

**BL O/1206/24**

**O/0332/24**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**TRADE MARK APPLICATION NO. 3761804**

**BY SE BICYCLES COMPANY LIMITED TO REGISTER AS A TRADE MARK:**



**IN CLASSES 6, 7, 9, 11, 12, and 35**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. OP000434606**

**BY ENERGICA MOTOR COMPANY S.P.A.**

**AND**

**IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON**

**BY ENERGICA MOTOR COMPANY S.P.A.**

**AGAINST A DECISION OF OLIVER ROSE' MEYER**

**DATED 11 APRIL 2024**

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## DECISION

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### Introduction

1. This is an appeal from a decision of Oliver Rose'Meyer acting for the Registrar, dated 11 April 2024, in relation to opposition proceedings filed by Energica Motor Company S.p.A. ("**the Appellant**") against UK Trade Mark application no. 3761804 for the mark shown on the cover page of this decision ("**the Respondent's Mark**") owned by SE Bicycles Company Limited ("**the Respondent**").

2. The Respondent's Mark was applied for in respect of the following goods and services:

**Class 6:** Bicycle locks; metal stands for bicycles.

**Class 7:** Clutches and parts thereof; transmissions and transmission shafts; bearings; shock absorbers; springs; starter motors; kick starters; cylinders and parts thereof; camshafts; valves and fittings; crank shafts and piston rings; gear shafts and parts thereof; carburettors and parts thereof; connection rods; oil pumps and oil filters; electrical generators, alternators and dynamos; bearings for engines; chains; starting and ignition apparatus for motor vehicles; electrical generators and parts thereof.

**Class 9:** Electrical switches, electrical cut-offs; speedometers and parts therefor; batteries for land vehicles; helmets.

**Class 11:** Lamps, reflectors for lamps and lights; bulbs; tail lights for land vehicles; lights for bicycles.

**Class 12:** Vehicle axle assemblies; brake shoes, brake pads; clutches and parts thereof; transmissions and transmission shafts; bearings; vehicle wheel hubs; direction indicators; shock absorbers; springs; starter motors; cylinders and parts thereof; valves and fittings; cranks for motorcycles, cycles and bicycles; cranks [parts of land vehicles]; connection rod; connection rods; oil pumps and oil filters; bearings for engines; kick starters; chains; indicators for land vehicles; metal rods/shafts for use within gear shift apparatus, being parts for land vehicles; magnetic

flywheels, flywheels being parts for land vehicles; Pedal land vehicles; cycles; bicycles, tricycles; folding bicycles, cycle cars; baskets, panniers, bag carriers, luggage carriers, bells, covers, mudguards, saddles, direction indicators, all for use on pedal land vehicles; stands and kickstands for pedal land vehicles; bicycle pumps, handlebars, bicycle bar ends, bicycle saddle posts, bicycle bar extensions, bicycle trailers, bicycle rims, bicycle cranks, stands, chains, stabilisers, spokes, sprockets, horns, structural parts, fitting bicycle covers, brakes, derailleurs, gears, frames, wheels, hubs, water bottle cages, pumps, children's bicycle seats, twist grips, baskets adapted for bicycles, brake cables, suspension systems, front forks, toe clips; parts and fittings for all the aforesaid goods; none being tyres, inner tubes and treads for recapping tyres, nor parts and fittings for tyres, inner tubes and treads for recapping tyres.

**Class 35:** Retail services, wholesale services, electronic retail services, mail order retail services all in connection with the sale of Bicycle locks, metal stands for bicycles, clutches and parts thereof, transmissions and transmission shafts, bearings, shock absorbers, springs, starter motors, cylinders and parts thereof, camshafts, valves and fittings, crank shafts and piston rings, gear shafts and parts thereof, connection rods, oil pumps and oil filters, electrical generators, alternators and dynamos, bearings for engines, chains, starting and ignition apparatus for motor vehicles, electrical generators and parts thereof, electrical switches, electrical cut-offs, speedometers and parts therefor, batteries for land vehicles, helmets, lamps, reflectors for lamps and lights, bulbs, tail lights for land vehicles, lights for bicycles, vehicle axle assemblies, brake shoes, brake pads, clutches and parts thereof, transmissions and transmission shafts, bearings, vehicle wheel hubs, direction indicators, shock absorbers, springs, starter motors, cylinders and parts thereof, camshafts, valves and fittings, crank shafts and piston rings, connection rods, oil pumps and oil filters, bearings for engines, kick starters, chains, indicators for land vehicles, metal rods and/or shafts for use within gear shift apparatus, being parts for land vehicles, magnetic flywheels, flywheels being parts for land vehicles, Pedal land vehicles, cycles,

bicycles, tricycles, folding bicycles, cycle cars, baskets, panniers, bag carriers, luggage carriers, bells, covers, mudguards, saddles, direction indicators, stands and kickstands for pedal land vehicles, bicycle pumps, handlebars, bicycle bar ends, bicycle saddle posts, bicycle bar extensions, bicycle trailers, bicycle rims, bicycle cranks, stands, chains, stabilisers, spokes, sprockets, horns, structural parts, fitting bicycle covers, brakes, derailleurs, gears, frames, wheels, hubs, water bottle cages, pumps, children's bicycle seats, twist grips, baskets adapted for bicycles, brake cables, suspension systems, front forks, toe clips, parts and fittings for all the aforesaid goods; none being tyres, inner tubes and treads for recapping tyres, nor parts and fittings for tyres, inner tubes and treads for recapping tyres.

