

0-446-12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2577601
BY HYUNDAI MOTOR COMPANY
TO REGISTER**

HYUNDAI EON

AS A TRADE MARK

IN CLASS 12

AND:


**OPPOSITION THERETO UNDER NO. 102228
BY E.ON AG**

BACKGROUND

1. On 6 April 2011, Hyundai Motor Company (“HMC”) applied to register the trade mark shown on the cover page of this decision. The application was accepted and published for opposition purposes on 29 April 2011 for the following goods in class 12:

Passenger cars, trucks, trailers, vans; engine for land vehicles; transmissions for land vehicles; differential gears for land vehicles; axles for land vehicles; clutches for land vehicles, steering wheels for automobiles, and wheels for automobiles.


2. On 29 July 2011, E.ON AG filed a notice of opposition directed against all of the goods in HMC’s application. E.ON’s grounds are based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). For its ground based upon section 5(2)(b), E.ON relies upon the following trade mark:

Trade Mark	No.	Application Date	Registration Date	Goods relied upon
 Colours claimed: Red	CTM 8700536	20.11.2009	24.05.2010	12- Vehicles; apparatus for locomotion by land, air or water; Electric vehicles.

3. In relation to its opposition based upon section 5(2)(b) of the Act, in its notice of opposition E.ON says:

“[HMC’s trade mark] consists of 2 words, the second of which is phonetically identical to the entire mark [the subject of the above registration]. It is submitted that the addition of an additional word preceding the second word...is not sufficient to eliminate the likelihood of confusion. The specification [of HMC’s application] embraces a range of goods which might be summarised as vehicles and parts or sub-assemblies for vehicles. The “vehicles” embraced by the specification of the later mark are identical to the “vehicles” embraced [by the above registration]. It is submitted that parts and sub-assemblies for vehicles are similar to vehicles themselves.”

4. For its ground based upon section 5(3) of the Act, E.ON relies upon the following trade mark:

Trade Mark	No.	Application Date:	Registration Date:	Services relied upon
	IR designating the EU: No. 887251	2.12.2005 IC claimed: 7.6.2005	28.5.2007	39 - Supply and distribution of electricity.

		(Germany)		40 - Generation of electricity
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5. Other than claiming in its notice opposition that the similarity between the above trade mark and the trade mark the subject of HMC's application was such that the relevant public will believe that the trade marks are used by the same undertaking, or that there is an economic connection between the users of the trade marks, E.ON provides no further basis for this ground of attack.

6. On 12 October 2011, HMC filed a counterstatement in which the grounds of opposition are denied.

7. Both parties filed evidence. While neither of the parties asked to be heard, both filed submissions in lieu of attendance at a hearing; I will refer to these submissions as necessary below.

EVIDENCE

E.ON's evidence

8. This consists of a witness statement, dated 13 April 2012, from Daren Carter who is the Head of Marketing Communications at E.ON Energy Limited, a subsidiary of E.ON AG. The facts emerging from Mr Carter's statement are as follows:

- E.ON AG acquired the power generation and supply company Powergen in 2002;
- Powergen was rebranded and began to use the e.on trade mark in the UK in 2004;
- From 2004 (operating as E.ON Energy), electricity and gas was sold to SMEs and large industrial and commercial businesses in the UK;
- In 2006 the Powergen brand (under which it sold to domestic customers) was also rebranded to e.on;
- By 2007 all elements of the business in the UK were using the e.on trade mark;
- E.ON AG based in Germany is one of the largest investor-owned power and gas companies in the world;
- E.ON employs 12,000 people in the UK;
- In the UK E.ON generates electricity, retails power and gas, develops gas storage sites and undertakes gas and oil exploration and production;

