BL O/0866/25

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK REGISTRATION NO.
UK00003484499

ZOOMO

IN CLASSES 9, 12, 37 & 39
IN THE NAME OF
ZOOMO PTY LTD

AND

IN THE MATTER OF APPLICATION CA505151
TO INVALIDATE THAT REGISTRATION
BY
ZEG ZWEIRAD-EINKAUFS-GENOSSENSCHAFT EG

AND

IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
BY
ZEG ZWEIRAD-EINKAUFS-GENOSSENSCHAFT EG
AGAINST DECISION NO. O/0311/24
DATED 8th APRIL 2024

MR. ALEXANDER BAJJON (of Schlich) appeared for the Appellant/Invalidation Applicant
MR. FLORIAN TRAUB (of Pinsent Masons LLP) appeared for the Respondent/Registered Proprietor

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DECISION

Introduction & Background

1. This is an appeal by ZEG Zweirad-Einkaufs-Genossenschaft EG ("the Applicant") against decision BL O/0311/24 of Beverley Hedley, sitting as a Hearing Officer on behalf of the Registrar of Trade Marks, dated 8 April 2024.

2. Zoomo Pty Ltd ("the Proprietor") is the proprietor of the registered trade mark No. 3484499 ZOOMO covering cover goods and services in classes 9, 12, 37 and 39 ("the Registration"). The Registration was filed on 27 April 2020 and claims an Australian priority date of 20 April 2020. Entry on the register took place on 11 August 2020.

3. On 18 July 2022 the Applicant filed an application to have the Registration declared partially invalid under Section 47(2)(a) of the Trade Marks Act 1994 ('the Act'), relying upon grounds under 5(2)(b) of the Act. The application is directed against the following goods and services of the Proprietor's registration only:

> Class 12: Electric bicycles; electric vehicles; bicycles; power assisted cycles; power assisted pedal cycles; tricycles; power assisted tricycles; folding electric cycles; cycle frames; delivery bicycles.
>
> Class 37: Maintenance and repair of land vehicles; maintenance and repair of vehicles; repair of vehicles; vehicle repair; vehicle servicing.
>
> Class 39: Rental of bicycles; rental of cycles; rental of electronic bicycles.

4. The Applicant relied upon the following two trade mark registrations and the goods/services covered by those registrations, namely:

i) UKTM 801143709 ('709') ZEMO

> Class 12: Vehicles; apparatus for locomotion by land, air or water; land vehicles; two-wheeled vehicles; motorized two-wheeled vehicles; bicycles, electric powered bicycles, motor-assisted cycles; parts, spare parts and fittings for all afore mentioned vehicles (included in this class); parts for bikes and two-wheeled vehicles (included in this class); cycle frames; motors for bicycles; motors for cycles; electric motors for two-wheeled vehicles; motors for land vehicles; handle stem, handle bars, saddle support and saddles for vehicles, especially for cycles.
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> Class 35: Retail and wholesale trade services with goods of class 12, especially with vehicles, two-wheeled vehicles, cycles, parts of vehicles, vehicles accessories, electric vehicles, all aforementioned retail and wholesale trade services also via the Internet and via mail order with the mentioned goods.
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> Filing date: 05 July 2012 (with a claimed priority date of 11 January 2012 from Germany)
>
> Date of entry in register: 29 January 2015

ii) UKTM 801011264 ('264') ZEMO

Class 12: Vehicles; apparatus for locomotion by land, air or water; land vehicles; two-wheeled vehicles; motorized two-wheeled vehicles; bicycles, electric powered bicycles, motor-assisted cycles; parts, spare parts and fittings for all afore mentioned vehicles (included in this class); parts for bikes and two-wheeled vehicles (included in this class); cycle frames.

Filing date: 29 May 2009 (with a claimed priority date of 03 December 2008 from Germany)

Date of entry in register: 06 August 2010

5. The proprietor filed a counterstatement. Although it denied the Applicant's claims overall, it conceded that the parties' class 12 goods were identical.

6. The Hearing Officer dismissed the Application, essentially on the basis that the marks ZOOMO and ZEMO were not so similar as to give rise to a likelihood of confusion, direct or indirect.

