

O-0797-25

TRADE MARKS ACT 1994

IN THE MATTER OF AN APPLICATION TO PROTECT INTERNATIONAL
TRADE MARK REGISTRATION NO. WO0000001665812 IN
THE UNITED KINGDOM

Atto

IN THE NAME OF THE BYD COMPANY LIMITED

AND

AN OPPOSITION UNDER NO. 436547

BY MOVING LIFE LTD

Background and pleadings

1. On 7 April 2022, BYD COMPANY LIMITED (“the applicant”) requested the protection in the United Kingdom (“UK”) of the international trade mark ‘Atto’.¹ The mark has a priority date of 9 December 2021. The priority country is China.

2. The applicant’s mark was published for opposition purposes on 1 July 2022 for the following goods:

Class 12

Cars; motor coaches; trucks; motor buses; automobile bodies; automobile chassis; motors, electric, for land vehicles; motorcycles; brake pads for automobiles; forklift trucks.

3. On 29 September 2022, Moving Life Ltd (“the opponent”) filed a notice of opposition. The opposition is based on section 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

4. Section 5(4)(a) of the Act reads:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa)...

(b) 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.”

¹ There is some dispute between the parties as to whether the mark is stylised or a word mark. I will return to this later in the decision.

5. Subsection (4A) of Section 5 reads:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

6. The opponent relies on the sign ATTO, which it claims has been used throughout the UK since early 2016. It claims to have used the sign for mobility scooters.²

7. The opponent submits:

“The Opponent has an earlier trading goodwill in the UK connected to the sign ATTO for the goods listed at Q2 above. Normal and fair use by the Applicant of the mark applied-for in connection with the goods applied-for will constitute a misrepresentation by the Applicant to the public, leading the public to believe that the Applicant's goods are those of the Opponent or are connected to, associated with or endorsed by the Opponent, or of the same level of quality as the Opponent's goods. Such misrepresentation will risk or cause damage to the Opponent's business, goodwill and/or reputation.”

8. The applicant filed a counterstatement in which it denied the grounds of opposition.

9. Both sides filed evidence and skeleton arguments. A hearing took place before me on 5 September 2024 at which the opponent was represented by Becky Knott of Counsel, instructed by JA Kemp LLP. The applicant was represented by Kendal Watkinson of Counsel instructed by Haseltine Lake Kempner LLP.

² See the opponent's evidence, dated 1 August 2023, in which it reduced the goods relied on for the purpose of goodwill.

10. Although the UK has left the European Union (EU), section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive and, therefore, this decision continues to refer to the trade mark case law of the EU courts.

DECISION

11. In *Discount Outlet v Feel Good UK*,³ Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether ‘a substantial number’ of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

12. The opponent must show that it had goodwill in a business and that the ATTO sign relied upon is associated with, or distinctive of, that business.

³ [2017] EWHC 1400 IPEC

Relevant date

13. In terms of the relevant date for assessment of this ground, in *Advanced Perimeter Systems Limited v Multisys Computers Limited*,⁴ Mr Daniel Alexander QC, sitting as the Appointed Person, quoted with approval the summary made by Mr Allan James, acting for the Registrar, in *SWORDERS Trade Mark*:⁵

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’”

14. The date protection was requested in the UK is 7 April 2022. The applicant makes no claim to use of the sign prior to this date and it is this date that is relevant for the purposes of this assessment.

15. The first hurdle for the opponent is to show that it had the requisite goodwill at the designation date of the applicant’s mark. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd*:⁶

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of

⁴ BL O-410-11

⁵ BL O-212-06

⁶ [1901] AC 217 at [224]

attraction sufficient to bring customers home to the source from which it emanates.”

