

O-0867-25

**TRADE MARKS ACT 1994  
IN THE MATTER OF  
TRADE MARK APPLICATION NO.3966526  
BY  
LOOP CERTIFICATIONS LTD  
TO REGISTER**



**AS A CERTIFICATION MARK  
IN CLASSES  
6, 7, 9, 11, 12, 14, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 35 & 42**

**AND OPPOSITION THERETO (UNDER NO. 446996)  
BY  
LEDVANCE GMBH**

## Background and pleadings

1. Loop Certifications Ltd (“the applicant”) applied for the certification mark set out on the title page on 11 October 2023. It was published for opposition purposes on 19 January 2024 for goods and services in classes 6, 7, 9, 11, 12, 14, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 35 & 42. Only classes 9 and 11 are being opposed, namely

*Class 9: Hardware (Computer -); Computers and computer hardware; Mobile phones; Mobile phone chargers; Mobile phone speakers; Mobile phone straps; Mobile phone cases; Mobile phone covers; Mobile telephones; Mobile phone battery chargers; Devices for hands-free use of mobile phones; Spectacle lenses; Spectacle glasses; Spectacle frames; Spectacles.*

*Class 11: Kettles; Vehicle lights; Lights for festive decoration; Electric lights for festive decorations; Decorative lights; Christmas lights [other than candles].*

2. LEDVANCE GmbH (“the opponent”) opposed class 9 and 11 of the application on 19 April 2024 under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent initially relied on five International Registrations (“IRs”) in classes 9 and 11. However in its final written submissions, the opponent indicated that it only wished to rely on three of its IRs.<sup>1</sup> The details of the three IRs are set out below.

Earlier Registrations	Goods relied on
IR No. WO1626952 (“the ‘952 IR”)  <b>LEDLOOP</b>  Designation Date: 30 August 2021 Date of Protection in UK: 25 February 2022	<i>9: Photographic, optical, measuring and control apparatus and instruments; signalling apparatus and instruments; electrical and electronic control apparatus and instruments; electrical and electronical regulating apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating</i>


<sup>1</sup> Opponent’s written submission dated 10 February 2025, paragraph 11.

Priority Date: 20 August 2021 (EUIPO)

*or controlling electricity; apparatus for recording, transmission or reproduction of data, sound or images; multimedia projectors; picture projectors; magnetic data carriers; LEDs (light emitting diodes) and laser diodes; organic LEDs (light-emitting diodes) and organic laser diodes; LED lamp modules, also for signalling purposes; displays using LED-technology; data processing devices and computers; electric and electronic devices and apparatus for the operation, regulation and control of lighting facilities; electric and electronic devices and apparatus for the operation, regulation and control of luminaires and lamps; electric and electronic devices and apparatus for the operation and regulation of central building control systems; electric and electronic devices and apparatus for the operation, regulation and control of building installations, interface modules for the afore-mentioned apparatus and devices; light conductors; fiber optic couplers; sensors; light barriers; electric starters; LED drivers; transformers; electronic ballasts; miniature transformers; choking coils; electrical terminal connectors; contact elements including plugs, terminals, sleeves, commutators, electric breakers [switches]; computer programs and software of all kind (included in this*

*class); software applications [apps] for electrical and electronic devices; software applications for the operation, regulation and control of lighting facilities, software applications for the operation, regulation and control of luminaires and lamps; software applications for the operation and regulation of central building control systems; software applications for the operation, regulation and control of building installations; parts of all the aforesaid goods included in this class; all the aforementioned goods not in relation to telecommunication.*

*11. Apparatus for lighting; lighting apparatus, especially lamps and luminaires, including lighting apparatus made using sustainable materials; lighting apparatus and lighting systems composed thereof, especially on basis of light emitting diodes (LEDs), also organic LEDs; LED-lamps and LED-luminaires (included in this class); LED based lighting lamps as well as lighting apparatus and systems composed thereof; lighting modules, namely modules based on LED (also based on organic LED) with light functions and for lighting applications; parts of all the aforesaid goods included in this class.*

<p>IR No. WO1626956 ("the '956 IR")</p> <p><b>LIGHTLOOP</b></p> <p>Designation Date: 30 August 2021 Date of Protection in UK: 25 February 2022 Priority Date: 20 August 2021 (EUIPO)</p>	<p>As above</p>
<p>IR No. WO1767909 ("the '909 IR")</p>  <p>Designation Date: 17 October 2023 Date of Protection in UK: 13 March 2024 Priority Date: 12 July 2023 (EUIPO)</p>	<p>As above</p>

3. The opponent claims that the respective goods are either identical or highly similar and that the respective marks are similar. As such there exists a likelihood of confusion, including a likelihood of association, under section 5(2)(b) of the Act.

