

**BL O/0564/25**

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001722156 IN THE NAME OF BELDEN INC. FOR THE TRADE MARK



IN CLASS 9

AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. OP000443305

BY PRYSMIAN S.P.A.

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF N BARRATT (O/0276/25) DATED 21 MARCH 2025.

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DECISION  
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**Introduction**

1. This is an appeal by Belden Inc. ("**Appellant**") from decision O/0276/25 of N. Barratt ("**Decision**") concerning the opposition by Prysmian S.P.A. ("**Respondent**") to the Appellant's application under International Registration No. WO0000001722156 for the following mark ("**Application**"):



2. The International Registration is derived from an earlier trade mark registered by the holder in the USA, and benefits from the priority date of 18 August 2022, being the filing date of the Appellant's US mark. The International Registration was registered on 14 February 2023 and on

the same day the Appellant designated the UK as a territory in which it sought protection, for *Electronic wires and cables* in Class 9.

3. The International Registration was published in the Trade Marks Journal on 30 June 2023, and on 28 September 2023 the Respondent filed an opposition under ss. 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 ("**the Act**"). However, the Respondent subsequently withdrew the s. 5(4)(a) ground, meaning that the opposition proceeded on the basis of s. 5(2)(b) only.
4. The Respondent relied upon International Registration No. WO0000001596868 ("**Earlier Mark**") for the mark shown below, relying on *Electric cables; optical cables; fiber optic cables; data cables* in Class 9:



5. The Earlier Mark was registered on 22 March 2021, and protection in the UK was granted on 4 February 2022. The Earlier Mark benefits from an earlier priority date of 8 March 2021.
6. The Appellant filed a counterstatement denying the claims made against it, and filed evidence. Neither party requested a hearing, and only the Appellant filed written submissions in lieu. N. Barratt for the Registrar decided on the papers that the Application should be refused protection in the UK for all goods for which protection was sought.
7. On 17 April 2025 the Appellant filed a Notice to Appeal to the Appointed Person against the Decision under Section 76 of the Trade Marks Act 1994.

#### **The Hearing Officer's decision**

8. The Hearing Officer held as follows (in summary, and insofar as is relevant to this appeal):
  - a. The average consumer could include both professionals such as electricians and telecommunications engineers, and members of the general public as well as business users. The level of attention paid would be at a medium level. The selection process would be primarily visual, although an aural component via word of mouth recommendations cannot be ignored;
  - b. The dominant element of both marks is the wording ECO CABLE, with the figurative elements playing a secondary role in the overall impressions of the marks;
  - c. The marks are visually similar to a high degree, aurally identical and conceptually identical;
  - d. The Earlier Mark has a low degree of distinctive character;
  - e. The goods are identical;
  - f. There is a likelihood of direct confusion, alternatively a likelihood of indirect confusion. The opposition therefore succeeded.

#### **Grounds of Appeal**

9. The Appellant's Grounds of Appeal are as follows:
- a. **Ground 1:** The Hearing Officer was wrong to give no weight to an earlier decision by the EUIPO refusing the Appellant's application for the word mark ECO CABLE.
  - b. **Ground 2:** The Hearing Officer was wrong to consider the words ECO CABLE as the dominant and distinctive component of the Earlier Mark.
  - c. **Ground 3:** The Hearing Officer failed to take into account the evidence provided as to the identity of the average consumer, and erred in focusing on the retail trade.
  - d. **Ground 4:** The Hearing Officer erred in dismissing the Appellant's contention that it is making honest concurrent use of its mark.
  - e. **Ground 5:** The Hearing Officer was wrong to give no weight to an EUIPO decision relating to the EU equivalents of the marks in suit.
  - f. **Ground 6:** The Hearing Officer's finding that the image (within the Earlier Mark) of three white circles inside a circular border would not be recognised by the average consumer as denoting a cable cross-section is not rationally supportable.
10. The Appellant's trade mark attorney, Barbara Cookson, expanded upon the above in her helpful skeleton argument and at the hearing, and I set out below further details as are necessary to understand my overall conclusions. The Respondent played no part in this appeal.

