O/0953/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003964486

BY HEYBIKE INC.

TO REGISTER THE TRADE MARK:

HEYBIKE

IN CLASS 12

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 445555

BY WINORA-STAIGER GMBH

BACKGROUND AND PLEADINGS

1. On 6 October 2023, HEYBIKE INC. ("the applicant") applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 27 October 2023. The applicant seeks registration for the following goods under the above application:

Class 12 Bicycle saddles; Folding electric bicycles; Motorized bicycles; Motorized mobility scooters; Self-balancing one-wheeled electric scooters; Self-balancing unicycles.

2. The application was opposed in full by Winora-Staiger GmbH ("the opponent") on 29 January 2024 based upon sections 5(2)(b) and 5(3) of the Trade Marks Act ("the Act"). The opponent relies upon the following trade mark:

HAI BIKE

Comparable UK trade mark (EU) registration no. UK00906498505[1]
Filing date 30 November 2007.
Registration date 2 July 2013.

3. Under section 5(2)(b), the opponent relies upon its class 12 "bicycles, and parts and accessories (as far as not included in other classes), including saddle". The opponent also claims that there is a likelihood of confusion because the goods are identical and similar, and the marks are similar.

4. Under section 5(3), the opponent relies upon its class 12 "bicycles". The opponent also claims that a link would be made between the parties goods, which "would lead to an unfair advantage" as this would make the applicant's "advertising and marketing

[1] Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

much easier". The opponent claims that use of the applicant's mark would weaken the earlier mark's ability to identify its goods as coming from the opponent, and that this would lead to "dilution and blurring of the identity of the earlier mark". Moreover, the opponent claims that the "strong image" of its mark which projects its quality, durability, manufacturing expertise and marketing success would be transferred onto the applicant's goods, "which stands to damage the reputation of the earlier mark", which includes "diluting the exclusivity and pulling power of the opponent's mark and its business". The opponent claims that "the applicant would unfairly benefit from the long-standing and established selling power of the opponent's goods".

5. The applicant filed a counterstatement denying all of the claims.

6. The opponent is represented by Reddie & Grose LLP and the applicant is represented by Trademarkia. Neither party requested a hearing, however, the opponent filed written submissions in lieu. The applicant filed written submissions during the evidence rounds and the opponent filed evidence in chief. I make this decision having taken full account of all the papers.

7. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

8. The opponent's evidence consists of the witness statement of Christoph Mannel dated 2 July 2024. Mr Mannel is the Managing Director of the opponent, and his statement is accompanied by 14 exhibits (CM01-CM14).

9. Whilst I do not propose to summarise them here, I have taken all of the evidence and the parties' submissions into consideration in reaching my decision and will refer to them where necessary below.

DECISION

Section 5(2)(b)

10. Section 5(2)(b) 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."

11. The opponent's trade mark qualifies as an earlier mark pursuant to section 6 of the Act. The earlier mark had completed its registration process more than five years before the relevant date (the filing date of the mark in issue). Accordingly, the use provisions at section 6A of the Act do apply. However, as the applicant did not request that the opponent prove use of its mark, the opponent is entitled to rely upon all of its goods without demonstrating that it has used its mark.

Section 5(2)(b) case law

12. The following principles 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 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 great 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 the earlier mark to mind, 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

13. The competing goods are as follows:

Opponent's goods	**Applicant's goods**
Class 12 Bicycles, and parts and accessories (as far as not included in other classes), including saddle.	Class 12 Bicycle saddles; Folding electric bicycles; Motorized bicycles; Motorized mobility scooters; Self-balancing one-wheeled electric scooters; Self-balancing unicycles.

14. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

15. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

> (a) The respective uses of the respective goods or services;
>
> (b) The respective users of the respective goods or services;
>
> (c) The physical nature of the goods or acts of service;
>
> (d) The respective trade channels through which the goods or services reach the market;
>
> (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
>
> (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

16. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court ("GC") stated that:

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

17. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade*

Mark (BL O/399/10) and *BVBA Management, Training en Consultancy v. BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

18. 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 GC stated that "complementary" means:

> "… there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think the responsibility for those goods lies with the same undertaking."

19. I bear in mind that the opponent's specification uses the word "including". I note that the use of this word does not limit the preceding term, but is used only to provide examples of goods falling within the broader category. On this basis, the opponent is entitled to rely upon the term "parts and accessories of bicycles" at large.

Bicycle saddles.

