

O/0866/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003733419

BY MICHAEL BEAKE

TO REGISTER THE FOLLOWING MARK:

PETROL REVOLT

IN CLASSES 14, 16, 18, 21, 25, 35 AND 41

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 431657

BY PETROL INDUSTRIES B.V.

Background and pleadings

1. On 15 December 2021, Michael Beake (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. The application was published for opposition purposes on 07 January 2022, and registration is sought for the goods and services shown below:

Class 14: *Keyrings; keyrings of common metals; key fobs; leather key fobs; cufflinks; tie clips; brooches [jewellery].*

Class 16: *Pens; ballpoint pens; roller ball pens; fountain pens; pen and pencil holders; pencils; pencil cups; stationery; money clips.*

Class 18: *Bags; canvas bags; travelling bags; wallets; card wallets; business card holders in the nature of wallets, umbrellas; golf umbrellas.*

Class 21: *Mugs; travel mugs; coffee mugs; cups; coffee cups; flasks; vacuum flasks; insulated flasks; hip flasks; drinking bottles; water bottles.*

Class 25: *Sweatshirts; hooded sweatshirts; T-shirts; printed t-shirts; short-sleeved T-shirts; jackets; casual jackets; jackets [clothing]; headwear, peaked headwear; sports shoes, shirts and trousers.*

Class 35: *Advertising; promotion [advertising] of business; advertising via the Internet; advertising, marketing and promotional services; online advertising via a computer communications network; retail services connected with the sale of clothing and clothing accessories, keyrings, mugs, drinking bottles, flasks, pens, stationery; online ordering services; online retail store services in relation to clothing, shoes and hats, keyrings, cufflinks, tie clips, brooches, pens, pencils, stationery, bags, wallets, card wallets, umbrellas, cups, mugs, drinking bottles, water bottles, flasks, stationery; event marketing; arranging and conducting of marketing and promotional exhibitions, events and shows; arranging and conducting of exhibitions; arranging and conducting of fairs and exhibitions for racing and high performance sports cars events.*

Class 41: *Entertainment services relating to motor sports; organising of motor racing events; organisation of sport cars rallies, tours and racing events; provision of recreational events; arranging and conducting of entertainment events; organisation of automobile rallies, tours and racing events; entertainment services relating to high performance sports cars events; organisation of conferences, exhibitions and competitions; organisation of competitions and awards; organisation of entertainment and cultural events; arranging and conducting competitions; arranging and conducting of meetings in the field of entertainment; publication of magazines; providing on-line non-downloadable magazines relating to high performance sports cars; provision of an online magazine featuring information in the field of high performance sports cars.*

2. On 07 March 2022, the application was partially opposed by Petrol Industries B.V. (“the opponent”) based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed at the applicant’s goods and services in classes 14, 18, 25 and 35 only. The opponent relies upon the following trade mark:¹

UK00918263185

PETROL

Filing date: 26 June 2020

Registration date: 18 November 2020

3. The opponent relies upon some of the goods and services for which its mark is registered, namely those set out below:

Class 14: *Jewellery, precious stones; Chains, rings and bracelets; Horological and chronometric instruments; Watches.*

Class 18: *Bags; Purses; Trunks and suitcases; Umbrellas.*

¹ On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing EUTM. As a result of the opponent having an EUTM being protected as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable trade mark shown here is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law and retains its original filing date.

Class 25: *Clothing, footwear, headgear; Denim jeans; Clothing of denim; Overcoats and jackets, trousers, shirts, sweaters, socks, belts [clothing], skull caps, neckties, dresses, shoes, mules, sandals.*

