O/0864/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3744446

BY

INDUSTRIAL SERVICES (EAST ANGLIA) LIMITED

TO REGISTER THE FOLLOWING TRADE MARK
IN CLASSES 1, 4 AND 35

SCAFFX

AND OPPOSITION THERETO UNDER NUMBER 433443

BY

ZEP UK LIMITED

Background and Pleadings

1. On 18 January 2022, Industrial Services (East Anglia) Limited ("the Applicant") applied to register in the UK the trade mark numbered 3744446 SCAFFX for goods and services in classes 1, 4 and 35 as outlined in full later in my decision. It was accepted and published for opposition purposes on 11 February 2022.

2. On 11 May 2022, Zep UK Limited ("the Opponent") opposed the application in part, under section 5(2)(b) of the Trade Marks Act 1994 ("the Act") relying on the following trade mark:

UKTM no. 1406866

SCAFFEZE

Filed on 1 December 1989 and registered on 19 April 1991

Class 4: Lubricants; lubricants having cleaning properties; penetrating oils; all included in Class 4.

3. The Opponent claims that as a result of the similarity between the marks and the identity/similarity between the goods and the services there exists a likelihood of confusion.

4. The Applicant filed a defence and counterstatement denying that the marks are similar or that the goods/services are identical or similar.

5. The trademark upon which the Opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark completed its registration process more than 5 years before the application, it would ordinarily be subject to the proof of use requirements under section 6A of the Act. However, the Applicant did not require the Opponent to show proof of use of its mark and therefore it may rely upon all the goods of its registration without having to demonstrate the use it has made of them.

6. Both parties are represented; the Applicant by Achieve Law and the Opponent by WP Thompson IP. Neither party filed evidence during the evidence rounds, however, the Opponent filed written submissions which I have taken into account and to which I will refer as appropriate later in my decision. The Applicant asked to be heard on the matter, that hearing took place before me via video link on Tuesday 27 June 2023. Dr Antony Oswin of Achieve Legal Services, appeared for the Applicant, whilst Mr

Francesco Simone, of WP Thompson IP appeared for the Opponent. Only Mr Simone filed skeleton arguments prior to the hearing.

Relevance of EU Law

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. That is why this decision continues to refer to the case law of the EU courts on trade mark matters.

Decision

Section 5(2)(b)

8. Section 5(2)(b) of the Act states as follows:

> "5(2) A trade mark shall not be registered if because-
>
> > (a) ….
> >
> > (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

9. And Section 54A states:

> "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."

General principles

10. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95*, Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97*, Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. Case*

C-342/97, Marca Mode CV v Adidas AG & Adidas Benelux BV, Case C-425/98*, Matratzen Concord GmbH v OHIM,* Case C-3/03*, Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04*, Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P *and Bimbo SA v OHIM,* Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater 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 to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the goods and services

11. When conducting a goods and services comparison, all relevant factors should be considered as per the judgment of the Court of Justice of the European Union ("CJEU") in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* Case C-39/97, where the court stated at paragraph 23 that:

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

12. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

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

13. In *Gérard Meric v Office for Harmonisation in the Internal Market ("OHIM"),* Case T-133/05, the General Court ("GC") stated that:

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

14. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM,* Case T-325/06, the GC stated that "complementary" means:

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

15. Furthermore, terms used in specifications of goods should not be interpreted widely but confined to the core of the possible meanings attributable to the terms.[1]

16. The respective goods and services at issue are as follows:

[1] *Sky v Skykick* [2020] EWHC 990 (Ch) as per Arnold J.

Applicant's goods and services[2]	Opponent's goods
Class 1: Chemicals for preventing corrosion; chemical (industrial); chemical substances for use as additives to industrial lubricating greases; ~~Oleic acid for use in the manufacture of lubricating oils;~~ Chemical products for addition to lubricants for decarbonising; chemical products and preparations for use in treatment of metals.	
Class 4: Lubricants and industrial greases, waxes and fluids; lubricants; lubricants for metal working; lubricating oils; lubricating grease; lubricating fluids; all purpose lubricants; lubricants for metallic surfaces.	Class 4: Lubricants; lubricants having cleaning properties; penetrating oils; all included in Class 4.
Class 35: ~~Advertising, marketing and sales promotions~~; online ordering services; retail services and wholesale services connected with the sale of chemicals for preventing corrosion, chemical (industrial), chemical substances for use as additives to industrial lubricating greases, ~~oleic acid for use in the manufacture of lubricating oils~~, chemical products for addition to lubricants for decarbonising, chemical products and preparations for use in	

[2] The Opponent does not oppose those goods and services that are struck through.

treatment of metals, lubricants and industrial greases, waxes and fluids, lubricants, lubricants for metal working, lubricating oils, lubricating grease, lubricating fluids, all purpose lubricants, lubricants for metallic surfaces; consultancy, information and advisory services relating to all the aforesaid services.	

