

O/0592/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003943365

BY TANZEEL MAHROOF

TO REGISTER THE TRADE MARK:

Loyal To The Oil

IN CLASS 3

AND

IN THE MATTER OF FAST TRACK OPPOSITION THERETO

UNDER NO. 600003122 BY

AMAL MAHMOUD AND RAED KHALEEL CO.

BACKGROUND AND PLEADINGS

1. On 8 August 2023, Tanzeel Mahroof (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. The trade mark was published for opposition purposes on 1 September 2023 and registration is sought for the goods set out in paragraph 15 below.

2. On 29 November 2023, the application was opposed under the fast track opposition scheme by Amal Mahmoud and Raed Khaleel Co. (“the opponent”) based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following trade mark:

LOYAL لويال

UKTM no. 3842482

Filing date: 25 October 2022

Registration date: 13 January 2023

Relying upon all goods for which the mark is registered, namely:

Class 3 Aromatics [essential oils], bleaching preparations [laundry], cleaning preparation, drains preparations, refurbishing preparations, laundry preparations, polish for furniture and flooring, shampoos, soap, stain removers, soap.

3. The opponent claims that the marks are similar, and the goods are identical or similar, with the result that there is a likelihood of confusion.

4. The applicant filed a counterstatement denying the claims made.

5. Rule 6 of the Trade Marks (Fast Track Opposition (Amendment) Rules 2013, S.I. 2013 2235 disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but it provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

6. The effect of the above is to require parties to seek leave in order to file evidence in fast track oppositions. Further, Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it, or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

7. In this case, neither party sought leave to file evidence. A hearing was neither requested, nor was it considered necessary. Neither party filed written submissions in lieu. This decision is taken following a careful consideration of all papers on file.

REPRESENTATION

8. The applicant is represented by Briffa.

9. The opponent is represented by Beck Greener LLP.

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.

DECISION

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

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

(a)...

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

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

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

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

13. Given its earlier filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark had not completed its registration process more than 5 years prior to the filing date of the mark in issue, it is not subject to the use provisions in section 6A of the Act. Consequently, the opponent can rely upon the full breadth of its specification.

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

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

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

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

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

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

Comparison of goods

15. The competing goods are as follows:

Opponent's goods	Applicant's goods
<p><u>Class 3</u> Aromatics [essential oils], bleaching preparations [laundry], cleaning preparation, drains preparations, refurbishing preparations, laundry preparations, polish for furniture and flooring, shampoos, soap, stain removers, soap.</p>	<p><u>Class 3</u> Perfume; Perfumes; Perfume oils; Perfumery and fragrances; Amber [perfume]; Fragrances; Oils for perfumes and scents; Fragrance sachets; Musk [perfumery]; Cologne; Perfume water; Aromatics for perfumes; Room perfume sprays; Liquid perfumes; Potpourris [fragrances]; Colognes; Scents; Fragrance emitting wicks for room fragrance; Aromatics for fragrances; Perfumery; Perfumes for cardboard; Fragrance refills for non-electric room fragrance dispensers; Cedarwood perfumery; Extracts of perfumes; Extracts of flowers [perfumes]; Flowers (Extracts of -) [perfumes]; Extracts of flowers being perfumes; Body deodorants [perfumery]; Eau de cologne [cologne water]; Perfumes for ceramics; Ionone [perfumery]; Deodorants for</p>

	<p>personal use [perfumery]; Aftershave lotions; Body fragrances; Perfumeries; Fragrance preparations; Perfume oils for the manufacture of cosmetic preparations; Fragrances for automobiles; Vanilla perfumery; Household fragrances; Perfumed potpourris; Perfumed sachets; Room perfumes in spray form; Natural oils for perfumes; Fragrance sachets for eye pillows; Room fragrances; Perfumery products; Aftershave; Perfumed soaps; Feminine deodorant sprays; Cologne water; Mint for perfumery; Solid perfumes; After-shave lotions; Air fragrance preparations; Peppermint oil [perfumery]; Perfumed soap; Perfuming sachets; Aftershave balms; Scented oils; Scented linen sprays; Synthetic perfumery; Scented sachets; Aftershave balm; Air fragrance reed diffusers; Perfumed powders [for cosmetic use]; Scented body lotions; Synthetic vanillin [perfumery]; Aftershaves; Geraniol for fragancing; Perfumed powder [for cosmetic use]; Scented soaps; Incense spray; Perfumed powders; Scented body spray; Perfumed creams; Suntan lotion [cosmetics]; Essential oils as perfume for laundry purposes; Eau de Cologne; Eau de cologne; Sachets for perfuming linen; Linen (Sachets for perfuming -); Perfumed powder;</p>
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	<p>Fumigation preparations [perfumes]; Scented room sprays; After-sun oils [cosmetics]; Suntan oils [cosmetics]; Eau de colognes; Perfumed lotions [toilet preparations]; After-shave; Fragrance for household purposes; Aromatherapy lotions; After-shave balms; Scented body lotions and creams; Aftershave creams; Tanning oils [cosmetics]; Scented fabric refresher sprays; Skin fresheners [cosmetics]; Perfumery, essential oils; Eaux de cologne; Eaux de Cologne; Deodorant soap; Soap (Deodorant -); Perfumed body lotions [toilet preparations]; Fragrant sachets; Incense sachets; Aftershave milk; Geraniol fragrancing compounds; Roll-on deodorants [toilettries]; Natural perfumery; Perfumed water; Cosmetics; Scented body creams; Scented fabric refresher spray; Eau de parfum; Moisturisers [cosmetics]; Refills for electric room fragrance dispensers.</p>
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16. The applicant claims that aromatic oils and essential oils are not the same, because essential oils are naturally fragranced, whereas aromatic oils are artificially fragranced. I disagree. In my view, the term ‘aromatics’ is broad enough to cover both artificially and naturally fragranced products. Consequently, I consider the term “aromatics [essential oils]” in the opponent’s specification to be self-evidently identical to “aromatics for perfumes” in the applicant’s specification. As this represents the opponent’s best case, I will proceed on the basis of these identical goods.