16. The opponent’s evidence of goodwill is provided in a witness statement by Rafy David and exhibits RD1–RD13. Mr David is the CEO of the opponent, a position he has held since 2019. He describes the opponent’s business in the following terms:

2. ML is a portable mobility solution company dedicated to developing and manufacturing products for those with limited mobility. ML specialises in products that transport with ease which allow customers to travel and engage in a more active lifestyle, namely mobility scooters (the “ATTO Scooters”) and related accessories including batteries, chargers, bags, pet carriers, arm rests, cushions, and cases, all sold under the “ATTO” trademark (collectively, the “ATTO Products”). The ATTO Scooters stand out in the market as being less bulky, more easily manoeuvrable, and more compact than other products of a similar nature.

17. With regard to the products sold in the UK, Mr David states:

“5. [The opponent] launched the original / classic model of the ATTO Scooters in January 2016 (the “Classic ATTO Model”) in the UK. The success and popularity of the Classic ATTO Model led [the opponent] to develop accessories for the Classic ATTO Model as well as a “sportier” ATTO SPORT model launched in 2021 (the “ATTO SPORT Model”) of the ATTO Scooters, which featured a higher top speed.

6. Both the Classic ATTO and ATTO SPORT Models of the ATTO Scooters are designed to be accessible and portable on all types of transportation, including cars, trains, and airplanes. The ATTO Scooters conform with CE standards and are certified as flight safe.”

18. The Classic ATTO and ATTO Sport scooters and related accessories are sold in the UK via the opponent’s own website www.movinglife.co.uk and through its distributors. Information about the opponent’s products can also be accessed on its

global website www.movinglife.com. There were more than 17000 UK visitors to the opponent's global website during 2017.⁷

19. The opponent's ATTO products were launched in the UK in February 2016 at the Waldorf Hilton in London.

From Mobility To Freedom

**ATTO Product Seminar
London, Feb 20, 2016**

- 14:00 – 14:30 Welcome
Gathering, drinks and snacks
- 14:30 – 15:10 Introducing ATTO
Ori Goren, CEO
- 15:10 – 16:00 Marketing ATTO in the UK
Marcel Zwart, EU Sales Manager
- 16:00 – 16:15 Break
- 16:15 – 17:00 ATTONOMY
Izikim Goldman
VP Research & Development
- 17:00 – Seminar wrap-up

CLICK TO REGISTER

movinglife

ATTO
Folding & Splitting

20. Mr David states that the opponent also initiated an email campaign, targeting UK distributors and advertised in industry magazines including 'The Home Care Industry Information Service' (THIS) magazine. Mr David describes THIS as, 'a long running magazine for the mobility, disability, independent living and rehabilitation industry'.

21. Mr David provides details of units sold (scooters) and turnover figures for the same years, which relate to all ATTO products sold in the UK for that year.

| Year | ATTO scooters sold | Turnover (USD) |
|------|--------------------|----------------|
| 2016 | 80 | 190,000+ |
| 2017 | 100 | 280,000+ |
| 2018 | 190 | 470,000+ |
| 2019 | 260 | 470,000+ |
| 2020 | 200 | 450,000+ |

⁷ See exhibit RD1, page 16.

| | | |
|------|-----|------------|
| 2021 | 490 | 1,000,000+ |
| 2022 | 480 | 1,000,000+ |

22. Invoices are dated between 13 July 2016 and 25 October 2022. They show sales of ATTO and ATTO SPORT mobility scooters and accessories such as seat cushions and armrests, flight batteries, flight kits and voltage adapters.⁸

23. Mr David states that the opponent’s marketing for the ATTO Products in the UK include supporting and working with UK-based suppliers, attending relevant exhibitions, print advertising and digital advertising. He provides the following expenditure figures:

| Year | Marketing expenditure (USD) |
|-------------|------------------------------------|
| 2018 | 13,000+ |
| 2019 | 8,000+ |
| 2020 | 30,000+ |
| 2021 | 30,000+ |
| 2022 | 80,000+ |

24. A Tweet dated 26 April 2016 by National Accessibility, Inclusion & Disability (Naidex) reads:

“Kristoffer Thorirsson @CompareMobility will be demonstrating the Atto mobility scooter exclusively today in Naidex Connects. Head over!”

