O/1217/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003687243
IN THE NAME OF REDSHAW ADVISORS LIMITED
FOR THE FOLLOWING SERIES OF TRADE MARKS:

IN CLASSES 35, 36, 41 and 42.

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 429848
BY INSPIRED ENERGY PLC

BACKGROUND AND PLEADINGS

1. On 27 August 2021, Redshaw Advisors Limited ("**the applicant**") applied to register the series of UK trade marks found on the cover page of this decision, under number UK00003687243 ("**the contested mark**"). The application was published for opposition purposes on 1 October 2021. Registration is sought for the following services:

Class 35:

Business consultancy and advisory services; Business advice and consultancy services; Business strategy services; Business planning services; Consultancy and advisory services in the field of business strategy; business management; business administration; provision of business information; business appraisals; marketing services; corporate communication services; all the aforementioned relating to the management, assessment and offsetting of carbon emissions, allowances and carbon reduction.

Class 36:

Financial services; commodity trading services; Arranging financial transactions; Arranging and concluding trading and commercial transactions; Trading and brokerage of futures contracts; Exchange market services relation to commodity futures contracts; Fund management; brokerage of carbon credits; brokerage of carbon offsets; all the aforementioned relating to the management, assessment and offsetting of carbon emissions, allowances and carbon reduction.

Class 41:

Education services; Training services; coaching services; organisation of educational conferences; organisation of seminars; organisation of business training; publication services; electronic publication services; publication of manuals.

Class 42:

Providing scientific information, advice and consultancy relating to carbon offsetting; Provision of information, advice and consultancy in relation to carbon offsetting;

Technical research in the field of carbon offsetting; environmental surveys; environmental assessment services; research services in the filed [sic] of carbon emissions and carbon offsetting; technical project studies in the filed [sic] of carbon offsetting; certification services in the field of carbon offsetting; all the aforementioned relating to the management, assessment and offsetting of carbon emissions, allowances and carbon reduction.

2. On 4 January 2022, the application was opposed by Inspired Energy plc ("**the opponent**") based upon section 5(2)(b) of the Trade Marks Act 1994 ("**the Act**"). The opposition is directed against all the applied-for services. The opponent relies upon the following mark to support its claim:

PLAN.IT.ZERO

UK trade mark number: UK00003636835
Filing date: 5 May 2021
Registration date: 22 October 2021
("the opponent's mark")

Services relied upon:

Class 35:
Business management and administration services and advice in relation to energy, sustainability and environmental activities; management of energy programmes; managing onsite generation and renewable energy programmes; management of schemes to comply with energy and carbon legislation; management of energy and renewable energy technology; designing, installing and managing on-site generation, renewable energy and energy reduction programmes; data collection services in relation to energy, sustainability and environmental activities; analysing energy and water usage and managing energy and water reduction programmes; preparation of business reports in relation to sustainability and environmental schemes; reporting and advisory services for businesses in the field of Environmental, Social and Governance (ESG) performance and ratings.

Class 36:

Equipment financing services; provision of investment capital for the purchase and installation of energy efficient technology and decarbonising technology; arrangement of capital investment for the purchase and installation of energy efficient technology and decarbonising technology; financing of projects implementing energy efficient technology; financing of renewable energy, energy efficient, or decarbonising technology; consultancy services relating to the financing of renewable energy, energy efficient, or decarbonising technology; financial planning and investment advisory services in relation to on-site energy generation for businesses.

Class 42:

Environmental consultancy services relating to biodiversity, climate change, pollution, water security and emissions; provision of advisory and consultancy in the fields of sustainability, decarbonisation and environmental issues; preparation of technical reports in the fields of energy and sustainability.

3. The opponent argues that the competing trade marks are similar, the services are either identical or highly similar and that these factors will give rise to a likelihood of confusion.

4. The applicant filed a counterstatement denying the ground of opposition.

5. The opponent is professionally represented by Downing IP Limited; the applicant is professionally represented by Sonder & Clay. Only the opponent filed evidence during the evidence rounds. Neither party asked for an oral hearing, however the applicant elected to file written submissions in lieu.