#### **Standard of review**

11. The approach to be adopted in an appeal hearing has been laid down a number of times in case law. It was summarised in *Axogen v Aviv* [2022] EWHC 95 (Ch) at §24-25:

#### **"Appellate Function**

24. Although I was referred to numerous cases on the subject (including *English v Emery Demibold & Struck Ltd* [2002] 1 WLR 2409, *REEF Trade Mark* [2003] RPC 5, *Fine & Country Ltd v Okotoks Ltd* [2014] FSR 11, *Fage UK Ltd v Chobani UK Ltd* [2014] EWCA Civ 5, *Shanks v Unilever Plc* [2014] RPC 29, *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17, *Apple Inc v Arcadia Trading Limited* [2017] EWHC 440 (Ch), *Actavis Group PTC v ICOS Corporation* [2019] UKSC 1671 and *NINEPLUS O/039/21*), the approach of the appeal court to a statutory appeal under section 76(1) of the TMA is uncontroversial. I bear the following principles, relevant to the issues before me, firmly in mind:

- i) The appeal is by way of a review, not a rehearing (see *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17) at [52(i)]);
- ii) The appeal court will allow an appeal where the decision of the lower court was "wrong" (see CPR 52.11). Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffices to justify interference (*NINEPLUS O/039/21* at [14]);
- iii) The decision of the lower court will be "wrong" if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. Absent an error of law, the appellate court would be justified in concluding that the decision of the lower court

was wrong if the judge's conclusion was "outside the bounds within which reasonable disagreement is possible" (*Actavis Group* at [81]);

- iv) The approach required by the appeal court depends on a number of variables including the nature of the evaluation in question (*REEF Trade Mark* [2003] RPC per at [26]). There is a "spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision" (*TT Education* at [52(ii)]), with decisions of primary fact at one end of the spectrum and multi-factorial decisions (of the type which the parties agree were made in this case by the Hearing Officer) being further along the spectrum.
- v) In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions (*TT Education* at [52(iv)], *REEF* at [28] and *Fine & Country* at [50]-[51]).
- vi) An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. The evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible (*Actavis Group* at [80]).
- vii) Another variable to be taken into account will be "the standing and experience of the fact-finding judge or tribunal" (*REEF* at [26], *Actavis Group* at [78]). Expert tribunals are charged with applying the law in the specialised fields and their decisions should be respected unless it is quite clear that they have misdirected themselves in law. Appellate courts should not rush to find such misdirections simply because they might have reached a different conclusion on the facts (*Shanks* at [28] citing the warning given by Baroness Hale in *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49).
- viii) The appellate court should not treat a judgment as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed; "The duty to give reasons must not be turned into an intolerable burden" (see *REEF* at [29]). The reasons need not be elaborate. There is no duty on a judge, in giving her reasons, to deal with every argument presented by counsel in support of his case. It is sufficient if what she says shows the basis on which she has acted (*English* at [17], *Fage* at [115]). The issues the resolution of which were vital to the judge's conclusions should be identified and the manner in which she resolved them explained (*English* at [19]).
- ix) In evaluating the evidence, the appellate court is entitled to assume, absent good reason to the contrary, that the first instance judge has taken all of the evidence into account (*TT Education* at [52(vi)]).

12. To the above should be added:

- The judgment of the Court of Appeal in *Lidl Great Britain Ltd v. Tesco Stores Ltd* [2024] EWCA Civ 262, where Arnold LJ said at §110 "It is common ground that, in so far as the

appeals challenge findings of fact made by the judge, this Court is only entitled to intervene if those findings are rationally insupportable"; and

- The Supreme Court's guidance in *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8 where it stated at §49 "...on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out the balancing exercise afresh but must ask whether the decision of the judge was wrong by reason of an identifiable flaw in the judge's treatment of the question to be decided, such as a gap in logic, a lack of consistency, or a failure to take into account some material factor, which undermines the cogency of the conclusion".

13. In the context of appeals relating to the likelihood of confusion, an evaluative issue described by Mr Iain Purvis QC sitting as an Appointed Person in *ROCHESTER Trade Mark* BL O/049/17 at [31] as "indeterminate and open to debate", Mr Purvis QC went on to say this at [33]:

"...the reluctance of the Appointed Person to interfere with a decision of a Hearing Officer on likelihood of confusion is quite high for at least the following reasons:

- (i) The decision involves the consideration of a large number of factors, whose relative weight is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case
- (ii) The legal test 'likely to cause confusion amongst the average consumer' is inherently imprecise, not least because the average consumer is not a real person
- (iii) The Hearing Officer is an experienced and well-trained tribunal, who deals with far more cases on a day-to-day basis than the Appellate tribunal
- (iv) The legal test involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade. Any wise person who has practised in this field will have come to recognize that it is often very difficult to make such a prediction with confidence. Jacob J (as he then was) made this point in the passing off case *Neutrogena v Golden* [1996] RPC 473 at 482:

'It was certainly my experience in practice that my own view as to the likelihood of deception was not always reliable. As I grew more experienced I said more and more "it depends on the evidence."'