Class 35: *Business mediation in the purchase and sale, import and export, and wholesaling and retailing of perfumery, aftershaves, essential oils, cosmetics, hair lotions, preparations for skin care and hair care, make-up, nail polish, nail grooming products, spectacles and sunglasses, covers for smartphones, mobile telephones, tablets and laptops, smartphone applications, jewellery; Business mediation in the purchase and sale, import and export, and wholesaling and retailing of cabochons, chains, rings and Bracelets, Timepieces, chronological, Watches, Panniers, change purses, Trunks and travelling bags, Articles of clothing, Umbrellas; Business mediation in the purchase and sale, import and export, and wholesaling and retailing of footwear, headwear, jeans, clothing of denim, overcoats, jackets, trousers, shirts, sweaters, socks, belts [clothing], skull caps, neckties, dresses, shoes, mules, sandals; Organisation of events for commercial and advertising purposes; Consultancy and information regarding the aforesaid services; The aforesaid services also provided via electronic networks, such as the Internet; all previous services not to be offered on premises or in relation to gasoline or automotive service stations, all previous services not to be offered in on-line stores in connection to merchandise not carrying Petrol sign or sign similar thereto.*

4. By virtue of its earlier filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to Section 6 of the Act. As the earlier mark had not completed its registration process more than five years before the date of the application in question, it is not subject to proof of use pursuant to Section 6A of the Act.

5. The opponent claims that the marks are similar and that the goods and services are identical or similar, meaning that there is a likelihood of confusion.

6. The applicant filed a counterstatement in which he denied the claims.

7. The Tribunal allowed the opponent to make some minor amendments to the statement of grounds to clarify some of the wording used in the context of the claim that the goods and services are similar. An amended statement of grounds was therefore filed on 23 January 2023 and an amended counterstatement was filed on 9 February 2023.

8. The opponent is represented by Maguire Boss and the applicant is represented by BDB Pitmans LLP.

9. Both parties filed evidence. The opponent also filed written submissions dated 23 January 2023. Neither party requested a hearing, nor did they file written submissions in lieu. I have taken the evidence and submissions into account in reaching this decision and will refer to them below where necessary. This decision is taken following a careful perusal of the papers.

The opponent's evidence

10. The opponent filed evidence in the form of the witness statement of David Tate dated 23 January 2023, which is accompanied by 2 exhibits (DT1-DT2). Mr Tate is a trade mark attorney employed by Maguire Boss, the representative for the opponent.

11. Mr Tate's evidence is very brief and goes to the issue of similarity of goods and services.

The applicant's evidence

12. The applicant filed evidence in the form of the witness statement of Michael Beake (the applicant himself) dated 11 April 2023, which is accompanied by 8 exhibits (MB1-MB8).

13. The main purpose of Mr Beake's evidence is to talk about the business in relation to which he intends to use the contested mark, and to demonstrate that the parties operate in different segments of the market, a point to which I will return below. The

rest of Mr Beake's evidence is irrelevant, and I will briefly address here the reasons why it has no part to play in this decision.

14. In his evidence, Mr Beake referred to the fact that the application was initially registered due to an error and that when the error was uncovered, the status of the application was changed to reflect the opposition. Mr Beake also pointed out that, having received communication from the UKIPO that the application had been registered, he proceeded with the business, confident in the notion that he could use the applied-for mark.

15. The initial registration of the application was the result of a slip in the recording of the present opposition, and whilst it is regrettable, it did not create an enforceable expectation that the mark will be registered. Hence, it is not a fact that I can take into account.

16. Mr Beake also relied upon the fact that the opponent owns an earlier registration (UK00801218818) for the word mark 'PETROL' covering goods and services in classes 3, 9, 14, 18, 25 and 35 which are identical to those relied upon in this opposition. Mr Beake alleged that since that registration has a filing date of 6 June 2014 (and would be subject to proof of use), the earlier mark relied upon in this opposition was filed only in order to circumvent proof of use.

17. Mr Beake's allegation that the opponent re-filed the earlier mark relied upon in the present proceedings in order to "evergreen" the 2014 mark in 2020, and avoid having to furnish evidence of genuine use in opposition proceedings, is not enough in itself to establish bad faith since it is possible for there to be a legitimate reason for this.² In any event, the point Mr Beake made is purely academic since the validity of the earlier mark relied upon by the opponent in these proceedings has not been challenged.