Relevance of EU law

6. 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. This is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Evidence and submissions

7. The opponent's evidence comprises the witness statement of Mr Michael Downing, a Chartered Trade Mark Attorney, dated 4 October 2023, together with exhibit MPD1. I also note that Mr Downing mentions that he holds a degree in Natural Sciences from the University of Cambridge. Mr Downing identifies that the purpose of the witness statement and the accompanying exhibit is to address the question of similarity of the services and the presence of a likelihood of confusion.

8. Whilst the parties' evidence and submissions will not be summarised here, I have taken them into consideration in reaching my decision and will refer to them below, as and where necessary.

Preliminary issue

9. Mr Downing states within his witness statement:

"I am aware from my own knowledge of environmental issues and the science behind them that in some cases, the best advice might be to not carbon offset, as for a particular business it could be a distraction from other, more meaningful ways of carbon reduction. In other cases, carbon offsetting might be worthy of recommendation. As advisors to a business, it will be important that the Opponent is, and is seen to be, frank and impartial in the advice that its [sic] *gives. If the applicant is using the similar-sounding plannetzero in relation to advice (etc) that is limited to "the management, assessment and offsetting of carbon emissions, allowances and carbon reduction", i.e. carbon offsetting, then a business may well question the Opponent's impartiality if they discover the applicant acting as a broker of carbon credits. To my mind, this is a clear likelihood of confusion which would be harmful to the Opponent*."[1]

1 Witness statement of Mr Michael Downing, paragraph 8.

It is unclear whether this is intended to be expert evidence, or that Mr Downing is an expert in the relevant field. I note that no request was made for permission to adduce expert evidence, and as such, I will treat this as submissions, despite its inclusion within a witness statement. These arguments appear to relate to the possibility of reputational damage to the opponent, which is not a factor that I have to consider under section 5(2)(b).[2] My assessment in this decision is focused solely on whether consumers are likely to confuse the marks based upon the similarity of the marks and the identity/similarity of the services.

DECISION

Legislation

10. Sections 5(2)(b) and 5A of the Act read as follows:

"5(2) A trade mark shall not be registered if because-

[…]

(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".

"5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

2 It seems to me that a legitimate reading of the limitation of the services (which include business advisory services) is that the services are specified as "relating to the management [and] assessment… of carbon emissions … and carbon reduction." Despite Mr Downing's submission in his witness statement, it is therefore anyway not clear to me that the cited reference to the limitation in the opponent's specification is concerned only with carbon credits and carbon offsetting; it refers to advice in relation to carbon reduction, which presents a broader span of environmental options.

11. Given the respective filing dates, the opponent's mark is an earlier mark, in accordance with section 6 of the Act. As it had not been registered for more than five years at the date of application, it is not subject to the proof of use requirements specified within section 6A of the Act. Therefore, the opponent can rely on all of the earlier services identified.

Case law

12. I am guided by the following principles which are gleaned from the decisions of the Court of Justice of the European Union ("CJEU") 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 services

13. Section 60A of the Act provides:

"(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975."

14. All relevant factors relating to the services should be taken into account, which include, inter alia:[3]

- the physical nature of the acts of service;
- their intended purpose;
- their method of use / uses;
- who the users of the services are;
- the trade channels through which the services reach the market;
- whether they are in competition with each other (taking into account how those in trade classify services, for instance whether market research companies put them in the same or different sectors); and
- whether they are complementary to each other. Complementary signifying that "there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those services lies with the same undertaking".[4] Noting that

3 See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.*, [1996] R.P.C. 281 – the "**Treat**" case.

4 *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82, see also *Sandra Amalia Mary Elliot v LRC Holdings Limited,* BL O/255/13.

complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity.[5]

15. In *Gérard Meric v Office for Harmonisation in the Internal Market ('Meric'),*[6] the General Court held that goods or services can be considered as identical when the goods or services designated by an earlier mark are included in a more general category, designated by the trade mark application and vice versa.

16. For the purposes of considering the issue of similarity of services, 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.[7]

17. The services to be compared are those identified above in paragraphs 1 and 2 of this decision.

18. I note from the applicant's written submissions that it accepts that some of the competing services are similar, in particular services within classes 35 and 42.[8] The applicant also accepts that its term "*financial services*" in class 36 is similar to the opponent's services. However, it denies that the remaining terms within class 36, and those within class 41 of its specification are similar to the opponent's services.[9]

19. Whilst the applicant has conceded that there is some level of similarity, it has not specified the precise level of similarity, as such, I will continue to conduct a full analysis of the competing services to determine the overall level of similarity or identity.