Any sensible Appellate tribunal will therefore apply a healthy degree of self-doubt to its own opinion on the result of the legal test in any particular case.

34. I shall therefore approach this appeal on the basis that in the absence of a distinct and material error of principle, I ought not to interfere with the decision of the Hearing Officer unless I consider that his view on the issue of likelihood of confusion was clearly wrong in the sense that it was outside the range of views which could have been reasonably taken on the established facts."

14. I shall bear all the above in mind when reviewing the Decision.

## Discussion

**(1) The Hearing Officer was wrong to give no weight to an earlier decision by the EUIPO refusing the Appellant's application for the word mark ECO CABLE**

15. In its counterstatement below, the Appellant referred to a decision by the EUIPO Board of Appeal on 6 November 2013, under case R0416/2013-4, in which the Appellant's application to register the word mark ECO CABLE was rejected. The Appellant contended that this decision confirms that both words ECO and CABLE either alone or in combination are completely descriptive and devoid of distinctive character.
  16. The Hearing Officer said at §13 "While this decision is noted, it is of no relevance to the present opposition". The Appellant contends that, given that the UK was a member of the EU at the time that earlier decision was handed down, the Hearing Officer should have given it significant consideration.
  17. As I see it, it is not necessary for me to deal with this ground 1, because the Hearing Officer made a finding (at §45) that the wording is "descriptive of the goods relied upon". Therefore, the Hearing Officer's analysis would have been unchanged even had account been taken of the earlier EUIPO decision.
- (2) The Hearing Officer was wrong to consider the words ECO CABLE as the dominant and distinctive component of the Earlier Mark**
18. The Hearing Officer, after citing the usual summary of the correct approach to determining likelihood of confusion in *Sabel v Puma*, said at §34:

"It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks".
  19. At §39 the Hearing Officer held (in relation to the Earlier Mark):

"I remind myself that consumers tend to be drawn to parts of the mark that can be read. Given this, I find that it is 'ECO CABLE' that will dominate the overall impression of the mark. As for the figurative elements, I find that the leaf device will play a secondary role in the overall impression of the mark due to its size and position within the mark whereas the figurative concentric circle elements will play an even less role. Lastly, I appreciate the presence of a coloured background, however, this is nothing more than a banal background element that will have a negligible impact on the mark as a whole".
  20. In my view, the Hearing Officer fell into error in the above analysis. At §45 the Hearing Officer held:

"I have discussed above that the message conveyed by the opponent's mark is of a cable that is environmentally friendly. I consider this is descriptive of the goods relied upon. That being said, I repeat what I have above in that by virtue of being a registered trade mark, it is afforded at least some distinctive character" (my underlining).
  21. Once the Hearing Officer had decided that the words were descriptive of the goods, it was not open to the Hearing Officer to decide that the words were nonetheless the dominant element of the Earlier Mark. Whilst the Hearing Officer was right to say that by virtue of being a registered mark, the Earlier Mark must be assumed to have at least some distinctive character<sup>1</sup>, this does not mean (in the context of a figurative mark) that the words themselves must be

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<sup>1</sup> At §13 the Hearing Officer cited *Formula One Licensing BV v OHIM*, Case C-196/11P as authority for this proposition.

assumed to have some distinctive character. Rather, where (as here) the words themselves are wholly descriptive, the distinctive character must reside wholly or mainly in the stylised elements of the Earlier Mark.

22. The second ground of appeal accordingly succeeds.

**(3) The Hearing Officer failed to take into account the evidence provided as to the identity of the average consumer, and erred in focusing on the retail trade**

23. The Appellant contends that “The Hearing Officer failed to take into account the evidence provided and, in particular, when making assessments of the average consumer, he failed to take into account the purchasing process and the significance to that consumer of the visual elements of the mark. He instead focuses on the retail trade, despite the catalogues in Exhibits NB2 and NB3 illustrating the uses of these cables and the invoices NB4 all being business-to-business”.