25. Mr David confirms that this relates to an ATTO distributor demonstrating ATTO products at Naidex Connects at the NEC in Birmingham.⁹ He draws my attention to the number of attendees at the event and gives the example that the 2022 Naidex event anticipated 9,000 visitors.

⁸ See exhibit RD3

⁹ See exhibit RD4

26. Further evidence of ATTO's attendance at the show in 2019 and 2021 include the following from the Moving Life Facebook page:¹⁰



27. A write up of the 2019 show highlights the ATTO scooter, which the author, Derek Hirst, describes as, *“a mobility scooter that can fold and fit into the overhead compartment on a plane. It can also then be separated into two parts for easier storage”*.

28. Leaflets are provided that show the opponent's stockist, John Preston Healthcare, attending the Motorhome and Caravan Show 2018.¹¹ It gave live demonstrations of ATTO products at the show, which Mr David describes as popular, for example, in 2022, it was attended by 100,000 people.

¹⁰ See exhibit RD8

¹¹ In other photographs, John Preston Healthcare can be seen on the banner behind the scooter.



29. The accompanying text about the product reads:

“Our Product Specialist will be offering demonstrations on the ATTO folding mobility scooter at the Motorhome & Caravan show in the NEC Birmingham.

The Atto Folding Mobility Scooter is the most advanced travel scooter or folding scooter on the market today.

It folds to the size of a travel suitcase in a matter of a few seconds and can be wheeled behind you with great ease. This is ideal for travelling through airports or bringing with you in your motorhome, caravan or trains and buses.

The ATTO also splits apart in a few seconds meaning the heaviest part you lift is just 16.2kg.

It also means that your ATTO can be stored or put to the side without taking up too much space – the full dimensions are below.”

30. Mr David provides a screen shot of a You Tube video (the video itself has not been provided).¹² It purports to show Devon Disability Collective demonstrating, “ATTO

¹² See exhibit RD6

Folding Mobility Scooter UK by Moving Life in the Boot of a Mini.” The video was posted on 2 November 2018 and had 28,711 views by the date it was printed, which is not provided. Mr David describes the Devon Disability Collective as a supplier to the NHS and submits that it has, *‘significant reach and influence within the mobility community...’*.

31. Mr David states that the ATTO scooter has been featured on QVC, ‘the UK’s most popular shopping channel’. This appears to have been in August 2020, though the supporting exhibit is undated.¹³ He provides a print accessed via the waybackmachine, which shows QVC had 64k+ followers in December 2019.¹⁴

32. Mr David provides prints from Google Ads that show four advertisements dated somewhere between March 2022 and June 2023 (all but a month of which is after the relevant date). The advertisements are all from Moving Life and relate to the Atto and Atto Sport scooters.¹⁵

33. Undated examples of print advertising are provided. Mr David states these are examples of advertisements placed in Disability Motoring UK Magazine.¹⁶ The first is the launch of the ATTO Sport scooter at the Folding Scooter Store. The second is an advertisement by the opponent for ‘ATTO the world’s most portable scooter’. Both offer free demonstrations at home or by video.

34. The mark appears in the following presentation on the scooters themselves and on the packaging:



¹³ See exhibit RD7

¹⁴ See the print on page 7 of Mr David’s witness statement

¹⁵ See exhibit RD9

¹⁶ See exhibit RD10



35. The movinglife sign can also be seen on the scooters in grey and blue, embossed white on white and on the ATTO Sport in silver on a grey background:



36. The opponent asks its customers to provide feedback on its range of ATTO products. Prints of 99 reviews have been supplied.¹⁷ These are dated between 19 November 2016 and 22 May 2023. Of the 99 reviews, 72 are for ATTO scooters, the rest relate to armrests, backpacks for the scooters, seat cushions, batteries, flight kits, baskets, bags, carryalls, pouches and mobile phone holders.