17. The parties set out their respective positions at the hearing. Dr Oswin gave a blanket denial that there was identity/similarity between the goods/services even where there were obviously terms that were identical, whilst Mr Simone referred back to the table that he had produced in his skeleton argument arguing that the goods/services were either identical or similar. I have taken on board the parties' submissions in my assessment and shall consider the applied for terms in turn.

Class 4

Lubricants

18. The term *Lubricants* appears in both parties' specifications and are self-evidently identical.

Lubricants for metal working; lubricating oils; lubricating grease; lubricating fluids; all purpose lubricants; lubricants for metallic surfaces.

19. These applied for goods are all substances with lubricating properties and therefore would all be encompassed in the Opponent's *Lubricants* and thus be regarded as identical in accordance with the principles in *Meric*.

Industrial greases, waxes and fluids

20. Whilst these goods are not identical to *lubricants* they are nevertheless highly similar. The viscosity and properties of the respective goods may differ, being either in liquid form or semisolid, however, they share the same purpose as the Opponent's *lubricants* namely to be used to reduce friction and to allow ease of use between

moving parts. Furthermore, I consider that they will be produced by the same providers, reach the market via the same trade channels and be directed at the same end user. There may also be a degree of competition between the respective goods depending on the nature of the item that requires lubricating, where the consumer may choose to purchase a more solid structured product over a liquid type solution.

Class 1

21. The Niche classification guide explanatory note describes goods pertaining to class 1 as mainly chemical products for use in industry, including those which go into the making of products belonging to other classes. I shall bear this in mind when undertaking the comparison.

Chemical (industrial); Chemical substances for use as additives to industrial lubricating greases; Chemical products for addition to lubricants for decarbonising

22. At the hearing Mr Simone argued that these goods are of the same nature and have the same use as the Opponent's goods in class 4, being chemical substances. He argued that they could be used industrially "in machines or manufacturing or any building repairs, or even home repairs or home improvement projects" and directed at the same users namely professionals operating machines, manufacturers, builders or the general public doing do-it-yourself projects. Dr Oswin advanced no specific submissions to the contrary other than submitting that the respective goods were dissimilar.

23. The applied for chemicals, chemical substances and products for use as additives to lubricants and lubricating greases are chemical preparations to be used in lubricants which would share the same properties as the lubricants themselves since the broad term lubricants would also include lubricants used in the industrial process. Given this I consider that a company that produces lubricants would also use chemicals in the same manufacturing process and as additives to industrial lubricants or added to lubricants for decarbonising, overlapping in nature and purpose as well as targeting the same consumer namely a manufacturer. I also consider that there is complementarity with the respective goods, as the chemicals are important for the use of lubricants, being added to the lubricants in the manufacturing process in such a way

that the consumer would believe they come from the same undertaking. The contested goods are similar to the Opponent's *lubricants* to a medium degree.

Chemicals for preventing corrosion; chemical products and preparations for use in treatment of metals

24. Anti-corrosion chemicals and chemical products for use in the treatment of metals include those with lubricating properties. The contested goods therefore overlap in purpose to the Opponent's *lubricants*. Consequently I consider that they would also overlap in producer, share the same trade channels and be directed towards the same end user. I consider that the contested goods are similar to the Opponent's *lubricants* to a medium degree.

25. Moving on to consider the applied for services, in *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

26. Furthermore, in *Tony Van Gulck v Wasabi Frog Ltd,* Case BL O/391/14, Mr Geoffrey Hobbs K.C. as the Appointed Person, reviewed the law concerning retail services versus goods. He said that:

> "9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for

determining whether, when and to what degree services are *'similar'* to goods are not clear cut."

27. In *Sanco SA v OHIM,*[3] Mr Hobbs concluded that amongst other matters the GC's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered or proposed to be registered.

28. However, in *Frag Comercio Internacional, SL v OHIM* T-162/08, the GC held that a registration for retail services which did not identify the kinds of goods covered by the services, was too vague to permit a proper comparison to be made. It appears clear, therefore, that a comparison can only be properly made if the goods to which the retail services are connected are specified, but it is also necessary to look at the goods for which the Applicant's services are normally associated and ascertain as to whether those correspond to the Opponent's goods.