The Appeal & Respondent's Notice

7. The Applicant filed an appeal under S.76 of the Act on 2 May 2024. The Grounds of Appeal were:

Ground 1: The Hearing Officer was wrong to consider that the marks were only visually similar to a low-medium degree and consequently placed too much emphasis on the visual differences when determining a likelihood of confusion.

Ground 2: The Hearing Officer did not state to what extent she considered the marks to be conceptually similar, but nevertheless wrongly made a conceptual comparison which affected the overall similarity of the marks and consequently, the likelihood of confusion.

Ground 3: Had the aforesaid errors not been made, the Hearing Officer would have concluded that there was a likelihood of confusion.

8. The Opponent filed a Respondent's Notice on 7 June 2024. Primarily it sought the maintenance of the Hearing Officer's Decision for the reasons that she gave. In addition, it asked that the Hearing Officer's

findings on degrees of the visual/aural similarity of the parties' marks (about which, more below) should be replaced with findings of complete dissimilarity.

Standard of Appeal

9. The standard of appeal is well-known. It is limited to a review, not a re-hearing, and I should only interfere with the Hearing Officer's findings if the decision was wrong. The judgment of Joanna Smith J. in *Axogen Corporation v Aviv Scientific Limited* [2022] EWHC 95 (Ch) commencing at [24] is an appropriate summation of the detail of the approach to be followed:

> 24. Although I was referred to numerous cases on the subject …. the approach of the appeal court to a statutory appeal under section 76(1) of the TMA is uncontroversial. I bear the following principles, relevant to the issues before me, firmly in mind:
> i) The appeal is by way of a review, not a rehearing;
> ii) The appeal court will allow an appeal where the decision of the lower court was "wrong" (see CPR 52.11). Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffices to justify interference;
> iii) The decision of the lower court will be "wrong" if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. Absent an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was "outside the bounds within which reasonable disagreement is possible";
> iv) The approach required by the appeal court depends on a number of variables including the nature of the evaluation in question. There is a "spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision", with decisions of primary fact at one end of the spectrum and multi- factorial decisions (of the type which the parties agree were made in this case by the Hearing Officer) being further along the spectrum.
> v) In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions.
> vi) An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. The evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible;
> vii) Another variable to be taken into account will be "the standing and experience of the fact-finding judge or tribunal". Expert tribunals are charged with applying the law in the specialised fields and their decisions should be respected unless it is quite clear that they have misdirected themselves in law. Appellate courts should not rush to find such misdirections simply because they might have reached a different conclusion on the facts.
> viii) The appellate court should not treat a judgment as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed; "The duty to give reasons must not be turned into an intolerable burden". The reasons need not be elaborate. There is no duty on a judge, in giving her reasons, to deal with every argument presented by counsel in support of his case. It is sufficient if what she says shows the basis on which she has acted. The issues the resolution of which were vital to the judge's conclusions should be identified and the manner in which she resolved them explained.

ix) In evaluating the evidence, the appellate court is entitled to assume, absent good reason to the contrary, that the first instance judge has taken all of the evidence into account.

25. In the context of appeals relating to the likelihood of confusion, an evaluative issue described by Mr Iain Purvis QC sitting as an Appointed Person in ROCHESTER Trade Mark BL 0/049/17 at [31} as "indeterminate and open to debate", Mr Purvis QC went on to say this at [33 }:
" ... the reluctance of the Appointed Person to interfere with a decision of a Hearing Officer on likelihood of confusion is quite high for at least the following reasons:
(i) The decision involves the consideration of a large number of factors, whose relative weight is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case (ii) The legal test 'likely to cause confusion amongst the average consumer' is inherently imprecise, not least because the average consumer is not a real person
(iii) The Hearing Officer is an experienced and well-trained tribunal, who deals with far more cases on a day-to-day basis than the Appellate tribunal
(iv) The legal test involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade. Any wise person who has practised in this field will have come to recognize that it is often very difficult to make such a prediction with confidence. Jacob J (as he then was) made this point in the passing off case *Neutrogena v Golden* [1996} RPC 473 at 482:

'It was certainly my experience in practice that my own view as to the likelihood of deception was not always reliable. As I grew more experienced I said more and more "it depends on the evidence. "' Any sensible Appellate tribunal will therefore apply a healthy degree of self-doubt to its own opinion on the result of the legal test in any particular case.