37. Since 2017, the opponent has asked its customers to register the ATTO products they have purchased. Mr David provides a print of 495 product registrations from UK customers.¹⁸ They are dated between 25 September 2017 and 2 June 2023. The

¹⁷ See exhibit RD11

¹⁸ See exhibit RD12

registrations shown all seem to relate to the purchase of the scooters themselves, rather than accessory goods.

38. Mr David also provides a print from trust pilot that shows three five-star reviews from March and April 2023.¹⁹

39. It is clear from the evidence provided that from 2016 the opponent was selling its ATTO branded mobility scooters in the UK. The applicant submits that the goodwill shown by the opponent is insufficient, with only 80 scooters sold in 2016. In fact, 2016 was the launch year for the opponent in the UK. The total scooters sold from 2016 to 2022 is approximately 1300, with a value in the UK of £2000-£3000 per item.²⁰ Turnover figures for the period amount to \$3-4m. I have no indication of the size of the mobility scooter market, but in any case, the turnover and number of scooters sold by the opponent is not insignificant.

40. Sales were made via the opponent themselves, its authorised retailers and the QVC shopping channel, although evidence of the latter is limited to undated screen shots and a review. There is evidence of 495 products being registered with the opponent, many with positive reviews about the opponent's ATTO scooters.

41. At the hearing, the applicant's counsel made much of the fact that use of the earlier sign by the opponent is only in the form of the stylised ATTO sign, as applied to the scooters. I disagree. In all of the supporting advertising, in print media, online, on invoices and in the review article by Derek Hirst, the opponent's products are described as ATTO scooters. Where there are photographs of the product they are, in each case, alongside plain text use of the ATTO sign.

42. I have borne in mind that use of ATTO is both in stylised and plain word form and find that however the public encounters the opponent's sign, it will always be made aware that the stylised word sign is ATTO and that is the way in which it will refer to the opponent's goods.

¹⁹ See exhibit RD13

²⁰ This is taken from UK reviews and sales material, though the turnover figures given by Mr Rafi are in US dollars.

43. I am satisfied that the opponent had sufficient goodwill in its business at the relevant date and that ATTO was one of the signs associated with that goodwill. The use shown is such that goodwill rests in the words themselves rather than in any particular presentation.

44. I note that the applicant submits in its skeleton argument that, “...*if it is considered that the [o]pponent does have sufficient goodwill in...the word ATTO, the extent and scope of any such goodwill would be limited to the mobility scooters market...*”²¹ Following a limitation to its initial pleadings, the opponent claims goodwill in the ATTO sign for mobility scooters only. Goodwill has only been shown in respect of one type of mobility scooter, which folds to fit in overhead flight compartments or the boot of a car and splits into two for easy storage. In fact, the portability of the ATTO scooters is the primary selling point. Accordingly, I find the term ‘mobility scooters’ to be too broad, given the range of goods included within it.

45. Taking account of the evidence, I find protectable goodwill in the ATTO sign, at the relevant date, for ‘portable mobility scooters’.

Misrepresentation

46. The test for misrepresentation can be found in *Neutrogena Corporation and Another v Golden Limited and Another*, in which Morritt L.J. stated that:²²

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is:

‘is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the

²¹ See paragraph 18 of the applicant’s skeleton argument

²² [1996] RPC 473

public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]?’

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

47. With regard to the number of members of the relevant public who must be deceived or confused for the opponent to be successful in a claim under this ground, I bear in mind the decision in *Lumos Skincare Limited v Sweet Squared Limited and others*,²³ in which Lord Justice Lloyd commented on the paragraph above as follows:

“64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the ‘substantial number’ of people who have been or would be misled by the Defendant's use of the mark, if the Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small.”

48. The opponent has established goodwill in the sign ‘ATTO’. The applicant's mark is ‘Atto’ in a slightly stylised typeface. It submits that the parties' respective marks are identical. The applicant does not accept that the marks are identical, but accepts a medium to high degree of similarity between them.

