O-0694-25

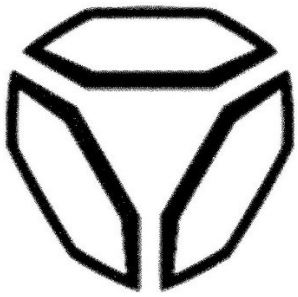
TRADE MARKS ACT 1994

IN THE MATTER OF

INTERNATIONAL TRADE MARK NO. WO0000001710761

DESIGNATING THE UNITED KINGDOM

FOR THE FOLLOWING TRADE MARK:



IN THE NAME OF KAWASAKI MOTORS, LTD.

IN CLASSES 12, 35 & 37

AND

APPLICATION FOR INVALIDATION THERETO (UNDER NO.506652)

BY

YADEA TECHNOLOGY GROUP CO., LTD.

Background & pleadings

1. Kawasaki Motors, Ltd. ("the holder") is the holder of International Registration ("IR") no. WO1710761 ("the designation") in respect of the trade mark set out on the title page of this decision. Protection in the UK was designated on 18 April 2023 based on a Japanese priority date of 1 November 2022. The designation was published in the Trade Marks Journal on 17 February 2023 in classes 12, 35 and 37. The specifications have subsequently been restricted and a WIPO notification to this effect was received on 6 December 2024. The goods and services as they now stand are set out in Annex 1 of this decision.

2. Yadea Technology Group Co., Ltd. ("the cancellation applicant") applied on 26 October 2023 under section 47(2) of the Trade Mark Act 1994 ("the Act") to fully invalidate the above registration initially on the grounds of sections 5(2)(b), 5(3), 5(4)(a) and 5(4)(b). The grounds of invalidation under section 5(3) and 5(4)(a) were subsequently withdrawn by the cancellation applicant. Under section 5(2)(b) the cancellation applicant relies on the following UK Trade Mark.

UK TM No.3820805	**Goods & services relied on**
YADEA Filing Date: 17 August 2022 Registration date: 11 November 2022	9: Navigational instruments; rearview cameras for vehicles; voltage regulators for vehicles; protective helmets; anti-theft warning apparatus; locks, electric; batteries, electric, for vehicles. 12: Electric bicycles; Bicycles; Motorcycles; Motor scooters; Mopeds; Electric vehicles; Motors, electric, for land vehicles; Mobility scooters; Motorcycle engines; Tricycles; Vehicles for locomotion by land, air, water or rail; Remote control vehicles, other than toys; Tyres for vehicle wheels; Cars; Vehicle wheels; Motorcycle saddles;

	Motorcycle frames; Delivery tricycles; Casings for pneumatic tyres; Driving motors for land vehicles. 35: Online advertising on a computer network; providing business information via a web site; commercial information agency services; import-export agency services; sales promotion for others; marketing; provision of an online marketplace for buyers and sellers of goods and services; administrative processing of purchase orders.

3. Under section 5(4)(b) the cancellation applicant claims that the above earlier mark has been protected by copyright as a graphic work since 1 February 2016. However, in the cancellation applicant's evidence, which I discuss later in this decision, the subject of copyright protection is given as the device, namely  .

4. The holder filed a counterstatement in which it denied that the respective trade marks were similar. With regard to the goods and services, the holder admitted there was identity or similarity between its class 12 goods and the cancellation applicant's class 12 goods. Furthermore the holder also admitted that there was a degree of similarity between its classes 35 and 37 and the cancellation applicant's class 12 goods. No other similarity between the respective goods and services was admitted.

5. The cancellation applicant's registration has a filing date that is earlier than the priority date of the holder's designation and is therefore considered an earlier mark, in accordance with section 6 of the Act. As it has not been registered for five years or more before the filing date of the application for invalidity, it is not subject to the proof of use requirements, as per section 47(2A) of the Act.

6. Both parties filed evidence, and the holder filed written submissions in lieu of a hearing.

7. Both parties have been represented throughout these proceedings. The holder has been represented by Dehns and the cancellation applicant by Lincoln IP.

8. I make this decision following a consideration of all the papers before me.

9. 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.