The average consumer and the nature of the purchasing act

17. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

18. The average consumer for the goods will be members of the general public or manufacturers within the perfume industry. The cost of the goods is likely to vary, as will the frequency of purchase. However, factors such as scent and strength/concentration are likely to be taken into consideration. Consequently, I consider that a medium (or average) degree of attention will be paid during the purchasing process.

19. The goods are likely to be purchased by self-selection either from physical retail outlets or online equivalents. Consequently, visual considerations will dominate the purchasing process. However, I do not discount an aural component to the purchase given that advice may be sought from retail assistants.

Comparison of trade marks

20. It is clear from *Sabel* 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 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.”

21. 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.

22. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
LOYAL لويال	Loyal To The Oil

23. The opponent's mark consists of the word LOYAL in fairly standard font, followed by a word that appears to be written in an Arabic script. Both of these elements play a role in the overall impression, with the word LOYAL playing the greater role as the eye is naturally drawn to the element of the mark that can be read and it is the first (and larger) word in the mark. The applicant's mark consists of the words LOYAL TO THE OIL. The overall impression of the mark lies in the combination of these words, which come together to form a unit.

24. Visually, the marks overlap to the extent that they both contain the word LOYAL. However, in the opponent's mark this is followed by what appears to be Arabic script and in the applicant's mark the word forms part of a longer phrase (being, Loyal To The Oil). In my view, the marks are visually similar to a low degree.

25. Aurally, the only element of the opponent's mark that is likely to be pronounced is the word LOYAL due to the majority of average consumers being unable to read the Arabic element of the mark. The applicant claims that a significant proportion of average consumers will be able to understand that the Arabic script alongside the word LOYAL in the opponent's mark is the English version of the same word. I have no evidence before me on the point. Consequently, I will proceed on the basis that the script that follows it is unlikely to be articulated by the average consumer. The word LOYAL will be given its ordinary English pronunciation, which will be the same for the applicant's mark. However, the additional words TO THE OIL in the applicant's mark act as a point of aural difference. In my view, the marks are aurally similar to between a low and medium degree.

26. Conceptually, the word LOYAL in the opponent's mark will be given its ordinary dictionary meaning. The applicant's mark shares the concept of loyalty by virtue of the common word LOYAL. However, in the applicant's mark, its inclusion in the phrase LOYAL TO THE OIL makes it clear to what the loyalty relates; by contrast, it is an abstract concept in the opponent's mark. In my view, this results in no more than a medium degree of conceptual overlap between the marks.

Distinctive character of the earlier marks

27. 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-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).”

28. 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.

29. The opponent has not filed any evidence of use of the mark. Consequently, I have only the inherent position to consider. The word LOYAL is an ordinary dictionary word which has connotations of someone who remains supportive/firm in their relationship with a particular person. I do not consider it to be allusive/descriptive for the relevant goods. It is distinctive to a medium (or average degree). I do not consider that the addition of the Arabic script increases the distinctiveness of the mark overall to any material degree, resulting in a medium degree of inherent distinctive character.

Likelihood of confusion

30. 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 them and the goods 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 first is the interdependency principle i.e. a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

31. I have found as follows:

- a) The goods are identical.
- b) The average consumer for the goods is a member of the general public or a professional user in the manufacturing industry, who will pay a medium degree of attention during the purchasing process.
- c) The purchasing process for the goods is predominantly visual, although I do not discount an aural component to the purchase.
- d) The marks are visually similar to a low degree, aurally similar to between a low and medium degree and conceptually similar to no more than a medium degree.
- e) The earlier mark is inherently distinctive to a medium (or average) degree.

32. Bearing in mind the differences between the marks, I do not consider it likely that one will be mistakenly recalled for the other, even when they are used on identical goods. Consequently, there is no likelihood of direct confusion.

33. I will now consider whether there is a likelihood of indirect confusion. 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’.

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.).

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

34. The common element of the marks (being the word LOYAL) is not so strikingly distinctive that the average consumer would assume that no-one else but the brand owner could be using it. Consequently, category a) does not apply. The addition of the words "TO THE OIL" in the applicant's mark cannot be said to be a non-distinctive addition. This is because, whilst I note that the goods in issue are oil-based, the addition of the words "to the oil" creates conceptual differences between the marks when taken as a whole and creates a rhyming sequence. Consequently, category b) does not apply. The removal of the Arabic script from the opponent's mark and its replacement with the words TO THE OIL, which creates a unitary meaning, is not consistent with a brand extension. Consequently, category c) does not apply. Whilst I bear in mind that the examples listed in *LA Sugar* were not intended to be exhaustive, I can see no other reason for indirect confusion to arise, nor has the opponent identified any. Consequently, I do not consider there to be a likelihood of indirect confusion.

35. As I have found no confusion in respect of identical goods, the same finding would apply for the rest of the applicant's specification.

CONCLUSOIN

36. The opposition is unsuccessful and, subject to any successful appeal, the application may proceed to registration.

COSTS

37. The applicant has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the applicant the sum of **£175** for preparing a counterstatement and considering the Notice of opposition.

38. I therefore order Amal Mahmoud and Raed Khaleel Co to pay Tanzeel Mahroof the sum of **£175**. This sum is to 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 25th day of June 2024

S WILSON

For the Registrar