49. I note that in its international application the applicant ticked the declaration that its mark should be considered as one presented in standard characters, meaning that both marks are word marks registered for the identical term ATTO. Fair and notional

²³ [2013] EWCA Civ 590

use of a word mark includes use in in standard typefaces and cases, meaning the respective marks are identical.

50. In terms of distinctiveness, ATTO has no obvious meaning to the relevant UK public and will be seen as an invented word. Accordingly, ATTO is a sign with a high degree of inherent distinctiveness.

51. The goods for which the applicant's mark is to be used are 'cars; motor coaches; trucks; motor buses; automobile bodies; automobile chassis; motors, electric, for land vehicles; motorcycles; brake pads for automobiles; forklift trucks.

52. The opponent's goodwill is in portable mobility scooters.

53. The opponent has filed evidence from Grace Tsai (with exhibits GT1-GT13) and Aaron Newell (with exhibits AXN0201-AXN0209) concerning the similarity of the parties' respective goods for the purpose of establishing that there will be a misrepresentation. Ms Tsai is a solicitor at the opponent's representative, her witness statement is dated 2 August 2023. Mr Newell is also a solicitor at the opponent's representative. His statement is 6 February 2024. The following points arise:

Goods need not fall into the same category in order to establish misrepresentation.

54. The opponent relies on the well-known decision in LUMOS, which concerned skincare versus nail care goods. It also submits that an increase in the convergence of two fields of activity may contribute to a finding of misrepresentation. In support of this point, it relies on *NAD Electronics Inc v NAD Computer Systems Ltd*,²⁴ in which Ferris J accepted an increase in convergence between audio hi-fi and computers.

The parties are in the same industry, which is transport.

55. It relies on its presence at the Motorhome and Caravan Show at the NEC in 2018 and its stand at Naidex at the NEC in September 2021, as well as a government consultation concerning micromobility vehicles, published on 16 March 2020.²⁵ It

²⁴ [1997] FSR 380

²⁵ See exhibit GT1

concludes, *“Micromobility solutions (which include (e-scooters) are considered to be an important part of the future of transportation in the UK”* ²⁶ It further submits that the opponent’s goods have been categorised as, *‘an innovation in the transport system’*.

ATTO scooters are intended for use in conjunction with other modes of transport

56. The opponent points to the fact that its goods can be placed within a car or taken up to the plane door by the user. It concludes that:

*“Indeed, part of the function of a foldable scooter is to be transported easily in a car so that the user can park the car in a central car park and use the scooter from there to travel the last leg of its journey. This means it is likely that consumers, upon encountering a car (or other such vehicle) branded with the Mark, will assume that the Atto Scooters and the vehicle in question are manufactured by the same company or that there is some other connection / business relationship to them. Consumers would be storing and transporting an “ATTO” in an “ATTO”.*²⁷

The opponent’s goods are complementary to and in competition with traditional vehicles such as cars and motorcycles.

57. In support of this point, it submits that scooters are sold to customers who also purchase cars, electric cars, wheelchair accessible vehicles and powered wheelchairs. Under the mobility scheme a customer is only allowed to lease a car, wheelchair assisted vehicle or powered wheelchair (scooter) at one time.²⁸ It concludes that these goods compete with each other under the scheme.

58. The opponent further relies on the first exhibit to Aaron Newell’s witness statement that shows a company called ‘electric life’ selling electric bicycles, motorbikes and mobility scooters.²⁹

²⁶ See paragraph 32 of the opponent’s skeleton argument.

²⁷ See paragraph 35 of the opponent’s skeleton argument.

²⁸ See exhibit GT11

²⁹ See exhibit AXN0201

Many of the mainstream branded cars offered under the Motability Scheme will be adapted for wheelchair use by specialists.