DECISION

Section 5(2)(b)

10. Section 5(2)(b) of the Act is as follows:

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

11. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V*, Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L.Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) The matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) The average consumer normally perceives the mark as a whole and does not proceed to analyse its various details;

(d) The visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) Nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a 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 to mind the earlier mark, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

12. In *Canon*[1], the CJEU stated at paragraph 23 of its judgment:

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

13. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case)[2], 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;

[1] *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, C-39/97
[2] [1996] R.P.C. 281

(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.

14. In addition, I find the following case law to be helpful when in *Gérard Meric v Office for Harmonisation in the Internal Market,*[3] 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 fur 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."

15. In *Kurt Hesse v OHIM*,[4] 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM),*[5] 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 that the responsibility for those goods lies with the same undertaking."

[3] Case T- 133/05
[4] Case C-50/15 P
[5] Case T-325/06

16. In *Sanco SA v OHIM,*[6] 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 – in that case, *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 is 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. noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited*:[7]

> "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."

17. In *Oakley, Inc v OHIM*,[8], the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

18. In *Tony Van Gulck v Wasabi Frog Ltd*[9], Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

[6] Case T-249/11
[7] BL-0-255-13
[8] Case T-116/06, at paragraphs 46-57
[9] Case BL O/391/14

> "9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are *'similar'* to goods are not clear cut."

19. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*, Case C-411/13P and *Assembled Investments (Proprietary) Ltd v. OHIM,* Case T-105/05*,* at paragraphs [30] to [35] of the judgment, upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd* Case C-398/07P, Mr Hobbs concluded that:

> i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;
>
> ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services <u>normally</u> associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;
>
> iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

Class 12

20. In its counterstatement and written submissions the holder admitted that its class 12 goods were identical or similar to the cancellation applicant's class 12 goods. Having reviewed both of the class 12 specifications, I find that the respective goods are either identical or can be considered identical on the *Meric* principle.

Class 35

21. The holder also admitted that its class 35 services are moderately similar to the cancellation applicant's class 12 vehicle related goods.[10] The holder's services are essentially retail and wholesale services in relation to vehicles, parts and fittings. As per the *Oakley* extract given above, I find that retail services for particular goods may be complementary to those goods, being distributed through the same trade channels, and therefore similar to a degree. It is the case that vehicles and their parts and fittings would be available through authorised dealerships and brand specific retail websites. Therefore, with regard to the complementarity of retail services and goods in these proceedings, I find that the holder's retail terms are similar to a moderate degree to the cancellation applicant's vehicle related goods.

Class 37

22. The holder also admitted that its class 37 services are moderately similar to the cancellation applicant's class 12 vehicle related goods.[11] The holder's services are essentially repair and maintenance of vehicles, parts and fittings. I agree with the holder that repair and maintenance of vehicles, parts and fittings are complementary to the goods themselves. Therefore I find the respective goods and services to be similar to a moderate degree.

[10] Holder's counterstatement paragraph 5 and written submissions paragraph 9.
[11] Ibid.

Average consumer and the purchasing process

23. I next consider who the average consumer is for the goods and services at issue and how they are purchased. It is settled case law that the average consumer is deemed to be reasonably well informed and reasonably observant and circumspect.[12] 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 or services in question.[13]

24. The average consumer for the contested goods and services will be the general public and businesses. In its written submissions the holder also states that automotive professionals should be included in addition to the other categories of consumer in class 37.[14] I agree with the holder that automotive professionals will also be relevant consumers for the service classes. The contested goods and services will vary in price but in general the goods and services will be infrequent purchases and could potentially be very expensive, e.g. a vehicle. The holder submits that the level of attention paid during purchasing will be high. I agree with the holder on this point. There will be many factors at play, not least the design and safety features, suitability for purpose and performance of a vehicle which will be uppermost in the mind of consumers in the selection of a vehicle for purchase. There will also be a greater degree of attention paid for repair and maintenance services, in my view, as there are additional safety considerations such as road worthiness at stake.

25. The purchasing process will be predominantly visual as consumers will see vehicles, parts and fittings in physical showrooms or the online equivalents. However I do not discount an aural component as parts and fittings can be ordered via the telephone or advice may be sought from technical sales or repair staff during purchase.