20. The applicant's above goods fall within the broader category of "bicycles, and parts and accessories (as far as not included in other classes), including saddle" in the opponent's specification. The goods are identical on the principle outlined in *Meric.*

Folding electric bicycles; Motorized bicycles.

21. The applicant's above goods fall within the broader category of "bicycles" in the opponent's specification. The goods are identical on the principle outlined in *Meric.*

Self-balancing one-wheeled electric scooters; Self-balancing unicycles.

22. I consider that the applicant's above goods are similar to "bicycles" in the opponent's specification. The parties goods are all types of vehicles which are used as a method of transportation, and therefore overlap in purpose. However, I note that the applicant's goods are one-wheeled whereas the opponent's goods are two-

wheeled, and therefore they differ in nature. The goods will nonetheless overlap in user, being members of the general public. I find that the applicant's unicycles and the opponent's bicycles are powered by pedals, and the applicant's self-balancing electric scooters and electric bicycles (which are encompassed by the opponent's term "bicycles") are powered by electricity, meaning that their methods of use overlap. Without any evidence before me, I do not consider that the goods would be sold through the same trade channels. As the goods are all types of vehicles, they may be in competition, however, they are not complementary. I therefore find that the goods are similar to between a low and medium degree.

Motorized mobility scooters.

23. The applicant's above goods are typically four-wheeled or three-wheeled modes of transport, which have a full-sized flat seat, used by those who have limited mobility. I also find that the applicant's goods are typically used for short distance travel. They are, therefore, quite distinct in nature and method of use from the opponent's "bicycles" which consist of two wheels and a small saddle, and can be used for relatively long distance travel, or to increase the users fitness. The purpose of the goods overlaps to the extent that they are both modes of transport, albeit the specific purpose of the applicant's goods are to assist people with mobility issues. The users are unlikely to overlap, and I have no evidence before me to establish that there is an overlap in trade channels.[2] Instead, I find that mobility scooters are likely to be sold by specialist retailers. The goods are unlikely to be in competition, nor are they complementary. Taking the above into account, I find that the goods are dissimilar. However, if I am wrong in this finding, I consider that at best, the goods are similar to only a low degree.

The average consumer and the nature of the purchasing act

24. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In

[2] The evidence provided by the opponent in **exhibit CM14** only shows an overlap in trade channels between electric bicycles and electric scooters.

Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited, [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

25. The average consumer for the goods will be members of the general public, and in the case of mobility scooters, specifically those with mobility issues. I also consider that the parties' vehicle goods are likely to be purchased relatively infrequently and they will be expensive purchases that require additional care and attention. The average consumer will take various factors into consideration such as the safety, cost, durability, performance, comfort and suitability of the vehicle for the user's needs. Consequently, I consider that a between a medium and high degree of attention will be paid by the average consumer when selecting the goods.

26. However, in relation to accessories for bikes, including saddles, these are more likely to be cheaper purchases, with the average consumer taking into consideration the compatibility with its vehicle, its comfort and durability. I therefore find that the average consumer will pay a medium degree of attention when purchasing these goods.

27. The goods are likely to be obtained by self-selection from retail outlets or online equivalents. In my view, the consumer would typically wish to see these goods in person and, in all likelihood, test them out before purchase. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount an aural component to the purchase given that advice may be sought from specialist retail assistants and word-of-mouth recommendations may play a part.

Comparison of the trade marks

28. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in 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."

29. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

30. The respective trade marks are shown below:

Opponent's mark	Applicants' mark
HAI BIKE	**HEYBIKE**

31. The opponent's trade mark consists of the letters "HAI" and the word "BIKE". The word BIKE will be understood as non-distinctive for the goods relied upon. Consequently, the letters "HAI" will be the dominant and distinctive element in the mark, playing a greater role in the overall impression, with "BIKE" playing a lesser role.

32. The applicant's mark consists of the two words "HEY" and "BIKE", conjoined. For reasons I will come to discuss in my conceptual comparison, they are likely to be read as a unit, evoking the meaning of "hello bike". There are no other elements to contribute to the overall impression which lies in conjoined words.

33. Visually, the marks overlap in the word "BIKE" which appears at the end of the marks and the letter "H" being the first letter of both marks. These act as visual points of similarity. However, the second and third letter of each mark differs, being "AI" in the opponent's mark and "EY" in the applicant's mark. These act as visual points of difference. I therefore consider that the marks are visually similar to no more than a degree.