3. The Appellant opposed the application under s.5(2)(b) of the Trade Marks Act 1994 (“**the Act**”), directed against all of the goods and services specified in the Application, relying on all of the goods covered by the following earlier registered word mark (“**the Earlier Mark**”):

**ENERGICA**

UK trade mark registration number UK00917922575

**Class 12:** Parts of Electric vehicles (EV); Electric apparatus for locomotion by land; Electric apparatus for locomotion by air; Electric apparatus for locomotion by water; Electric motors for electric land vehicles; Electric micro cars; Electric motorbikes; Electric motor cycles; Electrically operated scooters; Electric cars; Electric bicycles; Electric quadricycles; Electric aquatic vehicles; Electric jet skis; Electric snowmobiles; Boats and Electrically powered watercraft.

4. Since the Earlier Mark had not been protected for five years or more at the filing date of the Application, it was not subject to the proof of use requirements specified in section 6A of the Act.
5. Neither party filed evidence, but both parties filed written submissions in lieu. As neither party requested a hearing, the decision was made on the papers.

### The Hearing Officer's Decision

6. The Hearing Officer decided that it was not necessary for him to undertake a full review of the goods and services covered by both parties' trade marks as he found that some of the class 12 goods were identical. He therefore proceeded on the basis that some of the Respondent's goods were identical to some of the goods covered by the Earlier Mark. If the opposition was successful in respect of those goods, then he would go on to consider the parties' goods and services in full.
7. In its written submissions, the Appellant submitted that the average consumer would be the general public at large, and that the visual element would play a significant role in the purchasing act, as would the aural element. The Hearing Officer agreed with the Appellant to the extent that the average consumer would include the general public, but added that it would also include businesses that specialise in the provision of vehicle equipment. He found that the purchasing process would be predominantly visual, without ruling out an aural element, and that the average consumer would be paying a medium degree of attention.
8. The Hearing Officer based his decision on a finding that a significant proportion of consumers, while not instantly recognising the word ENERGI due to the stylisation of the word in the Respondent's Mark, would still decipher that word from the sign. He concluded that there was no more than a medium degree of visual similarity between the marks, that they were aurally similar to a medium to high degree, and that they were conceptually similar to a high degree, but that *"the unknown nature of the 'CA' at the end of the [Earlier Mark] will act as a slight point of conceptual difference"*.
9. The Hearing Officer found the Earlier Mark to have no more than a medium degree of inherent distinctive character, with no claim having been made as to the Earlier Mark having acquired an enhanced degree of distinctiveness through use.
10. The Hearing Officer concluded that there would be no likelihood of direct confusion due to the addition of the letters "CA" in the Earlier Mark, the significant stylistic differences created by the typeface in the Respondent's Mark, and the average consumer considering that the shared conceptual hook of a reference to "energy" was coincidental.
11. Having recognised these differences, the Hearing Officer concluded that the average consumer would not assume that the marks were owned by economically linked undertakings, and so found no likelihood of indirect confusion either.

12. Consequently, the opposition failed in its entirety.

### The Appeal

13. The Appellant filed a Notice of Appeal to the Appointed Person under s.76 of the Act. At the hearing before me, which was held remotely, the Appellant was represented by Jessica Vallis and Rowland Buehrle of Beck Greener LLP. The Respondent did not attend and was not represented.

### Standard of review

14. It is well established that in order to interfere with the decision of the Hearing Officer I must be satisfied that there was a distinct and material error of principle in the decision or that the Hearing Officer was wrong. The relevant principles were set out in *Axogen Corporation v Aviv Scientific Limited* [2022] EWHC 95 (Ch) at [24]. An appeal is by way of review, not a rehearing. Neither surprise at a Hearing Officer's conclusion nor a belief that she or he has reached the wrong decision will justify interference. 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. In the absence of 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*" (*Actavis Group PTC v ICOS Corporation* [2019] UKSC 1671 at [80]). 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 (*TT Education v Pie Corbett Consultancy* [2017] RPC 17 at [52(iv)], *REEF Trade Mark* [2003] RPC 5 at [28] and *Fine & Country Ltd v Okotoks Ltd* [2014] FSR 11 at [50]-[51]).