4. The IRs relied upon by the opponent are earlier marks, in accordance with section 6 of the Act. None of the earlier IRs completed their designation procedure more than five years prior to the application date of the contested mark. Therefore they are not subject to the proof of use conditions, as per section 6A of the Act.

5. The applicant filed a counterstatement in which it denied the respective marks were similar. With reference to the goods, it stated that the respective goods in class 9 were not similar but in class 11, it stated that "few goods from class 11 can be considered

identical or similar”.<sup>2</sup> However it did not state which goods in this class could be considered as identical or similar. I will return to this point later in the decision.

6. Both sides have been represented in these proceedings. The applicant has been represented by Basck Limited and the opponent by Wynne-Jones IP Limited. Only the applicant filed evidence in these proceedings and the opponent filed submissions in lieu of a hearing.

7. I make this decision based on a reading of all the material before me.

8. 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 that predate the UK’s withdrawal from the EU.

### **Applicant’s evidence**

9. The applicant filed a witness statement in the name of Tim Lai, its Director. Mr Lai attaches 9 exhibits. Mr Lai states that the applicant has been using the contested mark since early 2024 and its business model is,

“... an impartial authority, establishing and verifying the criteria against which a product’s environmental claims are evaluated. It is a certification company, an independent third party that provides proof regarding supply chain recycled content claims, whose primary area of focus is maintaining the integrity of environmental claims, specifically – signalling to the consumers that the good or service that bears its certification mark adheres to genuine environmentally friendly practices and preventing greenwashing”.<sup>3</sup>

10. Mr Lai also says that the applicant does not retail goods. He states:

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<sup>2</sup> Applicant’s Counterstatement, paragraph 9.

<sup>3</sup> Tim Lai’s witness statement, paragraph 5.

“Furthermore, Loop’s mark is to be a certification mark. This has been clearly stated by the Applicant while filing the mark. It means that the use of the mark by Loop is significantly narrowed and serves a specific purpose – providing a guarantee that the goods or services bearing the mark meet a certain defined standard or possess a particular characteristic (in the Applicant’s case – that the environmental claims are justified)”.<sup>4</sup>

11. Finally Mr Lai states that he is not aware of any customer confusion or association between the applicant and opponent. Nor has he received customer complaints about confusion.

12. That concludes my summary of the evidence but before I move on, there are several issues emanating from the applicant’s evidence that need some further analysis.

13. Firstly the applicant states that its application is a certification mark. The essential function of a certification mark is to indicate goods which are certified by the proprietor of that mark, the applicant in this case, in order that the consumer may distinguish such certified goods from those which are not so certified. Whilst the applicant cannot trade in the goods it certifies, as confirmed by Mr Lai, the relevant goods classes for which certification can be obtained are attached to the application. Therefore one of the applicant’s customers, having received certification for say lighting goods, can affix the certification mark to its goods or packaging. It would appear then that the likelihood of confusion in respect of a certification mark should be understood as the risk that the public might believe that goods certified by the applicant could be provided by an economically connected entity such as the proprietor of the IRs as per the regular assessment conducted under section 5(2)(b).

14. Secondly and related to the above point, the applicant states that it does not operate in the same areas as the opponent. Even if I accept that the applicant and the opponent currently operate in different areas, this would not be relevant to the

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<sup>4</sup> Ibid, paragraph 21.

issue of confusion which I must decide in these proceedings. It is settled law that in assessing whether there is a likelihood of confusion, I must make my comparison of “notional and fair use”<sup>5</sup> based on the class 9 and 11 goods covered by the application and since the earlier marks are not subject to proof of use, the opponent’s classes 9 and 11. It is the *inherent* nature of the specifications which I have to consider. Current use and business activities are not relevant to this notional comparison. My task, therefore, is to conduct the comparison simply on the basis of the goods as they are set out in the respective specifications. The concept of notional and fair use is outlined in paragraph 78 of *Roger Maier* decision, viz:

“78. ....the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion.”