² *Hasbro Inc.-v- EUIPO*, Case T-663/19-MONOPOLY.

EU Law

18. 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. This is why this decision continues to make reference to the trade mark case law of EU courts.

Preliminary Issues

19. I note that, in accordance with rule 19(2) of the Trade Mark Rules 2008, a Preliminary Indication (PI) was issued to both parties on 27 September 2022, indicating that the similarity between the marks and the parties' goods in classes 14, 18 and 25 was likely to result in a finding of indirect confusion. However, it was considered that a PI would be inappropriate in respect of the applicant's services in class 35, because the matter of the similarity, or otherwise, of the respective services in class 35 was "*too finely balanced*".

20. PIs are issued to give the respective parties an indication on a *prima facie* basis as to the likely decision in respect of the grounds of opposition, giving either party the opportunity to withdraw either the opposition or the application accordingly, without incurring costs. The PI is not binding, nor does it replace a full decision by a different Hearing Officer.

21. As the PI was that the application should be refused for some of the goods for which it seeks registration, the applicant was allowed until 27 October 2022 to file a notice of intention to proceed on a Form TM53.

22. On 26 October 2022, the applicant filed a Form TM53 requesting the opposition to proceed to the evidential stages.

23. Although the Registry has issued a preliminary opinion that the opposition should succeed for the contested goods in classes 14, 18 and 25, I am not bound by it.

Consequently, I will make my own assessment of the likelihood of confusion between the parties' marks and the respective goods and services.

DECISION

Section 5(2)(b)

24. Section 5(2)(b) of the Act is as follows:

“A trade mark shall not be registered if because-

[...]

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

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

25. Section 5A of the Act is as follows:

“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.”

26. 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 great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

27. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (“CJEU”) stated that:

“23. 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 complementary.”

28. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

(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.

29. The General Court (“GC”) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa.

30. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] 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.”

31. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between the goods/services is to assess whether the relevant public are liable to believe that the responsibility for the goods/services lies with the same undertaking or with economically connected

undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together”

32. The goods and services to be compared are as follows:

The applicant’s goods and services	The opponent’s goods and services
<p>Class 14: <i>Keyrings; keyrings of common metals; key fobs; leather key fobs; cufflinks; tie clips; brooches [jewellery].</i></p>	<p>Class 14: <i>Jewellery, precious stones; Chains, rings and bracelets; Horological and chronometric instruments; Watches.</i></p>
<p>Class 18: <i>Bags; canvas bags; travelling bags; wallets; card wallets; business card holders in the nature of wallets, umbrellas; golf umbrellas.</i></p>	<p>Class 18: <i>Bags; Purses; Trunks and suitcases; Umbrellas.</i></p>
<p>Class 25: <i>Sweatshirts; hooded sweatshirts; T-shirts; printed t-shirts; short-sleeved T-shirts; jackets; casual jackets; jackets [clothing]; headwear, peaked headwear; sports shoes, shirts and trousers.</i></p>	<p>Class 25: <i>Clothing, footwear, headgear; Denim jeans; Clothing of denim; Overcoats and jackets, trousers, shirts, sweaters, socks, belts [clothing], skull caps, neckties, dresses, shoes, mules, sandals.</i></p>
<p>Class 35: <i>Advertising; promotion [advertising] of business; advertising via</i></p>	<p>Class 35: <i>Business mediation in the purchase and sale, import and export,</i></p>

the Internet; advertising, marketing and promotional services; online advertising via a computer communications network; retail services connected with the sale of clothing and clothing accessories, keyrings, mugs, drinking bottles, flasks, pens, stationery; online ordering services; online retail store services in relation to clothing, shoes and hats, keyrings, cufflinks, tie clips, brooches, pens, pencils, stationery, bags, wallets, card wallets, umbrellas, cups, mugs, drinking bottles, water bottles, flasks, stationery; event marketing; arranging and conducting of marketing and promotional exhibitions, events and shows; arranging and conducting of exhibitions; arranging and conducting of fairs and exhibitions for racing and high performance sports cars events.