15. In a recent trade mark appeal in *Stitch Editing Limited v. TikTok Information Technologies Ltd* [2023] EWHC 1167 (Ch), Sir Anthony Mann said at paragraphs [6] to [8]:

*"6. The correct approach to appeals such as this has recently been confirmed in the decision of Richards J in Instagram LLC v Meta 404 Ltd [2023] EWHC 436 (Ch). In that case (which was another trade marks appeal case) the judge followed the guidance to be applied in appeals generally and set out in Volpi v Volpi [2022] EWCA Civ 464.*

*"i) An appeal court should not interfere with the trial judge's conclusions on primary facts unless it is satisfied that he was plainly wrong.*

ii) The adverb "plainly" does not refer to the degree of confidence felt by the appeal court that it would not have reached the same conclusion as the trial judge. It does not matter, with whatever degree of certainty, that the appeal court considers that it would have reached a different conclusion. What matters is whether the decision under appeal is one that no reasonable judge could have reached.

iii) An appeal court is bound, unless there is compelling reason to the contrary, to assume that the trial judge has taken the whole of the evidence into his consideration. The mere fact that a judge does not mention a specific piece of evidence does not mean that he overlooked it.

iv) The validity of the findings of fact made by a trial judge is not aptly tested by considering whether the judgment presents a balanced account of the evidence. The trial judge must of course consider all the material evidence (although it need not all be discussed in his judgment). The weight which he gives to it is however pre-eminently a matter for him.

v) An appeal court can therefore set aside a judgment on the basis that the judge failed to give the evidence a balanced consideration only if the judge's conclusion was rationally insupportable.

vi) Reasons for judgment will always be capable of having been better expressed. An appeal court should not subject a judgment to narrow textual analysis. Nor should it be picked over or construed as though it was a piece of legislation or a contract."

7. So far as the decision below is evaluative, an appellate court should also approach the appeal with caution:

"76. So, on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out a balancing task afresh but must ask whether the decision of the judge was wrong by reason of some identifiable flaw in the judge's treatment of the question to be decided, "such as a gap in logic, a lack of consistency, or a failure to take account of some material factor, which undermines the cogency of the conclusion". (Re Sprintroom Ltd [2019] EWCA Civ 932)

8. And last, as Richards J observed in *Instagram*, proper respect should be paid to the decision of an expert tribunal in the field in question:

"26. Finally, it is relevant to observe that this is an appeal from a tribunal with particular expertise. As Lady Hale observed in *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49 at paragraph 30, the court should approach the appeal on the basis that it is probable that an expert tribunal, charged with applying the law in their specialist field, has probably got it right."

16. I have borne those principles firmly in mind.

### Grounds of Appeal

17. The Appellant relied on three grounds of appeal, which I will consider in turn.

## **Ground One: Visual similarity**

18. The Appellant argued that “the Hearing Officer erred in finding that despite the marks have only a “medium degree of visual similarity”, they are distinguishable on the basis that:

- a. The [Respondent’s Mark] contains “heavy stylization elements”
- b. The [Earlier Mark] is not capable of being presented in a similar typeface to the [Respondent’s Mark].”

19. The Hearing Officer said the following in relation to the respective marks and their visual similarity:

*“26. The opponent’s mark consists of the single word ‘ENERGICA’. There are no other elements in the mark to contribute to its overall impression, which lies in the word itself.*

*27. The applicant’s mark is a composite mark containing the word ‘ENERGI’ which is presented in a stylised uppercase font. To the left of the word is a stylised triangular device. While the device is noticeable, one’s eye is drawn to the word element which makes the greater contribution in forming the overall impression. As for the stylisation of the word itself, I am of the view that this has quite a large impact on the overall impression of the mark (though to a slightly lesser degree than the word itself). The stylisation of the word goes beyond a simple or standard typeface where the word would be immediately identifiable and instead disguises the word to such a degree that the consumer would not instantly recognise it. Further, for some consumers the stylised typeface will render the word unreadable, however a significant proportion of consumers will still decipher the word ‘ENERGI’ from the sign. To give the opponent their best case it is upon these consumers that I will base the remainder of this opposition because it is established that if a court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention, then it may properly find infringement (See *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41).*

### **Visual Comparison**

*28. Visually, it cannot be denied that both marks share the same first six letters (ENERGI). The difference between the marks is the addition of the letters ‘CA’ at the end of the opponent’s mark, and the inclusion of a device element in the applicant’s mark, as well as the stylised font used. Regardless of the different impressions these elements have in their respective marks, they are all points of visual difference. Additionally, while the opponent’s mark is a word only mark, it is not capable of being used in heavily stylised typefaces, like the one used by the applicant. As a result, the stylisation is a considerable point of difference. Bearing in mind my assessment of the overall impression of the marks, I consider that there is no more than a medium degree of visual similarity between the marks at issue.”*

20. The Appellant submitted that “*visually the marks are highly similar, due to the entire verbal element of the Respondent’s mark (which the HO acknowledges to have the greatest contribution in forming the mark’s overall impression) being a reproduction of the majority of the Appellant’s mark*”. The Appellant did not give any further reasons why the Hearing Officer was wrong to find the marks to be visually similar to a medium degree, as opposed to a high degree.

