O/0998/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATIONS NOS. UK00003881396 AND UK00003881402
BY MOOVE IP HOLDING COMPANY LIMITED
TO REGISTER:

MOOVE

AND

AS TRADE MARKS IN CLASS 36

AND

IN THE MATTER OF THE OPPOSITIONS THERETO
UNDER NOS. 442403 AND 442405
BY MOOVE LUBRICANTS LIMITED

BACKGROUND AND PLEADINGS

1. On 23 February 2023, Moove IP Holding Company Limited ("the applicant") applied to register the trade marks shown on the cover page of this decision, in the UK. The applications were accepted and published in the Trade Marks Journal on 05 May 2023 in respect of the following services:

> **Class 36:** *Financial services; loan financing; micro-loan financing; financing services; micro-financing services; auto financing services; automobile lease-purchase financing; hire purchase financing services; providing financial information via a website; providing financial services via an app; non-advisory financial services for riders and drivers*.

2. The applicant initially sought registration of both applications for other goods and services in classes 9, 35, 39 and 42; however, the other classes were subsequently deleted by way of two Forms TM21B which were filed on 26 November 2024.

3. On 07 August 2023, both applications were opposed by Moove Lubricants Limited ("the opponent") based upon Sections 5(2)(a), 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act") with the opponent relying upon the following marks:

UK00003790008 ("the first earlier mark") MOOVE Filing date: 19 May 2022 Registration date: 13 January 2023 The mark is registered for a range of goods and services in classes 01, 04, 07, 09, 35, 37, 39, 40, 41 and 42 which are all relied upon.
UK00003790009 ("the second earlier mark") moove



(series of two)

Filing date: 19 May 2022
Registration date: 13 January 2023

The mark is registered for a range of goods and services in classes 01, 04, 07, 09, 35, 37, 39, 40, 41 and 42 which are all relied upon.

4. By virtue of their earlier filing dates, the trade marks relied upon by the opponent are earlier marks in accordance with Section 6 of the Act. Neither earlier mark had been registered for more than five years at the filing date of the contested applications; as such, they are not caught by the use conditions under Section 6A of the Act.

The opposition to the word-only mark MOOVE (UK00003881396)

5. Under Section 5(2)(a), the opponent claims that there is a likelihood of confusion because the marks are identical, and the goods and services are similar. Under this ground, the opponent relies upon the first earlier mark and states:

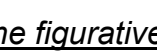
> *"The Applicant's MOOVE mark and the Opponent's MOOVE mark are visually, phonetically and conceptually identical. Further, the Class 09 goods and Classes 35, 36, 39 & 42 services of the Applicant's mark are similar or complementary to the goods/services covered by Opponent' s earlier mark. Accordingly, there is an inevitable likelihood of confusion, including a likelihood of association, as a result of the identity between the marks and similarities of the goods/services under the marks. It is submitted that the registration of the Application would be contrary to Section 5(2)(a) of the Act. In this regard, the Opponent requests that the Application is refused registration in its entirety and that an award of costs is made in its favour."*

6. Under Section 5(2)(b), the opponent claims that there is a likelihood of confusion because the marks are highly similar, and the goods and services are identical or similar. Under this ground, the opponent relies upon the second earlier mark and states:

> *"The Applicant's MOOVE mark and the Opponent's MOOVE stylised mark are highly similar bearing in mind that the Opponent' s mark will be perceived as a stylised MOOVE mark. The marks are visually highly similar and phonetically and conceptually identical. Overall, the marks are highly similar. The stylisation of Opponent's marks is not sufficient to render the marks sufficiently different. Further, the Class 09 goods and Classes 35, 36, 39 & 42 services of the Applicant's mark are identical, highly similar or complementary to the goods in Classes 01, 04, 07 & 09 and services in Classes 35, 37, 39, 40, 41 & 42 of the Opponent's earlier mark. Accordingly, there is an inevitable likelihood of confusion, including a likelihood of association, as a result of the similarities between the marks and similarities/identity of the goods/services under the marks. It is submitted that the registration of the Application would be contrary to Section 5(2)(b) of the Act. In this regard, the Opponent requests that the Application is refused registration in its entirety and that an award of costs is made in its favour."*

7. Under Section 5(3), the opponent claims that it has used the earlier marks since at least 2012 and has acquired a significant reputation and goodwill in relation to the registered goods and services. The opponent also submits that the marks are identical or highly similar, that the goods and services are identical, similar or complementary, and that use of the applicant's mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the opponent's marks.

8. Lastly, under Section 5(4)(a) the opponent relies upon two signs corresponding to the two earlier marks. The opponent claims to have used these signs throughout the UK since 1 July 2012 in relation to goods and services corresponding to those registered under the earlier marks. The opponent claims that use of the applicant's marks would be contrary to the law of passing off.

The opposition to the figurative mark  *(UK00003881402)*

9. The pleadings in respect of this application are more or less the same as those which I have outlined above in respect of the other application, the only difference being that the opponent pleaded Section 5(2)(b) in respect of the first earlier mark. The main difference in the pleadings here is that the opponent claims that this application will be perceived as a stylised MOOVE mark and, therefore, it is highly similar to both the first and the second earlier mark.