24. The Hearing Officer’s analysis of the average consumer at §30 was:

“The average consumer for the goods at issue will vary and could include professionals, such as electricians or telecommunications engineers, or members of the general public at large as well as business users. Regardless of the identity of the consumer, the goods are generally going to be selected via general retailers or retailers specialising in electronic goods. In such retailers, the goods will be displayed on racks or shelves where they will be self-selected by consumers. The goods are also likely to be selected online via those retailers’ websites where the goods will be selected after the consumers view images of them. I consider that the selection process will be primarily visual. That being said, I cannot ignore the fact that an aural component will play a role via word-of-mouth recommendations or discussions with sales staff”.

25. I do not accept that the Hearing Officer erred in any way in the above. The Hearing Officer took both retail and professional purchasers into account, and held that the selection process is primarily visual. It was for the Hearing Officer to decide what weight to give to the evidence submitted.

26. I dismiss this third ground of appeal.

**(4) The Hearing Officer erred in dismissing the Appellant’s contention that it is making honest concurrent use of its mark**

27. This fourth ground of appeal is relevant only if the Hearing Officer’s finding of a likelihood of confusion is upheld. I shall accordingly revisit it below should that be necessary.

**(5) The Hearing Officer was wrong to give no weight to an EUIPO decision relating to the EU equivalents of the marks in suit**

28. At §14 the Hearing Officer said:

“In its written submissions in lieu, the holder states that there is a parallel opposition under number B 003200619 at the EUIPO against the EU designation. The holder states that this file is now closed and ready for a decision. While noted, I am unsure of the relevance of this point to present opposition as (1) no decision has been issued and (2) even if it had, it would not be binding on the decision I must make here”.

29. I have reviewed the Appellant’s submissions below, which stated:

“There is a parallel opposition B 003200619 at the EU IPO against the EU designation. The Holder has submitted similar evidence to that before the UKIPO and the Opponent has made extensive submissions through its Italian representative. The file is now closed as of 14th June 2024 and is ready for a decision. Its progress can be checked here: <https://euipo.europa.eu/eSearch/#details/trademarks/W01722156/opposition/003200619>”.

30. The EUIPO decision was, I understand, issued on 24 July 2024, and reissued on 25 September owing to an administrative error relating to costs. It appears that the Hearing Officer was not aware of the EUIPO decision being handed down. In my view, the Appellant should have expressly drawn the Hearing Officer’s attention to the EUIPO decision, rather than leaving it for the Hearing Officer to check whether it had been issued. In the circumstances, I do not consider that the Hearing Officer was wrong to give no weight to the parallel EUIPO decision.

31. I dismiss this fifth ground of appeal.

**(6) The Hearing Officer’s finding that the image (within the Earlier Mark) of three white circles inside a circular border would not be recognised by the average consumer as denoting a cable cross-section is not rationally supportable**

32. At §39 the Hearing Officer said (in relation to the Earlier Mark, set out again below for convenience):

“The holder states in its written submissions in lieu that the opponent’s mark includes a depiction of a cross-section through a cable (the arrangement of white circles), although I cannot see that the opponent has argued this. I do not believe the average consumer would view this arrangement of white circles as a cross section through a cable”.



33. Whereas I agree with the Appellant that the average consumer would, in the context of a mark containing the wording “ECO CABLE”, be likely to understand the element on the right as a cross-section through a cable, the analysis of the marks was a matter for the Hearing Officer, and I cannot say that the Hearing Officer’s finding to the contrary was rationally insupportable, or wrong in the sense described at §11 above.

34. I dismiss this sixth ground of appeal.

#### **Re-evaluation of likelihood of confusion**

35. Given that I have overturned the Hearing Officer’s analysis of the dominant elements of the Earlier Mark, it is necessary for the likelihood of confusion to be re-evaluated. I could remit the matter to the Hearing Officer, however the Appellant asks me to carry out the re-evaluation myself, and the respondent has chosen not to file any submissions on this (or indeed any other) matter. In the circumstances, I consider it is appropriate for me to carry out the re-evaluation myself.