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

10. This has been reinforced by the recent judgment of the Supreme Court in *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8 at [49]-[50], per :

"49 . ... the appeal court does not carry out the balancing exercise afresh but must ask, in treatment of the question to be decided, such as a gap in logic, a lack of consistency, or a failure to take into account some material factor, which undermines the cogency of the conclusion.

50. On the other hand, it is equally clear that, for the decision to be "wrong" under CPR 52.21(3), it is not enough to show, without more, that the appellate court might have arrived at a different evaluation."

11. When it comes to an evaluation of the similarity, or lack of it, of parties' trade marks, in *TVIS Limited v Howserv Services Limited and ors* [2024] EWCA Civ 1103 ("PETSURE") Arnold LJ said at [34]:

"The assessment of the degree of visual and aural similarity between a sign and a trade mark is a matter for the first instance tribunal."

There is no reason to think that the position is any different for the assessment of conceptual similarity.

12.I bear these principles in mind.

The Hearing Officer's Decision

13. The relevant parts of the Hearing Officer's Decision are as follows:

> *Comparison of marks*
>
> 40) 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. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:
>
> ".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."
>
> It would be wrong, therefore, to dissect the marks artificially, although it is necessary to take account of their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.
>
> 41) The marks to be compared are:
>
> Zemo v ZOOMO
>
> Neither mark lends itself to deconstruction into separate elements; their respective overall impressions are based solely on the single word of which they consist.
>
> 42) Visually, the fact that the earlier mark is presented in title case whereas the contested mark is presented in block capitals is not a point of visual difference because both marks are word-only marks and therefore protection lies in the word itself. Such marks can notionally be used in any standard font. The contested mark consists of five letters; the earlier mark consists of four letters. Both marks share the same initial letter, 'z'. Both marks also share the same two last letters, 'mo'. However, the contested mark contains 'oo' after the initial letter, whereas the earlier mark contains the letter 'e'. In my view, the visual

difference created by the 'oo' on the one hand and 'e' on the other is quite striking on the eye. The fact that both marks are fairly short words means that that difference is more noticeable than it may have been had both marks been longer. Overall, and notwithstanding the shared first letter 'z' and last two letters 'mo', I find a low-medium degree of visual similarity between the marks.

43) Aurally, the contested mark is likely to be pronounced as ZOO-MOH. Mr Traub submitted that the earlier mark is likely to be pronounced as ZEH-MOH (where the 'e' is short as in 'bed') whereas Mr Bajjon submitted that it is likely to be pronounced as ZEE-MOH (where the 'e' sound is long, as in 'zero'). It seems to me that there will be a significant proportion of consumers who pronounce it in the way contended by Mr Bajjon and another significant proportion who pronounce it in the way contended by Mr Traub. Whichever of those two possible pronunciations occurs, both marks consist of two syllables, the second of which is identical and the first of which begins with the same sound created by the initial letter 'z'. Neither the 'eh' or 'ee' sound is similar, in my view, to the sound 'oo'. It follows that regardless of how the letter 'e' is pronounced in the earlier mark, it is different to the 'oo' part of the contested mark. overall, I find a medium degree of aural similarity between the marks, whether the earlier mark is pronounced as 'ZEH-MOH' or 'ZEE-MOH'.

44) Conceptually, the earlier mark will be perceived as a meaningless invented word. The applicant's position is that the contested mark will also be perceived as a meaningless invented word and therefore the conceptual aspect is neutral. The proprietor's position is that it's mark will be perceived as alluding to the word 'zoom' and will therefore evoke the idea of speed or 'zooming along on a bike'. It is true that the contested mark appears to be invented. Nevertheless, even invented marks are capable of being evocative or suggestive of a concept if there are aspects of the mark which resemble a known word. The word 'zoom' is a very well-known English language word. The word 'zoomo' strongly resembles that well-known word and is therefore likely to evoke the idea associated with it which is to move or travel very quickly. It follows that the contested mark evokes a concept which is not shared by the earlier mark."

Merits of the Appeal

Ground 1 – Visual Comparison

14. The Applicant submitted that the Hearing Officer's assessment of visual similarity overlooked *"key principles from the case law regarding the visual comparison of marks*".

