character, but the same factors are to be taken into account in both assessments.[34] Therefore, while the opponent has not provided any turnover figures for TRANSIT vans, and there is no direct evidence of sales to show geographical spread of the mark (i.e. invoice evidence), taking all of the above into account, I find that the opponent had a relatively strong reputation at the relevant date for vans.

I bear in mind that while "motor land vehicles" will also encompass vans, as a whole, it a broad category which would encompass many other vehicles such as motorcycles, cars and trucks, for which the opponent has not provided any evidence in relation to. However, on the basis that the applicant has conceded the opponent has a reputation for "motor land vehicles" and "trucks", I am bound in finding that they have at least a small reputation for these goods.

[34] *O2 Worldwide Limited v CX02.COM (UK) Limited*, BL O/393/19, paragraph 39

The degree of the earlier marks' distinctive character, whether inherent or acquired through use

I found the Second Earlier Mark to be inherently distinctive to a very low degree for the opponent's motor land vehicles, trucks and vans. This is on the basis that the ordinary dictionary word "transit" is descriptive of these goods, which are used to transit people and objects.

As noted above, I found that the distinctiveness of the Second Earlier Mark has been enhanced to a medium degree, but only in relation to "vans (excluding electrically powered vans)".

Whether there is a likelihood of confusion

I do not consider there to be a likelihood of direct or indirect confusion for the reasons provided in paragraphs 105 and 106.

117. I am now required to determine whether, in this particular case, the relevant public would bring the opponent's Second Earlier Mark to mind when confronted with the applicant's mark. That is, to make a link between them.

118. Whilst I remind myself at this stage that finding a likelihood of confusion is not required in order to find a link would be made between the marks, under section 5(3) the opponent has pleaded that *there is a likelihood that public will believe that goods offered under the contested mark originate from the opponent or an economically linked undertaking*. This is supported by paragraph 65 and 69 of their submissions in lieu, in which they state that:

"The public will link the parties' marks, believing their origin to be economically connected. This constitutes unfair advantage as it is inevitable that association with a well-known highly reputed mark will bring benefit to the Applicant.

[…]

> Consumers are likely to purchase the Applicant's goods and services under the mistaken belief that they originate from the same source as the Opponent's or that the two parties are economically connected, extending the Opponent's brand promise to the Applicant's goods."

119. As can be seen, the opponent's case is predicated on the existence of a likelihood of confusion. There is no separate basis to the claim that a link would be made between the marks.[35]

120. I bear in mind that I have found that the parties' marks are visually similar to no more than a medium degree, which arises from the use of the words "TRANSIT" and "TRANZIT". I have found that these words convey the same meaning, that being the movement, transportation or passage from one place to another, which is descriptive of the purpose of the parties' vehicles and their parts and fittings thereof in classes 12 and 9. Therefore, the shared descriptive and weakly distinctive concept results in the marks being conceptually similar to a medium degree. I also note that for the services which were not opposed under section 5(2)(b), that being the applicant's class 39 transportation services, the meaning conveyed by "TRANZIT" is also descriptive.

121. Under section 5(2)(b), I found there to be no likelihood of direct or indirect confusion on the parties' vehicle goods and their parts and fittings thereof in classes 12 and 9. Under section 5(3), I have found that the applicant's class 39 transportation services are similar to the opponent's vans, but only to a very low degree. I acknowledge that the provisions of section 5(3) offer additional protection, taking into account the repute and distinctiveness of earlier trade mark. Nevertheless, I still do not consider that the relevant public will believe that the user of applicant's mark is economically connected to the user of the opponent's mark (and vice versa). The reputation and distinctive character of the Second Earlier Mark are not such that the differences between the competing marks will be outweighed. As noted above, I have found the purchasing process in this case to be predominantly visual, and therefore the distance between the parties' marks (the star and "UR" element at the beginning

[35] As noted above, the applicant also rebutted that there would be a likelihood of confusion in its counterstatement.

of the applicant's mark, as well as the difference in the letters S vs Z in the descriptive "TRANSIT" and "TRANZIT" elements) is sufficient to offset any similarity between the parties' goods and services. In light of this, I find that upon encountering the marks, the average consumer is unlikely to make a link via confusion between them (i.e. mistaking one mark for the other, or believing that they are economically connected). Therefore, the opponent's claim in respect of a link (and therefore damage) fails.

122. As noted above, the applicant's class 39 consultancy services relating to transportation were not opposed under section 5(2)(b). However, I have found these services to be dissimilar to the opponent's goods for which I have found a reputation. I also note that I found the applicant's class 9 solar panels, solar batteries, solar cells and solar cell panels, and class 37 charging of electric vehicles, to be dissimilar to the opponent's goods (and the opposition for these goods and services failed under section 5(2)(b)). In regard to these goods and services, I remind myself that finding similarity between them is not required in order to find a link would be made between the parties' marks. However, the closeness of the goods and services is a factor to taken into account when considering if the use of the later mark would bring the earlier mark to mind.

123. I have found the opponent's motor land vehicles, trucks and vans and the applicant's solar batteries/panels/cells, its charging of electric vehicle services and its consultancy services relating to transportation are entirely different in nature, method of use, purpose, and trade channels. I have therefore found them to be dissimilar based on the factors identified in *Treat*.[36] While this case is usually applied in the context of a section 5(2)(b) claim, I find that the *Treat* factors can be considered, and are useful when assessing the similarity of the parties' goods and services in the context of section 5(3).

124. Notwithstanding the fact that the parties' goods and services are likely to overlap in user, I find that the above goods and services are too removed from one another. I consider that the distinctiveness of the Second Earlier Mark, and its reasonably strong repute, is still not sufficient to bridge the distance between parties' marks and their

[36] [1996] R.P.C. 281

dissimilar goods and services. In light of this, I consider that upon encountering the marks, the average consumer is unlikely to make a link via confusion between them (i.e. mistaking one for the other, or believing that they are economically connected). Consequently, as I have found there to be no link between the marks in the minds of the relevant public in the UK, there can be no resulting damage caused to the opponent's Second Earlier Mark.

125. For the other types of damage that the opponent has pleaded, that being dilution and detriment to repute and distinctive character of the earlier mark, these fail because I have found the opponent's claim in respect of link failed.

126. The opposition based upon section 5(3) of the Act is dismissed.

CONCLUSION

127. The opposition is unsuccessful, and the application may proceed to registration.

COSTS

128. The applicant has been successful and would normally be entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023.

129. However, as the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal wrote to the applicant and invited them to indicate whether they intended to make a request for an award of costs. The applicant was informed that, if so, they should complete a Pro Forma, providing details of their actual costs and accurate estimates of the amount of time spent on various activities associated with the proceedings. They were informed that "if the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time) may not be awarded".

130. The applicant did not file a completed Pro Forma and paid no official fees. That being the case, I make no award of costs in this matter.

Dated this 16th day of June 2026

L FAYTER

For the Registrar