O/0760/24

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION NO. 3882498
IN THE NAME OF DONGGUAN VESPER TECHNOLOGY CO., LTD.
TO REGISTER AS A TRADE MARK

IN CLASS 12

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 441234
BY PIAGGIO & C. S.P.A.

BACKGROUND AND PLEADINGS

1. On 26 February 2023, Dongguan Vesper Technology Co., Ltd. ("the applicant") applied to register the trade mark shown on the cover page of this decision in the United Kingdom. The application was accepted and published for opposition purposes on 10 March 2023, in respect of the following goods:

Class 12: *Wheel rims for vehicles; Motorcycles; Racing cars; Structural parts for motorcycles; Automobiles; Suspensions for vehicles; Brake systems for vehicles; Power transmissions for land vehicles; Brakes for vehicles; Frames for two-wheeled motor vehicles.*

2. The application is opposed by PIAGGIO & C. S.P.A. ("the opponent"). The opposition was filed on 7 June 2023 and is based upon section 5(2)(b)[1] of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all of the goods in the application. The opponent relies upon the following three marks:

UK trade mark registration number 678204
Filing date: 25 March 1949
Registration date: 25 March 1949
Registered in Class 12
Relying on all goods, namely *Motor cycles*.
(the '204 mark); and

[1] The grounds under section 5(3) as originally filed were withdrawn by the opponent in an email to the Registry dated 6 February 2024. The opponent maintains its opposition under section 5(2)(b) only.

VESPA

UK trade mark registration number 1200683

Filing date: 28 July 1983

Registration date: 28 July 1983

Registered in Class 12

Relying on some goods only, namely *Motor land vehicles; motorcycles, scooters (vehicles); parts and fittings included in Class 12 for all the aforesaid goods.*

(the ’683 mark); and

UK trade mark registration number 801544412

Filing date: 1 April 2020

Registration date: 23 December 2020

Registered in Classes 12 and 25

Relying on all goods in class 12 only, namely *Two-wheeled, three-wheeled and four-wheeled vehicles; electrically powered scooters; bodies for vehicles; brakes for vehicles; caps for land vehicle gas tanks; luggage nets for vehicles; seat covers for vehicles; shock absorbing springs for vehicles; suspension shock absorbers for vehicles; vehicle chassis; vehicle seats; pneumatic tires; casings for pneumatic tires; non-skid devices for vehicle tires; adhesive rubber patches for repairing inner tubes; tire pumps for bicycles and motorcycles; repair outfits for inner tubes, namely, tire repair patches; rims for vehicle wheels; valves for vehicle tires; air bags in the nature of safety devices for automobiles; electric cigarette lighters for land vehicles; anti-theft devices for vehicles; antitheft alarms for vehicles; horns for vehicles; safety seats for children for vehicles; bells for cycles; stands for bicycles and motorcycles as parts of bicycles and motorcycles; mudguards; direction signals for vehicles; frames for bicycles and motorcycles; luggage carriers for vehicles; pedals for bicycles and motorcycles; rearview mirrors; saddle covers for bicycles and motorcycles; saddlebags adapted for bicycles and motorcycles; saddles for bicycles and*

motorcycles; engines for land vehicles; electric motors for land vehicles; bags specially adapted for motorcycles, namely tank bags, sissy bar bags, tail bags, side handbags, top cases.
(the '412 mark)

3. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Registration designating the EU. As a result, the opponent's '412 mark was converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.[2]

4. The above marks qualify as earlier marks under section 6(1) of the Act. As the earlier '204 and '683 marks were each registered more than 5 years before the application date of the applicant's mark, they are, in principle, subject to the provisions on use under section 6A of the Act. The opponent made a statement of use in relation to all of the goods relied upon. As the '412 mark had not completed its registration procedure more than five years before the application date for the contested mark, it is not subject to the use provisions contained in section 6A of the Act.

5. Under section 5(2)(b), the opponent submits that there is a high degree of visual similarity and aural identity between the marks and that the goods at issue are identical and/or highly similar, leading to a strong likelihood of both direct and indirect confusion. The opponent therefore submits that the application should be refused registration in its entirety, and it seeks an award of costs in favour of the opponent.

6. The applicant filed a counterstatement denying the claims and submits that there is no possibility of confusion between the marks. Although the applicant could have required the opponent to provide proof of use of either or both of the earlier '204 and

[2] See also Tribunal Practice Notice ("TPN") 2/2020 End of Transition Period – impact on tribunal proceedings.