34. Aurally, the word "BIKE" in both marks will be given its ordinary dictionary pronunciation. In its submissions in lieu, the opponent submits that the "HAI" element in its mark is identical to the common word "HAY". However, I disagree. I consider it likely that some average consumers will view it as an acronym and thus pronounce each letter individually. I also consider that for the average consumers who will pronounce "HAI" as a word, the letters "AI" at the end of a word in the English language typically create an "EYE" sound (such as chai, samurai, bonsai). Consequently, I find that "HAI" would be pronounced as "HI".

35. I consider that the beginning of the applicant's mark will be given its ordinary dictionary pronunciation "HEY", and therefore the "H" element at the beginning of the marks overlap aurally. Nevertheless, the "I" and "EY" elements of the marks act as points of aural difference, making the marks as a whole aurally similar to between a medium and high degree.

36. Conceptually, in its submissions in lieu, the opponent submits that "where the HAI element is heard by the consumer and understood as the word HEY, these elements will also share an identical semantic meanings [sic]". However, as noted above, I do not consider that "HAI" in the opponent's mark would be articulated as the word "HAY" (and, therefore, would not invoke the word "HEY" in the mind of the consumer). Consequently, I do not accept this line of argument.

37. The applicant's mark consists of the ordinary dictionary words "HEY" (a casual alternative for the greeting "hello") and "BIKE" (the two-wheeled pedalled vehicle) which together will be understood as conveying "hello bike". The applicant submits that the word "HAI" in the opponent's mark is a German word which translates in English to "shark" and therefore the mark as a whole means "shark bike". The applicant states that this is supported by the fact that the opponent is a German company and that they made this intention clear when they filed for a mark at the USPTO. Nevertheless, my assessment of the marks must be made from the perspective of the UK average consumer, and I have no evidence before me that a significant proportion of UK consumers would know that "HAI" is a German word that translates to "shark". I consider that it will most likely be viewed as an acronym or an invented word which evokes no conceptual meaning. Consequently, the only point of conceptual similarity between the marks arises from the common use of the non-distinctive word, BIKE. I therefore find that the parties' marks are conceptually similar to between a low and medium degree.

Distinctive character of the earlier trade mark

38. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger [1999] ECR 1-2779, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically

widespread and long-standing use of the mark has been; the amount invested by the undertaking in promotion of 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)."

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

40. I will begin by assessing the inherent distinctive character of the opponent's "HAI BIKE" mark. As noted above, the word BIKE is clearly non-distinctive for bicycles and the word "HAI" will either be seen as an acronym or as an invented word which evokes no conceptual meaning to UK consumers. If it is viewed as an acronym, it will be inherently distinctive to a medium degree. If it is viewed as an invented word, it will be inherently distinctive to a high degree.

41. I will now assess whether the evidence filed by the opponent is sufficient to demonstrate enhanced distinctiveness. The relevant market for assessing this is the UK market.

42. Mr Mannel states that HAIBIKE was launched in 1995, with screenshot evidence of the brand's history exhibited in **CM02** establishing that the brand was founded in Germany. The opponent's goods can either be bought directly through its website or via official Haibike dealers in the UK. Mr Mannel states that the first "Haibike" was an electric mountain bike, which was sold in the UK via justebikes.co.uk in May 2011, as demonstrated by **exhibit CM03**. I note that the "Haibike eQ X-DURO" is priced at £2,899.52 in this exhibit. I have also been provided with further screenshots from the opponent's website and third party websites showing the opponent's goods for sale in **exhibit CM06**, however, these screenshots are all undated. Nevertheless, **exhibit CM05** contains a "Haibike dealerbook" which shows the opponent's range of electric

bikes for 2020. The brochure is written in both German and English, and I note that the Haibike mark is clearly shown on the down tube of the bikes, as follows:

43. To support the above evidence, Mr Mannel has provided the following table which shows "the sales and revenue figures for bicycles sold each calendar year between January 2019 and December 2023 under the HAI BIKE mark" to the opponent's UK dealers:

	2019 CY	2020 CY	2021 CY	2022 CY	2023 CY
Sales	In excess of **5,000 bicycles**	In excess of **11,000 bicycles**	In excess of **8,000 bicycles**	In excess of **9,000 bicycles**	In excess of **7,000 bicycles**
Revenue (GBP)	In excess of **7,000,000**	In excess of **17,000,000**	In excess of **14,000,000**	In excess of **16,000,000**	In excess of **13,000,000**

44. Mr Mannel states that in October 2022, the opponent partnered with RaceCo Cycles UK to open a "Haibike Experience Centre" in Birmingham, and the opponent also opened an Experience Centre with Primera Sports in Bournemouth in June 2023. These centres are reported in articles contained in **exhibit CM07**. The Birmingham experience centre appears to be a section of the RaceCo Cycles UK store (which is stated to be "one of the leading Mountain Bike and Cycle stores in the UK") dedicated to displaying Haibike bikes. The Bournemouth centre is described as "the first Haibike specific store in the UK".

