

O-061-05

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2324760
BY NICOS IORDANOU TO REGISTER A TRADE MARK IN CLASS 4**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 91850
BY ELF AQUITAINE**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2324760
by Nicos Iordanou to register a Trade Mark in Class 4**

and

**IN THE MATTER OF Opposition thereto under No. 91850
by Elf Aquitaine**

BACKGROUND

1. On 24 February 2003 Nicos Iordanou applied to register the trade mark EVOLUTION OIL in Class 4 for a specification of “Lubricating oils”.

2. The application was subsequently published in the Trade Marks Journal and on 25 July 2003 Elf Aquitaine filed a Notice of Opposition. In summary the grounds were:

- (i) Under Section 5(2)(b) of the Act because the mark applied for is similar to the following earlier trade marks owned by the opponent which cover identical goods in Class 4 and there exists a likelihood of confusion on the part of the public –

Registration No.	Mark	Date Registration Effective	Specification of goods
UK Registration No. 2113598	ELF DIESEL EVOLUTION	3 May 1996	Class 01: Chemical additives for fuels all for use in relation to diesel engines. Class 04: Industrial oils and greases; lubricants; fuels (including motor spirit) and non chemical additives for fuels, all for use in relation to diesel engines.
International Registration No. 711166	OPTANE EVOLUTION	12 November 1998	Class 01: Additives for motor fuel, chemical additives used for reducing fuel pollutant emissions, chemical additives used for reducing motor fuel consumption. Class 04: Industrial oils and greases; lubricants; fuel (including fuel for

			engines); unleaded premium fuel.
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(ii) Under Section 5(4)(a) of the Act by virtue of the law of passing off.

3. The applicant filed a Counterstatement denying the grounds of opposition. While the applicant admits that the goods covered by the application are identical to the goods covered by the earlier registration he avers that there is no likelihood of confusion and that he possesses goodwill in his mark.

4. Both parties filed evidence and ask for an award of costs in their favour. The parties are content for a decision to be taken without recourse to a hearing.

OPPONENT'S EVIDENCE

5. The opponent's evidence consists of a witness statement by Anne Wong dated 4 February 2004. Ms Wong is a partner in Carpmaels & Ransford, the opponent's professional advisors in these proceedings.

6. Ms Wong submits that the respective marks are very similar. They share the word EVOLUTION which, she states, is an unusual and uncommon term in relation to the goods. Ms Wong points out that the word OIL in the applicant's mark merely describes the goods as does the word DIESEL in the opponent's earlier registration No. 2113598. She submits that the word ELF acts like a house mark.

7. Ms Wong refers to Exhibit ANW1 to her statement, which comprises the results of a search using the database trademarkexplorer.com on 3 February 2004, to find all UK, European Community and International (UK designation) trade mark registrations and applications containing the element EVOLUTION in Classes 1 and 4. This shows one third party registration for a composite mark in which, Ms Wong states, the word EVOLUTION does not stand out. She concludes that EVOLUTION is a distinctive word in relation to the goods.

8. Ms Wong goes on to state that the respective goods are identical and that use of the mark of the opposed application is not relevant, particularly as it does not pre-date the application dates of the opponent's earlier trade marks.

APPLICANT'S EVIDENCE

9. The applicant's evidence consists of two witness statements, one each by Nicos Iordanou and Stephen Kinsey.

10. Mr Iordanou is the applicant. His witness statement is dated 13 May 2004. Mr Iordanou is the Managing Director of Evolution Oil Limited.

11. Mr Iordanou states that the mark in suit was first adopted and used in the UK in relation to lubricating oils in August 2001 and that use of the mark has been continuous since that date. He adds that there are customers for EVOLUTION OIL products in Birmingham, Leicester, Ipswich, London, Gloucestershire and Kent and that annual turnover in goods under the trade mark EVOLUTION OIL has been approximately as follows:

YEAR	£
2001	93,000
2002 – Jan. 2003	101,000

12. Mr Iordanou states that his company's customers for EVOLUTION OIL products have been wholesale automotive distributors and motor repair workshops. The EVOLUTION OIL products have been promoted by leaflets, trade advertising, mail shots and cold calling and at automotive trade shows. At Exhibit NI 1 to Mr Iordanou's statement is an example promotional leaflet, a sticker used as a wrapper and some copy invoices. Mr Iordanou adds that approximately £1,600 was spent by his company in 2001 in promoting EVOLUTION OIL products in the UK.