'683 marks under section 6A of the Act, it did not do so.[3] As a result, the opponent is able to rely on all the goods for which it made a statement of use on the notice of opposition (form TM7), without having to provide evidence that it has used its marks in relation to any of those goods.

7. Only the opponent elected to file evidence; neither party elected to file written submissions. Neither party requested a hearing, therefore this decision is taken following careful consideration of the papers.

8. In these proceedings, the opponent is represented by Boult Wade Tennant LLP and the applicant is represented by Pablo Albert Catala[4].

EVIDENCE

9. The opponent filed evidence in support of the opposition in the form of the witness statement of Daniela Paull dated 17 October 2023, which is accompanied by four exhibits, labelled DP1 to DP4. Ms Paull is a Chartered Trade Mark Attorney and Senior Associate of the opponent's representatives.

10. The main purpose of the evidence is to support the opponent's argument that "VSPR" will be perceived by the average consumer as an abbreviation of "VESPER"

11. I have taken the evidence into account in reaching my decision and will refer to it during the decision to the extent I consider necessary.

DECISION

12. 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

[3] As per question 7 of the form TM8 where the applicant has ticked 'No' in answer to the question: 'Do you want the opponent to provide "proof of use"?'.
[4] Form TM33 appointing Pablo Albert Catala as representative to the applicant, replacing previous representative Carolina Sanchez Margareto, was received on 20 May 2024. I note, however, that this was filed following the deadline for any final submissions in lieu of a hearing. As such, all correspondence relating to the case prior to it being ready for a decision was filed by Ms Sanchez on behalf of the applicant.

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.

Section 5(2)(b)

13. Section 5(2)(b) is relied on and 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. Section 5A states:

> "Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

15. I am guided by the following principles which are gleaned from the decisions 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 Office for Harmonisation in the Internal Market (Trade Marks and Designs) ("OHIM")*, Case C-3/03, *Medion AG v.*

Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

16. Pursuant to section 60A of the Act, the goods are not to be automatically regarded as being similar to each other on the ground that they appear in the same class, nor automatically regarded as dissimilar from each other on the ground that they appear in different classes.

17. The goods to be compared are all in class 12, as follows:

Applicant's goods
Wheel rims for vehicles; Motorcycles; Racing cars; Structural parts for motorcycles; Automobiles; Suspensions for vehicles; Brake systems for vehicles; Power transmissions for land vehicles; Brakes for vehicles; Frames for two-wheeled motor vehicles
Opponent's goods under the '204 mark
Motor cycles.
Opponent's goods under the '683 mark
Motor land vehicles; motorcycles, scooters (vehicles); parts and fittings included in Class 12 for all the aforesaid goods.
Opponent's goods under the '412 mark

Two-wheeled, three-wheeled and four-wheeled vehicles; electrically powered scooters; bodies for vehicles; brakes for vehicles; caps for land vehicle gas tanks; luggage nets for vehicles; seat covers for vehicles; shock absorbing springs for vehicles; suspension shock absorbers for vehicles; vehicle chassis; vehicle seats; pneumatic tires; casings for pneumatic tires; non-skid devices for vehicle tires; adhesive rubber patches for repairing inner tubes; tire pumps for bicycles and motorcycles; repair outfits for inner tubes, namely, tire repair patches; rims for vehicle wheels; valves for vehicle tires; air bags in the nature of safety devices for automobiles; electric cigarette lighters for land vehicles; anti-theft devices for vehicles; antitheft alarms for vehicles; horns for vehicles; safety seats for children for vehicles; bells for cycles; stands for bicycles and motorcycles as parts of bicycles and motorcycles; mudguards; direction signals for vehicles; frames for bicycles and motorcycles; luggage carriers for vehicles; pedals for bicycles and motorcycles; rearview mirrors; saddle covers for bicycles and motorcycles; saddlebags adapted for bicycles and motorcycles; saddles for bicycles and motorcycles; engines for land vehicles; electric motors for land vehicles; bags specially adapted for motorcycles, namely tank bags, sissy bar bags, tail bags, side handbags, top cases.

18. 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, or vice versa: *Gérard Meric v OHIM,* Case T-133/05, at [29].