15. Thirdly Mr Lai states that he is not aware of any confusion in the market place. However again in the *Roger Maier* decision at [80], it is stated that the lack of confusion in the market place is not a determinative factor in my assessment. Moreover in *The European Limited v The Economist Newspaper Ltd*,<sup>6</sup> Millett L.J. stated that:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

16. Therefore I cannot take the lack of confusion point made by Mr Lai into account.

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<sup>5</sup> *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220.

<sup>6</sup> [1998] FSR 283

## DECISION

### Section 5(2)(b)

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

“5 (2) 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”.

18. Section 5A is also relevant and reads:

“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”.

19. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, EU:C:1997:528, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, EU:C:1998:442, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, EU:C:1999:323, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, EU:C:2000:339, *Matratzen Concord GmbH v OHIM*, Case C-3/03, EU:C:2004:233, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, EU:C:2005:594, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P, EU:C:2007:333, and *Bimbo SA v OHIM*, Case C-591/12P, EU:C:2016:591:

(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 will wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

### **Comparison of goods**

20. In *Canon*<sup>7</sup>, the CJEU stated at paragraph 23 of its judgment:

“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.”

21. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case)<sup>8</sup>, where he identified the factors for assessing similarity as:

- (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.

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<sup>7</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, C-39/97

<sup>8</sup> [1996] R.P.C. 281

22. In addition I find the following case law to be helpful when in *Gérard Meric v Office for Harmonisation in the Internal Market*,<sup>9</sup> the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur 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.”

23. The goods to be compared are set out below

<b>Opponent’s goods</b>	<b>Applicant’s goods</b>
<p><i>9: Photographic, optical, measuring and control apparatus and instruments; signalling apparatus and instruments; electrical and electronic control apparatus and instruments; electrical and electronical regulating apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of data, sound or images; multimedia projectors; picture projectors; magnetic data carriers; LEDs (light emitting diodes) and laser diodes; organic LEDs (light-emitting diodes) and organic laser diodes; LED lamp modules, also for signalling purposes; displays using LED-technology; data processing devices and</i></p>	<p><i>9: Hardware (Computer -); Computers and computer hardware; Mobile phones; Mobile phone chargers; Mobile phone speakers; Mobile phone straps; Mobile phone cases; Mobile phone covers; Mobile telephones; Mobile phone battery chargers; Devices for hands-free use of mobile phones; Spectacle lenses; Spectacle glasses; Spectacle frames; Spectacles.</i></p>

<sup>9</sup> Case T- 133/05

*computers; electric and electronic devices and apparatus for the operation, regulation and control of lighting facilities; electric and electronic devices and apparatus for the operation, regulation and control of luminaires and lamps; electric and electronic devices and apparatus for the operation and regulation of central building control systems; electric and electronic devices and apparatus for the operation, regulation and control of building installations, interface modules for the afore-mentioned apparatus and devices; light conductors; fiber optic couplers; sensors; light barriers; electric starters; LED drivers; transformers; electronic ballasts; miniature transformers; choking coils; electrical terminal connectors; contact elements including plugs, terminals, sleeves, commutators, electric breakers [switches]; computer programs and software of all kind (included in this class); software applications [apps] for electrical and electronic devices; software applications for the operation, regulation and control of lighting facilities, software applications for the operation, regulation and control of luminaires and lamps; software applications for the operation and regulation of central building control systems; software applications for the*

<p><i>operation, regulation and control of building installations; parts of all the aforesaid goods included in this class; all the aforementioned goods not in relation to telecommunication.</i></p>	
<p><i>11: Apparatus for lighting; lighting apparatus, especially lamps and luminaires, including lighting apparatus made using sustainable materials; lighting apparatus and lighting systems composed thereof, especially on basis of light emitting diodes (LEDs), also organic LEDs; LED-lamps and LED-luminaires (included in this class); LED based lighting lamps as well as lighting apparatus and systems composed thereof; lighting modules, namely modules based on LED (also based on organic LED) with light functions and for lighting applications; parts of all the aforesaid goods included in this class</i></p>	<p><i>11: Kettles; Vehicle lights; Lights for festive decoration; Electric lights for festive decorations; Decorative lights; Christmas lights [other than candles].</i></p>

24. For the purpose of a comparison, it is appropriate to group related goods together, where they are sufficiently comparable to do so.<sup>10</sup>

### Class 9

25. I find the applicant's terms namely *Hardware (Computer -); Computers and computer hardware* would be covered by the opponent's broad terms, namely *apparatus for recording, transmission or reproduction of data, sound or images; data processing devices and computers* and are therefore considered identical under the *Meric* principle.