Class 35

Business consultancy and advisory services; Business advice and consultancy services; Business strategy services; Business planning services; Consultancy and

5 *Kurt Hesse v OHIM*, Case C-50/15 P, se also *Sanco SA v OHIM*, Case T-249/11
6 Case T-133/05, paragraph 29
7 See *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.
8 Applicant's written submissions, paragraphs 12 and 18
9 Applicant's written submissions, paragraph 13.

advisory services in the field of business strategy; business management; business administration; provision of business information; business appraisals; marketing services; corporate communication services; all the aforementioned relating to the management, assessment and offsetting of carbon emissions, allowances and carbon reduction.

20. The applicant's class 35 services, listed above, are all business management and administration services, relating to environmental activities, or advice and consultancy services relating to the same. I consider the terms "*business appraisals*; *corporate communication services; marketing services*" all fall within the scope of the business management services. As such, I find that the above business management and administration services along with the advice and consultancy services would all be encompassed within the opponent's broad term "*Business management and administration services and advice in relation to energy, sustainability and environmental activities".* Further, the applied-for advice and consultancy services would also include the opponent's term *"reporting and advisory services for businesses in the field of Environmental, Social and Governance (ESG) performance and ratings".* Therefore, it follows that these services are *Meric* identical. However, if I am wrong in applying such a wide scope in relation to the terms "*business appraisals*; *corporate communication services; marketing services*", I still consider it likely those services may be part of a suite of services provided by the same professional undertaking that offers business management and business administration services, such that the competing services may be considered complementary, with common trade channels and overlapping users. As a result, overall, I would still find there to be a medium degree of similarity between the competing services.

Class 36

21. The applicant has admitted that the opponent's class 36 services are similar to its specified term "*financial services*", so I will deal with that term first. In my view, an ordinary understanding of the applicant's term "*financial services*" is that it is wide enough to cover providing financial arrangements to facilitate a particular purpose,

such that, under the *Meric* principle, the opponent's specification of "*financing of renewable energy"* (for example) may be considered to be identical to the applied-for "financial services".

22. I can also deal discretely with the applied-for "*Fund management; [..,] relating to the management, assessment and offsetting of carbon emissions, allowances and carbon reduction."* Fund management services involve studying a client's needs and financial goals to create an investment plan and execute an investment strategy. In relation to the applied-for services they are limited to the management, assessment and offsetting of carbon emissions. The particular fund management services would be included in the opponent's services "*financial planning and investment advisory services in relation to on-site energy generation for businesses*". Consequently, I find these services *Meric* identical.

23. The remaining services in class 36 to be compared are:

The applicant's services:	**The opponent's services:**
Commodity trading services; Arranging financial transactions; Arranging and concluding trading and commercial transactions; Trading and brokerage of futures contracts; Exchange market services relation to commodity futures contracts; brokerage of carbon credits; brokerage of carbon offsets; all the aforementioned relating to the management, assessment and offsetting of carbon emissions, allowances and carbon reduction.	*Equipment financing services; provision of investment capital for the purchase and installation of energy efficient technology and decarbonising technology; arrangement of capital investment for the purchase and installation of energy efficient technology and decarbonising technology; financing of projects implementing energy efficient technology; financing of renewable energy, energy efficient, or decarbonising technology; consultancy services relating to the financing of renewable energy, energy efficient, or decarbonising technology; financial*

	planning and investment advisory services in relation to on-site energy generation for businesses.