19. In *Canon*, Case C-39/97, the Court of Justice of the European Union ("CJEU") stated that:

> "In assessing the similarity of the goods or services concerned, … 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".[5]

20. Additionally, the factors for assessing similarity between goods and/or services identified in *British Sugar Plc v James Robertson & Sons Limited* ("*Treat*") [1996]

[5] Paragraph 23

R.P.C. 281 include an assessment of the users and the channels of trade of the respective goods (and/or services).

21. 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 General Court ("GC") stated that "complementary" means:

> "82. ...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".

22. For the purposes of considering the issue of similarity of the goods, it is permissible to consider groups of terms collectively where appropriate: *Separode Trade Mark*, BL O-399-10, at [12].

23. While making my comparison, I bear in mind the comments of Floyd J. (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

> "12. … Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise. … Nevertheless the principle should not be taken too far. ... Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

<u>The contested goods in Class 12</u>

Motorcycles

24. The applicant's "*Motorcycles"* are self-evidently identical to the opponent's "*Motor cycles"* (the '204 mark) and its "*motorcycles"* (the '683 mark). The term would also be

encompassed by the broad term "*Two-wheeled, … vehicles"* relied upon under the '412 mark, rendering the goods identical as per the principle outlined in *Meric*.

Racing cars; Automobiles

25. The above goods would be encompassed by the opponent's broader terms "*Motor land vehicles"* (the '683 mark) and its "… *three-wheeled and four-wheeled vehicles"* (the '412 mark), and as such are identical as per *Meric*.

26. With regards to the opponent's "*Motor cycles"* under the '204 mark, while I consider a motor cycle to be a motor (land) vehicle, I do not consider that automobiles would include motor cycles, the term "automobile" being widely interpreted as referring to a car. However the applicant's "*Racing cars; Automobiles"* and the opponent's "*Motor cycles"* are all used as a means of transport, and while the main purpose of racing cars is quite specific, there is no reason why motor cycles couldn't also be used for the purpose of racing. Overall, there is an overlap in nature (all being land vehicles) as well as a degree of overlap in the basic method of use of the competing goods. While the goods are not complementary, there could be an element of competition, with the consumer choosing one vehicle type over the other, and there is likely to be an overlap in trade channels. Overall, I consider the applicant's *"Racing cars; Automobiles"* and the opponent's "*Motor cycles"* to be similar to a low to medium degree.

Wheel rims for vehicles; Structural parts for motorcycles; Brake systems for vehicles; Brakes for vehicles; Frames for two-wheeled motor vehicles.

27. The above goods are all parts and/or fittings for vehicles and as such are covered by the broad term "*Motor land vehicles; motorcycles, scooters (vehicles);* ***parts and fittings included in Class 12 for all the aforesaid goods****"* under the '683 mark, rendering them *Meric* identical.

28. Under the '412 mark "*rims for vehicle wheels"* are self-evidently identical to *"Wheel rims for vehicles"* and its *"brakes for vehicles"* are identical to the applicant's "*Brake systems for vehicles; Brakes for vehicles"*. Meanwhile, the opponent's "*frames for …*

motorcycles" are encompassed by "*Frames for two-wheeled motor vehicles"*, as well as being encompassed by the applicant's broad term "*Structural parts for motorcycles"*, and thus the goods are identical as per *Meric*.

29. Under the '204 mark, the opponent only relies upon "*Motor cycles"*. While the opponent's finished product may be reliant on the applicant's goods, that in itself does not make them similar in nature. In *Les Éditions Albert René v OHIM*, Case T-336/03, the General Court ("GC") found that:

> "61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different."

That being said, there will be some overlap in users of the goods, given that repair and maintenance would be important for the continuous use of the opponent's motor cycles, with the need to source replacement parts from time to time. The goods at issue are clearly different in physical nature, purpose and method of use. The channels of trade will be different, and the goods are not in competition. There is a degree of complementarity between the goods inasmuch that without the component parts such as *Structural parts for motorcycles*, the finished vehicle would not be able to function adequately. Bearing in mind the guidance from *Les Éditions Albert René*, and the variety of different components used in the manufacture of a motor cycle, although some undertakings may provide more than one element, I do not consider that the average consumer would necessarily expect every component to come from the same or economically-linked undertakings as a fully functioning motor cycle. Consequently, I consider there to be a low to medium degree of similarity between the contested goods.

Suspensions for vehicles; Power transmissions for land vehicles;

30. Again, these goods are parts and/or fittings for vehicles and are therefore covered by the broad term "*Motor land vehicles; motorcycles, scooters (vehicles);* ***parts and***

fittings included in Class 12 for all the aforesaid goods*"* under the '683 mark, rendering them *Meric* identical.