45. Mr Mannel confirms that in 2023, "there were 235 active Haibike dealer accounts in the UK", which is supported by a screenshot from the opponent's website in **exhibit**

CM06 showing a map which pins 18 Haibike dealers located across Scotland, Ireland, England and Wales. However, this screenshot is undated and therefore I am unable to determine whether all of these locations were active before the relevant date. The only invoice evidence provided by the opponent is 2 invoices contained in **exhibit CM06**. Mr Mannel states that these invoices are between the opponent and "a UK dealer" which show use of the Haibike brand in the footer of the invoice. However, the invoices are between "RALEIGH"[3] and "PURE ELECTRIC" or "BRITISH BIKE HIRE", and not the opponent. I also note that whilst the word "HAIBIKE" is shown on the footer of the invoices, the invoices themselves do not show the sale of Haibaike goods.

46. Mr Mannel states that with regard to the opponent's investment and exposure of its mark to consumers in the UK, he has provided the following annual advertising and marketing spend for HAI BIKE between 2017 and 2022:

2017	2018	2019	2020	2021	2022
110,000 GBP	115,000 GBP	180,000 GBP	315,000 GBP	285,000 GBP	350,000 GBP

47. Mr Mannel confirms that the above figures have been rounded down and therefore the actual figures are in excess of the aforementioned numbers which appear in the table.

48. **Exhibit CM08** contains a variety of third party articles (from ebike companies such as electrek and mbr mountain bike rider) dated between 15 June 2021 and 27 January 2023 reviewing the opponent's electric bikes and mountain bikes. I note that the bikes are priced between £2,400 and £10,000. Mr Mannel also states that the opponent's bikes have received multiple design awards from reddot in 2018 and 2021, an IF design award in 2018, a Design & Innovation awards in 2018, 2019, 2021 and 2023.

49. A 2021 reader survey report from ebike-mtb.com, which is the "leading e-mountain bike magazine" is contained at **exhibit CM04**. The survey was conducted to determine what the "hottest brands" of 2021 were, and this was voted for by over 16,000 readers.

[3] Raleigh and the opponent are both bicycle brands owned by the Accell Group, as confirmed by the 2021 annual report contained in **exhibit CM01**.

HAIBIKE was voted best brand of electric mountain bikes which participants currently use, and the top brand of electric mountain bikes which participants intend to buy next. I note that UK-readers were the second largest participant group, making up just over 10%. To support this, Mr Mannel states that he was informed by the UK Market insight manager that the market share held by HAIBIKE (in the context of the electric mountain bike market) was between 10 and 15% in December 2022.

50. While Mr Mannel has provided screenshots of the opponent's Instagram and YouTube posts,[4] I have not been provided with any accompanying evidence to show how many UK consumers were subscribed to these accounts, or exposed to the posts/videos, before the relevant date. Nevertheless, I have also been provided with the engagement numbers for 6 of the opponent's "Haibike UK" Facebook posts, which are dated between 9 January 2020 and 12 July 2020.[5] It shows that the total engagement per post amounted to between 640 and 36,433. I also note that each post clearly contains the opponent's bikes. Furthermore, the opponent has engaged in the sponsorship of athletes as part of its promotional activities, some of which have appeared in competitions in the UK.[6] The opponent also hosted its own racing competition called the "Haibike UK Mini Enduro Series" between 2017 and 2023.[7] However, it is not clear to me how widely viewed these events would have been by UK consumers.

51. Lastly, I note that the opponent did appear at the Motorhome & Caravan Show in the NEC in Birmingham in October 2019, which attracted approximately 100,000 visitors. A picture of its stand is exhibited at **CM11**, which clearly displays bikes on "HAIBIKE" branded stands.