and wholesaling and retailing of perfumery, aftershaves, essential oils, cosmetics, hair lotions, preparations for skin care and hair care, make-up, nail polish, nail grooming products, spectacles and sunglasses, covers for smartphones, mobile telephones, tablets and laptops, smartphone applications, jewellery; Business mediation in the purchase and sale, import and export, and wholesaling and retailing of cabochons, chains, rings and Bracelets, Timepieces, chronological, Watches, Panniers, change purses, Trunks and travelling bags, Articles of clothing, Umbrellas; Business mediation in the purchase and sale, import and export, and wholesaling and retailing of footwear, headwear, jeans, clothing of denim, overcoats, jackets, trousers, shirts, sweaters, socks, belts [clothing], skull caps, neckties, dresses, shoes, mules, sandals; Organisation of events for commercial and advertising purposes; Consultancy and information regarding the aforesaid services; The aforesaid services also provided via electronic networks, such as the Internet; all previous services not to be offered on premises or in relation to gasoline or automotive service stations, all previous services not to be offered in on-line stores in connection to merchandise not

	<i>carrying Petrol sign or sign similar thereto.</i>
--	--

33. Both parties filed evidence about the similarity of goods and services. Before moving to consider whether the goods and services are similar, I will briefly address the relevance of this evidence.

34. Mr Beake's evidence focuses on the differences between the business operated by the applicant and that operated by the opponent. He explains that the application relates to a new sport car and motorbike business whose purpose is for consumers to share and celebrate a passion for all petrol-powered vehicles. The business organises track days, VIP events and other events to provide owners of sports cars and motorbikes an opportunity to drive their cars or motorbikes around a racing circuit. As regard the opponent's business, Mr Beake provides copies of webpages from the opponent's website (<https://petrolindustries.com>) and points out that the opponent is a retailer of clothing for men and boys and does not provide any of the other goods or services for which the earlier mark is registered.

35. Mr Beake's evidence and argument are not pertinent to this case. This is because the particular segment of the market in which the opponent has so far chosen to trade does not deprive the opponent's marks of the normal level of protection afforded to every registered mark. This means that I must consider notional and fair use of the opponent's mark across all segments of the markets for the goods and services for which it is registered. So far as the applicant's proposed use of his mark is concerned, when assessing the likelihood of confusion in the context of registering a new mark, it is necessary to consider all the circumstances in which the mark applied-for might be used if it were registered.³ Consequently, the fact that the parties are currently, or currently intend to, target different market segments is irrelevant where the goods and services at issue are identical or similar.

36. Turning to the opponent's evidence, it is as follows:

³ Case C-533/06, O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited

- DT1: this exhibit shows examples from John Lewis' website of purses with card pockets. Mr Tate points out that some of the product descriptions for purses mention that they may be used to hold documents such as receipts;
- DT2: this exhibit shows examples of goods such as pens, cups, mugs and flasks that are made from, or embellished with, precious metals or jewels, and are sold by jewellery (for example pens and silver cups sold by Tiffany & Co) and luxury brand companies (for example Montblanc pens).

37. Whilst I note this evidence, it does not add much to the relevant factors which I should take into account when assessing the similarity of the goods or services.

38. Finally, in its counterstatement the applicant admits that its goods and services are similar to some of the opponent's goods and services. He states (emphasis added)

“Solely in terms of a comparison of the specifications, the Applicant admits that there is a degree of overlap between some of the goods and services of the Opponent's earlier registered mark and the goods and services of the Application. However, the Applicant denies that this is likely to lead to a likelihood of confusion on the part of the public.

Comparing the goods and services in Classes 14, 18 and 35 the Applicant's goods and services and the Opponent's goods and services are not identical. Accordingly, the Applicant disagrees with the Opponent's assessment of the comparison of the goods and services in relation to identity.