[12] *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,* [2014] EWHC 439 (Ch)
[13] *Lloyd Schuhfabrik Meyer,* Case C-342/97.
[14] Paragraph 10

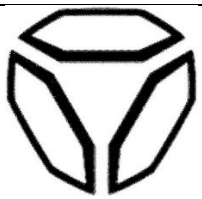
Mark comparisons

26. 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 *Bimbo SA v OHIM*[15], 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."

27. 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.

28. The respective trade marks to be compared are:

Cancellation applicant's mark	Holder's mark
	

29. The cancellation applicant's mark is a composite arrangement of a device and a word. The device comprises three orange coloured geometric shapes, positioned such that there is one shape on the top of the device and a shape on both the left and right sides such that a gap (in white) shaped like a letter Y is formed in the centre. The word that follows the device to its right is YADEA which is presented in block capitals in a regular typeface. Both device and word contribute to the overall

[15] Case C-591/12P

impression of the mark although it is not an equal contribution. In marks which consist of both a word and a device, it is a general rule of thumb that the words will speak louder than the devices. I consider that rule to be applicable in this case. Although the device here is significant in terms of its size, position and stylisation and will make a substantial visual impact, the mark is likely to be referred to by the YADEA word element, especially as this is a distinctive word.

30. The holder's mark is a device only. The device comprises three geometric shapes, positioned with one shape on the top of the device and the other shapes on the left and righthand sides forming a triangular shaped gap in the centre. The overall impression is derived from this presentation.

Visual comparison

31. In a visual comparison, the respective devices contain the same arrangement of shapes, namely one shape presented on top of two other shapes, one on the left and one on the right hand side, leaving a gap that resembles a letter Y between them. The holder, in is written submissions, submits that its shapes are "transparent, angular hexagons" whereas the cancellation applicant has "three, orange, curved shapes".[16] The cancellation applicant's device is indeed coloured orange, but colour has not been claimed. It is settled case law[17] that registration of a mark in black and white covers use of a mark in colour. However the holder, in its written submissions, has drawn my attention to a convergence document published in April 2014 by the European Trade Mark and Design Network titled "Common Communication on the Common Practice of the Scope of Protection of Black and White ("B&W") Marks".[18] The holder states,

> "It is submitted that the fact that the hexagons within the Holder's Mark are transparent is a substantial distinguishing feature between the respective devices, particularly as it is necessary to evaluate the likelihood of confusion on the basis of fair and normal use of the marks. As stated in the Common

[16] Holder's written submissions, paragraph 17.
[17] *Specsavers* [2014] EWCA Civ 1294 at 5 and *J.W. Spear & Sons Ltd v Zynga, Inc*. [2015] EWCA Civ 290 at 47.
[18] Common Communication on the Common Practice of the Scope of Protection of Black and White marks accessed 9 Jul 2025.

> Communication of the Common Practice of the Scope of Protection of Black and White Marks, a change only in colour does not alter the distinctive character of a mark as long as, *inter alia*, "the contrast of shades is respected'. In the present case, the hexagons within the Holder's Mark are unshaded, so fair and normal use of the Holder's Mark would not extend to a version containing orange-filled hexagons."[19]

32. I disagree with the holder's submission. In my view, an average consumer would not understand the holder's shapes to be "transparent", they would understand the shapes to be black and white. I do not believe there is an issue of shading here. In *Specsavers*, the case law states that notional and fair use can apply to the use of a colour, although it warns against the application of a complex colour arrangement. The colour at issue here is a single colour, namely orange, and I find that the colour submission as presented by the holder is not relevant.

33. Finally, the point of visual difference between the respective marks is that an additional word, YADEA, is present in the cancellation applicant's mark and has no counterpart in the holder's mark. Taking all the above into account, I find there is a low to medium degree of visual similarity.

Aural comparison

34. The respective device elements will not be verbalised. The cancellation applicant's word element will likely be verbalised as YAH-DEE-AH which has no counterpart in the holder's mark. Overall I find there is no aural similarity.