52. Taking the above into account, it is clear that the opponent has been selling its goods since at least 2011, with its sales from 2019 to the relevant date being significant (with the sale of over 40,000 bikes amounting to over £67,000,000 in the UK).[8] The

[4] **Exhibit CM10**
[5] **Exhibit CM10**
[6] **Exhibits CM12** and **CM13**
[7] **Exhibit CM13**
[8] The table contained in paragraph 43 states that the figures provided by the opponent are "in excess", meaning that the sales and units have been rounded down, which is why my calculations have been made stating "over" the amount provided.

advertising spend is not insignificant and it is consistent, and there is some supporting evidence of promotional sponsorships (albeit it is not clear what the reach of these would have been). Further, there is evidence of average consumers having voted for HAIBIKE as a favourite brand for electric mountain bikes. In my view, the distinctiveness of the earlier mark benefits from a reasonable degree of enhancement in relation to electric mountain bikes, which takes the distinctiveness of the earlier mark overall to a high degree or a very high degree for those goods (depending on the inherent starting point, as discussed above).

53. For the avoidance of doubt, in reaching this finding, I have borne in mind that the evidence of use shows the letters/word HAI and BIKE conjoined (either in standard text or stylised), whereas the mark relied upon in these proceedings is “HAI BIKE” (as two separate words). In my view, nothing turns on this. This is because the word BIKE is a recognisable dictionary word, which is likely to be picked out by the average consumer as a descriptive word for the goods in question. Consequently, the average consumer will readily breakdown the conjoined letters/word into HAI and BIKE, in the same way as the earlier mark relied upon.

Likelihood of confusion

54. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact 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 that he has retained in his mind.

55. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to no more than a medium degree.
- I have found the marks to be aurally similar to between a medium and high degree.
- I have found the marks to be conceptually similar to between a low and medium degree.
- If the “HAI” element of the opponent’s earlier mark is seen as being an acronym, it will be inherently distinctive to a medium degree, which has been enhanced through use to a high degree.
- If the “HAI” element of the opponent’s earlier mark is seen as an invented word it will be inherently distinctive to a high degree, which has been enhanced through use to a very high degree.
- I have identified the average consumer as members of the general public (and in the case of mobility scooters, specifically those with mobility issues) who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that between a medium and high degree of attention will be paid during the purchasing process for the vehicle goods, and a medium degree of attention will be paid for its parts.
- I have found the parties’ goods to be identical to similar to a low degree.

56. Taking all of the factors listed in paragraph 55 into account, even bearing in mind the principle of imperfect recollection, I am satisfied that the parties’ marks are unlikely to be mistakenly recalled as each other.

57. Notwithstanding the identity of some of the goods, and the high level of inherent and enhanced distinctive character possessed by the opponent’s mark, I do not consider that the consumer paying a medium or between a medium and high degree of attention during the purchasing process will overlook the differences between “HAI” and “HEY” at the beginning of the parties’ marks. Given that the purchasing process is predominantly visual, the visual differences will be immediately apparent for the

average consumer. It is also well established that where the meaning of at least one of the two supposedly conflicting marks at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them.[9] In this instance, the applicant's mark has a clear and specific meaning; "hello bike". This creates a strong conceptual hook to differentiate it from the word "HAI" in the opponent's mark which will either be perceived as an acronym or an invented word which evokes no meaning. Taking all of the above into account, I do not consider there to be a likelihood of direct confusion.

58. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C. sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10:

> "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

[9] *The Picasso Estate v OHIM*, Case C-361/04P, CJEU

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. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor Q.C. (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". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

60. I bear in mind that Mr Purvis QC *in L.A Sugar Limited* sets out that there are three main categories of indirect confusion and that indirect confusion 'tends' to fall in one of them (paragraphs 16 & 17).

61. The common element, which I have found to be non-distinctive and descriptive of the goods, certainly cannot be said to fall into category a). A non-distinctive addition has not been added to either mark as per category b), as the differences between them are placed in the second and third letters of the marks (AI vs EY). I also do not consider that the change of the "HAI" to "HEY" elements is consistent with a brand extension as per category c), especially as the marks have clear and distinct conceptual differences. While I bear in mind that the examples set out by Mr Purvis are not exhaustive, I cannot see any other basis upon which indirect confusion should

be found, nor has the opponent identified any in its written submissions. I do not consider there to be a likelihood of indirect confusion.

62. The opposition based upon section 5(2)(b) of the Act is dismissed.

Section 5(3)

63. Section 5(3) of the Act states:

> "5(3) A trade mark which –
>
> > (a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark."

64. Section 5(3A) of the Act states:

> "Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected."

65. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

> a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24.*

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26.*

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63.*

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42.*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; Intel, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79.*

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34.*

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74.*

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs

particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40.*

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

66. The conditions of section 5(3) are cumulative. Firstly, the opponent's and applicant's mark must be identical or similar. Secondly, the opponent must show that its earlier mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must have established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the opponent's mark being brought to mind by the later mark. Fourthly, assuming that the first, second and third conditions have been met, section 5(3) requires that one or more types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

67. The relevant date for the assessment under section 5(3) is the date of application of the applicant's mark i.e. 6 October 2023.