24. The opponent argues as follows:

- that the intended result of both parties' class 36 services is for businesses to improve their environmental impact and their Environmental, Social and Governance (ESG) performance ratings;
- that all of its own specified terms are included within the applicant's broader terms *Financial services; arranging financial transactions; trading and brokerage of futures contracts* and are therefore identical;
- that the applicant's class 36 services in relation to carbon offsets and carbon credits have the same intended use, intended users and trade channels to the opponent's services, which include assisting businesses with planning, financing, managing and running energy efficient and decarbonising technology.[10]

25. In contrast, the applicant submits its own Class 36 services all relate to financial trading in commodities and carbon credits, which are very specific financial services and very different from the Opponent's financing services:

"[…] Trading services are typically provided by specialist financial trading companies specialising in stock market activity, whereas financing services are typically provided by banks and other lending institutions. The use of such services is entirely different, one being trading on the stock market for financial gain, whilst the other is securing finance for the acquisition and installation of hardware. Consequently, the users and uses of such services are entirely different. Nor are the services in competition or complementary to one another as they serve such a different purpose."[11]

26. It is my understanding that the applicant's remaining class 36 services listed at paragraph 23 above (brokerage, trading and transactions) are fundamentally for

10 Opponent's Form TM7 continuation sheet, table of services, top of page 3 of 4.
11 Applicant's written submissions, paragraph 15.

buying or selling 'something', "relating to" the management, assessment and offsetting of carbon emissions, allowances and carbon reduction. Such services encompass financial trading - whether by traders or brokers - of commodities (including, for example, carbon credits).[12]

27. It seems to me that of the opponent's earlier specified services, the most similar to the above applied-for services are: "*financial planning and investment advisory services in relation to on-site energy generation for businesses; consultancy services relating to the financing of renewable energy, energy efficient, or decarbonising technology*". I will use this as the point of comparison.

28. I am without evidence or detailed submissions to assist in this assessment of similarity. However, it seems likely that there could be some overlap in companies that provide both the trading services and investment advisory/consultancy services. These companies not only buy and sell assets through trading and brokerage services but also devise strategies to achieve goals laid out by clients which would involve offering financial planning and investment advisory/consultancy services. As such, it follows that there would be an overlap in trade channels. Users would overlap, as a business seeking financial planning and investment advisory services in relation to on-site energy generation may also seek brokerage for carbon credits following the financial planning and investment advisory services. As such, there may be a degree of complementarity as the services are important to one another and it is reasonable for consumers to believe that they come from the same undertaking. However, the method of use and the intended purposes differ. The opponent's services are to provide financial planning and investment advice in relation to onsite energy generation, whereas the applicant's services are trading services on the exchange markets and brokerage services for commodities such as carbon credits. Further, any overlap insofar as they are both a type of financial service is very broad. Overall, I consider the services to be similar to a medium degree.

29. For clarity, I have considered the opponent's remaining financial terms within class 36, and in my view, none of these would put the opponent in a better position. As the

12 'Futures contracts' being a type of trading method used in the financial markets whereby buyers and sellers agreed to trade a specific quantity of a commodity or financial instrument for a specific price at a set point in the future.

applicant submitted, the opponent's remaining services assist businesses in securing finance for equipment that will improve its carbon emissions, whereas the above applied for services are all financial trading or brokerage services for commodities such as carbon credits. Consequently, again, in the absence of any evidence to the contrary, I find that the trade channels, method of use and core intended purpose will differ. Any overlap in nature due to the fact that the competing services fall under the umbrella of financial services, or users, will be to such a generalised degree that it does not engage similarity.

Class 41

Education services; Training services; coaching services; organisation of educational conferences; organisation of seminars; organisation of business training

30. The applicant's above services are not limited, and therefore, these training and education services could include environmental courses in relation to sustainability, decarbonisation, biodiversity, climate change, pollution, water security and emissions. Consequently, there is an overlap between these services and the opponent's class 42 services, such as, for example, "*Environmental consultancy services relating to biodiversity, climate change, pollution, water security and emissions" or "provision of advisory and consultancy in the fields of sustainability, decarbonisation and environmental issues"*. Whilst fundamentally environmental education/training services differ in their nature from environmental advice and consultancy services, the trade channels would overlap where companies offer not only environmental advice or consultancy services on sustainability and decarbonisation themselves but also courses in relation to environmental activities for staff, particularly as focus on sustainability and the environment are becoming increasingly important and there is a need, especially for businesses, to become more educated on this matter. It could also be said that training in relation to environmental activities, and environmental advisory and consultancy services share the same purpose of improving business performance surrounding environmental activities. Further, the user community would tend to be the same, i.e. businesses looking to improve their environmental impact. However, although the deployment of environmental advisory and consultancy services within a business will sometimes give rise to identifying a need for

environmental training, it does not necessarily follow that this would lead the average consumer to believe that the services derive from the same undertaking. Consequently, complementarity does not arise between the services. Overall, I consider these services to be similar to no more than a medium degree.