<sup>10</sup> *Separode Trade Mark* decision, BL O-399-10.

26. With regard to the applicant's terms *Mobile phones; Mobile phone speakers; Mobile telephones; Devices for hands-free use of mobile phones*, I note the opponent's written submissions<sup>11</sup> that these goods should also be covered by its own broad terms I identified in the paragraph above. However I note that the opponent's class 9 specification contains the following limitation *all the aforementioned goods not in relation to telecommunication*. I take this limitation to mean that the opponent's terms do not cover any type of telecommunication apparatus and instruments. To my mind mobile telephones are the very embodiment of a piece of telecommunication apparatus. Therefore I find the opponent's terms do not cover telecommunication apparatus so its goods cannot be considered similar to the applicant's mobile telephones. In addition I find the applicant's terms namely *Mobile phone chargers; Mobile phone battery chargers* to be complementary to mobile phones and in my view can be considered as pieces of telecommunication apparatus and therefore not similar to the opponent's terms.

27. I do not find the applicant's remaining mobile phone related terms, namely *Mobile phone straps; Mobile phone cases; Mobile phone covers*; to have any similarity with any of the opponent's terms in class 9. To my mind, cases and covers are generally made of fabric or plastic and they protect the device within. Straps are generally for tethering the device to the person or to an object like a bag. None of these goods are electronic in nature and do not share the same purpose or trade channels as the opponent's goods. As such I find them to be dissimilar.

28. The applicant has the following goods remaining in its class 9 specification namely *Spectacle lenses; Spectacle glasses; Spectacle frames; Spectacles*. The opponent submits that these goods are similar to its terms *optical, measuring and control apparatus and instruments*.<sup>12</sup> At its most basic level, I find spectacles, frames, lenses and glasses may be seen as optical apparatus as there is some overlap of nature, purpose, user and trade channels, therefore I find there is a low level of similarity.

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<sup>11</sup> Opponent's written submissions, paragraph 20.

<sup>12</sup> Opponent's written submissions, paragraph 23.

29. Where there is dissimilarity between the terms in the respective specifications, it follows that there is no likelihood of confusion to be considered for these goods.<sup>13</sup>

### Class 11

30. The applicant's terms *Vehicle lights; Lights for festive decoration; Electric lights for festive decorations; Decorative lights; Christmas lights [other than candles]* would be covered by the opponent's broad term *Apparatus for lighting*. Those goods are therefore considered identical under the *Meric* principle.

31. I do not find the applicant's remaining term, namely *Kettles* to be similar to the opponent's goods in class 11 as it does not share a nature or purpose with them. The applicant's goods are for boiling water whereas the opponent's goods in this class are for illumination. The opponent submits however that the applicant's kettles may be similar to its class 9 terms *electrical and electronic control apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity*.<sup>14</sup> I disagree with this submission. This would be akin to saying all electrical goods are similar to all other electrical goods despite their nature and purpose which, in my view, is too broad a comparison and would make it unfeasible to conduct a common sense approach to the goods comparison itself. As such I find the goods to be dissimilar. It follows that there is no likelihood of confusion to be considered for these goods.

### **Average consumer and the purchasing process**

32. I next consider who the average consumer is for the goods at issue and how they are purchased. It is settled case law that the average consumer is deemed to be reasonably well informed and reasonably observant and circumspect.<sup>15</sup> 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.<sup>16</sup>

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<sup>13</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA.

<sup>14</sup> Opponent's written submissions, paragraph 24.

<sup>15</sup> *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)

<sup>16</sup> *Lloyd Schuhfabrik Meyer*, Case C-342/97.

33. The average consumer for the contested goods will be the general public and some businesses. There are a variety of contested goods so the price range will vary from the inexpensive to the very expensive. The goods are likely to be less frequent purchases, but a consumer would have in mind the kind and suitability for purpose of the goods to be purchased. In my view, the average consumer is likely to pay a medium degree of attention during the purchasing process.

