

BL O/580/19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3322712

BY

SHELL BRANDS INTERNATIONAL AG

TO REGISTER THE FOLLOWING TRADE MARK:

SHELL GO+

IN CLASSES 09, 16, 35 AND 36

AND

OPPOSITION THERETO (NO. 413906)

BY

EG RETAIL B.V.

Background and pleadings

1. Shell Brands International AG, (hereafter “the applicant”) applied to register the trade mark:

SHELL GO+

in the UK on 05 July 2018. It was accepted and published in the Trade Marks Journal on 20 July 2018, for the following goods and services:

Class 09: Computer software.

Class 16: Printed cards in connection with customer loyalty schemes, included in this class.

Class 35: Organisation and management of customer loyalty schemes; advertising and promotional services.

Class 36: Financial affairs; monetary affairs.

2. EG Retail B.V. (“the opponent”) opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).
3. The opposition is based on two earlier European Union Trade Marks (EUTM’s).
4. Firstly, EUTM no. 9770901, which was filed on 28 February 2011 and registered on 20 July 2016, in classes 04, 30, 35, 37 and 43; for the mark:

GO

5. The opponent relies only on the services registered in class 35 of that earlier mark, namely:

Class 35: Business mediation in sales excluding the aforementioned services in relation to travel accessories, apparatus, equipment and clothing for

outdoor pursuits, sports and the leisure market; office functions; data management; excluding increasing traffic flow to websites on the internet.

6. The opposition is also based on EUTM no. 9995119, which was filed on 25 May 2011 and registered on 06 February 2016 for the mark:

GO

7. The opponent relies on all of the goods for which this earlier mark is registered, namely:

Class 09: Magnetic and machine-readable cards containing encoded information; Cards with built-in facilities for storing and processing data (smart cards); Apparatus for reading and writing encoded information on cards; Encoded cards for use when buying petrol; Payment cards; Apparatus for data processing; Recorded computer programs; Encoded cards, in particular fuel cards.

Class 36: Financial services; Services with regard to the issue of credit and debit cards.

8. Given the dates of registration, the opponents marks qualify as earlier marks in accordance with section 6 of the Act but are not subject to proof of use.
9. In its statement of grounds, the opponent claims that the contested mark is highly similar to the earlier marks, as the earlier marks are comprised solely of the word 'GO' and the contested mark contains that element. The opponent states that the goods and services at issue in classes 09 and 36 are identical and that the goods and services at issue in classes 16 and 35 are highly similar or similar. As such, there is a likelihood that the average consumer will believe that the goods and services originate from the same or economically linked undertakings.
10. In its counterstatement the applicant denies that the respective marks are similar, and also denies any similarity between the goods and services at issue. As such, it states that there can be no likelihood of confusion.

11. Both parties filed written submissions and the applicant submitted evidence. I will not summarise the written submissions here but will refer to them later in my decision, where necessary.
12. A hearing to determine the claim was requested and took place before me on 14 August 2019.
13. Throughout the proceedings the applicant has been represented by Osbourne Clarke, whilst the opponent has been represented by Wildbore & Gibbons. At the hearing the applicant was represented by Mr Richard May of Osbourne Clarke. The opponent was not represented at the hearing.

Evidence

14. The applicant submitted evidence to support a claim that the word 'GO' has become commonly used in the marketplace, especially in the area of digital transformation, by many third parties and notably some high-profile undertakings such as Amazon, Sky and Marks & Spencer. The evidence is comprised of a witness statement of Keenan Moroz, Senior Counsel for the applicant, along with exhibits KM1 - KM18.
15. In his witness statement, Mr Moroz sets out his position in his company. Mr Moroz is Senior Counsel, Global Brands, at Shell Canada Services Limited (Shell Canada). Shell Canada and Shell Brands International AG (the applicant) are part of the well-known Shell group of companies. Mr Moroz has worked for the applicant company for 14 years and has been in his current role for four years.
16. The exhibits accompanying the witness statement of Mr Moroz can be summarised as follows:
 - **KM1**: comprises extracts from the company website and the App store, with press coverage of the launch of 'SHELL GO+'.
 - **KM2 - KM18**: show third party use of composite marks incorporating the word 'GO'. This information includes use of the marks: 'SCAN, PAY, GO' by Londis and Tesco; 'AMAZON GO' by Amazon; 'MOBILE, PAY, GO' by Marks &

Spencer; 'GO2PAY' by Adelante Software Limited; 'GOTAP/GOPAY' by International Trading Group; 'RING GO' by Cobalt Telephone Technologies; 'SKY GO' by Sky UK Limited; 'Pay as you go' by Tesco Mobile Limited; 'ICE CARD GO' by Planet Ice and 'GOCARDLESS' by GoCardless Ltd.