- In the UK E.ON's generation portfolio includes gas, coal and oil-fired power stations;
- In the UK E.ON is a market leader in combined heat and power and is one of the UK's leading green generators with 21 wind farms and the UK's first wave power generator. It has a further 1,500MW of renewable capacity under development;
- In the UK E.ON supplies power and gas to around five million domestic, small and medium sized enterprise and industrial customers;
- E.ON's trade mark is displayed at all its generating and gas storage sites and appears on all corporate correspondence and on all gas and electricity bills. Exhibit DC1 consists of a copy of an electricity bill dated 4 November 2011 and the envelope in which it was sent, both of which bear the trade mark the subject of CTM 8700536;
- Exhibit DC2 consists of extracts from the annual reports of E.ON UK PLC for the periods ending: 31 December 2005 to 31 December 2010. Mr Carter states that: "the number of accounts has been in excess of 8 million since 2005", and notes that the trading profit in 2007 was £744m rising to £748m in 2009;
- Exhibit DC3 consists of an extract from the 2010 annual report of E.ON AG. Turnover in the UK in 2009 and 2010 appears to be £8.9 and £9 billion respectively;
- E.ON's marketing, advertising and promotional spend in the period 2008-2011 (all of which Mr Carter explains features the e.on trade mark) was as follows: 2008 - £24,450m, 2009 - £12,672m, 2010 - £15,019m and 2011 - £7,341m;
- In 2006 E.ON UK plc purchased the sponsorship rights to the FA Cup, a sponsorship which ran until 2011. The total annual cost of this sponsorship was as follows: 2006/07 to £2009/10 - £8m per year, 2010/11 - £5.5m. Exhibit DC4 consists of photographs of "What to expect on the journey to the stadium" and "What to expect directly outside the stadium" in which the e.on trade mark can be seen and which bear a date of 19 May 2007;
- E.ON sponsored Ipswich Town Football Club for the 2006/07 season. Exhibit DC5 consists of a page downloaded from www.eon.uk.com on 30 March 2012 referring to the sponsorship and in which the e.on trade mark can be seen;
- Mr Carter states that, inter alia, E.ON "also runs extensive advertising campaigns every year on both national and regional television channels" (although no evidence in this regard has been provided);
- Exhibit DC6 is an extract from a report commissioned by E.ON in the UK from an independent market research consultant Dr Eisele & Dr Noll GmbH. This report,

entitled “Brand Tracker Q4 2010” was based on data collected between 1-28 November 2010. Mr Carter notes that the unaided brand awareness of the e.on trade mark in the UK was 66.1% and that when aided this level of awareness rose to 91.4%;

- A further report entitled “UK Residential Customer Tracker Topline Report” produced by Ipsos Mori and dated March 2012 is provided as exhibit DC7. Mr Carter notes that in response to the question: “Which energy suppliers can you think of? By energy suppliers we mean those providing mains gas and or electricity”, that the awareness of the e.on brand rose from 56% at the beginning of 2009 to 70% at the start of 2012.

HMC’s evidence

9. This consists of a witness statement, dated 15 June 2012, from Wendy Oliver who is a paralegal at D Young & Co LLP, HMC’s professional representatives in these proceedings. The purpose of Ms Oliver’s statement is shown by the final paragraph of her statement which reads:

“8. In conclusion from the brand reports, publications and articles detailed above...I believe it shows beyond doubt the scale of notoriety the HYUNDAI brand has in the UK as well as worldwide. It also shows that [HMC’s] presence and customer base is significant and ever increasing in the UK. Taking this into account I believe the HYUNDAI brand is now a household name, such to the extent that the general public and consumers would only associate products or services bearing or including the HYUNDAI name to be products or services originating from [HMC]...”

10. In support of the above conclusions, Ms Oliver provides:

- exhibit WOO1 – this consists of a range of articles obtained from local and national publications in the UK and dating between 2006 and 2011 which relate to HMC and its business activities;
- exhibit WOO2 consists of a number of articles obtained from a Google® search conducted on 6 March 2012. The first, dated 29 September 2011, is from *Marketing Week* and indicates that HMC “has taken over the iconic Piccadilly Circus billboard” and that “it is estimated to be seen by 56 million people every year”. The second article, dated 29 July 2011, is from *theguardian* and indicates that “Hyundai has been named as the maker of the most reliable cars on sale today, according to Which? Magazine’s annual new and used car survey...” The third article, dated 19 January 2012, is from www.am-online.com and is entitled “Hyundai expands UK network to 152 sites”. The fourth and final article is from www.hyundai-car.co.uk which detail HMC’s achievements between 2004 and 2011;

- exhibit WOO3 consists of extracts from a publication produced by Interbrand and entitled “*Best Global Brands...*”. The extracts indicate that between 2005 and 2011 HMC’s global rank rose from 84 to 61.

11. That concludes my summary of the evidence filed to the extent that I consider it necessary.

DECISION

The ground based upon section 5(2)(b)

12. Section 5(2)(b) of the Act reads 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, or

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

13. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

14. In these proceedings, E.ON is relying upon the trade mark shown in paragraph 2 above, which has an application date prior to that of the application for registration. As HMC’s application for registration was published for opposition purposes on 29 April 2011, and as E.ON’s earlier trade mark was registered on 24 May 2010, E.ON’s earlier trade mark is not subject to proof of use as per The Trade Marks (Proof of Use, etc) Regulations 2004.