Further, the Applicant disagree with the Opponent's assessment of the close similarity and similarity of the goods and services.”

39. Hence, whilst the applicant denies identity or close similarity, he also admits that the goods and services are similar to a degree which is lower than “*closely similar*”. I will approach the comparison with this in mind.

Class 14: Keyrings; keyrings of common metals; key fobs; leather key fobs; cufflinks; tie clips; brooches [jewellery].

40. The opponent's specification in class 14 covers *Jewellery, precious stones; Chains, rings and bracelets; Horological and chronometric instruments; Watches.*

41. The only comment the applicant made in relation to this class is that the terms "key rings of common metals" and "leather key fobs" are not identical to the opponent's specification "Jewellery". I will only say that this submission does not assist the applicant because even if these goods are not identical, they can be similar (or similar to other goods).

42. The applicant's *brooches [jewellery]* fall within the opponent's term *jewellery*. The same applies to the applicant's terms *cufflinks* and *tie clips*, both of which are worn on clothes and can be made of precious metal falling therefore within the dictionary definition of jewellery "as decorative objects worn on your clothes or body that are usually made from valuable metals, such as gold and silver, and precious stones".⁴
These goods are identical according to the principle outlined in *Meric*.

43. *Keyrings; keyrings of common metals; key fobs; leather key fobs.* Key fob is defined as "a piece of leather or other material to which a key or group of keys is fastened".⁵ Key fobs and keyrings are very similar goods, both being used to hold and carry keys. The closest clash I can see here is with the opponent's *chains*, which may include key chains. The goods have the same purpose, target the same users, normally coincide in trade channels and are in competition. **These goods are similar to a high degree.**

Class 18: Bags; canvas bags; travelling bags; wallets; card wallets; business card holders in the nature of wallets, umbrellas; golf umbrellas.

⁴ Cambridge online dictionary

⁵ Cambridge online dictionary

44. The applicant's Bags; canvas bags; travelling bags fall within the term *bags* in the opponent's specification. **These goods are identical according to the principle outlined in *Meric*.**

45. The applicant's umbrellas; golf umbrellas fall within the term *umbrellas* in the opponent's specification. **These goods are identical according to the principle outlined in *Meric*.**

46. The applicant's wallets; card wallets; business card holders in the nature of wallets, are highly similar to the opponent's *purses*. I note the applicant's argument that these goods are not "closely similar" because, whilst it is accepted that a purse is used for carrying money, it is not accepted that it is used for carrying cards and documents. First, whilst the applicant has denied that the goods are closely similar, he admitted that there is an overlap. Second, the opponent filed evidence showing that purses are used to carry cards as well as cash and coins, which corresponds to my experience that purses have apposite departments for carrying cards. The goods have a similar nature and purpose, i.e. they are used to carry money and cards, have the same methods of use, are in competition and share trade channels. **These goods are similar to a high degree.**

Class 25: Sweatshirts; hooded sweatshirts; T-shirts; printed t-shirts; short-sleeved T-shirts; jackets; casual jackets; jackets [clothing]; headwear, peaked headwear; sports shoes, shirts and trousers.

47. The opponent's specification in class 25 includes the broad terms *clothing, footwear, headgear* which encompass all of the applicant's goods in the same class. **These goods are identical according to the principle outlined in *Meric*.**

Class 35: Advertising; promotion [advertising] of business; advertising via the Internet; advertising, marketing and promotional services; online advertising via a computer communications network; retail services connected with the sale of clothing and clothing accessories, keyrings, mugs, drinking bottles, flasks, pens, stationery; online ordering services; online retail store services in relation to clothing, shoes and hats, keyrings, cufflinks, tie clips, brooches, pens,

pencils, stationery, bags, wallets, card wallets, umbrellas, cups, mugs, drinking bottles, water bottles, flasks, stationery; event marketing; arranging and conducting of marketing and promotional exhibitions, events and shows; arranging and conducting of exhibitions; arranging and conducting of fairs and exhibitions for racing and high performance sports cars events.

