

O/0509/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003828252 BY KMB GROUP LTD

TO REGISTER THE FOLLOWING TRADE MARK:



IN CLASS 25

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 438140 BY PETROL INDUSTRIES B.V.**

Background and Pleadings

1. On 9 September 2022, KMB Group Ltd ('the Applicant') applied to register the trade mark shown on the cover of this Decision, number UK00003828252. The application was published for opposition purposes in the Trade Marks Journal on 23 September 2022. Registration is sought for the following goods:

Class 25:

Clothing; Clothes; Knitted clothing; Gloves [clothing]; Waterproof clothing; Jackets [clothing]; Thermal clothing; Work clothes; Weatherproof clothing.=

2. On 19 December 2022, Petrol industries B.V. ('the Opponent') filed an opposition against the application based on section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). The opposition is directed against the Applicant's specification in its entirety.
3. The Opponent relies upon the following earlier trade mark registration:

UK00918263185¹

PETROL

Filing date: 26 June 2020

Date of entry in register: 18 November 2020

Only the following goods are relied upon: ²

¹ The earlier mark is a comparable marks pursuant to Article 54 of the 'Agreement on the withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community (2019/C 384 1/01)', also known as the 'Withdrawal Agreement', based on EUTM 018263185 which was registered prior to the withdrawal of the UK from the European Union.

² The earlier mark stands registered in respect of a number of goods and services in classes 3, 9, 14, 18, 25 and 35. The full specification is set out at Annex 1 to this decision.

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.

4. The Opponent claims that the applied-for mark is similar to that of the Opponent and the goods for which registration is sought are identical or highly similar to the class 25 goods in respect of which the earlier mark is registered. The Opponent claims that there is therefore a likelihood of confusion.
5. The Applicant filed a Defence and Counterstatement in which it denies that the marks are similar and, therefore, denies that there is a likelihood of confusion.
6. The Opponent is represented by Maguire Boss. The Applicant represents itself. A hearing was neither requested nor considered necessary. Only the Opponent has filed evidence and written submissions during the evidence round, to which I will refer where appropriate. Neither party has filed written submissions in lieu of a hearing. The following decision has been made after careful consideration of the papers before me.

PRELIMINARY MATTERS

Fair and Notional use

7. The Applicant has sought to draw a distinction between the Opponent's goods as 'consumer/Fashion clothing' and the Applicant's goods as 'Oil company specific workwear'.³ While this is noted, this is not relevant to the assessment of the likelihood of confusion between the parties' marks, for the following reasons.
8. I am required to make the assessment of the likelihood of confusion notionally and objectively based on the opponent's goods, as registered, and the applicant's goods, as applied for, in accordance with the relevant case law. That assessment requires that I must not take into account the actual way that either party has used their marks in the marketplace or the kinds of goods and services that those marks

³ Applicant's counterstatement at [8], second unnumbered paragraph.

have been used in relation to thus far. Further, I must consider all of the circumstances in which the mark applied for might be used if it were registered⁴. In this connection, in *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the Court of Justice of the European Union (“CJEU”) stated:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

State of the Register

9. The Applicant has pointed to the existence of other trademarks on the Register containing ‘Petroline’. In this connection, I bear in mind the decision of *46 Maras*⁵ in which Mr Thomas Mitcheson Q. C., sitting as the Appointed Person, held that:

‘...It is well established that mere evidence of the state of the register is of little assistance in determination of disputes of this nature. Without evidence of use and reputation, the existence of other registrations can have no bearing on the question of the likelihood of confusion.’

RELEVANCE OF EU LAW

10. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

⁴ As per *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C- 533/06, [66]

⁵ O/112/21 at para [20].

DECISION

Section 5(2)(b) of the Act and related case law

11. Section 5(2)(b) of the Act states:

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

(a) ...

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

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

12. In accordance with section 6 of the Act, the Opponent’s mark is an earlier mark by virtue of its filing date (26 June 2020) which fell before the filing date of the Applicant’s mark (9 September 2022).