17. During the hearing Mr May told me that the average consumer of the goods and services at issue would perceive the word 'GO' as a weak, allusive and commonly used word that would convey a message of speed, convenience or automation.
18. He said that the word 'SHELL' in the contested mark was an independently distinctive element. Whilst the element 'SHELL' was the most distinctive element in the contested mark, Mr May told me that the mark 'SHELL GO+' hung together as a unitary mark.
19. Mr May told me that the word 'GO' had become synonymous with speed and/or convenience and that the evidence in exhibits KM2 - KM18 supported this claim. This was particularly the case, he stated, in the area of digital transformation, where consumers expect more autonomy and the capacity to engage quickly, conveniently and with less physical interaction, through the use of mobile devices and apps.
20. Mr May referred me to the third-party evidence within exhibits KM2 - KM18. He noted that in the UBA Market article, on page 42 of exhibit KM4, research had shown that 53% of shoppers prioritised convenience when shopping and that, for retailers, the issue of 'how you buy' was as important as 'what you buy'.
21. Mr May referred me again to exhibit KM4 and evidence of use of the term 'Amazon Go'. This use relates to the establishment of Amazon retail environments that have no tills or the possibility to pay in cash for goods, and where the consumer has their chosen items scanned and a charge made directly to their bank account via a mobile phone or other electronic device.
22. In exhibit KM8 the sign 'RingGo' is shown. This is the name of a parking app which provides a service whereby the user of the app can park their car without purchasing a ticket in the traditional way, using cash. This service has been available for more than ten years and the UK wide NCP car park company use this technology.

23. Mr May referred me to exhibit KM9 which shows that the satellite television broadcaster Sky UK Ltd uses the sign 'Sky Go' as the name of one of their products. 'Sky Go' was launched in 2006 and has become a household name for satellite television services.
24. Mr May told me that all of the third-party marks shown in exhibits KM2 – KM18 are composite marks, intended to illustrate the claim of the applicant, that the average consumer has become used to seeing the word 'GO' used in combination with other distinctive elements, as unitary marks, but where the 'GO' element is likely to be perceived as an allusive and lowly distinctive element alluding to speed or convenience in the goods or services on offer.
25. Mr May also claimed that the average consumer of the relevant goods and services would perceive the shared element 'GO' as coincidence rather than a shared origin. As such they would be unlikely to call to mind the earlier 'GO' marks when faced with the contested 'SHELL GO+' mark, or vice-versa, but that if they did, it would be mere association rather than confusion.

Decision

Section 5(2)(b) of the Act

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

“(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.”

27. The following principles are gleaned from the decisions of the CJEU in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

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

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

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

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

- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may 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

28. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment 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”.

29. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(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.

30. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court 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 where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

31. In the applicant’s skeleton arguments and during the hearing before me, Mr May conceded that the goods and services at issue in classes 09 and 36 were identical.

32. Mr May also accepted that the contested class 16 goods were similar to the earlier class 09 goods of EUTM 9995119, albeit to a low degree in his opinion.

33. The parties' respective goods and services are:

Opponent's goods and services	Contested goods and services
<p><u>EUTM 9770901</u></p> <p>Class 35: Business mediation in sales excluding the aforementioned services in relation to travel accessories, apparatus, equipment and clothing for outdoor pursuits, sports and the leisure market; office functions; data management; excluding increasing traffic flow to websites on the internet.</p> <p><u>EUTM 9995119</u></p> <p>Class 09: Magnetic and machine-readable cards containing encoded information; Cards with built-in facilities for storing and processing data (smart cards); Apparatus for reading and writing encoded information on cards; Encoded cards for use when buying petrol; Payment cards; Apparatus for data processing; Recorded computer programs; Encoded cards, in particular fuel cards.</p> <p>Class 36: Financial services; Services with regard to the issue of credit and debit cards.</p>	<p>Class 09: Computer software</p> <p>Class 16: Printed cards in connection with customer loyalty schemes, included in this class</p> <p>Class 35: Organisation and management of customer loyalty schemes; advertising and promotional services.</p> <p>Class 36: Financial affairs; monetary affairs</p>