21. Lord Justice Arnold recently said the following in *TVIS Limited v Howserv Services Limited and others* [2024] EWCA Civ 1103 when dealing with the appellant’s submission that the judge had erred by simply holding that the marks in issue in that case were visually and aurally “*similar*” rather than “*highly similar*”:

*“34. I do not accept this argument for two reasons. The first is that no error of principle on the part of the judge has been identified. 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. Nor can it be said that the judge’s assessment is plainly wrong.*

*35. The second and more fundamental reason is that, while it is conventional for first instance tribunals in trade mark cases to articulate their assessment of the degree of visual and aural similarity between signs and trade marks using words such as “high”, “medium” or “low”, there is no legal requirement for tribunals to do so. All that is required is for the tribunal to assess the nature and extent of any similarities. This is because what matters is not the verbal label that is applied to the assessment, but whether the similarities in conjunction with the other factors which must be taken into account lead to a likelihood of confusion. It is possible for there to be no likelihood of confusion despite a relatively high degree of visual and aural similarity. Equally it is possible for there to be a likelihood of confusion despite a relatively low degree of visual and aural similarity. It depends on the other factors that are in play.”*

22. The Appellant has therefore not shown an error of principle by the Hearing Officer in reaching his conclusion simply because the verbal element of the Respondent’s Mark formed the “*greater contribution*”<sup>1</sup> in forming the mark’s overall impression and was a reproduction of the majority of the Earlier Mark. Instead, the Appellant’s argument simply amounts to a disagreement with the conclusion that the Hearing Officer reached on the degree of visual similarity between the marks.

23. However, the Appellant also submitted that the stylisation of the Respondent’s Mark was not so unusual that if the Appellant were to apply a similar italicised, blocky stylisation to its word mark and link the letters together, consumers would not be able to distinguish

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<sup>1</sup> The Hearing Officer actually said “*greater contribution*” as opposed to “*greatest contribution*” as stated in the Appellant’s Notice of Appeal, but nothing turns on it.

between the marks. The Appellant argued that that was something it was entitled to do, provided that it did not substantially alter the nature of the mark.

24. The correct approach to the comparison between a word mark and a stylised mark was considered by Mr Iain Purvis K.C. sitting as the Appointed Person in *Mr Heron*, case BL O/954/22. In particular, in paragraph 22 he cited the following paragraph from the EU General Court's decision in *Calvin Klein Trademark Trust v OHIM*, T-185/07

*“48. In that regard, it is important to point out, as the Board of Appeal stated in paragraph 23 of the contested decision, that the examination of the similarity of the marks at issue takes into consideration those marks in their entirety, as they have been registered or as they have been applied for. A word mark is a mark consisting entirely of letters, of words or of associations of words, written in printed characters in normal font, without any specific graphic element. The protection which results from registration of a word mark concerns the word mentioned in the application for registration and not the specific graphic or stylistic elements accompanying that mark. **The graphic representation which the mark applied for may have in the future must not, therefore, be taken into account for the purposes of the examination of similarity** (see to that effect, Case T-211/03 *Faber Chimica v OHIM – Naberska (Faber)* [2005] ECR II-1297, paragraphs 36 and 37; Case T-353/04 *Ontex v OHIM – Curon Medical (CURON)* [2007], not published in the ECR, paragraph 74; and Case T254/06 *Radio Regenbogen Hörfunk in Baden v OHIM (RadioCom)*, not published in the ECR, paragraph 43).”*

25. In that case, the earlier mark was the stylised mark and the mark applied for was the word mark, whereas the opposite is the case here. Mr Purvis K.C. then cited part of the judgment of the EU General Court's decision in *Faber Chimica v OHIM* [2005] ECR II-1297, a case which did involve a stylised mark being applied for and an earlier word mark, and in particular this paragraph:

*“37. In order to assess the similarity between a complex figurative mark and an earlier word mark, the particular graphic or stylistic aspects that the earlier mark might adopt are irrelevant. In any event, the assessment of the similarity with the earlier word mark, which is the only relevant assessment in the present case, should not be replaced by an assessment of similarity with a figurative element which does not form part of the protection conferred by the earlier registration.”*

26. Having cited a third case, *Ontex*, T-353/04, which concerned two word marks, where the Court of Justice of the European Union rejected the argument that the two marks would look extremely similar if written in very small or cursive script, Mr Purvis K.C. summarised the position as follows:

*“28. The position on this line of authorities seems clear. A word mark protects the word itself and the comparison must be made on the basis of the word, not any particular presentation of the word. This excludes arguments based on*

*presenting the word in a specific font, fancy script, roundel or other device. This is the case whether the word mark is the earlier mark (Faber) or the contested mark (Calvin Klein) or indeed both are word marks (Ontex)."*

27. The Appellant was therefore wrong to consider the Earlier Mark in the same or a very similar font to that of the Respondent's Mark. The Earlier Mark had to be considered "*written in printed characters in normal font, without any specific graphic element*". That meant that the visual differences correctly identified by the Hearing Officer in paragraph 28 of the Decision were relevant factors for him to consider when assessing the visual similarity of the marks.