36. In *Nicoventures Holdings Limited v The London Vape Company Ltd* [2017] EWHC 3393 (Ch), Birss J (as he then was) allowed an appeal from the Registrar in which an opposition to a trade mark application was upheld. At §§34-36 Birss J said:

“Each mark includes as important elements the terms VAPE and CO. There is more to each mark than that because they each include stylised features which are unremarkable but are different from one another (decision paragraphs 27 and 28). The point is that the marks do have a high degree of visual, aural and conceptual similarity (paragraphs 29-31) but that similarity arises from the common elements of the terms VAPE and CO and the combination of those two words. Bearing in mind the goods and services for which these marks are registered or applied for respectively, those words individually are both descriptive and non-distinctive. Put together the combination is also descriptive and non-distinctive.

As the Hearing Officer held in paragraph 31 they connote an undertaking in the vaping market. The average consumer, who is a member of the general public over 18 years old, will pay a relatively high degree of attention to the selection of goods and a reasonable level of attention to the selection of services.

Bearing all this in mind but in particular having regard to the low degree of distinctiveness about the features these two marks have in common, even taking into account imperfect recollection the differences in the two marks will take on a greater significance for the average consumer than they might otherwise. Although the stylised aspects of each mark are not very remarkable, the fact remains that these aspects are entirely different. From the point of view of visual similarity, the likelihood of confusion is low. Considering conceptual similarity, the concept the two marks share is entirely down to their non-distinctive elements. It is the common concept which is non-distinctive. That does not lead to a likelihood of confusion. In some ways the respondent’s best case could be thought to come from considering the aural similarity. From that point of view of course the visual stylised elements will not be present, and hearing “Vape dot co” or “THE Vape dot co” is not so far away from hearing “Vape and co” but the fact is again that they are not the same and what they share is entirely non-distinctive when one bears in mind this is all in the context of electronic cigarettes”.

37. Although *Nicoventures* was not cited to the Hearing Officer, the principle it establishes was cited by the Appellant in its submissions below as follows: “The only common elements are the descriptive words which would not be regarded by the professional consumers in the UK as proprietary in any way”. I consider that that was sufficient to alert the Hearing Officer that the principle was relied upon by the Appellant.

38. Whereas each case must of course turn on its own facts, this particular case is in my view on all fours with *Nicoventures*. In particular:

- The goods in question are identical;
- The selection process is primarily visual, with a medium level of attention paid;
- Whereas the marks have a high degree of visual, aural and conceptual similarity, that similarity arises from the common elements of the terms ECO and CABLE and the combination of those two words. Bearing in mind the goods for which these marks are

registered or applied for respectively, those words individually are both descriptive and non-distinctive. Put together the combination is also descriptive and non-distinctive;

- The Earlier Mark has a low degree of distinctiveness;
- Paying particular regard to the low degree of distinctiveness about the features the two marks have in common, even taking into account imperfect recollection the differences in the two marks will take on a greater significance for the average consumer than they might otherwise. Although the stylised aspects of each mark are not very remarkable, the fact remains that these aspects are entirely different.

39. Accordingly, there is no likelihood of direct confusion.

40. As to indirect confusion, the Hearing Officer found a likelihood primarily on the basis of the shared wording. However, given that the shared wording is entirely descriptive, the average consumer would need to look to the other elements of the marks to deduce the origin of the goods. Given that the stylised aspects of each mark are entirely different, there is nothing that could give rise to a “proper basis”, as required under *Liverpool Gin*, for finding a likelihood of indirect confusion.

41. That being so, there is no need for me to consider the issue of honest concurrent use pursuant to ground 4.

### **Conclusion**

42. The appeal is successful. The Application will proceed to grant in the UK.

### **Costs**

43. Clearly, the Appellant has been the successful party in this appeal. In accordance with the scale costs in TPN 1/2023, I order that the Respondent should pay the Appellant the sum of £1,500.

44. As for the costs below, the Hearing Officer ordered that the Appellant should pay the Respondent £350. I set that costs order aside, and reverse it, such that the Respondent shall pay the Appellant £350 towards its costs below.

45. Accordingly, the Respondent must pay the Appellant the sum of £1,850 within 21 days of this decision.

**Dr. Brian Whitehead**

**23 June 2025**

### **Representation**

Ms Barbara Cookson, trade mark attorney, of Lucas & Co for the Appellant/ Applicant

The Respondent/ Opponent played no part in this appeal