59. The opponent submits that automotive manufacturers will participate in the scheme and will offer adaptations such as those for scooter use.³⁰ It also draws my attention to the fact that some scooters are road legal and are registered with the DVLA,³¹ and submits that some of these appear similar to a small car.³²

Vehicle manufacturers offer other transport goods and mobility goods

60. The witness statements include examples of motor manufacturers 'branching out' into other types of transport. For example, a Mercedes Benz scooter (a kick scooter, rather than a mobility scooter). A similar Audi scooter is also shown in the applicant's evidence.³³

61. The opponent also provided examples of Toyota branded mobility equipment, including scooters. The evidence relates to the launch of 'C Walk T' at the Tokyo motor show with a proposed commercial launch in Japan in 2020.³⁴

The applicant's submissions regarding misrepresentation

62. These are simply that the level of similarity between the respective mark/sign is irrelevant, as the parties operate in different sectors and target different consumers. It claims that the opponent operates in the field of portable mobility solutions, while the applicant operates within the car industry. It says:

"21. The Witness Statement of Grace Tsai sets out examples of "well-known automotive manufacturers who are involved in manufacturing and developing micromobility vehicles, particularly mobility scooters and other mobility aids". However, there is no evidence to substantiate that consumers themselves would know this or make such a connection.

³⁰ See exhibits GT12 and GT13

³¹ See exhibit AXN0207

³² See exhibits AXN0202 and AXN0203

³³ See exhibit RB19

³⁴ See exhibit AXN0204

22. Ultimately, micromobility products and traditional automotive products like cars and motorcycles make up two entirely different sectors. They have different end users, are sold through different trade channels, and are highly unlikely to fall within the same price brackets. As such, the respective products are not in competition nor complimentary to one another.”

63. In response to the opponent’s evidence of car manufacturers producing scooters, the applicant sought to rely on paragraph 24 of the decision in KONA,³⁵ in which Oliver Morris said:

“24. I have considered the evidence in relation to the commonality of manufacturers and trade channels. Put simply, it is not strong evidence. The evidence relating to common manufacturers is predominantly from outside the UK. However, even bearing in mind that car/bike manufacturing may be a more global business, there is no evidence which suggests to me that it is a characteristic of the UK market that bikes and cars are offered through the same or similar trade channels. There is only one real example of a shared outlet and I agree with Ms Blythe that the evidence paints a picture that this is the exception rather than the rule. The Ford and Nissan evidence takes matters little further forward given its impact in the UK is not particularly clear.”

64. At the close of the hearing, I gave the opponent fourteen days to provide me with its response to the case, which had not been foreshadowed in advance of the hearing. The opponent filed written submissions in response. In short, the opponent draws my attention to the fact that the KONA case was decided under 5(2)(b) and 5(3), based on the evidence before that hearing officer. This is a case brought under 5(4)(a) and must be decided on its own facts and based on the evidence before me. I agree and will do exactly that.

Conclusion on misrepresentation

³⁵ BL O/806/18

65. The application is made for cars, motor coaches, trucks, motor buses, automobile bodies, automobile chassis, motors, electric, for land vehicles, motorcycles, brake pads for automobiles, forklift trucks. The users of such vehicles may also use mobility aids so there may be an area of overlap. However, it exists only at a very high level and will be very small in terms of the entire automobile market, which will include almost all members of the general public. The use and nature of the applicant's goods is different to the opponent's portable mobility scooters.

65. The opponent appears to make two points. The first is that the parties are in the same field of activity, being transport. The second is that a common field of activity is not essential for there to be a misrepresentation.

66. On the first point the opponent suggests convergence between the parties' areas of trade and points to vehicle manufacturers offering other types of micro transport and in one case, a mobility walking aid. This evidence is not helpful as it either relates to goods not offered by the opponent, such as kick scooters (offered by Audi and Mercedes Benz) or relates to markets outside the UK. For example, evidence concerning a Toyota branded mobility aid relates to Japan and talks of a future launch, in Japan. There is no evidence of mobility goods provided by vehicle manufacturers being offered for sale in the UK at all and the evidence falls a long way short of indicating that the relevant UK public would expect motor manufacturers to produce mobility goods of the type offered by the opponent.