28. As Mr Purvis K.C. explained in *Mr Heron*:

*"38. The ultimate statutory question is whether 'because of the similarity' between the contested sign and the registered mark (and the goods and services), there is a likelihood of confusion. This is a multifactorial question which requires the tribunal to consider the whole of the contested sign and the overall impression it gives to the average consumer.*

*39. The stylisation of a word in a device mark is part of the overall impression given by the device and it therefore cannot be ignored when assessing the likelihood of confusion with a different, word mark..."*

29. The same conclusion can be drawn from paragraph 35 of *TVIS Limited v Howserv Services Limited and others* referred to above. Accordingly, the Hearing Officer was correct to take into account the stylised font, together with all the other visual differences between the marks, as part of his overall assessment of the likelihood of confusion. Of particular relevance to this issue are the following two factors which form part of the standard summary of the principles established by the various decisions of the Court of Justice of the European Union on the likelihood of confusion and the corresponding provisions concerning relative grounds of objection to registration (see paragraph 18 of *TVIS Limited v Howserv Services Limited and others*):

*"(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"*

30. This case does not simply involve the comparison between a mark depicting a word in a particular stylised font and an earlier word mark. The Hearing Officer described the Respondent's Mark as a "*composite mark containing the word "ENERGI" which is*

*presented in a stylised uppercase font*” but also including *“a stylised triangular device”*. He was therefore right to take into account the stylised elements of the mark in his overall assessment of the likelihood of confusion, even though he was wrong to say that the Earlier Mark was *“not capable of being used in heavily stylised typefaces, like the one used by the Applicant”*. I believe what he was intending to refer to in that sentence was the test set out in paragraph 24 above.

31. Accordingly, all the visual differences he identified in paragraph 28 of the Decision were all correctly identified as points of visual difference which could be factored into the Hearing Officer’s overall assessment of the likelihood of confusion. I therefore reject the First Ground of Appeal.

**Ground Two: a finding of a medium degree of visual similarity, together with a high degree of aural and conceptual similarity, should lead to a conclusion that the marks are similar in their overall impression, which is likely to cause direct or indirect confusion.**

32. This ground was drafted in such a way that it could have been read to suggest that in any case where there is a finding of a medium degree of visual similarity, a high degree of aural similarity and a high degree of conceptual similarity, then there should always be a finding of direct or indirect confusion. This was certainly the way in which Mr Buehrlen advanced some of his submissions. For example, he described weighing up the Hearing Officer’s findings on similarity of the marks, a medium distinctiveness and identical goods as *“a slam dunk”* on more than one occasion at the hearing before me, as well as the concept of thinking that you were *“home and dry”* if these factors were present in a case.

33. However, as we have seen from paragraph 35 of *TVIS Limited v Howserv Services Limited and others* above, that is not the case. Lord Justice Arnold specifically referred to the possibility of there being *“no likelihood of confusion despite a relatively high degree of visual and aural similarity”*.

34. One of the arguments that the Appellant made at the hearing before me in support of its submission that the Hearing Officer should have found a likelihood of confusion was that the Hearing Officer was wrong to find visual considerations were of primary importance, as he did in paragraph 38 of the Decision.

35. The Hearing Officer set out his conclusions on the likelihood of direct confusion as follows:

*“37. Having conducted a comparison of the marks at issue, I have determined that:*

- At least some of the goods and services are identical as outlined above.*
- The average consumer is either a member of the general public, or a business specialising in vehicle parts and accessories. Both will demonstrate a medium level of attention during the purchasing process.*
- The purchasing process for the goods and services will be primarily visual in nature, though aural considerations have not been excluded.*
- The opponent’s mark possesses no more than a medium level of inherent distinctive character.*
- The marks at issue are visually similar to no more than a medium degree, aurally similar to a medium to high degree, and conceptually similar to a high degree, albeit with a slight conceptual difference created by the additional letters ‘CA’ in the opponent’s mark.*

*38. However, it is the visual consideration which is of primary importance due to the purchasing process of the respective goods and services being visually dominated [a footnote referred to New Look Limited v OHIM, joined cases T-117/03 to T-119/03 and T-171/03].*

*39. Taking all of the above into account, I consider that the differences between the marks are such that the consumers would be able to accurately recall and sufficiently remember which mark was which. I appreciate that the marks share an identical six letter string, however, the addition of the letters ‘CA’ in the opponent’s mark are subsumed into the body of a different word and are such that they will not be overlooked. I say this because while the mark will be understood as referring to the concept of ‘energy’, the word will still be viewed as a whole and will not be dissected by consumers to the point that it will be viewed simply as ‘ENERGI’.*