Section 5(2)(b) – case law

15. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* -BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the Court of Justice of the European Union (CJEU) cases mentioned) on the basis indicated below:

The CJEU cases

Sabel BV v Puma AG [1998] RPC 199; Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 117; Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. [2000] F.S.R. 77; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

The principles

“(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

The average consumer and the nature of the purchasing process

16. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and then to determine the manner in which these goods will be selected by the average consumer in the course of trade. In its submissions E.ON say:

“7...Given the goods in question fall in class 12 the relevant public are likely to be reasonably well informed and reasonably observant and circumspect...”

17. In its submissions HMC say:

“In this case the average consumer will be any prospective purchaser of consumer vehicles and related goods in class 12...As such, the average consumer will be the general member of the public. As such items are likely to be expensive, low volume goods which are purchased infrequently, due regard must be given to the commercial realities of the market place, including the degree of care which the purchaser will exercise in the selection of any such item.”

18. In my view, the average consumer for the goods at issue will be either a member of the general public buying for their personal use or businesses buying for use on a commercial basis. However, regardless of whether the average consumer is a member of the general public or a business, the cost of the vast majority of the goods at issue in these proceedings militates against an impulse purchase. My own experience suggests that the selection of, for example, a vehicle for personal use is likely to require a

reasonable degree of research (including reviewing bespoke magazines, brochures, websites and test reports), visits to and discussions with vehicle dealers and, in most cases, one or more test drives, all of which suggests that the average consumer will pay a high level of attention when selecting the goods at issue. While I accept that the degree of care taken when selecting parts for vehicles such as engines, transmissions, gears, axles, clutches, steering wheels and wheels may be somewhat less, the cost of the majority of these goods and the need to ensure, for example, compatibility with an existing vehicle is, in my view, unlikely to reduce to any significant extent the degree of attention paid by the average consumer (who will also be a member of the public or a trade buyer). As to how the average consumer is most likely to encounter the trade marks at issue in these proceedings, this is most likely to consist primarily of a visual act having encountered the trade marks in the ways I have mentioned above and in advertisements in magazines, on websites, television and on posters etc. in the high street.

Comparison of goods

19. The competing goods are as follows:

HMC's goods	E.ON's goods
Passenger cars, trucks, trailers, vans; engine for land vehicles; transmissions for land vehicles; differential gears for land vehicles; axles for land vehicles; clutches for land vehicles, steering wheels for automobiles, and wheels for automobiles.	Vehicles; apparatus for locomotion by land, air or water; Electric vehicles.

20. In its submissions E.ON say:

“8. The goods in question are either identical – passenger cars, trucks, trailers, vans are identical to vehicles and to apparatus for locomotion by land, air or water – or similar insofar as these are parts and accessories for vehicles. This similarity would cover [the remaining goods in HMC’s application]. The goods in question are therefore in part identical and in part similar.”

21. In its submissions HMC say:

“It is clear that [the goods in its application] are identical and similar goods [to the goods covered by E.ON’s earlier trade mark]...”

22. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05 the GC said:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category,

designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

23. Like the parties, I agree that (on the principle outlined in *Meric*), the “passenger cars, trucks, trailers, vans” in HMC’s application are identical to “vehicles; apparatus for locomotion by land, air or water” in E.ON’s registration. In view of the principles outlined by the Court of First Instance (now the General Court) in *Boston Scientific Ltd v OHIM* case T-325/06) i.e.

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48)”,

I also agree with the parties that the remaining goods in HMC’s application (all of which are, as E.ON say, parts and accessories for vehicles) should be regarded as similar to the goods in E.ON’s earlier trade mark.

Comparison of trade marks

24. The trade marks to be compared are as follows:

HMC’s trade mark	E.ON’s trade mark
HYUNDAI EON	

25. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his or her mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant components

26. HMC's trade mark consists of two elements. Both parties agree that the first element i.e. the word HYUNDAI is invented, and that the second element, EON, means "a long period of time". In my view, both elements are, when considered in relation to the goods in respect of which registration is sought, distinctive, although in view of its positioning as the first element in HMC's application, it is the word HYUNDAI which is, in my view, the more dominant element of HMC's trade mark.