13. Mr Iordanou concludes by saying that no confusion with any products marketed by the opponent has been reported to him or has otherwise come to his attention.

14. Mr Kinsey's witness statement is dated 14 May 2004. He is a partner in Wildbore & Gibbons, the applicant's professional advisors in these proceedings.

15. Mr Kinsey instructed an in-house search using the Marquesa Proprietary Database for all United Kingdom, European Community and International Registrations designating the UK and also pending applications, containing the word EVOLUTION in Classes 1 and 4. A copy of the results are attached to Mr Kinsey's statement as Exhibit SK1. In addition to the mark mentioned in Ms Wong's statement, Mr Kinsey draws attention to two further registrations. However, neither seems to cover lubricants.

OPPONENT'S EVIDENCE IN REPLY

16. This consists of a further witness statement by Anne Wong. It is dated 20 December 2004.

17. In relation to Mr Iordanou's witness statement, Ms Wong points out that the opponent's earlier registrations post date the opponent's use and she submits that, in any event, the applicant's use is not substantial and does not support a claim that it is well known in the oil industry.

18. Going to Mr Kinsey's witness statement, Ms Wong submits that the marks mentioned by Mr Kinsey do not show that the word EVOLUTION is common for marks specifying lubricants and oils.

19. This completes my summary of the evidence filed in this case. I turn now to the decision.

DECISION

20. Firstly, I go to the Section 5(2)(b) ground of opposition.

Section 5(2) of the Act reads as follows:

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (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.”

21. An earlier right is defined in Section 6, 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 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,”

22. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

23. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*;

- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*;
- (g) account should be taken on 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 was registered; *Lloyd*;
- (h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*;
- (i) further, 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; *Marca Mode CV v. Adidas AG*;
- (j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.*

24. In essence, the test under Section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion, I am guided by the judgments of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements, taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. I must compare the mark applied for and the opponent's registrations on the basis of any use made of the respective marks and also on the basis of their inherent characteristics, assuming normal and fair use of the marks on the relevant goods covered across the width of their respective specifications.

25. In its evidence the applicant points out that the mark in suit has been in use since 2001 without any known instances of confusion. However, the evidence makes it clear that the applicant's use, while significant, does not enable me to infer that it is a major supplier or distributor and it also would appear that the applicant's customers have been wholesale automotive distributors and motor repair workshops ie. the trade. Furthermore, I have no details of the opponent's use. The opponent simply relies upon the existence of its earlier registrations and its case rests upon notional, fair use of the marks, which would include the promotion and sale of lubricating oils to the public at large by both parties. In any event, the fact that no instances of confusion are demonstrated is not necessarily telling in relation to relative grounds – see *Compass Publishing B.V. v Compass Logistic Ltd* [2004] EWCA (Ch). As stated earlier, my comparisons must take into account notional, fair use.

26. I turn to a consideration of the respective goods covered by the application in suit and the opponent's earlier registrations. As conceded by the applicant, the opponent's goods include lubricants in Class 4 and the respective goods are obviously identical.

27. I now go to a comparison of the mark in suit with the opponent's earlier registrations. In their evidence, both parties have taken me to the position on the trade mark register in

relation to marks containing the word EVOLUTION. None of these marks are identical to the marks before me, nor do they demonstrate the position in the market place. I am not assisted by this “state of the register” evidence – *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281. My decision involves a comparison of the applicant’s and opponent’s own particular marks and must be made on its own merits.

28. The mark in suit consists of the obvious dictionary words EVOLUTION OIL. The word EVOLUTION is fully distinctive in relation to the goods, whilst the word OIL describes the goods or their content. While the opponent has two earlier marks ie. ELF DIESEL EVOLUTION and OPTANE EVOLUTION, the former mark comprises obvious dictionary words, whilst the latter mark contains an invented word – the word OPTANE. The words ELF, OPTANE and EVOLUTION are all fully distinctive, but the word DIESEL is descriptive in relation to the goods.