*40. In addition, the stylistic differences created by the typeface used in the applicant’s mark are significant and, as above, the opponent’s mark is not capable of being presented in a similar or identical typeface. As a result, I consider that consumers will be able to recall which mark had such heavy stylisation elements and which did not. Lastly, while the distinctiveness of the opponent’s mark is not low and the conceptual similarity between the marks is high, I am of the view that the shared conceptual hook (being a reference to ‘energy’) is something that would be considered coincidental by the consumer, particularly given the nature of the goods for which the opponent’s mark is registered. Consequently, I do not consider that there exists a likelihood of direct confusion between the marks.”*

36. In particular, the Appellant argued that the goods covered by the Earlier Mark related to electric vehicles such as electric bicycles, and that *“the conceptual message, ecological and environmental, credibility and the like”* were likely to be of greater and more

significant importance than visual considerations for class 12 goods. However, there was no evidence before the Hearing Officer to support that submission. Nor would the same conclusion be an obvious one from a review of the goods covered by the Respondent's Mark which, although it would include electric bicycles as it covered "cycles", covered a wide range of goods used for conventional non-electric vehicles and cycles (e.g. "oil pumps and oil filters").

37. The Appellant also argued before me that for specialist component parts in class 12, aural aspects would be more important than visual aspect of the marks, and the average consumer would only pay a low degree of attention, because their concern was to buy the correct part. In the alternative, the Appellant argued that the visual, aural and conceptual aspects should have been given equal weight.

38. I find no fault in the Hearing Officer's description of the purchasing process, which he set out in paragraph 20 of the Decision as follows:

*"20. I agree with the opponent insofar as I also believe the average consumers for the contested goods are the general public, however, I also consider that they will include businesses that specialise in the provision of vehicle equipment. The purchasing of goods such as pedal land vehicles, cycles, bicycles, tricycles, folding bicycles, and cycle cars is likely to be less frequent than for parts and fittings and there will be considerable price variations for the goods. The purchasing process will be predominately visual as consumers will either visit a physical shop, showroom, garage or browse online websites. An aural element cannot be ruled out as consumers may seek advice from sales staff or order parts in person or by telephone. I do disagree with the opponent that the level of attention paid in the purchasing of the goods will be low due to them being routinely replaced. Whilst parts and accessories for vehicles may be replaced more frequently than a vehicle itself, it is my view that there are likely to be a number of factors for consumers to consider during purchase such as suitability for purpose, technical capabilities and aesthetics, so as to select the appropriate part or accessory to ensure that it operates correctly for their chosen vehicle. I therefore find that a consumer will be paying a medium degree of attention."*

39. The Appellant referred to the *New Look* case and suggested that because the opposition was found to be successful in that case, the Hearing Officer should have reached the same conclusion here. However, the Hearing Officer has to decide the case on the facts before him, so the fact that the opposition was successful in *New Look* was not a factor he was obliged to take into account. Since clothing was not in issue in this case, the Hearing Officer's reference to the *New Look* judgment in the footnote to paragraph 38 of the Decision must have been to rely on the proposition that visual, aural and conceptual aspects do not always carry the same weight - paragraph 49 of the *New Look* judgment:

*“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (BUDMEN, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumers choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”*

40. At the hearing before me, the Appellant questioned the Hearing Officer’s reference to *New Look* on the basis that the purchasing process when buying clothes was far more visual than the purchasing process for items listed in the Respondent’s Mark, such as oil filters. The Appellant suggested that when buying items such as oil filters, the purchaser does not care what the product looks like and is only concerned with buying the correct component part for their vehicle, for which they will rely on aural advice rather than visual aspects. Mr Buehrlen suggested that the judgment in *New Look* found that visual comparisons are more important for clothing because trade marks used to appear just on the label of clothes but now tend to appear on the clothing as decoration or embellishments and so form part of the look of the articles themselves, and that the same does not apply to items such as oil filters. However, I can see nothing which says that in the *New Look* judgment (I was not referred to any particular paragraph).