34. The goods are likely to be selected from websites, or advertising material (both printed and online equivalents). Consequently, there will mainly be a visual consideration in the purchasing process. However, I do not discount an aural component, such as receiving technical advice, to the purchase.

### **Mark comparisons**

35. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*<sup>17</sup>, 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.”

36. 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.

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<sup>17</sup> Case C-591/12P

37. The respective marks to be compared are:

Opponent's IRs	Applicant's certification mark
<p>LEDLOOP LIGHTLOOP</p> 	

38. The opponent's '952 and '956 IRs are both word-only marks consisting of the conjoining of two elements, namely LED and LIGHT, with the word LOOP in plain block capitals. There is no other aspect to the marks. However both LED and LIGHT are descriptive words in relation to lighting goods. As such the overall impression will be dominated more by the LOOP element.

39. The opponent's '909 IR is a composite word and device arrangement with a two arrow device, one pointing left and the other right, positioned above the words EVER LOOP. There is a device of a leaf on the double letters OO in the word LOOP. The whole is contained within an orange circle and the lower portion of the circle is coloured grey. Where a mark contains words and devices, it is a rule of thumb that the words will likely dominate the device. I consider that to be the case here. The words EVER LOOP contribute most to the overall impression and the device elements play a secondary role.

40. The applicant's mark is also a composite word and device arrangement comprising three arrows in a circular formation resembling a recycling symbol, which in turn contain the word LOOP positioned above a QR code which itself is positioned above a percentage sign. The word LOOP contributes most to the overall impression, but the other device elements play a contributing role.

41. In a visual comparison, all the respective marks contain the word LOOP. It is the only word element in the applicant's mark and the second word element in all the opponent's IRs. In addition the respective marks contain devices of arrows, albeit the '909 IR contains two arrows pointing in different directions and the applicant's mark contains a circular shape comprising three arrows. The points of difference are the IR's additional words which have no counterpart in the applicant's mark and the remaining devices namely the leaf, QR code and percentage sign.

42. Taking the opponent's word-only IRs first, I find there is a lower than medium degree of visual similarity between them and the applicant's mark. With regard to the opponent's figurative IR, I find there is an even lower degree of visual similarity. Put simply the opponent's IRs looks very different to the applicant's mark.

43. In an aural comparison, the device elements will play not a part, so I must just assess the verbal elements. As such I find that a consumer will give the shared word LOOP, its usual pronunciation. The consumer will also give the words LIGHT and EVER their usual pronunciations. With regard to the opponent's '952 IR comprising LEDLOOP, it is likely that some consumers will recognise the LED element as being the acronym for Light Emitting Diode and spell it out as the letters L-E-D. Others may not know the acronym and just say it as a word namely LED-LOOP. Overall I find there is a medium degree of aural similarity.

44. In a conceptual comparison, all word elements in the respective marks are known dictionary words. The concept of the shared word LOOP will be either considered as a shape or something which is connected at the start and end to allow continuous passage. For the opponent's word-only marks, as LED and LIGHT are both descriptive words in relation to lighting goods, a consumer may bring to mind the concept that LOOP relates to an aspect of lighting or lighting control. For the word element EVER LOOP, this might bring to mind a concept of a loop which is infinite. In its written submission, the opponent states that the double letters OO in its figurative mark are stylised as the infinity symbol.<sup>18</sup> I would counter this submission by saying that, in my view, the infinity symbol had been lost by the positioning of the leaf device. In terms

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<sup>18</sup> Opponent's written submission, paragraph 17.

of what remains of the opponent's figurative element, the differently pointing arrows may not bring much of a concept to mind, other than that of arrows and leaf devices can often invoke some kind of environmental concept.

45. In addition to its word element, LOOP, the applicant's mark contains three arrows in a circular shape, which resembles a non-distinctive recycling symbol or may just reinforce the loop concept of something joined at the start and end. The QR code is now a ubiquitous symbol in modern commerce as a way of taking a consumer to a business's website. An average consumer will understand what the QR code is for and not give it much more thought as a distinctive element. Likewise with the percentage sign. In my view a consumer will recognise it as the mathematic symbol but no more than that.

46. Taking all of the above into account, I find that there is conceptual similarity to a low degree as the similarity lies only in the shared **LOOP** element.

#### **Distinctive character of the earlier registered trade mark**

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

48. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*,<sup>19</sup> 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-

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<sup>19</sup> Case C-342/97

108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR 1-2779, 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).”