Conceptual comparison

35. Neither of the device elements in the respective mark have an "immediately graspable" concept.[20] The word element in the cancellation applicant's mark is invented and as such also has no concept. Taking all of this into account, I find the respective marks to be conceptually neutral.

[19] Holder's written submissions, paragraph 18.
[20] It is settled case law that for a conceptual message to be relevant it must be capable of immediate grasp by the average consumer, *The Picasso Estate v OHIM*, Case C-361/04 P.

Distinctive character of the earlier registered trade mark

36. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

37. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*,[21] the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR 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 promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

38. No claim has been made for enhanced distinctive character of the earlier mark through use, and no evidence of use was filed in these proceedings, therefore I have only the inherent position to consider. The earlier mark consists of an abstract

[21] Case C-342/97

device and invented word, neither of which have any meaning in relation to the goods and services for which they are registered. Therefore the earlier right is inherently distinctive to a high degree.

Likelihood of confusion

39. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.[22] I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

40. 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 and services down to the responsible undertakings being the same or related.

41. In *L.A. Sugar Limited*[23], Mr Iain Purvis Q.C., sitting as the Appointed Person, explained that:

> "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

[22] *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27
[23] *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10

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

42. Moreover in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors,* [24] Arnold LJ approved Mr Purvis's formulation but added:

> "13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] 'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

43. However it is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*.[25] This is mere association not indirect confusion.

44. So far in this decision I have found that,

- The holder conceded the respective goods in class 12 were identical and similar and the services in classes 35 and 37 were similar to a moderate degree.
- The purchasing process is predominantly visual, but with an aural component and with consumers paying a high degree of attention.
- The respective marks are visually similar to a low to medium degree.
- The respective marks are not aurally similar.
- The respective marks are conceptually neutral.
- The earlier registration is inherently distinctive to a high degree.

45. In terms of the likelihood of direct confusion, I find that the respective marks both contain a device consisting of the same basic three shape configuration. However the cancellation applicant's mark contains a word, namely YADEA. As previously stated, the word will speak louder than the device and, in my view, it is how the mark will be

[24] [2021] EWCA Civ 1207
[25] BL O/547/17

referred to. This additional word is sufficient, in my view, for the average consumer not to directly confuse the marks, that is to mistake one mark for the other even where the goods and services are identical and similar.

46. In case I am wrong in my finding relating to direct confusion, I turn to consider whether there is any indirect confusion. The Holder, in its written submissions,[26] reminded me of the guidance given in *L.A.Sugar* that indirect confusion requires a consumer to undertake a thought process whereby they acknowledge the differences between the marks yet attribute the common element to a shared undertaking, taking one mark to be a possible brand extension or sub brand of the other mark.

47. The holder submits that whilst the *L.A.Sugar* list in not exhaustive, its mark does not fall into the categories designated. I agree with the holder's submissions in this regard. I cannot see a reason why the average consumer on seeing the holder's mark would assume that this is a likely brand extension from the opponent. It would appear unusual to have a word and device mark and a brand extension which consists of a somewhat different device only. The sight of one device may bring the other to mind but that is association and not confusion. As such I do not find the average consumer paying a high degree of attention is likely to be confused in to believing that respective goods and services come from the same or economically linked undertakings. I find there is no likelihood of indirect confusion.

48. The invalidation claim under section 5(2)(b) has failed.

Section 5(4)(b)

Cancellation applicant's evidence

49. The cancellation applicant filed a witness statement in the name of Gail Nicol, dated 8 April 2024. Ms Nicol is a Trade Mark Attorney at Lincoln IP, who are the cancellation applicant's legal representatives. Ms Nicol's witness statement relates to the ground of opposition bought under section 5(4)(b) and is accompanied by one exhibit.

[26] Paragraph 29-32

50. Ms Nicol states that the graphic image which is the subject of the copyright claim is the device contained within the earlier right, namely . Moreover Ms Nicol states that the graphic image was completed on 1 January 2016 and first published on 1 February 2016. Exhibit GN1 contains a Chinese language "Certificate of registration of the work" (and English language translation of same), issued by the China National Copyright Administration dated 7 December 2022. The samples of the artwork attached to the certificate are set out below:

51. In her witness statement Ms Nicol addresses the date gap between the completion and first publishing of the graphic image and its registration with the appropriate Chinese copyright authority some 6 years later. Ms Nicol states that the cancellation applicant made the decision to register the graphic image after they had noticed "imitations in trade" some years after the image's creation.