41. The Appellant also suggested that the Hearing Officer should not have found that the purchasing process would be visually dominated because the *New Look* judgment held that evidence was required if the Hearing Officer wanted to argue for “*a particularly onerous purchasing process*”. I believe this was intended to be a reference to paragraphs 42 and 43 of the judgment, where the Court said the following:

*“42. First, the applicant considers that, in the clothing sector, the average consumer is particularly attentive to trade marks so that it is difficult for that person to be misled.*

*43. It should be noted in this regard that the average consumer’s level of attention may vary according to the category of goods or services in question (see, by analogy, Case C-342/97 Lloyd Schuhfabrik Meyer [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of*

*mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.”*

42. In this case, the Hearing Officer was given no evidence to assist him with his analysis of the purchasing process, so he had to do his best based on his own knowledge and experience. As is made clear from paragraph 49 of the *New Look* judgment, the visual, aural and conceptual aspects do not always have the same weight. Hearing Officers are regularly required to determine the purchasing process without any supporting evidence, and I see no reason to criticise the Hearing Officer’s approach in this case. Many items are purchased online these days, and so it is perfectly understandable for the Hearing Officer to have concluded that the average consumer may have searched the internet for the component item they were looking to replace for their vehicle. The results of that search would be visual. The same could equally apply if the consumer visited a retail outlet to look for the component part. It may be that once the item had been found, the consumer would ask the retailer of that item for advice, but the Hearing Officer expressly acknowledged that aural aspects could not be ruled out as the consumer may contact sales staff for advice. So even where the visual appearance of the product itself may be of less importance (and certainly for items such as bicycles the consumer would be particularly interested in what the item looked like), the purchasing process can still be predominantly visual.

43. Accordingly, I reject the Appellant’s suggestion that just because a consumer may not know or care what their oil filter looks like, for example, they will not come across the mark in question visually or take notice of the visual appearance of the mark.

44. I also note that in its written submissions, the Appellant said, *“The visual element will therefore play a significant role, but so too will the aural element”*, which differed from the approach taken at the hearing before me.

45. With respect to the purchasing process, the Appellant said the following in its written submissions:

*“The majority of the goods applied for are vehicle parts and accessories, which are functional in nature and may be routinely replaced, such that the level of attention of the average consumer is likely to be **low to average**. For more expensive items, specifically ‘Pedal land vehicles’... and ‘cycles; bicycles, tricycles; folding bicycles’...the attention of the average consumer may be **somewhat higher**...”* (emphasis added)

which suggests that in fact there was not that much difference between the Appellant's standpoint and the Hearing Officer's finding that the consumer would pay a medium degree of attention.

46. In paragraph 37 of the Decision, the Hearing Officer correctly summarised the relevant different findings which he was required to consider together as part of his overall assessment of the likelihood of confusion. This included aural and conceptual similarity in addition to visual similarities. I find that the conclusion the Hearing Officer reached on the likelihood of direct confusion was one which a reasonable tribunal could have reached.
47. The Hearing Officer concluded as follows in relation to indirect confusion, after setting out the relevant law:

*“44. Consumers, having recognised the difference created by use of the two letters “CA” at the end of the opponent’s mark, and the additional stylisation and device element in the contested mark, would not then assume that they are economically linked undertakings. The common string of letters “ENERGI” is not strikingly distinctive, and consumers would have no reason to artificially dissect the marks to separate the string out from the rest of the mark. I do not consider it logical that an undertaking would remove the last two letters of their mark; this is more than simply removing a non-distinctive element. Whilst I appreciate that the L.A. Sugar categories (referred to above) are not exhaustive, I do not see any other plausible basis on which to conclude that consumers would see the competing marks as deriving from economically linked undertakings. Instead, in my opinion, the shared string of letters will be seen as merely coincidental. Consequently, and bearing in mind the comments of Arnold LJ and Mr Mellor Q.C in the preceding paragraph, I do not consider there to be a likelihood of indirect confusion.”*

48. The Appellant argued that dropping the letters “CA” at the end of the word “ENERGICA” was a “*consistent brand change that you would expect*”. The Appellant also submitted that ENERGI and ENERGICA were both Italian words, but that if the consumer did not know that, they would assume they were both foreign words “*probably of the same origin*”, and that the stylisation of the Respondent's Mark amounted to small variations in trade that one may expect. There was, however, no evidence before the Hearing Officer in respect of the origin of the words.
49. The Appellant therefore submitted that the Respondent's Mark fell within categories (b) or (c) described by Mr Iain Purvis KC sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10.

50. Category (b) was 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, such as adding terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc. That does not apply here where the mark ENERGICA has been changed to ENERGI. The letters CA have no independent meaning, and both marks in question are single, invented or foreign words.
51. Category (c) was 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). There is nothing logical in removing the letters “CA” from “ENERGICA” to form the word “ENERGI” and it is not what one would expect in a brand extension to remove two letters which have no independent meaning from an existing brand. I can also see no reason for finding that the Hearing Officer should have agreed with the Appellant’s contention that *“the addition of the last syllable -CA, would also appear to originate from the same language, the same geography and culture”*. Although it is recognised that the three categories cited in *L.A. Sugar* should not be read as an exhaustive list, I do not consider that the changes made from ENERGICA to ENERGI would be expected by the average consumer to be seen as two brands coming from the same owner.
52. I consider this case to be a good example of what Lord Justice Arnold was referring to in paragraph 35 of *TVIS Limited v Howserv Services Limited and others*. The Hearing Officer in this case found that there was a high degree of conceptual similarity between the marks, because they both alluded to the concept of energy. However, that similarity did not support a finding of a likelihood of confusion because the Hearing Officer found that the shared conceptual hook of an allusion to energy would be considered to be coincidental to the average consumer given the nature of the goods covered by the Respondent’s Mark. Indeed, the Appellant had accepted this connection between the concept of energy and the Respondent’s goods in paragraph 34 of its written submissions where it said: *“The Applicant’s Mark is strongly suggestive of the word “energy”, a concept with which many of the goods will be associated”*. The Appellant incorrectly approached the appeal by suggesting that because it had scored relatively highly in relation to visual, aural and conceptual similarity, with the goods being identical and the Earlier Mark having a medium level of distinctive character, it was inevitable that the opposition should have succeeded.