48. The opponent's specification covers *organisation of events for commercial and advertising purposes*. The limitation "not to be offered on premises or in relation to gasoline or automotive service stations, all previous services not to be offered in on-line stores in connection to merchandise not carrying Petrol sign or sign similar thereto" in the opponent's specification has the effect of excluding (a) services provided in relation to the sale of fuel for vehicles, a gasoline or automotive service station being defined as "a place where fuel is sold for road vehicles, often with a small shop"⁶ and (b) the online sale of merchandise not carrying petrol signs. This is not sufficient to avoid the conclusion that the opponent's services *organisation of events for commercial and advertising purposes* fall within, or encompass, the applicant's **advertising; promotion [advertising] of business; advertising via the Internet; advertising, marketing and promotional services; online advertising via a computer communications network; event marketing; arranging and conducting of marketing and promotional exhibitions, events and shows; arranging and conducting of exhibitions; arranging and conducting of fairs and exhibitions for racing and high performance sports cars events.** **These goods are identical according to the principle outlined in *Meric*.**

49. This leaves **retail services connected with the sale of clothing and clothing accessories, keyrings, mugs, drinking bottles, flasks, pens, stationery; online ordering services; online retail store services in relation to clothing, shoes and hats, keyrings, cufflinks, tie clips, brooches, pens, pencils, stationery, bags, wallets, card wallets, umbrellas, cups, mugs, drinking bottles, water bottles, flasks, stationery.** These services are subject to the same limitation as above, however, such limitation does not prevent a finding of similarity with the opponent's goods and services. The closest clash I can see here is with the opponent's goods, which include goods that are

⁶ Collins online dictionary

identical or highly similar to those to which the applicant's retail services relate. 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. I therefore find that the applied-for services listed below (which relate to goods that are either identical or highly similar to the opponent's goods in classes 14, 18 and 25) **are similar to a medium degree to the opponent's goods:**

retail services connected with the sale of clothing and clothing accessories, keyrings; online ordering services; online retail store services in relation to clothing, shoes and hats, keyrings, cufflinks, tie clips, brooches, bags, wallets, card wallets, umbrellas.

50. As regards the retail services relating to the remaining goods, *retail services connected with the sale of mugs, drinking bottles, flasks, pens, stationery; online retail store services in relation to pens, pencils, stationery, cups, mugs, drinking bottles, water bottles, flasks, stationery.* bearing in mind the applicant's admission about the existence of an overlap between some of the opponent's goods and services and the applied-for goods and services (which I take to refer to all of the objected goods and services) I find that that the retail services normally associated with the sale of these goods are sufficiently close to the opponent's goods to justify a finding of similarity.⁷ **These services are similar to a low degree.**

51. Finally, I reject the opponent's submission that the applicant's retail services are similar to its business mediation in the purchase and sale, import and export, and wholesaling and retailing of various goods. The opponent's services are different types of services aimed at supporting or helping other businesses to do or improve business. They are therefore in principle directed at the professional public. The opponent's retail services, in contrast, are usually directed at the general public and essentially allow consumers to satisfy different shopping needs.

⁷ Tony Van Gulck v Wasabi Frog Ltd, Case BL O/391/14

Average consumer

52. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. 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. (as he then was) 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 words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

53. The average consumer of the goods and service at issue is the general public or a business user.

54. The purchasing process for these goods and services is likely to be dominated by visual considerations. However, I do not discount aural considerations entirely as it is possible that the purchasing of these goods and services would involve oral discussions with sales representatives or word of mouth recommendations. The degree of attention is likely to be medium or, above medium, when services are directed at businesses.

Comparison of marks

55. 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.”

56. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account 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. The respective marks are shown below:

The applicant's mark	The opponent's mark
PETROL REVOLT	PETROL

57. The opponent's mark consists of the word 'PETROL', presented in capital letters. There are no other elements that contribute to the overall impression of the mark which lies in the word itself.