Holder's evidence

52. The holder filed two witness statements. The first is in the name of Hideki Kikuchi, who is the manager of the planning Division within the Holder's Styling and Design department, and is dated 17 June 2024. Mr Kikuchi states that the device, which is now the contested designation, was developed internally over some eight months before the final image was completed in June 2022. Mr Kikuchi states that the image is a representation of the holder's core values.

53. The second witness statement was filed in the name of Lu Xue, who is a Trade mark and Copyright Attorney at Wanhuida Intellectual Property, dated 27 June 2024. Wanhuida Intellectual Property are the holder's legal representatives in China. In her witness statement Ms Lu sets out the stages for obtaining a copyright registration in China. In the most relevant part of her witness statement, she states the following:

> "Since the copyright registration application is only subject to basic examination for formalities, the registration certificate that is issued by the NCAC is merely preliminary evidence that the registrant owns the copyright. It does not definitively prove ownership and can be challenged. When bringing copyright infringement proceedings in the Chinese courts, the copyright owner will usually be required to provide full evidence to prove its ownership, even if a copyright registration certificate exists."[27]

54. That concludes my summary of the evidence.

Statutory Provisions

55. Section 5(4)(b) of the Act is as follows:

> "A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented–
> […]
> (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) or (aa) above, in particular by virtue of the law of copyright, or the law relating to industrial property rights.
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of 'an earlier right' in relation to the trade mark."

56. In deciding this ground, I must address the following questions:

- Is the earlier mark a work under the Copyright, Designs and Patents Act 1988 ("CDPA") and therefore capable of being protected by copyright?
- Does the work meet the qualification criteria for copyright protection?
- Who is the owner of the work and when was it created?
- Would use of the contested mark constitute an infringement of any copyright?

Whether the earlier mark is a work under the CDPA

[27] Lu Xue's witness statement paragraph 5

57. Section 1 of the CDPA states that:

> "Copyright is a property right which subsists in accordance with this Part in the following descriptions of work–
> (a) original literary, dramatic, musical or artistic works,
> (b) sound recordings, films or broadcasts, and
> (c) the typographical arrangement of published editions."

58. Section 4 of the CDPA is as follows:

> "(1) In this Part 'artistic work' means-
> (a) a graphic work, photograph, sculpture or collage, irrespective of artistic quality,
> (b) a work of architecture being a building or a model for a building, or (c) a work of artistic craftsmanship.
> (2) In this Part – …
> 'graphic work' includes – (a) any painting, drawing, diagram, map, chart or plan, and (b) any engraving, etching, lithograph, woodcut or similar work;
> …"

59. In *Griggs Group Ltd v Evans*,[28] Peter Prescott Q.C., as a deputy judge of the High Court, said:

> "18. … a drawing is capable of being a 'work'. So if an artist uses his skill and labour to draw a word or phrase in a stylised way, as in the case of a logo, his drawing is capable of being an original work, protected by copyright law."

60. I consider that the cancellation applicant's device is a graphic work and capable of being protected by copyright.

Whether the work meets the qualification criteria for copyright protection

61. Section 153 of the CDPA states that copyright does not subsist in a work unless certain conditions are met. These are set out in the following sections of the Act and relate to the citizenship or residence of the author at the time the work was created

[28] [2003] EWHC 2914 (Ch)

or published, or the place where it was first published. The logo was first published in China.

62. Section 159(1) of the CDPA states that:

> "Where a country is party to the Berne Convention or a member of the World Trade Organisation, this Part, so far as it relates to literary, dramatic, musical and artistic works, films and typographical arrangements of published editions-
>
> …
>
> (c) applies in relation to a work first published in that country as it applies in relation to a work first published in the United Kingdom."