Publication services; electronic publication services; publication of manuals.

31. The above terms all relate to publication services. The opponent does not explain why it believes that these applied for services are similar to its own services; it is not the role of the tribunal to make findings of similarity on the basis of arguments not raised by an opponent.[13] However, it is reasonably apparent that the opponent's best comparable term is "*Preparation of technical reports in the fields of energy and sustainability"* in class 42 of its specification. Such technical report services would be used by consumers for their own internal business use. It is possible that such reports may come to appear on the websites of larger or public organisations for the general public to view in a bid to be transparent. Nonetheless, at their core the applicant's publication services for third parties differ in nature, method of use, intended purpose, trade channels, and users. The services are not competitive, nor are they complementary, as it is unlikely that prepared technical reports in these particular fields would be published by a third-party publication service. Having regard to the core of the respective services, I find that they are dissimilar.

Class 42

Providing scientific information, advice and consultancy relating to carbon offsetting; Provision of information, advice and consultancy in relation to carbon offsetting; Technical research in the field of carbon offsetting; environmental surveys; environmental assessment services; research services in the field of carbon emissions and carbon offsetting; technical project studies in the field of carbon offsetting; certification services in the field of carbon offsetting; all the aforementioned

13 Iain Purvis KC, sitting as Appointed Person in the *SmartX* trade mark decision BL O/0911/24, at paragraph 32.

relating to the management, assessment and offsetting of carbon emissions, allowances and carbon reduction.

32. The above services are all services that would either include or be included within the opponent's class 42 term "*Environmental consultancy services"*, as such, I find them to be *Meric* identical.

33. As some degree of similarity between the services is necessary to engage the test for a likelihood of confusion, my findings above mean that the opposition must fail against services of the registered mark that I have found to be dissimilar, namely:[14]

Class 41: *Publication services; electronic publication services; publication of manuals*.

The average consumer and the nature of the purchasing act

34. As indicated in the case law cited above, it is necessary to decide who the average consumer is for the parties' services and how they purchase them. "Average consumer" in the context of trade mark law means the "typical consumer."[15] The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of services in question.[16]

35. The parties' specifications cover a range of services, including business management, financial, educational, and scientific/environmental consultancy services, all relating specifically to environmental activities and the management of carbon emissions. Neither party identified who the average consumer is, nor the level of attention that they will pay during the purchasing process. However, in my view, the average consumer for the services is most likely to be a business user.

14 eSure Insurance v Direct Line Insurance [2008] ETMR 77 CA
15 *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).
16 *Lloyd Schuhfabrik Meyer*, Case C-342/97.

36. The services will likely be available through specialist providers. The services are likely to be initially presented to the consumer via websites, and where the services are encountered in physical premises, the marks will be displayed in pamphlets, brochures or signage. The selection process is, therefore, likely to be dominated by the visual component. Nevertheless, I do not discount aural considerations entirely as some consumers will select the services following word of mouth recommendations.

37. The services at issue are wide ranging, and their cost will vary depending on the nature of the services or the level of involvement with the service provider. With regards to the level of attention, as the services are aimed at businesses who are looking to improve their environmental impact, businesses will be concerned to make the right selection suitable to their business needs and their own reputation, considering factors such as cost, experience and reputation of the service provider, and the range of services available. Consequently, I would expect the level of attention paid to be at the higher end of the scale.

Distinctive character of the opponent's mark

38. The distinctive character of a trade mark can be measured only, first, by reference to the services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. 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 C-108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger [1999] ECR I-0000, 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 promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see Windsurfing Chiemsee, paragraph 51)."

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 services to those with high inherent distinctive character, such as invented words which have no allusive qualities. Dictionary words which do not allude to the services will be somewhere in between. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion, since the more distinctive the earlier mark, the greater the likelihood of confusion may be.