Class 35

Retail services and wholesale services connected with the sale of chemicals for preventing corrosion, chemical (industrial), chemical substances for use as additives to industrial lubricating greases, chemical products for addition to lubricants for decarbonising, chemical products and preparations for use in treatment of metals, lubricants and industrial greases, waxes and fluids, lubricants, lubricants for metal working, lubricating oils, lubricating grease, lubricating fluids, all purpose lubricants, lubricants for metallic surfaces;

29. Given that I have found similarity between the respective goods to which the contested retail and wholesale services relate, in accordance with the caselaw, the retail/wholesale services of those contested goods and the Opponent's goods are similar to at least a low degree as a result of the complementary nature of the goods and the services, where consumers would believe that the same undertaking is responsible for taking the goods to market.

[3] T-249/11

Online ordering services;

30. The contested services are drafted broadly and are merely the virtual/electronic equivalent of its retail services. The sale of its associated goods as provided by its retail and wholesale services can, therefore, be fairly attributed to the sale of the same associated goods via an online ordering service. On this basis I consider that the contested services are similar on a complementary basis to a low degree to the Opponent's goods, as it is plausible for the Applicant to sell those goods online that are similar in nature to the Opponent's and to which the Applicant is or would normally be associated.

Consultancy, information and advisory services relating to all the aforesaid services.

31. Given the nature of the goods and services it is feasible for advice and assistance to be given in the use, application and nature of the goods and the retail and online services thereof. A seller of goods would naturally impart information as to the use and application of the products they are selling. I agree with the Opponent, that the goods and the services would be complementary and therefore on this basis similar to a low degree.

Average consumer

32. When considering the opposing marks the average consumer is deemed reasonably informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion the average consumer's level of attention is likely to vary according to the category of goods/services in question.[4]

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

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word

[4] *Lloyd Schuhfabrik Meyer*, case c-342/97

"average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

34. Mr Simone argued that the average consumer was both a professional a manufacturer or tradesperson, and the general member of the public, whilst Dr Oswin argued that its goods were predominantly directed at the trade. I consider that the goods and services at issue are directed at tradespeople or manufacturers but could also include general members of the public. The purchasing process is likely to be predominantly visual, with the goods being self-selected from retail outlets or their online equivalents and the services via online searches or signage at the actual premises. I do not discount aural considerations, however, following word of mouth recommendations or enquiries with sales assistants over the telephone.

35. In so far as the level of attention undertaken, considerations such as price, ease of use and quality will be taken into account before purchase but also given that some of the goods are chemically based then considerations regarding the potential caustic properties of the goods and their disposal, may be a factor before purchase. Bearing these matters in mind, I consider that an average level of attention will be undertaken in the selection process for the general member of the public or tradespeople no higher or lower than the norm for such goods. In so far as the services at issue they are in essence the retail and wholesale services of the goods and advice relating to the same, which would not in my view attract a higher level of attention than the goods themselves and which I also find to be average. For goods and services directed at manufacturers the level of attention for this group would be slightly higher than average, but not considerably so.

Comparison of the trade marks

36. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

> ".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

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

38. The marks to be compared are SCAFFX (the contested mark) and SCAFFEZE (the earlier mark).

Overall impression

39. Both marks are word only marks presented in capitals in unremarkable fonts. The contested mark comprises of the word SCAFFX and therefore the overall impression lies in the entirety of the word. Similarly with no other elements to contribute to the overall impression of the earlier mark, it resides in the word SCAFFEZE itself.

Visual Comparison

40. Visually the marks overlap to the extent that each mark begins with the identical first five letters SCAFF-. However the marks' endings are different; the earlier mark ends with the letters -EZE whereas the contested mark ends in -X . Consequently, I consider that the marks are visually similar to a high degree.

Aural Comparison

41. Mr Simone submitted at the hearing that the marks were aurally highly similar. Dr Oswin argued that given that the respective parties' businesses were located in different parts of the country, the prefix SCAFF- could be pronounced in a number of different ways depending on the locality and dialect of the average consumer. He argued that this element would either be pronounced as SCARFF with an elongated ARHFF sound or as SCAFF as a short 'AFF' sound. He considered that this would result in the marks being aurally dissimilar. Since the contested mark and the earlier

mark are national marks this argument has little merit. Whilst there may be different ways in which the prefix SCAFF is pronounced, whichever pronunciation is given to it by consumers throughout the country, it will apply equally to both marks.

42. It is my view that the earlier mark will be pronounced as SCAFF-EEZ and the contested mark as SCAFF-EX. The pronunciation of the endings of the respective marks will be different, an -EX sound as opposed to an -EEZ, however, there is still an element of similarity with the respective suffixes as both overlap with the letter 'e'. Weighing up the differences as against the similarities particularly with the identical sound of the first syllable, I consider that the marks are aurally similar to a high degree.