31. With regard to the '412 mark, I consider that the opponent's "*suspension shock absorbers for vehicles"* would be a component of the applicant's "*Suspensions for vehicles"*, while the applicant's "*Power transmissions for land vehicles"* would work in conjunction with the opponent's "*engines for land vehicles; electric motors for land vehicles"* in order for the vehicle to function. As such, there will be an overlap in users and purpose of the goods, as well as in channels of trade. I consider there to be a complementary relationship between the components to the extent that it would not be unreasonable for the consumer to expect them to originate from the same or related undertakings. Overall, I consider there to be a medium degree of similarity between the contested goods.

32. In relation to the opponent's "*Motor cycles"* as relied upon under the '204 mark, I find a low to medium degree of similarity between these goods for the same reasons behind my earlier findings of the goods at issue in paragraph 29 of this decision.

The average consumer and the nature of the purchasing act

33. The average consumer is a legal construct, deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. 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: *Lloyd Schuhfabrik Meyer*, Case C-342/97, at [26].

34. In my view, the average consumer of the overlapping goods will be the general public for the vehicles themselves, while the average consumer for the various parts and fittings will also include the likes of professional vehicle repair outfits.

35. Motorcycles and automobiles are "high end" purchases which will be most frequently sourced from dedicated dealerships. I acknowledge that oral considerations will play a part during the selection of the goods, for example by way

of verbal recommendations and discussions with sales representatives. However, given the aesthetic appeal of the goods, their selection will be by predominantly visual means, through visiting physical showrooms and from the perusal of printed brochures, as well as through online research prior to purchase. The purchase of these goods is likely to be infrequent and highly considered, such considerations will include, inter alia, the initial cost and ongoing running and maintenance costs, and the performance and reliability of the vehicle, which together will merit a high degree of attention during the purchasing process.

36. The parts and fittings are likely to be sourced more frequently from a variety of undertakings, rather than from a single supplier, with the professional consumer in particular trusting in the reputation of suppliers of specialised goods to fulfil each of their specific requirements. The selection is likely to be a combination of both visual and oral, especially where parts may be ordered over the telephone, although it is likely that the goods will have already been viewed prior to this, for example in a brochure or online. The degree of attention will vary depending on the importance of the part in question, but in general, I consider that the general public as consumer will pay an average degree of attention to the purchasing act, while the professional consumer is likely to pay a higher than average degree of attention.

Comparison of marks

37. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components: CJEU stated in *Bimbo SA v OHIM* Case C-591/12P[6]

38. 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

[6] At [34].

and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

39. The respective trade marks are shown below:

Opponent's trade marks	**Applicant's trade mark**
The '204 mark  The '683 mark **VESPA** The '412 mark 	

40. In its statement of grounds, the opponent submits that there is a high degree of visual similarity and aural identity between the applicant's mark and the opponent's marks and submits that the average consumer 'looking for a sensible pronunciation' of the applicant's mark will 'fill the gaps in V_SP_R' which it submits is likely to be seen as an abbreviation for VESPER, being aurally identical to "vespa". The opponent reiterates this in the witness statement of Daniela Paull and has submitted evidence by way of four exhibits (DP1 to DP4) in support of its argument that "VSPR" will be

perceived by the average consumer as “VESPER”, which I will now consider in turn before I make my own comparison of the marks at issue.

41. The first exhibit, DP1, adduced by the opponent is a printout of an extract from WIKIPEDIA which describes “disemvowelling” as a piece of alphabetic text with all the vowel letters elided (omitted). The article states that it is often used in band and company names (but does not mention such use in brand names) and states that it used to be a common feature of SMS language where space was costly. Exhibit DP3 comprises a glossary of textspeak sourced from Wiktionary and mainly gives examples of initials being used as an abbreviation for a phrase, for example, “btw” instead of “by the way”, rather than just the vowels being omitted from single words, as is pertinent to the decision before me. Further, the article specifically lists SMS abbreviations and so is not on all fours with how such abbreviations may be seen when used as a trade mark. Exhibit DP4 is an entry from the Oxford Advanced Learner’s Dictionary which shows “thx” as an abbreviation (in informal writing) for THANKS or THANK YOU. However, in order for it to be analogous with the applicant’s mark, it would need to show the abbreviation for THANKS as THNKS rather than THX. I find nothing in these exhibits to be compelling evidence of how the initials which make up the applicant’s mark would be instantly perceived in relation to the goods at issue as anything other than four random letters.