58. The applicant's mark is a composite mark consisting of the words 'PETROL' and 'REVOLT'. I consider that the overall impression lies in the combination of these elements.

59. Visually and aurally, both marks include the word 'PETROL' which is the entirety of the earlier mark. The applicant's mark also includes the word 'REVOLT' which has

no counterpart in the opponent's mark. Overall, the marks are visually and aurally similar to a medium degree.

60. Conceptually, the applicant refers to the fact that the opponent's website at <https://petrolindustries.com> contains a reference to a line of sustainable clothing that is described as *"the Road to a cleaner future"*. The applicant argues that the opponent's idea of creating clothes with *"less impact on the planet"* is the opposite of what the applicant's mark 'PETROL REVOLT' tries to convey, namely a passion for petrol cars and motorbikes in an era of increasingly electric cars. The applicant's argument is irrelevant insofar as it relates to matters that are extraneous to the marks and are not reflected in the application and registration, respectively.

61. In its counterstatement the applicant's states:

"The words PETROL REVOLT in the Applicant's Mark could potentially allude to:

The idea of revolting against the increasing restrictions on cars and motorbikes that run on petrol.

The Petrol Revolt business is the antithesis of the electric powered vehicles and the new regulations and restrictions that are reducing the existence of the internal combustion engine cars and motorbikes. It is therefore highly unlikely that the Applicant's Mark will be understood as referring to rebellious or unconventional goods and services provided by the Opponent under its PETROL mark. The Applicant's appeal is to consumers who still prefer petrol sports cars and motorbikes in an era where increasingly there is a rapid acceleration towards use of electric cars and motorbikes. As such the Applicant target market is a niche market in relation to highly discerning consumers."

62. Whilst that might be the idea which has actually inspired the applicant's business, the application does not convey that message. There is nothing in the mark, which would immediately tell the relevant public that the intended meaning of the mark 'PETROL REVOLT' is that of promoting petrol cars and rebels against restrictions on

cars that run on petrol. It follows that the average consumer is unlikely to attribute any clear meaning to the words “petrol revolt” when encountering the mark in the context of goods and services which have nothing to do with cars (a point to which I shall return below). In such case, the words do not combine to form a unit with a different meaning than the two words taken separately.

63. The marks coincide in the concept of ‘PETROL’, which will convey the same meaning in both marks, namely that of a liquid which is used as a fuel for motor vehicles. This creates a certain conceptual similarity between the marks. However, the presence of the word ‘REVOLT’ in the applicant’s mark introduces a concept that has no counterpart in the opponent’s mark, that is to say the concept of “*an illegal and violent attempt by a group of people to change their country’s political system*”.⁸ Overall, I consider the marks to be conceptually similar to a medium degree.

Distinctive character of earlier mark

64. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically

⁸ Collins online dictionary

widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

65. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

66. The opponent makes no claim to enhanced distinctiveness through the use made of the earlier mark, therefore I only have the inherent distinctiveness of the mark to consider.

67. The word ‘PETROL in the opponent’s mark is neither descriptive nor allusive of the goods and services in question and, as such, it has a medium degree of distinctiveness.

Likelihood of confusion

68. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

69. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where Iain Purvis Q.C. as the Appointed Person explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

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

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

70. Earlier in this decision I found that:

- Most of the applicant’s goods and services are identical to the goods and services of the earlier mark, whilst others are similar to various degrees;
- The average consumer would be a member of the general public or a business user who would pay a degree of attention ranging from medium to above medium during the purchasing process. The purchasing process would be predominantly visual, although aural considerations cannot be excluded entirely;
- The overall impression of the earlier mark lies in the word ‘PETROL’, whilst the words ‘PETROL’ and ‘REVOLT’ make a roughly equal contribution to the distinctiveness of the applicant’s mark and the overall impression it conveys;
- The applicant’s mark ‘PETROL REVOLT’ does not form a unit having a different meaning as compared to its components taken separately insofar as the goods and services involved have nothing to do with petrol and cars that run on petrol;
- The marks are visually, aurally and conceptually similar to a medium degree;
- The earlier mark has a medium degree of inherent distinctive character, which has not been shown to have been enhanced through use.