27. Turning to E.ON's trade mark, this consists of a lower case letter "e" and the word "on" separated by a dot. The letters are presented in red in a slightly unusual but unremarkable font. Although E.ON claims the colour red as an element of its mark, as HMC's trade mark is presented in black and white this does not, for the reasons given by Mann J in *Specsavers International Healthcare Ltd v Asda Stores Ltd* (No. 2) [2011] FSR 1, assist in distinguishing the competing trade marks. Consisting of only three letters none of which is highlighted or emphasised in any way, and irrespective of the dot which appears between the letters "e" and "o", there are, in my view, no distinctive or dominant elements in E.ON's trade mark; the distinctiveness lies in the totality which, as far as I am aware (and there is no evidence or submissions to the contrary), is distinctive for the goods upon which E.ON relies in these proceedings.

Visual similarity

28. HMC's trade mark consists of two words containing seven and three letters respectively, whereas E.ON's trade mark consists of only three letters, the first and second letter of which is separated by a dot. In its submissions E.ON say that this:

"9...indicates that the existence of a certain degree of visual similarity cannot be denied."

29. In its submissions HMC say:

"Due to the presentation, the 3 letters are not read as EON [as in HMC's trade mark] but rather they would be read separately as E and ON. This creates a different impact both visually and conceptually..."

And:

"... the respective trade marks have only a very low level of visual similarity"...

30. The inclusion of the word HYUNDAI in HMC's trade mark and the differences in presentation between the word EON in HMC's application and the letters e.on in E.ON's earlier trade mark, results, in my view, in only a low level of visual similarity between the competing trade marks.

Aural similarity

31. In its submissions E.ON say:

“9...Orally there is a high degree of similarity. [E.ON's earlier trade mark] amounts to a single word which is entirely encompassed within [HMC's application]...”

32. In its submissions HMC say:

“[HMC's trade mark] consists of 5 syllables HY-UN-DAI E-ON, whereas [E.ON's trade mark] is only 2 E-ON. Although the final 2 syllables of [HMC's trade mark] are identical to [E.ON's trade mark], the phonetic impact is lost in the mark as a whole, particularly because the coincidence occurs at the end of the mark...As such, it is submitted that the marks are readily distinguishable from a phonetic comparison.”

33. The fact that both parties' trade marks consist of or contain an identifiable element which will, in my view, be pronounced by the average consumer as E-ON results, overall, in a reasonable degree of aural similarity between them.

Conceptual similarity

34. In its submissions E.ON say:

“9...As regards the conceptual similarity, both include the same word EON [the definition of which is mentioned above]. Therefore the marks are also conceptually similar.”

35. In its submissions HMC say:

“By contrast, [E.ON's trade mark] consists of the prefix “E” and the English word “ON”. E is now often used as a prefix, as an abbreviation for electronic. For example, E-COMMERCE, E-MAIL, E-CARDS, E-BOOK, E-VOUCHER and is well recognised as such. ON is the English preposition, used to show the relationship of one item with another. Overall, therefore, it is clear that conceptually HYUNDAI EON and E.ON create very different impressions on the consumer and are unlikely to be confused from a conceptual standpoint.”

36. Consisting as it does of an invented word, the HYUNDAI element of HMC's trade mark will not send any conceptual message to the average consumer. Although E.ON's trade mark is presented in the manner shown above, and notwithstanding HMC's submissions regarding the presentation of E.ON's trade mark and the use of the letter E as an abbreviation for electronic, in my view, the average consumer is more likely to construe E.ON's trade mark as the word eon and to that extent at least the competing trade marks are conceptually identical.

Distinctive character of E.ON's earlier trade mark

37. I must now assess the distinctive character of E.ON's trade mark. The distinctive character of a trade mark can be appraised only, first, by reference to the goods for which it is registered and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. Although E.ON has provided evidence, there is nothing within it which shows that it has used its trade mark on the goods upon which it relies in these proceedings. In those circumstances, I can only assess its trade mark's inherent characteristics. Having done so, and bearing in mind my conclusion above that it has no meaning for the goods upon which it relies, E-ON's trade mark is, in my view, a trade mark possessed of a fairly high degree of inherent distinctive character.