Reputation

68. In *General Motors*, Case C-375/97, the CJEU held that:

> “25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.
>
> 26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.
>
> 27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.
> 28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State‘. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout‘ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

69. In determining whether the opponent has demonstrated a reputation for the goods in issue, it is necessary for me to consider whether its mark will be known by a significant part of the public concerned with the goods. In reaching this decision, I must take all of the evidence into account including “the market share held by the trade mark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertakings in promoting it.”

70. Earlier in my decision, I found that the distinctive character of the opponent’s mark had been enhanced through use. I recognise that reputation is not the same as enhanced distinctive character, but the same factors are to be taken into account in both assessments.

71. The evidence clearly established that the opponent has been selling its goods since at least 2011, with the turnover from 2019 to the relevant date amounting to over £67,000,000 in the UK. This was generated from the sale of over 40,000 bikes. As noted above, this is supported by advertising spend which is not insignificant and it is

consistent, as well as examples of advertising including brochure evidence, third party article evidence and promotional sponsorships. Further, there is evidence of average consumers having voted for HAIBIKE as a favourite brand for electric mountain bikes. On this basis, I consider that the evidence is sufficient to establish a reputation. In my view, the opponent had a reasonably strong reputation for electric mountain bikes at the relevant date.

Link

72. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

> The degree of similarity between the conflicting marks
>
> The marks are visually similar to no more than a medium degree, aurally similar to between a medium and high degree and conceptually similar to between a low and medium degree.
>
> I also bear in mind that the visual, aural and conceptual similarity between the marks predominantly arises only from the common use of the non-distinctive word, BIKE.
>
> The nature of the goods for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods, and the relevant section of the public
>
> I will proceed on the basis that the goods are identical, as that represents the opponent's best case.
>
> The strength of the earlier marks' reputation
>
> The opponent enjoys a reasonably strong reputation for electric mountain bikes in the UK at the relevant date.

The degree of the earlier marks' distinctive character, whether inherent or acquired through use

If the "HAI" element of the opponent's earlier mark is seen as being an acronym, it will be inherently distinctive to a medium degree, which has been enhanced through use to a high degree.

However, if the "HAI" element of the opponent's earlier mark is seen as an invented word it will be inherently distinctive to a high degree, which has been enhanced through use to a very high degree.

Whether there is a likelihood of confusion

I do not consider there to be a likelihood of direct or indirect confusion.

73. I am now required to determine whether, in this particular case, the relevant public would bring the opponent's mark to mind when confronted with the applicant's mark. That is, to make a link between them.

74. I have found that the marks are visually similar to no more than a medium degree, which mainly arises from the shared use of the non-distinctive word "BIKE" at the end of the marks. The shared use of this non-distinctive word results in the marks being aurally similar to between a medium and high degree and conceptually similar to between a low and medium degree.

75. The "HAI" element at the beginning of the opponent's mark which will either be perceived as an acronym or an invented word, evokes no meaning. The "HEY" element at the beginning of the applicant's mark is an ordinary dictionary word which would be understood to the average consumer as denoting a casual alternative for the greeting "hello". On this basis, there is a clear conceptual difference between the marks. As noted above, I have also found the purchasing process in this case to be predominantly visual. I therefore consider that the distance between these marks (visually and conceptually) is sufficient to offset any similarity between the parties' goods. In light of this, I consider that upon encountering the marks, the average

consumer is unlikely to make a link between them, even when they are used on identical goods. Consequently, as I have found there to be no link between the marks in the minds of the relevant public in the UK, there can be no resulting damage caused to the opponent's earlier mark. However, even if a link is made, it will be too fleeting for damage to occur.

76. The opposition based upon section 5(3) of the Act is dismissed.

CONCLUSION

77. The opposition is unsuccessful, and the application may proceed to registration.

COSTS

77. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the applicant the sum of **£1,300** as a contribution towards the costs of the proceedings.

78. The sum is calculated as follows:

Considering the Notice of opposition and preparing a counterstatement	£300
Considering the opponent's evidence	£600
Preparing and filing written submissions during the evidence rounds	£400
Total	**£1,300**

79. I therefore order Winora-Staiger GmbH to pay HEYBIKE INC. the sum of £1,400. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 10th day of October 2025

L FAYTER

For the Registrar