40. Although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the opponent has only filed one exhibit throughout these proceedings. Whilst the opponent has not submitted that this is to demonstrate enhanced use of the mark, even if I were to consider this evidence, it is not enough to establish any enhanced use. Consequently, I have only the inherent position to consider.

41. Whilst the opponent has not specifically commented on distinctiveness in either its statement of grounds or its witness statement, the opponent asserts the following within its grounds of opposition:

> "Conceptually, both marks are a pun on the words 'planet' and 'net zero' in reference to reducing and removing carbon emissions to reach net zero. In the Registration 'planet' and 'net zero' are changed to the words 'plan-it-zero' alluding to planning and playing on the word planet. […] Though the puns are

slightly different they both break down ‘planet’ into ‘plan’ and both bring to mind ‘planet’ and ‘net zero’ as a concept.”[17]

42. As for the applicant, it states:

> “The mark of the Opponent also includes the words ‘plan’ and ‘zero’, again entirely descriptive for the services concerned. However, the words are separated by the term ‘IT’, which is highlighted by being separated by punctuation and serves to separate the two descriptive terms and prevents the mark being a recognisable phrase, as the mark of the Applicant is. […]”.[18]

43. The opponent’s mark consists of the words ‘PLAN IT ZERO’ each separated by a full stop. The words will each be seen in line with their everyday meanings. In addition, a significant proportion of average consumers will recognise the words ‘PLAN’ and ‘IT’ as a play on words for planet whilst also being understood as planning for something. I keep in mind that a mark can hold two separate meanings at once.[19] Further, in the context of the services for which the mark is registered, the mark as a whole alludes both to the planet and planning for the planet, with the word ‘ZERO’ being allusive of ‘net zero’. This concept is now well known, referring to the ambition to cut carbon emissions to levels that can be absorbed and durably stored by nature and other carbon dioxide removal measures, leaving zero in the atmosphere. In my view, I find that the earlier mark possesses a low degree of inherent distinctive character.

Comparison of the marks

44. It is clear from Sabel BV v. Puma AG 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 them, bearing in mind their distinctive and dominant components. The CJEU stated in Bimbo SA v OHIM, Case C-591/12P, that:

17 Opponent’s Form TM7 continuation sheet, top of page 2 of 4.
18 Applicant’s written submissions, paragraph 8
19 *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch), Mann J.

"34. […] 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."

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

46. The respective trade marks are shown below:

The applicant's mark	The opponent's mark
plannet zero plannet zero	PLAN.IT.ZERO

Overall impressions

47. As set out above, the applicant's mark is a series of marks, where the only difference between them relates to the presentation of the word 'zero' and the blue circle surrounding it. The applicant's series of marks are figurative, containing the words 'plannet zero' all in standard, lower-case font with the word 'zero' presented in a blue circle. The words 'plan', 'net' and 'zero' are identified through the use of different colours. Within both marks of the series, the word 'plan' is presented in black whilst

the middle word 'net' is presented in blue. In the first mark of the series the word 'zero' appears in black and is surrounded by an outline of a blue circle, whilst in the second mark of the series, the word 'zero' appears in white and is presented against the backdrop of a solid blue circle. I am of the view, that whilst not descriptive, as asserted by the applicant,[20] the series of marks will be viewed as highly allusive of the nature/intended purpose of the services, i.e. that they are services for planning to get to net zero. Further, the combination of the words 'plan' and 'net' will be understood either as a pun for planet or a misspelling of planet, which again is allusive of the services as they are for the ultimate purpose of helping the planet. Consequently, I find that the words will be viewed as a whole and play an equal role in the overall impression with the colour, stylisation and circular background device playing a slightly lesser contribution. This applies equally to both marks within the series.

48. The opponent's mark is a word only mark, as described above, it consists of the words "PLAN IT ZERO" with full stops separating each word. The overall impression of the mark lies within the words in equal measure as they will be viewed as a whole, with the punctuation playing a lesser role.