Likelihood of confusion

38. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to factor in the distinctive character of E.ON's trade mark as the more distinctive this trade mark is the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision I concluded that:

- the average consumer of the goods at issue is either a member of the general public or a business user who will select the goods by predominantly visual means and who will pay a high level of attention when doing so;
- the competing goods are either identical or similar;
- while both elements of HMC's trade mark are distinctive, the word HYUNDAI is the more dominant element;
- the distinctiveness of E.ON's trade mark lies in its totality;
- there is a low level of visual similarity between the competing trade marks;
- the presence in both parties' trade marks of an element that will be pronounced as the word E-ON results in a reasonable degree of aural similarity;

- the presence in both parties' trade marks of an element that will be construed as the word EON results, insofar as that element of the competing trade marks is concerned, in conceptual identity;
- E.ON's earlier trade mark is, absent use, possessed of a fairly high degree of inherent distinctive character.

39. In its submissions E.ON say:

"9. ...We would draw the tribunal's attention to the decision that if a mark consists exclusively of the earlier mark to which another word has been added it is an indication that the two trade mark are similar" [*ecoblue AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* – case T-281/07].

40. In its submissions HMC say:

"We submit that our assertion that the marks would be distinguished is supported by the following case law": [*Giorgio Beverly Hills, Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, case T-228/08; *Annco, Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* – case T-385/09 and *Virgin Enterprises Ltd v Casey* [2011] ETMR 35].

In all of these cases, despite some coincidence between one element of each trade mark, overall there was no likelihood of confusion."

41. In *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, the CJEU said:

"29. In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32).

30. However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31. In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32. The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33. If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.

34. This would be the case where, for example, the owner of a widely-known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known. It would also be the case if the composite sign was made up of the earlier mark and a widely-known commercial name. In fact, the overall impression would be, most often, dominated by the widely-known mark or commercial name included in the composite sign.

35. Thus, contrary to the intention of the Community legislator expressed in the 10th recital in the preamble to the directive, the guarantee of the earlier mark as an indication of origin would not be assured, even though it still had an independent distinctive role in the composite sign.

36. It must therefore be accepted that, in order to establish the likelihood of confusion, it suffices that, because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by the composite sign is attributed by the public also to the owner of that mark. “

42. The case law relied upon by the parties to support their differing positions indicates no more than each case will turn on its own particular facts. In this case, the word EON in HMC's trade mark is a distinctive element which retains an independent distinctive role within HMC's composite trade mark. Although I have found that the competing trade marks are visually similar to only a low degree, this is because HMC's trade mark also contains the word HYUNDAI as its first element. However, notwithstanding the presence of this additional element in HMC's trade mark, I still found the competing trade marks to be aurally similar to a reasonable degree and, insofar as the EON/e.on elements are concerned, conceptually identical. In its submission HMC say:

“That is, in the vehicle market, any use of HYUNDAI EON is more likely to be associated with the well known HYUNDAI brand, rather than be associated with the E.ON brand from another unrelated service sector, particularly as consumers are used to the use of sub-brands in the automobile industry. For example,

HYUNDAI IX35, HYUNDAI SANTA FE, KIA PICANTO, KIA SPORTAGE. We believe that the hearing officer will be able to take judicial notice of this common trend.”

43. HMC’s submissions are borne out by my own experience of trade marks in this area of trade. However, rather than assisting HMC, in my view, this “common trend” (as HMC puts it), supports rather than negates the likelihood of confusion. In my view, an average consumer familiar with this trend (and regardless of the degree of care taken when selecting the goods at issue) will consider HMC’s trade mark to consist of the primary trade mark HYUNDAI and the sub-brand EON. When considered in this context, the word EON (which retains an independent distinctive role within HMC’s trade mark) is, in my view, visually highly similar to E.ON’s trade mark and aurally and conceptually identical. Given the manner in which sub-brands are used in this area of trade, the average consumer will, in my view, assume the identical and similar goods at issue in these proceedings come from undertakings which are economically linked. As a consequence of that conclusion, E.ON’s opposition based upon section 5(2)(b) of the Act succeeds.

The objection based upon section 5(3) of the Act

44. E.ON is in no better position under this section of the Act, and, as such, I see no reason to determine this additional/alternative ground.

Conclusion

45. E.ON’s opposition based upon section 5(2)(b) of the Act succeeds in full.

Costs

46. As E.ON has been successful it is entitled to an award of costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to E.ON on the following basis:

Preparing a statement and considering HMC’s statement:	£200
Preparing evidence and considering HMC’s evidence:	£500
Written submissions:	£300
Official fee:	£200
Total	£1200

47. I order Hyundai Motor Company to pay to E.ON AG the sum of **£1200**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 14th day of November 2012

**C J BOWEN
For the Registrar
The Comptroller-General**