42. Perhaps the strongest evidence in support of the opponent’s argument can be found in exhibit DP2, being an article entitled “What’s in a brnd name?”. The article considers the impact of dropping vowels from words, particularly in relation to branding. However, the evidence is not without flaws, the most obvious being that the article is sourced from a New York based strategic branding and design studio which was published on 21 June 2019 and so it is not necessarily commensurate with how the UK consumer will perceive the same or similar brands in 2023, being the time that the opposed application was filed.

Overall impression

43. The applicant’s mark consists of the stylised letters VSPR in a black font, the initial letter “V” being fractionally larger than the remaining three letters, and accordingly

drops below the bottom level of the letters SPR. While I consider the presentation to be slightly unusual, in as much that it is more customary for the first letter of a sign to be higher at the top, rather than lower than the bottom line, of the subsequent letters, the typeface does not deviate from a relatively standard script. To my mind, each of the letters make a roughly equal contribution to the overall impression of the mark which rests in the combination of the four letters VSPR as presented.

44. The opponent's '203 mark consists of the word "Vespa", presented in a black cursive typeface, which is underlined and slopes upward from left to right. Although it will not go unnoticed, I do not consider that the stylisation contributes greatly to the overall impression and plays a secondary role to the word "Vespa".

45. The opponent's '412 mark also comprises the word Vespa in a highly similar (but not identical) cursive typeface to the '203 mark, with each letter presented in a different colour. The word is again underlined, with the line presented in yet another colour. The underlined word also slopes upward from left to right, although it is not as acute as for the '203 mark. I consider that the word Vespa and the stylisation of the word contribute equally to the overall impression of the mark.

46. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginning of words tend to have more visual and aural impact than the ends, although I accept that this is not always the case. Meanwhile, in *dm-drogerie markt GmbH & Co. KG v OHIM,* Case T-304/10, the GC noted that in the case of word signs which are relatively short, the differences between marks of different lengths will be more easily grasped by the average consumer.[7]

Visual comparison

47. The opponent's marks all comprise the same five letter word "Vespa", with the additional stylisation to the '204 and '412 marks as previously described. The applicant's mark consists of four letters, "VSPR". The marks therefore share the same initial letter, "V", and also have in common the letters "SP" in the same order, prior to

[7] At [42].

the last letter of each of the signs. While the stylisation of the marks at issue is different, in relation to the '683 mark, overall I consider it visually similar to the applicant's mark to a medium degree. I consider the '204 word mark and the applicant's mark to also be similar to a medium degree, while the '412 mark is only similar to a low degree, due to the overall presentation and use of multiple colours in the opponent's mark which is absent from the applicant's mark.

Aural comparison

48. The identical verbal element "Vespa" in each of the opponent's earlier marks will be pronounced as two syllables, VES-PAH. There are no other elements within the marks which will be articulated. I do not agree with the opponent's submissions that the average consumer will see the applicant's mark as an abbreviation for VESPER and therefore it is aurally identical to the opponent's marks. I take into account the opponent's evidence in this regard, as considered above in paragraphs 41 and 42. Given the lack of vowels, in my view, the applicant's mark would be perceived by a significant proportion of the average consumer as an initialism, rather than as an acronym. As such, I do not consider that the consumer would try to pronounce VSPR as a word, rather the individual letters will each be voiced, as four syllables, VEE-ESS-PEE-ARR. Overall, I consider the marks to be aurally dissimilar.

Conceptual comparison

49. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer - Case C-361/04 P *Ruiz-Picasso and others v OHIM* [2006][8].

50. The applicant submits in its counterstatement that the word "VESPA", which is present in all three of the opponent's marks, is an Italian word meaning 'wasp', while its own mark is based on consonants only, "VSPR". The opponent submits in its statement of grounds that the applicant's mark will be seen as "VESPER", due to the applicant's name being Dongguan Vesper Technology Ltd.

[8] Paragraph 56.

51. To my understanding, the word 'vesper' is a religious term referring to an evening prayer, however, in my view, a significant proportion of the average consumer will attach no meaning to the word and will instead perceive it as an invented word. I also consider that a significant proportion of the average UK consumer would not understand that the word "vespa" is the Italian word for 'wasp'. As such, to those consumers who see both the applicant's mark and the opponent's marks as invented terms with no clearly recognisable semantic content, the marks are conceptually neutral.