53. It is not enough for the Appellant to persuade me that a reasonable tribunal could have found a likelihood of confusion between the respective marks. As explained above, I must be persuaded that the Hearing Officer made a distinct and material error of principle or that the Hearing Officer was wrong. I consider that the Hearing Officer's findings of no likelihood of direct or indirect confusion for the reasons set out in paragraphs 34 to 44 of the Decision are findings which a reasonable tribunal could have reached. I therefore reject the Second Ground of Appeal.

**Ground Three: Inherent distinctiveness and the shared concept of “energy”**

54. The Appellant set out this ground in its Notice of Appeal as follows:

*“The Hearing Officer erred in finding that:*

- i) the Appellant's mark ENERGICA possesses no more than a medium level of inherent distinctive character (para 33), on the ground that it will be considered primarily as “somewhat allusive” to the word “energy”, despite acknowledging that consumers will not dissect the mark to the point where it would be viewed as “ENERGI” (para 39) and would view it as either an invented or foreign language word (para 33).*
- ii) that the concept of “energy” shared by the marks would be considered a mere coincidence by the consumer, despite both using the spelling “ENERGI” (such that consumers will primarily perceive both marks as being a foreign version of the word “energy”, particularly as the letters “GI” in Latin languages have a noticeably different pronunciation than the letters “gy” in English).”*

55. No further reasoning or submissions were included in the Notice of Appeal in respect of either of the sub-paragraphs.

56. With respect to paragraph (i), this was not mentioned in the Appellant's skeleton argument at all.

57. In paragraph 33 of the Decision, the Hearing Officer said the following:

*“33. The earlier mark consists of the plain word ENERGICA without any additional stylisation or figurative elements. As such, the inherent distinctive character rests solely in the word itself. 'ENERGICA' is not a dictionary defined word and, as above, will be viewed either an invented or foreign language word. Ordinarily, this would lend itself to a finding of distinctiveness on the higher end of the scale. However, in the present case, the main conceptual message of the opponent's mark is an allusion to the word 'energy'. While I do not consider that this is directly descriptive in the context of the goods for which the mark is registered, I am of the view that it is somewhat allusive. I say this because the opponent's goods (being electric vehicles and their accessories) are such that any reference to 'energy' will be understood, by a significant proportion of average consumers, to allude to an alternative fuel source that powers the*

*vehicles i.e., electricity. The reference to 'energy' for such goods, is therefore, unremarkable from a trade mark perspective. On balance of the above, I find that the opponent's mark possesses no more than a medium degree of distinctive character."*

58. I agree with the Hearing Officer's findings relating to the allusion to energy and the reference to "energy" being unremarkable from a trade mark perspective, and the fact that the Hearing Officer found that consumers would not overlook the additional letters "CA" does not mean that the Earlier Mark should have a higher than medium degree of distinctive character. Just because a mark is a misspelling or adaptation of a common English word does not mean that it must have a higher than medium degree of distinctive character.
59. With respect to paragraph (ii), I do not consider that the change in spelling of the word "energy" to "energi" is so remarkable or unexpected that the average consumer would assume that marks which share the spelling "energi" in place of the word "energy" must come from the same source. Consumers are used to seeing the letter "y" replaced by the letter "i" when a word is used as part of a longer word e.g. "happy/happiness", for example. There was no evidence to support the Appellant's contention that the average consumer would assume that both marks were derived from Italian, or failing that a Latin language, or how the words would be pronounced.
60. I therefore reject the Third Ground of Appeal.

### Conclusion

61. Since the appeal has failed, the Respondent's Mark shall proceed to registration for all of the goods and services applied for.

### Costs

62. The Hearing Officer ordered the Appellant to pay the sum of £500 to the Respondent. Since the Respondent took no part in the appeal, I will not make an award of costs in its favour in respect of the appeal. Accordingly, I order the Appellant to pay the sum of £500 to the Respondent within 21 days of the date of this decision.

Simon Clark  
The Appointed Person  
19 December 2024

### **Representation:**

Appellant: Jessica Vallis and Rowland Buehrle of Beck Greener LLP.  
Respondent: Did not appear