34. The applicant has conceded that the contested 'Computer software' in class 09 and 'Financial affairs; monetary affairs' in class 36 are identical to the earlier 'Recorded computer programs' and 'Financial services' of EUTM 9995119.
35. The contested 'Printed cards in connection with customer loyalty schemes, included in this class' in class 16 have been conceded by the applicant to be similar, to a low degree, to the earlier class 09 goods 'Magnetic and machine-readable cards containing encoded information; Cards with built-in facilities for storing and processing data (smart cards); Encoded cards for use when buying petrol; Payment cards; Encoded cards, in particular fuel cards' of the earlier EUTM 9995119.
36. These goods are generally the same size and shape as a bank debit or credit card and can be kept in a wallet or purse. They hold information such as the user's name and account number, either in printed format or electronically, and are used to collect or redeem rewards or points, based on a loyalty scheme intended to encourage the user to regularly purchase goods from one particular undertaking. As such they share nature, intended purpose, channels of trade and end-user. I find these goods to be similar to a medium degree.
37. The contested class 35 services 'Organisation and management of customer loyalty schemes' are services that deal with the setting up and day to day management of a loyalty scheme to encourage participants/consumers to repeatedly engage with the same undertaking in the purchase of goods or services. The intention of such schemes is to offer consumers a reward for regularly using one particular company or undertaking, in order to dissuade those consumers participating in the loyalty scheme from procuring the same or similar goods and services elsewhere. These services do not share nature, purpose, channels of trade or provider with any of the opponent's earlier goods and services. Whilst a provider of such loyalty schemes may provide participants with a loyalty card in paper or plastic form, this is not always the case. Where this might be the case however, it is not accepted that the opponent's range of cards in class 09 are complementary to, or in competition with the applicant's 'organisation and management of customer loyalty schemes'. These goods and services are not indispensable or essential in the use or uptake of the other. Therefore, I find the contested 'Organisation and management of customer

loyalty schemes' to be dissimilar to all of the earlier goods and services of the opponent.

38. The contested class 35 'Advertising and promotional services' are services provided by agencies and undertakings who specialise in the design and creation of advertising and promotional materials and campaigns on behalf of others. These services do not share nature, purpose, channels of trade, end-user or provider with any of the opponent's earlier goods and services. These services are therefore considered to be dissimilar to all of the earlier goods and services of the opponent.

39. In conclusion, the contested goods and services have been found to be identical; similar to a medium degree and dissimilar, to the opponent's goods and services.

Average consumer and the purchasing act

40. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

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

42. The goods and services at issue encompass a broad range of products. Some of the services on offer can be said to be specialist in nature and infrequently sought out,

e.g. 'business mediation in sales'; or may be services that attract a professional consumer such as 'organisation and management of customer loyalty schemes'. Other goods and services at issue may be said to be day to day products such as 'printed cards' and 'financial services', to which a general public consumer will also be attracted. The relevant public will therefore be both the general public in respect of certain goods and services at issue; and a professional consumer.

43. I consider that a member of the general public will pay no more than an average degree of attention during the selection process for the goods and services on offer that are of interest to them; whilst it can be said that the professional consumer will likely pay a higher level of attention during the selection process, to ensure that the goods or services chosen suit their specific requirements.
44. The average consumer is likely to purchase the goods and services at issue from specialist suppliers either in retail premises, online via a website or from a catalogue. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may be an aural element to the purchase of these goods and services, given that advice may be sought from sales representatives in person or over the telephone.

Comparison of marks

45. 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.”

46. 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.

47. The marks to be compared are:

Earlier EUTMs	Contested mark
GO	SHELL GO+

48. The earlier EU marks are both comprised solely of the plain word ‘GO’ in a standard type-face, as such the overall impression in those marks lies in that word.

49. The contested mark is comprised of the word ‘SHELL’, and the element ‘GO+’, all of which is presented in a standard type-face. The word ‘SHELL’ is readily understood by the English-speaking public to mean the hard covering of a nut or egg, or the hard covering of an animal such as a crab or tortoise. As such it has no connection or association with the goods or services at issue and can be said to be distinctive within the contested mark.

50. The word ‘GO’ will be understood as referring to movement (usually by a person). The ‘+’ symbol is commonly used as a substitute for the word ‘Plus’ which can be defined as referring to an advantage or benefit, or as something additional. Go+ within the contested trade mark has the hint of somehow offering a particular feature. As such those elements of the mark may be said to be relatively weak within the whole.

51. Whilst no single element in the contested mark can be said to be more dominant than other elements, the word ‘SHELL’ can be said to be the more distinctive element and, as it also forms the beginning of the mark, will play a greater role in the mark.