13. Section 6A of the Act provides that where the date on which the registration procedure of the earlier mark was completed more than 5 years prior to the application date (or priority date) of the applied-for mark, the Opponent may be required to prove use of the earlier mark. In the instant case, section 6A is not engaged because the Opponent’s marks had been registered for less than 5 years on the filing date of the applied-for mark.

14. The following principles are derived 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 C120/04; *Shake 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

15. In making an assessment between the competing goods, I bear in mind the case of *Gérard Meric v Office for Harmonisation in the Internal Market*⁶ wherein the General Court held to the effect that goods (and services) can be considered as identical when the goods and services designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa.

16. The goods to be compared are set out above at [1] and [3].

Contested goods: *Clothing; Clothes*

17. These terms are self-evidently identical to the Opponent's *Clothing*.

Contested goods: *Knitted clothing; Gloves [clothing]; Waterproof clothing; Jackets [clothing]; Thermal clothing; Work clothes; Weatherproof clothing*.

18. All of these goods will be encompassed by the Opponent's broad term *clothing*. I therefore find the parties' goods to be identical according to the principle in *Meric*.

⁶ Case T-133/05

Average consumer and the purchasing act

19. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect. The word “average” denotes that the person is typical. 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*.
20. The average consumer of the relevant goods will be predominantly the general public, with some purchases also made by the professional public. The purchasing act will be primarily visual; the purchaser may be exposed to the seller's mark online, in printed matter, television adverts or having seen signage on the retail premises in the street. In physical stores, the goods will most often be self-selected by the purchaser and examined and tried on before purchase. Where online stores are concerned, the prospective purchaser will likely read the product description before clicking on the item to purchase it. There may be an aural component to the purchasing process where questions are asked of retail staff. Some purchasers may also seek out the goods after ‘word-of-mouth’ recommendations. The price-point of the goods will vary, depending on the particular goods. For example: a T-shirt from a supermarket might cost just a few pounds; a pair of jeans from a boutique might cost around £100; an haute couture gown from a designer fashion house might cost several thousands of pounds. Clothing items are typically fairly frequent purchases. Factors influencing the purchasing decision might include, *inter alia*: the material; the fit; the size. I consider that the average consumer would pay at least a medium level of attention during the purchasing act.

Comparison of the marks

21. 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.”

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

23. The marks to be compared are:

Earlier mark: <p style="text-align: center;">PETROL</p>	Applied-for mark: 
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Overall impression of the marks

24. The earlier mark is a word mark⁷ consisting of the single element ‘PETROL’ in a plain typeface. The overall impression can only reside in the sole element of which the mark is composed.

⁷ In *LA Superquímica v EUIPO*, Case T-24/17, at paragraph [39] it was held that:

‘ [...] it should be noted that a word mark is a mark consisting entirely of letters, words or groups of words, without any specific figurative element. The protection which results from registration of a word

25. The Applicant's mark is a figurative mark comprising word and device elements. A single word element 'PETROLINE' appears in a plain typeface in emboldened font, with the 'LINE' portion of the word presented in red, in contrast to the preceding black 'PETRO' portion. Above the word element is a device positioned centrally. It might be described as a large, heavily emboldened, upper case 'P' overlaid with a teardrop shape which might be seen as depicting a droplet of liquid. My view is that the word element will likely play the greater visual role within the mark as a whole by virtue of the fact that words generally 'speak louder' than devices. The device will also play a role within the overall impression, albeit it will likely have a lesser visual impact because the 'P' will be seen merely as the initial for the word 'Petroline' and the 'droplet' might simply reinforce the notion of petrol as a liquid.

Visual comparison

26. Both marks include the element 'PETROL', which appears at the beginning of each mark. The points of visual difference between the marks are as follows:

- The presence of the large 'P' and 'droplet' device in the Applicant's mark, which are absent from the earlier mark;
- The contrasting black and red portions 'PETRO' and 'LINE', respectively, within the Applicant's mark;
- The word elements of the respective marks are different lengths: 5 characters versus 9 characters.