67. With regard to the trade channels by which the respective goods will reach the UK market, I have considered the opponent's evidence of a single retailer selling a range of electric items such as bicycles, motorbikes and mobility scooters. However, this is not strong evidence. A store choosing to sell electrically powered items does not prove that consumers would expect all of those items to originate from the same undertaking, any more than a department store would be expected to sell goods of only one undertaking. In any case, only one example has been provided, which looks to be a departure from the norms of the trade rather than showing the way in which these goods are routinely purchased. The opponent's evidence does not show a pattern of motor manufacturers routinely selling vehicles and portable mobility scooters side by side. I find the trade channels are more likely to differ, vehicles being sold through

dealerships, garages and showrooms and their online equivalents, while portable mobility scooters would be purchased via stores, websites and organisations specialising in mobility solutions.

68. The opponent claims its goods are in competition with the applicant's goods. Much is made of the fact that some mobility scooters are road legal and that some look like small cars. This is true, however, these are not goods of the type that are sold by the opponent. The opponent's mobility scooters are small portable mobility scooters, the selling point of which is that they fit into small spaces, such as the boot of a mini. These are clearly not goods that are in competition with trucks, coaches, motorcycles and forklifts or cars.

69. The opponent further claims that its goods and the applicant's goods are complementary. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*,³⁶ the General Court 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."

70. I have already found that the relevant public has not been educated to expect portable mobility scooters to be offered by vehicle manufacturers. The fact that the opponent's goods may be carried in the applicant's vehicles is not sufficient in and of itself to indicate a complementary relationship between the goods in a trade mark sense. As Mr Daniel Alexander Q.C. (as he then was) noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited*:³⁷

"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

³⁶ Case T-325/06

³⁷ BL O/255/13

not follow that wine and glassware are similar goods for trade mark purposes.”

71. The opponent’s second point is that it is not necessary for the parties to be operating in the same field of activity. In *Harrods Limited v Harrodian School Limited*,³⁸ Millet L.J. made the following findings about the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff’s business. The expression “common field of activity” was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff’s claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd.* (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego* case *Falconer J.* acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration,

³⁸ [1996] RPC 697 (CA)

‘...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’:

...

Where there is no or only a tenuous degree of overlap between the parties’ respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v McCain Foods (G.B.) Ltd.* [1984] RPC 501 Slade LJ said (at p.535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at p.545) that:

"even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one."

72. The threshold for misrepresentation is a simple one, ‘is it, on a balance of probabilities, likely that, if the applicant is not restrained, a substantial number of members of the public will be misled into purchasing the applicant’s goods in the belief that they are the opponent’s goods?’³⁹ One factor in this assessment will always be whether or not the relevant public makes any kind of association between the competing goods. Having considered the relevant tests and all of the evidence and submissions made by both parties, the opponent has not overcome the heavy burden of showing the kind of association between the parties’ respective fields of activity that would lead to a connection being made between them that could or would give rise to a misrepresentation. This is despite the fact that the applicant’s mark and the opponent’s earlier sign are identical.

³⁹ Found in the case of *Neutrogena*, see paragraph 46 of this decision.

73. The opposition fails under section 5(4)(a) of the Act.

Costs

74. BYD COMPANY LIMITED has been successful and is entitled to a contribution towards its costs. The opposition was filed on 29 September 2022. Tribunal practice notice 2/2016 provides the applicable scale for tribunal cases launched between 1 July 2016 and 1 February 2023 and is relevant here. I award costs on the following basis:

| | |
|---|--------------|
| Preparing a statement and considering the other side's statement - | £400 |
| Filing evidence and considering and commenting on the other side's evidence - | £1000 |
| Preparing for and attending a hearing - | £800 |
| Total | £2200 |

75. I order Moving Life Ltd to pay BYD COMPANY LIMITED the sum of £2200. 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 28th day of August 2025

Al Skilton
For the Registrar,
the Comptroller General