Visual comparison

49. The competing marks are visually similar as they both share the words 'plan' at the beginning of the marks, a position where the attention of consumers is usually directed,[21] and 'zero' at the end of the respective marks. The respective marks use different letter case but this is of no significance because the registration of word-only marks, such as the opponent's mark, provides protection for the words themselves, which may be presented in upper or lower case.[22] The competing marks differ in the presence of their respective middle words 'NET/IT'. Furthermore, the applicant's series of marks each display a blue circular background device surrounding the word 'zero'; in the first mark of the series, in the form of a blue circular outline, and in the second mark of the series, as a solid blue circle, neither of which is present within the opponent's mark. The applicant's marks also contain a light degree of stylisation and

20 Applicant's written submissions, paragraph 7
21 *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02
22 *Migros-Genossenschafts-Bund v EUIPO*, Case T-189/16

a moderately complex colour combination, (black, blue and white for the first mark of the series and black and blue for the second mark of the series), whilst in contrast the registered mark is a word only mark. As for the opponent's mark, it contains punctuation between each word, which is not replicated in the contested marks. Taking all of this into account, I am of the view that the marks are visually similar to a medium degree.

Aural comparison

50. The colour, stylisation, and blue circular background device will obviously not be articulated within the series of applied for marks. Consequently, both marks will comprise of four syllables. The applicant's marks will be pronounced as 'PLAN/NET/ZEE/ROW', whilst the opponent's mark will be verbalised as 'PLAN/IT/ZEE/ROW'. The competing marks aurally coincide in three out of four syllables due to the presence of the identical words 'plan' and 'zero', however, they differ (slightly) in their respective second syllables. Overall, the marks are aurally highly similar.

Conceptual comparison

51. With regards to any conceptual similarity the applicant asserts.

> "When the marks are viewed from a conceptual standpoint, the mark of the Applicant makes clear reference to planning for 'net zero.' The term 'net zero' is widely used for the relevant services, as can be seen from Exhibit MPD1 submitted by the opponent. There are multiple references, including:
>
> "The UK's target to reach net zero emissions by 2050" (Page 3)
>
> "If we're going to continue to this trend and meet net zero emissions" (Page 3)
>
> "The Carbon Law effectively states that to reach net zero by 2050" (Page 4)
>
> "Net zero is a vital part to building a sustainable business" (Page 7)

These are just a few of very many examples. Clearly the term is entirely descriptive. The mark of the Opponent uses the same words 'PLAN' and 'NET' to allude to their descriptive meanings, planning for net zero. However, the mark, when considered as a whole, has no specific meaning, so there is no direct concept and no conceptual similarity."[23]

52. The opponent's arguments are set out above at paragraph 41 and 42.

53. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.[24] In my view, both the competing marks will be perceived by a significant proportion of consumers as containing a pun on the word planet, albeit achieved in different ways through the use of different second words. It is my view that the word 'planet' in relation to the specific services is allusive, since all the services are fundamentally for the overall purpose of protecting or improving the planet. Moreover, through the use of the word 'plan', the competing marks also allude to planning. In conjunction with the shared word 'zero' and the services at issue, consumers will understand the marks to be alluding to a goal of 'net zero' for the planet. However, the use of ".IT." in the opponent's mark creates the concept of I.T services or modern technology which is absent from the applicant's mark. Overall, I find that the marks are conceptually similar to a degree somewhere between medium and high, noting that their shared concept is highly allusive of the services under the marks.

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 services down to the responsible undertaking 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

23 Applicant's written submissions, paragraph 11
24 *Ruiz Picasso v OHIM* [2006] E.T.M.R 29.

need to be borne in mind. The factors are interdependent, and a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the services and the nature of the purchasing act. In doing so, I must be alive to the fact that the average consumer rarely has an 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. In relation to assessing the likelihood of confusion where the common element has no or low distinctiveness, I keep in mind that in *Face2FaceHR Partners Limited v Peninsula Business Services Limited*,[25] Emma Himsworth K.C. as the Appointed Person, reviewed the case law in *Whyte and Mackay v Origin*[26] and *Nicoventures Holdings Limited v The London Vape Co Ltd,*[27] as well as guidance in the Common Communication on the Common Practice of Relative Grounds of Refusal - Likelihood of Confusion (impact of non-distinctive/weak components) dated 2 October 2014, which is referred to in the case law. Ms Himsworth summarised the correct approach as follows, at paragraph 44:

"(1) The distinctiveness of the mark as a whole must be assessed, taking into account that a minimum degree of distinctiveness must be acknowledged.