49. As no evidence was filed by the opponent in these proceedings. I can only consider the inherent distinctiveness of the earlier IRs. The earlier word-only IRs, namely LEDLOOP and LIGHTLOOP consist of two recognisable dictionary acronym/words conjoined with LOOP. Given the descriptiveness of LED and LIGHT in relation to lighting goods, the overall distinctiveness of the whole marks is between a low and medium degree. This could be elevated if the marks were applied to non-lighting related products. With regard to the opponent’s figurative mark EVER LOOP and devices, I find the overall distinctiveness is at a medium degree.

### **Likelihood of confusion**

50. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. 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 factors are interdependent, and include the principle that a lesser degree of similarity between the respective trade 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 opponent's registrations, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alert to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

51. In *L.A. Sugar Limited*,<sup>20</sup> Iain Purvis K.C. sitting 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

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<sup>20</sup> *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10

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)."

52. I bear in mind that the categories listed above in *L.A. Sugar* are not an exhaustive list of all the ways in which indirect confusion can occur. They are merely examples of the way in which it could or tends to occur.

53. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*,<sup>21</sup> Arnold LJ approved Mr Purvis's formulation but added:

"13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] 'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

54. However it is also settled case law that it is not sufficient to find a likelihood of confusion if a mark merely calls to mind another mark<sup>22</sup>. This is considered mere association not indirect confusion.

55. So far in this decision I have found:

- The goods are identical and similar to varying degrees, but some are dissimilar.
- The average consumer will pay a medium level of attention during the primarily visual purchasing process, but I do not discount that some aural considerations may play a part.
- There is a low rising to a low to medium degree of visual similarity between the opponent's IRs and the applicant's mark.

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<sup>21</sup> [2021] EWCA Civ 1207

<sup>22</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

- There is a medium degree of aural similarity between the respective marks.
- There is low degree of conceptual similarity based on the shared word LOOP in the respective marks.
- The opponent's word IRs are inherently distinctive to low degree for lighting related goods, but to a slightly higher degree for non-lighting related goods. Whereas its figurative IR is inherently distinctive to a medium degree.

56. The respective marks share the same word, LOOP. However, I find this similarity is heavily outweighed by the differences, namely the additional words in the opponent's IRs and the respective devices. These additional elements will not go unnoticed, and they are sufficient, in my view, for the average consumer not to directly confuse the marks, that is to mistake one mark for another, even where the goods are identical.

57. Having found that there is no likelihood of direct confusion, I now consider whether there is any indirect confusion. I remind myself of the guidance given in *L.A.Sugar* that indirect confusion requires a consumer to undertake a thought process whereby they acknowledge the differences between the marks yet attribute the common element to a shared undertaking, taking one mark to be a possible brand extension or sub brand of the other mark.

58. The distinctive word in common to all marks is LOOP. The average consumer on seeing the applicant's mark may assume that this is a brand extension from the opponent. The applicant's mark contains the word LOOP solus and although it has different devices, namely the recycling arrows forming a loop and QR code, these are non-distinctive elements. As such I find the average consumer is likely to be confused in to believing that respective goods come from the same or economically linked undertakings. I find there is a likelihood of indirect confusion.

## **Conclusion**

59. The opposition brought under section 5(2)(b) has been partially successful. Subject to any appeal of this decision, the application will be refused for the following goods in classes 9 and 11, namely:

*Class 9: Hardware (Computer -); Computers and computer hardware; Spectacle lenses; Spectacle glasses; Spectacle frames; Spectacles.*

*Class 11: Vehicle lights; Lights for festive decoration; Electric lights for festive decorations; Decorative lights; Christmas lights [other than candles].*

60. The application may proceed to registration for the following goods in classes 9 and 11, namely:

*Class 9: Mobile phones; Mobile phone chargers; Mobile phone speakers; Mobile phone straps; Mobile phone cases; Mobile phone covers; Mobile telephones; Mobile phone battery chargers; Devices for hands-free use of mobile phones.*

*Class 11: Kettles.*

61. The application can also proceed to registration for classes 6, 7, 12, 14, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 35 and 42 which did not form part of these opposition proceedings.

### **Costs**

62. As both parties have had a measure of success in this opposition, I decline to award costs.

**Dated this 22<sup>nd</sup> day of September 2025**

**June Ralph  
For the Registrar  
The Comptroller-General**