29. The guiding authorities make it clear that I must compare the marks as a whole and by reference to overall impression. However, as recognised in *Sabel BV v Puma AG* (mentioned earlier in this decision) in my comparison, reference will inevitably be made to the distinctiveness and dominance of individual elements. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how the marks would be perceived by customers in the normal course and circumstances of trade. I must bear this in mind when making the comparisons.

30. On a visual, aural and conceptual comparison the marks differ in that the applicant’s mark contains the word OIL and the opponent’s earlier registrations ELF DIESEL and OPTANE respectively. However, the marks are similar in that the same word, EVOLUTION, is common to all. This word is a distinctive and dominant feature within all the marks. It seems to me that as the words ELF DIESEL EVOLUTION and OPTANE EVOLUTION have no meaning in their totalities, it is likely that the words ELF and OPTANE would be perceived as house marks in the market place.

31. I am mindful of the views expressed in *Bulova Accutron* [1969] RPC 102. While the case was decided under the 1938 Act, it seems to me that the following views, expressed at 109-140 by Stamp J, remain relevant today:

“As I have already said, if what had to be considered was a side by side comparison, the additional word would have had a vital significance, but where imperfect recollection is relevant what has to be considered is how far the additional word is significant to prevent imperfect recollection and the resultant confusion. Particularly having regard to the fact that BULOVA is the house name of the applicants and has a significance other than as a trade mark, its addition before the word ACCUTRON does not in my judgement serve to prevent the deception or confusion which would in the view of the Court of Appeal have been caused but for that adoption. As the Assistant Registrar remarks in his decision:

“As Bulova and Accutron do not hold together as a phrase or present a wholly different meaning to the separate components, I think that their combination will be taken by many persons on first impression as an indication that the manufacturer of the watches is suing two separate trade marks in connection with his products.” I would add that the combination of the two words is likely to be taken by other persons on first impression as an indication that the part of the trade mark which consists of BULOVA is a house name of the marketers of the watches, that the trade mark is

ACCUTRON and that they will confuse them with watches marketed under the trade mark ACCURIST simpliciter.”

32. The respective marks share a common distinctive element, the word EVOLUTION, and bearing in mind that the words OIL and DIESEL are descriptive, the addition of the housemarks ELF or OPTANE to the opponent’s marks does not significantly defuse the risk of confusion.

33. In my considerations relating to a likelihood of confusion I must consider the goods at issue and the average customer for the goods. It seems to me that the customer for lubricating oils would encompass the general public as well as the trade. However, in general, the goods would be purchased with a reasonable degree of care. While this could mitigate against confusion occurring it does not follow that there is no likelihood of confusion as all relevant circumstances must be taken into account.

CONCLUSION

34. Notwithstanding the obvious differences in the marks, particularly on a side by side comparison, I take into account my earlier findings that the common word EVOLUTION is a dominant, distinctive element within the respective marks and the words ELF and OPTANE would be likely to be perceived by the customer as house marks of the opponent. Also, taking into account there is identity of goods then, notwithstanding that the customer for the goods is likely to be relatively careful and discerning, I believe there is a likelihood of confusion on the part of the public.

35. In reaching a decision in relation to the likelihood of confusion I have particularly borne in mind the following comments of the European Court of Justice in *Canon*:

“Accordingly, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive (see SABEL , paragraphs 16 to 18).”

36. In my view, on a global appreciation, the goods of the applicant and opponent are likely to be assumed as emanating from the “same stable”.

37. The opposition succeeds under Section 5(2)(b).

38. As I have found for the opponent under Section 5(2)(b) I have no need to consider the Section 5(4)(a) ground.

COSTS

39. The opponent is entitled to a contribution towards costs and I order the applicant to pay the opponent the sum of £1,100 which takes into account that no hearing was held in relation

to these proceedings. 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 10th day of March 2005

JOHN MacGILLIVRAY
For the Registrar
the Comptroller-General