27. In the light of the foregoing, I find the marks to have a medium level of visual similarity.

Aural comparison

mark thus relates to the word mentioned in the application for registration and not the specific figurative or stylistic aspects which that mark might have. As a result, the font in which the word sign might be presented must not be taken into account. It follows that a word mark may be used in any form, in any colour or font type (see judgment of 28 June 2017, *Josel v EUIPO — Nationale-Nederlanden Nederland (NN)*, T-333/15, not published, EU:T:2017:444, paragraphs 37 and 38 and the case-law cited).'

28. I consider that the earlier mark will be articulated in the usual way, i.e. 'PETCH-RULL'. The Applicant's mark, to my mind, will likely be articulated either as 'PET-RO-LINE' or 'PETCH-RULL-INE'.

29. For the average consumer who articulates the Applicant's mark as 'PETCH-RULL-INE', I find that the marks will have a medium level of aural similarity. For those who articulate the Applicant's mark as 'PET-RO-LINE', I consider the level of aural similarity to also be medium.

Conceptual comparison

30. The Opponent has argued that 'the word element PETROLINE is a portmanteau of the words 'PETROL' and 'LINE' and/or a conjoining of the prefix 'PETRO' with the word 'LINE'.⁸ Evidence has been filed by the Opponent by way of dictionary definitions. However, I consider the words 'Petrol' and 'line' to be so commonplace that it is unnecessary to consult dictionary definitions in this case. The average consumer will be very familiar with both words. 'Petrol' will be perceived as the shortened word for 'petroleum', the fuel used to power many vehicles and certain other machines such as chainsaws and lawnmowers, for example. The word 'line' will be understood as referring to, *inter alia*: a mark, scratch etc, or a 'line' or range of products. I also consider that the 'line' element, as coalesced with 'petro' might invoke the meaning 'petrol-like' 'petrol-derived' or 'belonging to' petrol.

31. I find that the earlier mark will be perceived by the average consumer as a reference to the fuel by that name. I consider that the Applicant's mark will be understood by a significant number of average consumers as meaning 'relating to' or 'derived from' petrol. All things considered, I find the marks to have a high level of conceptual similarity.

Distinctive character of the earlier mark

⁸ Opponent's statement of grounds, [16].

32. 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).”

33. Registered trade marks possess varying degrees of inherent distinctive character. Where a mark is suggestive or allusive of a characteristic of the goods or services, it tends to be low. Inherent distinctive character may range up to a high level for marks which consist of invented words with no allusive qualities.

34. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services specified in the registration and, secondly, by reference to the way that it is perceived by the relevant public.⁹

⁹ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

35. The Opponent has argued that the earlier mark will have a 'normal to high' level of inherent distinctiveness because the word 'petrol' has no meaning for the relevant goods.¹⁰

36. The word 'petrol' is a well-known word in the English language which will be understood as a reference to the fuel used to power vehicles, and a number of other machines. The mark neither describes nor alludes to the relevant goods, i.e. clothing. I find that the mark enjoys a medium level of inherent distinctive character.

37. Given that evidence of the use of the earlier mark is not pertinent to the instant proceedings, no evidence of its use has been filed. I am unable to make a finding in respect of enhanced distinctiveness.

Likelihood of confusion

38. Confusion can be direct or indirect. Mr Iain Purvis Q. C., (as he then was) as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v By Back Beat Inc*¹¹. Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*¹², the CJEU recognised that the average consumer rarely encounters the two marks side by side but must rely on the imperfect picture of them that they have kept in mind. Direct confusion can therefore occur by imperfect recollection when the average consumer sees the later mark but mistakenly matches it to the imperfect image of the earlier mark in their 'mind's eye'. Indirect confusion occurs when the average consumer recognises that the competing marks are not the same in some respect, but the similarities between them, combined with the goods/services at issue, leads them to conclude that the goods/services are the responsibility of the same or economically linked undertakings.