15. First, it was said by Mr Bajjon for the Applicant that the Hearing Officer failed to consider the "principle" that a coincidence of letters and their order in short marks favoured an increased level of similarity. Secondly, he submitted the Hearing Officer failed to give sufficient importance to the "principle" that the first part of a mark – in this case the letter "Z" – carries greater influence.

16. The difficulty for the Applicant is that neither proposition is a firm principle as such, but just a rule of thumb. Ultimately the assessment of similarity is a multi-factorial evaluative exercise in which these factors may have greater or lesser weight depending on the circumstances of the individual case. Furthermore, as regards "short" marks, it is equally a rule of thumb that small differences are sufficient to distinguish them, contrary to the Applicant's submissions.

17. Looking at [42] it is clear the Hearing Officer considered these points and gave them the weight they thought appropriate in their evaluation. The Applicant's complaint amounts to no more than a challenge to, and disagreement with, that weight. Such challenges are not amenable to appeal.

18. The second limb to the challenge to visual similarity is that the Hearing Officer neglected "*to take into account the similarities in shape between the lower-case letters "o" and "ee".* It will be recalled the Hearing Officer found that "*the visual difference created by "oo" on the one hand and "e" on the other is quite striking on the eye".* It was said that it was not reasonable for the Hearing Officer to conclude that these differences outweighed the other similarities of spelling/construction.

19. In my view, this is desperate stuff. These letters are not visually similar in any ordinary sense of the term, given their everyday familiarity to consumers who are used to differentiating them from an early age. That is even more true of a comparison between "oo" and "e", even before the additional differentiation arising from their respective use in the context of the marks as a whole. In any event, this submission was put to the Hearing Officer and clearly, they did not accept it. Far from being an unreasonable conclusion, the Hearing Officer's analysis is unimpeachable and I agree with it – the visual difference between "oo" and "e" is indeed striking.

20. I therefore dismiss the first ground of appeal.

Ground 2 – Conceptual Comparison

21. In effect, the Applicant's complaint is that the Hearing Officer decided in terms that the marks were conceptually different, when no conceptual comparison could or should be made. "Zemo" being an invented term, it was said that no conceptual comparison could be made with ZOOMO (notwithstanding it was not disputed the latter would be "*perceived as alluding to the word 'zoom'"*). The Applicant submitted that the Hearing Officer should have made no conceptual comparison and focussed only on the

alleged visual and aural similarities, and that the findings of conceptual difference effectively, and wrongly, diluted those similarities in the assessment of the likelihood of confusion.

22. It is well-established that where one mark has a conceptual meaning or evocation but the other does not, the marks are conceptually different and, furthermore, that such differences can outweigh any visual /aural similarities in so far as they are present (see, for example, C-361/04 *PICASSO/PICARO*).

23. It follows that the Hearing Officer was perfectly entitled to find, in terms, that the marks were conceptually different. The second ground of appeal is therefore dismissed.

Ground 3 – Likelihood of Confusion

24. Ground 3 was entirely dependent on the success of grounds 1 and/or 2. Since I have dismissed both, Ground 3 falls away.

Respondent's Notice

25. Mr Traub conceded that I need only consider the Respondent's Notice if I upheld the Appeal. Since I have dismissed the appeal in full I need say no more about the Respondent's Notice.

Overall Outcome

26. The Appeal is dismissed in its entirety. The Hearing Officer's Decision is upheld in all respects.

Costs

27. The Proprietor as the successful party is entitled to its costs. Both parties indicated they were content with costs to be awarded on the standard scale (per TPN 2/2016).

28. In the proceedings below the Hearing Officer ordered ZEG Zweirad-Einkaufs-Genossenschaft eG to pay Zoomo Pty Ltd the sum of £1600.

29. On this appeal, in respect of its preparation for and attendance at the hearing I order ZEG Zweirad-Einkaufs-Genossenschaft eG to pay Zoomo Pty Ltd the further sum of £1000.

30. The total sum of £2600 is payable by ZEG Zweirad-Einkaufs-Genossenschaft eG to Zoomo Pty Ltd within 21 days from the date of issue of this Decision.

Philip Harris
Appointed Person
22 September 2025