Visual similarity

52. The marks at issue are visually similar inasmuch as they both contain the word 'GO'. The marks differ in the word 'SHELL' and the '+' symbol of the contested mark, which have no counterpart in the earlier marks. As the word 'SHELL' forms the beginning of the contested mark and is longer in length, and the shared element 'GO' is an extremely short word, the marks are found to be visually similar only to a low degree.

Aural similarity

53. The opponent's earlier marks will be articulated as *GO*. The '+' element in the applicant's contested mark is commonly understood to represent the word 'PLUS' and the contested mark is therefore likely to be articulated as *SHELL/GO/PLUS*. It is possible that a part of the average consumer group may choose not to articulate the '+' element in the contested mark, in which case the mark may be articulated as *SHELL/GO*. Irrespective of the articulation or not of the '+' element in the contested mark, as the beginnings of the marks are quite different, they are found to be aurally similar to a low degree.

Conceptual similarity

54. Conceptually, both marks share the word 'GO' which indicates the movement of something or someone.

55. The contested mark also contains the word 'SHELL' which is a commonly understood word that appears to have no link or association with any of the goods or services at issue. The contested mark also contains the '+' symbol which is commonly used to represent the word 'Plus' and will convey a message of something additional or of benefit. It is accepted that the contested mark does not have an overall cohesive concept. That said, the word 'SHELL' clearly has an impact here as a concept in its own right and the mark's overall construction alludes to 'GO+' as a feature, perhaps being able to move or travel more quickly or in a way that is more convenient or desirable. That said, though the concept of 'SHELL' is

clear, the presence of 'GO' (even with the addition of the plus symbol) is still clearly noticeable. Bearing in mind all of the aforesaid, it cannot be concluded that the presence of 'SHELL' creates a clear conceptual gap (though it does have an impact). I therefore consider that there is some conceptual similarity, though this is pitched as being low.

56. In conclusion, the marks have been found to be visually, aurally and conceptually similar to a low degree.

Distinctive character of the earlier trade marks

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

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

58. The opponent has not claimed that its earlier marks have enhanced distinctive character through use, I therefore have to consider only the question of inherent distinctive character.
59. The opponent's marks are comprised solely of the word 'GO'. The word 'GO' will be understood as meaning the movement by people or objects.
60. Mr May stated during the hearing before me that the word 'GO' is commonly used in the marketplace and is being used by many undertakings in the arena of digital transformation in respect of non-traditional retail activities; providing improved speed, convenience or autonomy for the consumer. As such it has been claimed that the word 'GO' is an inherently weak term and is subsequently of low distinctive character. Whilst a presumption of validity must be made in respect of any earlier registered right, the evidence set out in exhibits KM2 – KM18, combined with Mr May's submissions at the hearing, support an argument that the word 'GO' may be said to be relatively weak. I do note however, that this position must be tempered by a recognition that in all of the evidence provided by Mr May, the word 'GO' is not used in isolation. Overall however, I agree with the applicant's position regarding the inherent nature of the word 'GO' solus. In addition to Mr May's submissions, I take from my own knowledge the fact that the word 'GO' is a very common and basic, everyday word in the English language and has a meaning already described above. Further, I am persuaded that it can be perceived as at least allusive to something which can be provided quickly or conveniently.
61. I therefore conclude that the earlier marks are distinctive but only to a lower than average degree.

Likelihood of Confusion

62. I now draw together my earlier findings into a global assessment of the likelihood of confusion, keeping in mind the legal principles established previously (see paragraph 27 above).
63. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of

similarity between the respective 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 the distinctive character of the opponent's trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks side by side but must instead rely upon the imperfect picture of them he has retained in his mind.

64. In considering the likelihood of confusion I also take into account the guidance provided in *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), where Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

65. Further, in *Anncó, Inc. V OHIM*, Case T-385/09, the General Court considered an appeal against OHIM's decision that there was no likelihood of confusion between ANN TAYLOR LOFT and LOFT (both for clothing and leather goods) and found that:

“48. In the present case, in the light of the global impression created by the signs at issue, their similarity was considered to be weak. Notwithstanding the identity of the goods at issue, the Court finds that, having regard to the existence of a weak similarity between the signs at issue, the target public, accustomed to the same clothing company using sub-brands that derive from the principal mark, will not be able to establish a connection between the signs ANN TAYLOR LOFT and LOFT, since the earlier mark does not include the ‘ann taylor’ element, which is, as noted in paragraph 37 above (see also paragraph 43 above), the most distinctive element in the mark applied for.

49 Moreover, even if it were accepted that the ‘loft’ element retained an independent, distinctive role in the mark applied for, the existence of a likelihood of confusion between the signs at issue could not for that reason

be automatically deduced from that independent, distinctive role in that mark.