52. Even allowing that some consumers may perceive the initials "VSPR" as an abbreviation of "vesper", and that they also recognise the meaning of that word as being an evening prayer, and/or that those same consumers recognise and understand "vespa" to mean "wasp", there is no conceptual similarity between the marks.

Distinctive character of the earlier marks

53. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. The factors I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97:

> "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)."

54. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and services, ranging up 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 made of it.

55. The opponent submits that "the VESPA brand is highly distinctive and extremely well-known in relation to the goods in contention due to the use of the mark in the UK for over half a century".[9] However, the opponent has not filed evidence of use of the mark to support this, and as such, I only have the inherent characteristics of the mark to consider.

56. Earlier in this decision, I found that a significant proportion of the average consumer for the goods at issue would not recognise the meaning of the marks as an Italian word meaning wasp, but would instead consider it to be an invented word with no allusive qualities. Even allowing that some consumers may identify the meaning of the word, it has no significance in relation to the goods. Overall, I consider the mark to be high in inherent distinctive character.

Likelihood of confusion

57. There is no simple formula for determining whether there is a likelihood of confusion. It is clear that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them 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 services and vice versa (*Canon* at [17]). I must consider the various factors from the perspective of the average consumer, bearing in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

[9] See email dated 6 February 2024 in which the opponent confirms that it does not wish to file full written submissions.

58. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different, but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

> "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."
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).
>
> (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.).

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

59. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

60. Earlier in this decision, I found:

- All the contested goods to be either identical or similar to a low to medium degree to the opponent's goods;

- The level of attention of the general public as the average consumer of the 'high end' goods such as cars and motorcycles to be high when selecting the goods, and average for the more frequently purchased parts and fittings, while the professional consumer is likely to pay a higher than average degree of attention to the selection of the parts and fittings;

- Whilst not ignoring aural considerations, the average consumer will select the 'high end' goods by predominantly visual means, and the parts and fittings by a combination of both oral and visual means;

- The competing trade marks are visually similar to a medium degree for the '683 and '204 marks and visually similar to a low degree for the '412 mark; the opponent's marks are all aurally dissimilar to the applicant's mark; the marks are either conceptually neutral where they are both seen as invented words, or there is no conceptual similarity between the marks where the meanings of one or both of the marks are understood;

- The earlier mark is inherently distinctive to a high degree.

61. While allowing that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind, I consider it unlikely that they would mistake one mark for the other. In my view,

the average consumer will notice and recall the visual, aural and conceptual differences between the marks. I do not consider there is any likelihood of direct confusion as the differences between the marks are too great for confusion to arise. I find this even where the respective goods are held to be identical, which offsets a lesser degree of similarity between the marks.

62. Taking into account the previously outlined guidance of Mr Iain Purvis Q.C. (as he then was), in *L.A. Sugar*, I will now consider whether there might be a likelihood of indirect confusion. In *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

63. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, Lord Justice Arnold referred to the comments of James Mellor QC (as he then was) sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said (at [16]) that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Lord Justice Arnold added that there must be “a proper basis” for concluding that there is a likelihood of indirect confusion when there is no likelihood of direct confusion.

64. I have made a multi-factorial assessment of the various considerations in play. I acknowledge that the categories listed by Mr Iain Purvis Q.C. (as he then was) are not exhaustive, however, given, in particular the aural and conceptual differences between the marks and the low to medium visual similarities, notwithstanding the high degree of inherent distinctive character of the earlier marks, I do not see anything which would lead the average consumer into mistakenly believing that one mark is a logical brand extension of the other, or assume that there is an economic connection between the undertakings. I therefore find no likelihood of indirect confusion.

65. The opposition under section 5(2)(b) of the Act fails.

CONCLUSION

66. The applicant has been successful. Subject to any successful appeal, the application by Dongguan Vesper Technology Co., Ltd. may proceed to registration in respect of all goods.

COSTS

67. The applicant has been successful and is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice ("TPN") 1/2023. Applying the guidance in that TPN, I award the applicant the sum of £250, which is calculated as follows:

Considering the notice of opposition and preparing a counterstatement:	£250
Total:	**£250**

68. I therefore order PIAGGIO & C. S.P.A. to pay Dongguan Vesper Technology Co., Ltd. the sum of £250. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 12th day of August 2024

Suzanne Hitchings
For the Registrar,
the Comptroller-General