71. Taking all of the above into account, and in the context of goods and services which have nothing to do with petrol and petrol cars, it is my view that the addition of the word ‘REVOLT’ in the applicant’s mark will be perceived by consumers as indicating a particular subset of the ‘PETROL’ brand, constituting a line of goods and services. For example, a rebellious line of goods in classes 14, 18 and 25 and

associated retail services in class 35 and/or a branch of advertising services that is innovative, or adopts an unconventional style of advertising, or specifically target activist businesses. Hence, I am satisfied that the average consumer who is familiar with the opponent's 'PETROL' mark would assume a commercial association between the parties due to the identical word 'PETROL'. There is a likelihood of indirect confusion.

72. However, when the contested mark 'PETROL REVOLT' is used in the context of the applicant's *arranging and conducting of fairs and exhibitions for racing and high performance sports cars events* services in class 35, the average consumer is more likely to appreciate the mark in the way described by the applicant. In those circumstances, I consider that the average consumer will understand the word 'PETROL' as a descriptive reference to a type of fuel used by the cars involved in the event, i.e. petrol cars, and the word 'REVOLT' as a reference to a rebellious act against the push towards owning non-petrol cars. I therefore asked myself whether that would be sufficient to exclude any likelihood of confusion. Having considered all of the relevant factors, I have concluded that it would. This is because even if I have found the services to be identical, when the word 'PETROL' is used in the context of services consisting of *arranging and conducting of fairs and exhibitions for racing and high performance sports cars events*, it loses much of its distinctiveness. Adding to this the fact the average consumer is likely to perceive the words 'PETROL REVOLT' as conveying the message of a revolt in favour of petrol cars, it just tilts the balance in favour of the applicant and there is no likelihood of confusion.

CONCLUSIONS

73. The opposition succeeds in relation to the following goods and services for which the application is refused:

Class 14: *Keyrings; keyrings of common metals; key fobs; leather key fobs; cufflinks; tie clips; brooches [jewellery].*

Class 18: *Bags; canvas bags; travelling bags; wallets; card wallets; business card holders in the nature of wallets, umbrellas; golf umbrellas.*

Class 25: *Sweatshirts; hooded sweatshirts; T-shirts; printed t-shirts; short-sleeved T-shirts; jackets; casual jackets; jackets [clothing]; headwear, peaked headwear; sports shoes, shirts and trousers.*

Class 35: *Advertising; promotion [advertising] of business; advertising via the Internet; advertising, marketing and promotional services; online advertising via a computer communications network; retail services connected with the sale of clothing and clothing accessories, keyrings, mugs, drinking bottles, flasks, pens, stationery; online ordering services; online retail store services in relation to clothing, shoes and hats, keyrings, cufflinks, tie clips, brooches, pens, pencils, stationery, bags, wallets, card wallets, umbrellas, cups, mugs, drinking bottles, water bottles, flasks, stationery; event marketing; arranging and conducting of marketing and promotional exhibitions, events and shows; arranging and conducting of exhibitions.*

74. The opposition fails in relation to the following services for which the application may proceed to registration:

Class 35: *arranging and conducting of fairs and exhibitions for racing and high performance sports cars events.*

75. As the goods and services in classes 16, 21 and 41 have not been opposed, they will also proceed to registration.

COSTS

76. The opponent has enjoyed the greater degree of success and is, consequently, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I bear in mind the applicant's partial success, and I award the opponent the sum of £700 calculated as follows:

Preparing a statement and considering the applicant's statement:	£200
---	------

Preparing evidence and submissions	£400
Official fees:	£100
Total	£700

76. I therefore order Michael Beake to pay Petrol Industries B.V. the sum of £700. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 14th day of September 2023

Teresa Perks
For the Registrar