50 Indeed, the likelihood of confusion cannot be determined in the abstract, but must be assessed in the context of an overall analysis that takes into consideration, in particular, all of the relevant factors of the particular case (*SABEL*, paragraph 18 above, paragraph 22; see, also, Case C-120/04 *Medion* [2005] ECR I-8551, paragraph 37), such as the nature of the goods and services at issue, marketing methods, whether the public's level of attention is higher or lower and the habits of that public in the sector concerned. The examination of the factors relevant to this case, set out in paragraphs 45 to 48 above, do not reveal, *prima facie*, the existence of a likelihood of confusion between the signs at issue.”

66. I have considered the role that the word ‘GO’ plays in the contested mark, and the principles taken from the *Medion v Thomson* case in respect of independent distinctive elements within composite marks.¹ In *Medion*, the marks at issue were ‘THOMSON LIFE’ and ‘LIFE’. It was found in that decision, that the word ‘LIFE’ in the ‘THOMSON LIFE’ mark had a distinctive significance that was independent of the significance of the whole.

67. It can be argued that the word ‘GO’ also has an independent distinctive significance within the context of the contested mark ‘SHELL GO+’ however, due to the relatively weaker nature of that word, it performs only a secondary role to that of the more distinctive element ‘SHELL’. This is because it is at least allusive of certain qualities that one might wish to find in the goods and services at issue, such as speed or convenience (with additional advantages denoted by the plus symbol). On balance, I consider that GO+ is an element which is independently distinctive, but whether this is enough to demonstrate a likelihood of confusion is another matter. This, I will go on to assess.

¹ Case C-120/04 *Medion* [2005] ECR I-8551

68. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, whilst indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and goods/services down to the responsible undertakings being the same or related.

69. I have already found that:

- the goods and services are identical; similar to a medium degree or dissimilar;
- the marks are visually, aurally and conceptually similar to a low degree;
- the average consumer will be a member of the general public or a professional;
- the general public consumer can be expected to be paying an average level of attention when selecting the goods and services at issue; the professional consumer may pay a higher than average level of attention;
- during the selection process, the visual and aural considerations will both be important however the visual element will likely play the greater role;
- the earlier marks have only a lower than average degree of distinctiveness;

70. In respect of the professional consumer and the higher than average level of attention being paid, it is noted that the goods and services of a specialised nature and of interest to a professional consumer are more likely to be those business services which have been found to be dissimilar in my earlier assessment.

71. Having weighed up all of the factors, I conclude that there is no likelihood of direct confusion between the marks. The distinctive word 'SHELL' which forms the beginning of the contested mark will not go unnoticed and the average consumer will not mistake one mark for the other.

72. I must therefore go on to consider the potential for indirect confusion between the marks.

73. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr 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.

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).”

74. These examples are not exhaustive but provide helpful focus.

75. I do not find that any of the categories put forward by Mr Purvis apply in this case. I do not accept that the common element ‘GO’ is strikingly distinctive, so much so that

the average consumer would assume that no one but the brand owner would be using it in a trade mark. In fact, I have concluded earlier in this decision that the word 'GO' is distinctive but only to a lower than average degree. The applicant's 'SHELL GO+' mark cannot be said to be one which would be an obvious sub-brand or brand extension of the mark 'GO' and neither can it be said that the addition of the distinctive word 'SHELL' could be argued to be entirely consistent or logical in the context of a brand extension.

76. The same can be said if the situation is reversed, that is, when considering whether 'GO' would be viewed as a sub-brand of the contested trade mark. As has been found previously in my decision, the word 'GO' is a very common everyday word in the English language, which has not only a clear meaning, but has at least an allusiveness towards speed and convenience. It is also visually an extremely short element. In weighing up, I conclude that the average consumer would not consider the term 'GO' solus to be a sub-brand of the contested 'SHELL GO+' mark; or a logical extension or evolution of that existing brand, as it would make little business sense to remove the more distinctive element 'SHELL' from any branding of the applicant's goods or services.

Conclusion

77. The opposition has failed. The application may proceed to registration.

Costs

78. The applicant has been successful and is entitled to a contribution towards its costs, which are sought on the usual scale (contained in Tribunal Practice Notice 2/2016). I award the applicant the sum of £1200 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing the statement of case and considering the counterstatement	£200
Preparing evidence	£500

Preparing for and attending a hearing	£500
Total	£1200

79. I therefore order EG Retail B.V. to pay Shell Brands International AG the sum of £1200. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 01st day of October 2019

**Andrew Feldon
For the Registrar
The Comptroller-General**