Conceptual Comparison

43. Dr Oswin argued that the average consumer would recognise the applied for mark[5] as a portmanteau word - the suffix being an abbreviation for the word scaffold and the prefix -EZE meaning that when used in the scaffolding trade to erect or dismantle scaffold it will make the task effortless. The Opponent merely submits that the marks are invented such that no conceptual comparison is possible.

44. Whilst I accept that some average consumers may see the suffix SCAFF- as alluding to scaffold it will only apply if the products are used in this context. The Opponent's goods are not scaffolding products or services relating to the erection or dismantling of scaffolding and therefore it cannot be said that the earlier mark is descriptive. At best the goods in question are products that may be used with scaffolding, but are not limited for use solely in this trade; they could be used in any trade that uses lubrication, such as those relating to machinery and hinges for example. Notional and fair use of a trade mark covers all the potential uses of the goods and not necessarily the ones in which a party actually trades. When assessing the conceptual similarity of two marks I remind myself that this is usually done without reference to the goods and services in question.[6]

45. I do not consider that the average consumer would come to the conclusion as suggested by Dr Oswin immediately and upon first impression without going through

[5] Whilst the statement of grounds referred to the marks the wrong way round, I take the Applicant's arguments to refer to the earlier mark.
[6] Mr Philip Johnson, sitting as the AP in *Viñedos Emiliana SA v Consorzio Tutela Vini Emilia, (2) Chiarli 1860 – Pr.I.V.I Srl And (3) Medici Ermete E Figli Srl* O/054/22.

a further thought process. If some consumers perceive its meaning as alluding to scaffold in my view they would only consist of a small proportion and an insufficient quantity for the purposes of the assessment. The arguments put forward by the Applicant therefore do not assist it greatly because if this meaning was apparent to the average consumer it would be equally attributable to the contested mark, making them conceptually identical.

46. Neither word is likely to convey a clear conceptual meaning as neither are dictionary words and therefore to my mind both marks will first and foremost be seen as invented words where no conceptual comparison is possible, rendering them conceptually neutral.

Distinctive character of earlier mark

47. Registered trade marks possess varying degrees of inherent distinctive character. Those marks that are regarded as descriptive of the goods will possess a low degree of distinctiveness. Conversely invented words with no association to the goods are highly distinctive. The more distinctive the earlier mark (either per se or by the use that has been made of it) the greater the likelihood of confusion.[7]

48. 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).

49. The Opponent has not filed evidence to support a claim of enhanced distinctive character, and therefore I only have the inherent position to consider. As previously outlined, the Opponent's mark will be seen as an invented word with no obvious

[7] *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)

connection to the goods, other than if one is to accept the Applicant's submissions an allusive connection to goods that allow scaffolding to be connected and dismantled effortlessly when used in the scaffolding trade. The earlier mark is not a dictionary word, and I consider that a greater proportion of average consumers will regard it as invented, meaning that it will possess a high degree of inherent distinctive character. If seen as alluding to scaffolding by some consumers then its level of inherent distinctive character will not be diminished significantly, since it is not directly descriptive and it will still retain an average level of distinctive character.

Likelihood of confusion

50. A number of factors must also be borne in mind when undertaking the assessment of confusion. 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 keep in mind a global assessment of all relevant factors when undertaking the comparison and that the purpose of a trade mark is to distinguish the goods and services of one undertaking from another. In doing so, I must consider that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind. Mr James Mellor, as the Appointed Person, directed that a common sense approach should be undertaken in any assessment where "every comparison must be conducted according to the approach laid down in the CJEU case law and every comparison will depend on its own facts" applying "the well-established propositions for assessing the visual, aural and conceptual similarities." [8]

51. There are two types of confusion; direct confusion where one mark is mistaken for the other and indirect confusion where the respective similarities between the marks lead consumers to believe that the respective goods and services originate from the same or related undertaking.

52. Earlier in my decision I found that the marks were visually and aurally highly similar. Conceptually given that predominantly the marks would each be regarded as invented

[8] *Robert Bosch GmbH v Bosco Brands UK Limited*, BL O/301/20

they are conceptually neutral. I found the respective goods in class 4 to be identical, with the remaining applied for goods in class 1 being similar to a medium degree. I found the services to be similar to a low degree. The goods and services would be selected predominantly via visual means; however, I did not discount aural considerations. I found that the average consumer is either a tradesperson, manufacturer or a member of the general public. For goods/services directed at the end consumer i.e. tradespeople and member of the public I found that an average level of attention would be undertaken, no higher or lower than the norm for such goods/services. For manufacturers, however, I found the selection process would be slightly higher than average but not considerably so. The earlier mark is inherently distinctive to a high degree.