39. I must keep in mind that a global assessment is required taking into account all of the relevant factors, including the principles a) – k) set out above at [14]. When considering all relevant factors 'in the round', I must bear in mind that a greater

¹⁰ Opponent's statement of grounds, [19].

¹¹ Case BL O/375/10 at [16].

¹² *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].

degree of similarity between goods *may* be offset by a lesser degree of similarity between the marks, and vice versa.

40. My view is that, despite the identity between the parties' goods, the net effect of the differences that I have identified between the marks is sufficient to prevent the average consumer from confusing one mark for another. Both marks are relatively short, and I consider that the differences in the lengths of the words will therefore be particularly apparent, both visually and aurally. I have found only medium levels of visual and aural similarity between the marks. I am of the view that the coalescence of 'PETRO' and 'LINE' in the Applicant's mark accords unity to the word element 'PETROLINE' as a whole which will likely diminish the possibility of the characters 'INE' being overlooked. My view is that the visual and aural differences, in this case, are sufficient to overcome the fairly close conceptual nexus between the marks. I have found the earlier mark to have a medium level of inherent distinctiveness. I consider that the Applicant's mark will also have a medium level of inherent distinctiveness. However, to my mind, the 'PETROL' portion of the Applicant's mark, by virtue of its coalescence with 'INE', accords a unity to the word element 'PETROLINE' which lessens the visual impact of 'PETROL' as a separable component. Clothing goods are predominantly self-selected by the consumer. In that connection, I bear in mind the heightened importance of the visual perception of a mark where the goods are purchased in this manner. In the case of *Quelle AG v OHIM*¹³, the General Court held that:

"68..... If the goods covered by the marks in question are usually sold in self-service stores where consumers choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any phonetic similarity between the signs."

¹³ Case T-88/05.

41. All things considered, I am not persuaded that a significant proportion of average consumers would confuse one party's mark for that of the other. I find that there is no likelihood of direct confusion. I find this to be the case even though a medium level of attention will be paid during the purchasing act.

42. I now consider whether there is a likelihood of indirect confusion. I note that in the recent case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

43. In *L.A. Sugar Limited v By Back Beat Inc*¹⁴ Mr Iain Purvis Q. C., (as he then was) as the Appointed Person, explained that [my words in parentheses]:

"17. Instances where one may expect the average consumer to reach such a conclusion [i.e. to conclude that marks relate to the same or economically linked undertakings] 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.).

¹⁴ Case BL O/375/10

(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)".

44. I acknowledge that the above categories are not intended to be exhaustive. I do not consider that the instant case falls into any of the categories identified by Mr Purvis. Nor can I conceive of any other 'mechanism' by which the average consumer would presume the marks to derive from the same or economically-related undertakings. It is my view that the construction of the parties' marks is such that they would unlikely be seen as logical brand extensions of one another. It is, in my view, difficult to conceive of 'PETROL' and 'PETROLINE' as having commercial efficacy as related brands. I find that there is no proper basis on which to make a finding of a likelihood of indirect confusion.

Outcome

45. The opposition has failed in its entirety. Subject to any successful appeal, the Application may proceed to registration in full.

Costs

46. The Applicant has succeeded. I note that the Applicant has not completed a costs proforma. I therefore make no order as to costs.

Dated this 4th day of June 2024

N. R. Morris

For the Registrar,

the Comptroller-General

Annex 1

The full specification in respect of which the earlier mark UK00918263185 is registered is as follows:

Class 3:

Perfumery, aftershaves, essential oils, cosmetics, hair lotions; Preparations for skin care and hair care; Make-up; nail polish and nail care products.

Class 9:

Glasses and sun glasses; Covers for smartphones, mobile telephones, tablets and laptop computers; Applications (software) for smartphones.

Class 14:

Jewellery, precious stones; Chains, rings and bracelets; Horological and chronometric instruments; Watches.

Class 18:

Bags; Purses; Trunks and suitcases; Umbrellas.

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.