63. China is a member of the World Trade Organisation and so the work qualifies for copyright protection.

Ownership of the work and its creation

64. In my summary of the cancellation applicant's evidence, I noted that the device was completed on 1 January 2016 and first published on 1 February 2016. However it was not registered at the China National Copyright Administration until 7 December 2022 which is just over a month after the priority date of the designation, being 1 November 2022. Ms Nicol addresses this issue by stating that the cancellation applicant took the step to register the image only after it found "imitations in trade". However no evidence was provided as to when these imitations were found, nor how many or how widespread the issue was. I assume that the image was in the public domain for there to be imitators, but I have been provided with no evidence on that point. Although a copyright registration certificate is provided as *prima facie* evidence of ownership, and I accept that it shows the cancellation applicant as the owner, it post-dates the holder's priority date and I have no evidence that the image was used before that date.

Whether use of the mark would constitute an infringement of the copyright in the work

65. Section 16 of the CDPA is the relevant legislation and reads as follows:

"(1) The owner of the copyright in a work has, in accordance with the following provisions of this Chapter, the exclusive right to do the following acts in the United Kingdom –

(a) to copy the work (see section 17);

(b) to issue copies of the work to the public (see section 18);

(ba) to rent or lend the work to the public (see section 18A);

(c) to perform, show or play the work in public (see section 19);

(d) to communicate the work to the public (see section 20);

(e) to make an adaptation of the work or do any of the above in relation to an adaptation (see section 21);

and those acts are referred to in this Part as the 'acts restricted by the copyright'.

(2) Copyright in a work is infringed by a person who without the licence of the copyright owner does, or authorises another to do, any of the acts restricted by the copyright.

(3) References in this Part to the doing of an act restricted by the copyright in a work are to the doing of it –

(a) in relation to the work as a whole or any substantial part of it, and

(b) either directly or indirectly; and it is immaterial whether any intervening acts themselves infringe copyright."

66. Section 17 of the CDPA provides that:

"(1) The copying of the work is an act restricted by the copyright in every description of copyright work; and references in this Part to copying and copies should be construed as follows.

(2) Copying in relation to a literary, dramatic, musical or artistic work means reproducing the work in any material form. This includes storing the work in any medium by electronic means.

(3) In relation to an artistic work copying includes the making of a copy in three dimensions of a two-dimensional work and the making of a copy in two dimensions of a three-dimensional work.

…

(6) Copying in relation to any description of work includes the making of copies which are transient or are incidental to some other use of the work."

67. In *Designers Guild Ltd v Russell Williams (Textiles) Ltd (t/a Washington DC*),[29] Lord Millett set out the approach to assessing whether artistic copyright has been infringed at [2425]-[2426]. He said:

"The first step in an action for infringement of artistic copyright is to identify those features of the defendant's design which the plaintiff alleges to have been copied from the copyright work. The court undertakes a visual comparison of the two designs, noting the similarities and the differences. The purpose of the examination is not to see whether the overall appearance of the two designs is similar, but to judge whether the particular similarities relied on are sufficiently close, numerous or extensive to be more likely to be the result of copying than of coincidence. It is at this stage that similarities may be disregarded because they are too commonplace, unoriginal or consist of general ideas. If the plaintiff demonstrates sufficient similarity, not in the works as a whole but in the features which he alleges have been copied, and establishes that the defendant had prior access to the copyright work, the burden passes to the defendant to satisfy the judge that, despite the similarities, they did not result from copying.

…

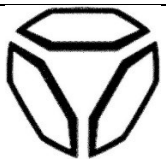
Once the judge has found that the defendant's design incorporates features taken from the copyright work, the question is whether what has been taken constitutes all or a substantial part of the copyright work. This is a matter of impression, for whether the part taken is substantial must be determined by its quality rather than its quantity. It depends upon its importance to the copyright work. It does not depend upon its importance to the defendant's work, as I have already pointed out. The pirated part is considered on its own (see Ladbroke (Football) Ltd v William Hill (Football) Ltd [1964] 1 WLR 273, 293, per Lord Pearce) and its importance to the copyright work assessed. There is no need to look at the infringing work for this purpose."