53. I acknowledge that I must consider all the factors in the global assessment and that each case must be determined on its own merits.[9] Taking account of my conclusions, I remind myself that I must assess the matter as to how the marks are perceived on first impressions and from the perspective of the consumer's immediate and instinctive reaction to the marks on first encounter.[10]

54. Bearing in mind the principle of imperfect recollection, I consider that the marks are likely to be mistakenly recalled or misremembered one for the other. This is particularly so, given the high degree of visual similarity between the marks and the purchase being a predominantly visual one. Where the goods/services are requested aurally this does not assist the Applicant since the marks would be equally likely to be misheard, given that the beginning of the marks are identical and the differences arising between the sounds EZE (pronounced as EEZ) and EX at the end of the respective marks are unlikely to be sufficient to distinguish between them.

55. Given that consumers rarely have a chance to compare marks side by side, I am satisfied that as a result of the identical prefix SCAFF at the beginning of each mark for goods that I found to be identical, they will be imperfectly recalled. I come to the same conclusion even for those goods and services that I found to be similar only to a medium/low degree. There is sufficient visual and aural commonality between the marks for consumers to directly confuse and mistake one mark for the other.

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[9] *Ella Shoes Ltd v Hachette Filipacchi Presse S.A.* Ian Purvis AP on Appeal O/277/12
[10] *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17

Furthermore, since both marks will be perceived as invented words, the average consumer is not assisted by a clear conceptual hook to help in being able to differentiate between them. In my view this results in a likelihood of direct confusion.

56. In case I am wrong, and for completeness, I will consider the likelihood of indirect confusion. Indirect confusion was considered by Iain Purvis K.C., as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*,[11] where he 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'.

57. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor Q.C. (as he was then), 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.

58. I consider the shared common use of the letters SCAFF at the beginning of both marks will lead the average consumer to conclude that the marks originate from the same or economically linked undertakings. If the consumer notices the differences created by the respective endings of the words, the letters EZE as opposed to X, they will put this down to a different range of goods produced by the same producer rather

[11] Case BL O/375/10

than a completely different entity. Taking all of the above into account I consider that there is a likelihood of indirect confusion.

Conclusion

59. The opposition under section 5(2)(b) of the Act succeeds. Subject to any successful appeal, the following goods and services shall be refused registration namely:

> Class 1: Chemicals for preventing corrosion; chemical (industrial); chemical substances for use as additives to industrial lubricating greases; Chemical products for addition to lubricants for decarbonising; chemical products and preparations for use in treatment of metals.
>
> Class 4: Lubricants and industrial greases, waxes and fluids; lubricants; lubricants for metal working; lubricating oils; lubricating grease; lubricating fluids; all purpose lubricants; lubricants for metallic surfaces.
>
> Class 35: Online ordering services; retail services and wholesale services connected with the sale of chemicals for preventing corrosion, chemical (industrial), chemical substances for use as additives to industrial lubricating greases, chemical products for addition to lubricants for decarbonising, chemical products and preparations for use in treatment of metals, lubricants and industrial greases, waxes and fluids, lubricants, lubricants for metal working, lubricating oils, lubricating grease, lubricating fluids, all purpose lubricants, lubricants for metallic surfaces; consultancy, information and advisory services relating to all the aforesaid services.

60. The application shall proceed to registration for those goods/services that were unopposed namely:

> Class 1: Oleic acid for use in the manufacture of lubricating oils;
>
> Class 35: Advertising, marketing and sales promotions; retail services and wholesale services connected with the sale of oleic-acid for use in the manufacture of lubricating oils; consultancy, information and advisory services relating to all the aforesaid services.

Costs

61. As the Opponent has succeeded it is entitled to a contribution toward its costs. Award of costs in proceedings are based upon the scale as set out in Tribunal Practice Note (TPN) 2 of 2016. Applying this guidance, I award costs to the Opponent on the following basis:

Preparing a statement of grounds and considering the other side's statement:	£300
Preparing submissions:[12]	£300
Preparing for and attending a hearing including drafting skeleton arguments:[13]	£600
Official fee	£100
Total	**£1300**

62. I order Industrial Services (East Anglia) Limited to pay Zep UK Limited the sum of £1,300 as a contribution towards its costs. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case, if any appeal against the decision is unsuccessful.

Dated this 13th day of September 2023

Leisa Davies
For the Registrar

[12] These were very brief, no more than 1.5 pages in length and so I have awarded costs accordingly.
[13] The hearing lasted no more than an hour.