(2) The distinctiveness of each of the components of both marks must be assessed with priority being given to the coinciding elements.

(3) The focus of the assessment of the likelihood of confusion should be on the impact of the non-coinciding components on the overall impression of the mark.

(4) Account must be taken of the similarities/differences in the non-coinciding elements of the marks.

[25] O/0368/23
[26] [2015] EWHC 1271 (Ch)
[27] [2017] EHWC 3303 (Ch)

(5) A coincidence of an element with a low level of distinctiveness will not usually lead to a likelihood of confusion.

(6) There may be a finding of a likelihood of confusion if (a) the non-coinciding elements of the mark are of lower (or equally low) degree of distinctiveness or are of insignificant visual impact and the overall impression is similar; or (b) the overall impression of the marks is highly similar or identical."

56. I note that in *General Ecology, Inc. v Wan Jou Lin & Great Ins Company Ltd*,[28] Professor Phillip Johnson, as the Appointed Person, found that marks **NATURE PURE**, and 

were confusingly similar, despite the common elements only having low distinctiveness. Furthermore, I remind myself that a low level of distinctiveness does not preclude a likelihood of confusion.[29]

57. I have found that some services are identical whilst others are similar to a medium degree. The average consumer will predominantly be business users looking to address their environmental activities, by, inter alia, improving their carbon emissions. These consumers will pay a high degree of attention during the purchasing process. The purchasing process will be predominantly visual, although I do not discount an aural component. The marks are visually similar to a medium degree, aurally similar to a high degree and conceptually similar to a degree between medium and high. However, this is in shared concepts that are weak as they are extremely allusive of the services provided. The earlier mark is inherently distinctive to a low degree.

58. As discussed above, I acknowledge that the competing marks share the words 'plan' at the beginning of the marks, a position where the attention of consumers is usually directed, and 'zero' at the end of the respective marks. However, taking all of the above factors into account, I consider it unlikely that consumers paying a high degree of attention will mistakenly recall or misremember the marks for one another. This is

28 O/0331/23
29 *L'Oréal SA v OHIM*, Case C-235/05 P

because despite the overlap in the words ‘plan’ and ‘zero’ the additional elements within the respective marks create a visual difference. This is particularly the case as the earlier mark possesses a low level of inherent distinctive character. Furthermore, whilst the concepts of the marks are similar, the coincidence is in respect of weakly distinctive, allusive concepts. Accordingly, I focus in my assessment on the impact of the non-coinciding component of “.IT.”, which creates a visual and conceptual point of difference. Keeping in mind the high level of attention paid by consumers for the services at issue, I consider it unlikely that the marks will be mistakenly recalled or misremembered for one another. As such, I do not consider there to be a likelihood of direct confusion, even in relation to identical services.

59. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis QC, (as he then was) sitting as the Appointed Person, explained that:

> “16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else

but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.).

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

60. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal. I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.[30]

61. Furthermore, in *Liverpool Gin*,[31] Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". 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.

62. Having recognised the differences between the marks, I consider it unlikely that the average consumer will conclude that they originate from the same or economically linked undertakings. In my view, the words "plan" and "zero" are not so strikingly distinctive in relation to the services that consumers will believe that only the opponent will be using them in a trade mark. Instead, they will be seen as merely coincidental,

30 *Duebros Limited v Heirier Cenovis GmbH* O-547-17,
31 *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207

particularly when the marks are viewed as a whole. Further, changing the middle word of the mark from 'IT' to 'NET' does not necessarily align with a logical brand extension or sub-brand. Consequently, overall, I do not consider there to be a likelihood of indirect confusion, even for identical services.

CONCLUSION

63. The opposition under section 5(2)(b) of the Act has failed in its entirety, therefore, the application may proceed to registration.

COSTS

64. As the applicant has been successful it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016.[32] In the circumstances, I award the applicant the sum of £850, calculated as follows:

Considering the Notice of Opposition and filing a Counterstatement	£250
Considering the other side's evidence	£250
Preparing written submissions in lieu	£350
Total	**£850**

65. I therefore order Inspired Energy plc to pay Redshaw Advisors Limited the sum of £850. 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 24th day of December 2024

Sarah Wallace
For the Registrar

32 As the opposition was brought prior to 1 February 2023.