[29] [2000] 1 WLR 2416

68. The cancellation applicant's allegation is that the holder's mark,

> " is so highly similar to Yadea's copyrighted mark such that it may lead to a likelihood of consumer confusion between the marks".[30]

69. The cancellation applicant's image and the holder's mark are set out below:

cancellation applicant's image	holder's mark
	

70. Elsewhere in this decision, I acknowledged that that both devices comprised a three shape configuration, with a shape at the top and a shape on both the left and right hand side. However this does not equate to a finding that the holder's mark has substantially copied the cancellation applicant's image. The device is not entirely commonplace or unoriginal, but three shapes in a triangle is not the most strikingly original work such that another triangular copyright work could not have been arrived at independently. Moreover the cancellation applicant has not able to provide any evidence that the holder was aware of its mark or had prior access to it and the holder's evidence states that it worked on the mark as an internal design project between October 2021 and June 2022 and that it was not aware of the cancellation applicant's image. On the basis if the evidence before me, I find that any similarities are more likely to be coincidence than copying.

71. The invalidation fails under section 5(4)(b).

Overall conclusion

72. The invalidation action has failed in its entirety. Subject to any appeal of this decision the IR will remain protected in the UK.

[30] TM26I – Notice of Invalidation , paragraph 16.

Costs

73. The holder has been successful in these proceedings. As such it is entitled to a contribution towards the costs incurred. Awards of costs for proceedings commenced after 1 February 2023 are governed by Annex A of Tribunal Practice Notice (TPN) 1/2023. Bearing in mind the guidance given in the TPN, I award costs as follows:

£400 Considering Notice of Opposition & preparing counterstatement.
£700 Preparing own and considering other side's evidence.
£450 Preparing submission in lieu.
£1550 Total

74. I order Yadea Technology Group Co., Ltd. to pay Kawasaki Motors, Ltd. the sum of £1550. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24th day of July 2025

June Ralph
For the Registrar
The Comptroller-General

Annex 1

Class 12: Vessels and their parts and fittings; automobiles and their parts and fittings; two-wheeled motor vehicles, bicycles and their parts and fittings; bicycles for children; motorcycles; electric vehicles; hybrid vehicles, namely, vessels, aircraft, automobiles and two-wheeled motorcycles; hydroplanes; hydrogen fueled vehicles, namely, vessels, aircraft, automobiles and two-wheeled motorcycles; personal watercraft; vehicles for locomotion by land, air or water, namely, aircraft, military drones and civil drones; all-terrain vehicles; side by side vehicles; utility vehicles.

Class 35: Retail services or wholesale services for vessels and their parts and fittings; retail services or wholesale services for automobiles and their parts and fittings; retail services or wholesale services for two wheeled motor vehicles, bicycles and their parts and fittings; retail services or wholesale services for bicycles for children; retail services or wholesale services for motorcycles; retail services or wholesale services for electric vehicles; retail services or wholesale services for hybrid vehicles, namely, vessels, aircraft, automobiles and two-wheeled motorcycles; retail services or wholesale services for hydroplanes; retail services or wholesale services for hydrogen fueled vehicles, namely, vessels, aircraft, automobiles and two-wheeled motorcycles; retail services or wholesale services for personal watercraft; retail services or wholesale services for vehicles for locomotion by land, air or water, namely, aircraft, military drones and civil drones; retail services or wholesale services for all-terrain vehicles; retail services or wholesale services for side by side vehicles; retail services or wholesale services for utility vehicles.

Class 37: Repair or maintenance of vessels and their parts and fittings; repair or maintenance of automobiles and their parts and fittings; repair or maintenance of two-wheeled motor vehicles, bicycles and their parts and fittings; repair or maintenance of bicycles for children; repair or maintenance of motorcycles; repair or maintenance of electric vehicles; repair or

maintenance of hybrid vehicles, namely, vessels, aircraft, automobiles and two-wheeled motorcycles; repair or maintenance of hydroplanes; repair or maintenance of hydrogen fueled vehicles, namely, vessels, aircraft, automobiles and two wheeled motorcycles; repair or maintenance of personal watercraft; repair or maintenance of vehicles for locomotion by land, air or water, namely, aircraft, military drones and civil drones; repair or maintenance of all-terrain vehicles; repair or maintenance of side by side vehicles; repair or maintenance of utility vehicles.