10. The applicant filed a defence and counterstatement in each opposition proceedings denying the claims made by the opponent. In particular, the applicant states that *"the Opposition lacks specificity regarding the similarity between the relevant goods and services, and instead relies on broad statements that group together seemingly unrelated categories of goods and services".* It also states that *"the goods and services covered by the Application are focused on vehicle financing with an added element of technology in its operation and, therefore, are dissimilar to the goods and services covered by the Opponent's Word Mark".*

11. On 02 July 2024 the Registrar directed under Rule 62(1)(g) of the Trade Marks Rules 2008 that the above cases be consolidated.

12. The applicant is represented by Cooley (UK) LLP, whereas the opponent is represented by N. J. Akers & Co.

13. Only the opponent filed evidence in these proceedings. Neither party requested a hearing, but only the opponent filed written submissions in lieu of a hearing. I make this decision having taken full account of all the papers, referring to them as necessary.

Relevance of EU Law

14. 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.

EVIDENCE

15. The opponent's evidence came in the form of a witness statement from Rupinder Sodhi dated 22 September 2024. Mr Sodhi is the "Head of Marketing, Europe" of the opponent. His witness statement is accompanied by 18 exhibits labelled Exhibits RS1-RS18.

16. I do not intend to summarise the evidence in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

My approach

17. The first earlier mark provides the opponent with its best-case scenario. This is because both earlier marks consist of the identical word element 'MOOVE' (as acknowledged by the applicant itself in its counterstatements),[1] and are registered for identical goods and services. Neither mark is subject to proof of use, and the only material difference between them lies in the additional figurative elements incorporated into the second earlier mark which make the latter even further removed from the contested marks.

18. Accordingly, for the purpose of the assessment under Section 5(2)(b), I will base my analysis on the first earlier mark, and I will only return to the second earlier mark if it becomes necessary to do so.

[1] See paragraph 22 of the counterstatement in opposition 442403 which states: "*The Applicant acknowledges that the Applicant's Mark and the Opponent's Stylised Mark both contain the word element "MOOVE"* and paragraph 8 of the counterstatement in opposition 442403 which states *"the Applicant acknowledges that the Applicant's Mark and the Opponent's Marks both contain the word element "MOOVE"*.

DECISION

Section 5(2)(b)

19. 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."

20. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

> (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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 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; and

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

Comparison of goods and services

21. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

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

> (a) The respective uses of the respective goods or services;
>
> (b) The respective users of the respective goods or services;
>
> (c) The physical nature of the goods or acts of service;
>
> (d) The respective trade channels through which the goods or services reach the market;
>
> (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
>
> (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

23. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM,* Case T-325/06, the General Court ("GC") stated that "complementary" means:

> "[…] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking."

24. In *Sanco SA v OHIM,* Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that the responsibility for the goods and services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited,* BL O/255/13*:*

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

25. Whilst on the other hand:

> "[…] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

26. In *Gérard Meric v OHIM,* Case T- 133/05, the 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."

27. The competing goods and services are as follows:

The applicant's services	**The opponent's goods and services**
	Class 1: *Chemical products for use in industry, science and photography; artificial and synthetic resins; chemical preparations for inhibiting and removing corrosion, including damp resisting purposes and having lubricating properties; plastics in the form of powders, liquids or pastes, for industrial use; anti-freeze preparations; coolants; chemical preparations for use in industry; chemical preparations for use as additives to fuels and oils; and adhesive substances for use in industry; tyre repair compositions; sealing compositions; chemical preparations for sealing; chemicals used to prevent scaling [other than household]; additives (chemical) for the prevention of sedimentation; de-icers including windshield de-icers; automobile cooling system rust inhibitors and leak sealants; flushing agents for cooling systems; hydraulic fluid; petrol additives [chemical]; coating agents [chemicals], other than paint.*

	Class 4: *Industrial oils, and greases (other than edible oils or fats or essential oils); motor oils; fuels, illuminants, lubricants, oil absorbent materials including natural or synthetic materials, and dust laying and dust absorbing compositions; natural, mineral, semi synthetic or synthetic oils, fluids, waxes and sprays for use in vehicles including motors, exhausts, engines, gears, clutches, brakes, steering wheels, aerials, door mechanisms, seat slides, carburettors and chokes; lubricants in the form of aerosols and oils; spray- on lubricants; multi-purpose sprays; wax for use in manufacture; non-chemical fuel additives; petrol additives [non-chemical].*
	Class 7: *Machines for treatment of materials and for manufacturing, machine tools, power-operated tools; coupling machines; lubrication machines; lubrication pumps; handling machines; power operated lubricant dispensers for machines; waste management and recycling machines; filtration machines; parts and fittings for all the aforesaid.*
	Class 9: *Scientific, research, surveying, photographic, audio-visual, optical, weighing, measuring, signalling, detecting, testing, inspecting and teaching apparatus and instruments;*

	apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; recorded and downloadable media, computer software, blank digital or analogue recording and storage media; software; management software for the field of lubricants and oils; platform software; databases; database management software; data and file management software; reporting software; borescopes for inspecting work; telemetry apparatus, telemetry devices for motor vehicles and engine applications; thermography apparatus; 3D glasses.
	Class 35: *Sales promotion services; marketing services; advertising services; import and export services; retail and online retail services in relation to chemicals, lubricating oils, greases, engine and gear lubricating oils and greases, hydraulic system fluids, anti-corrosion and antifreeze cooling system fluids, gearbox fluids, sugarcane, sugar, ethanol and bioenergy; sales promotion services in relation to chemicals, lubricating oils, greases, engine and gear lubricating oils and greases, hydraulic system fluids, anti-corrosion and antifreeze cooling system fluids, gearbox fluids; marketing services in relation to chemicals, lubricating oils, greases, engine and gear lubricating oils*

	and greases, hydraulic system fluids, anti-corrosion and antifreeze cooling system fluids, gearbox fluids; import and export services in relation to chemicals, lubricating oils, greases, engine and gear lubricating oils and greases, hydraulic system fluids, anti-corrosion and antifreeze cooling system fluids, gearbox fluids; sales promotion services in relation to sugarcane, sugar, ethanol and bioenergy; marketing services in relation to sugarcane, sugar, ethanol and bioenergy; import and export services in relation to sugarcane, sugar, ethanol and bioenergy; Sales promotion services, marketing services, import and export services for the automotive industry; business planning, administration and organisation; purchasing services; trade promotional services; personnel services; business assistance, management and administrative services; outsourcing services [business assistance]; outsourcing services in the nature of arranging service contracts for others; inventory management and control; data processing, systematisations and management; labour exchange services; business auditing; provision of information, advice and consultancy services relating to the aforesaid.

Class 36: *Financial services; loan financing; micro-loan financing; financing services; micro-financing services; auto financing services; automobile lease-purchase financing; hire purchase financing services; providing financial information via a website; providing financial services via an app; non-advisory financial services for riders and drivers*.	
	Class 37: *Lubrication services; engine lubrication; vehicle lubrication; vehicle repair and maintenance; construction services; maintenance services; machinery installation and repair services; installation and repair services of power generating apparatus and installations; installation and repair services for industrial plants; installation and repair services in relation to vehicles; installation and repair services in relation to construction; mining extraction, oil and gas drilling and extraction; mobile automotive oil change services provided at a customer's location; maintenance and repair of oil and gas storage installations; installation of oil production and exploration apparatus; construction of oil and gas storage installations; oil well casing, tubing and drill pipe installations; on-site construction supervision; spillage clearance; provision of information,*

	advice and consultancy services relating to the aforesaid.
	Class 39: *Distribution services; delivery services; oil and lubricant distribution services; oil and lubricant delivery services; distribution services and delivery services in relation to chemicals, lubricating oils, greases, engine and gear lubricating oils and greases, hydraulic system fluids, anti-corrosion and antifreeze cooling system fluids, gearbox fluids; distribution and delivery services in relation to sugar cane, sugar, ethanol and bioenergy; distribution and delivery services for the automotive industry; transportation logistics; storage of waste oil; oil distribution services; provision of information, advice and consultancy services relating to the aforesaid.*
	Class 40: *Treatment of materials, namely, waste, fuel, lubricants, oil, gas, chemicals, hazardous substances and materials; recycling of waste; processing of waste oil; waste treatment; waste disposal; destruction of waste; disposing of waste oil and recycling; waste management services [recycling]; mixing lubricants for third parties; reprocessing lubrication oils; oil spill treatment; provision of information, advice and consultancy services relating to the aforesaid.*

	Class 41: *Education; providing of training; education and training in the field of oil, lubricants, coolants, energy and chemicals; provision of information, advice and consultancy services relating to the aforesaid.*
	Class 42: *Scientific and technology services and research and design relating thereto; industrial analysis, industrial research and industrial design services; quality control and authentication services; design and development of computer hardware and software; software as a service; database design and development; updating of software databases; research services; diagnostic testing for industrial lubricants; condition monitoring relating to lubricants; energy auditing; advisory services relating to energy efficiency; research in the field of energy; research relating to waste analysis; chemical analysis services; analysis of materials; conducting sampling and analysis services to check for contamination; engineering services; engineering testing; industrial testing; diagnostic testing for industrial lubricants; testing services for determining the wear rate of lubricating components; analysis for oil research; analysis and testing services for the oil industry; quality assessment; quality*

	audits; quality control testing services for oil and lubricants; environmental assessment services; assessing chemical information in relation to risks; services for assessing the efficiency of industrial chemicals; analysis of oil fields; analysis services for oil-field exploration; scientific research and analysis; analysis and testing for oil workings; analysis of used machine oils; testing, analysis and monitoring in the field of lubricants; design and development of testing and analysis methods; testing, analysis and evaluation of the goods of others for the purpose of certification; oil field surveys; conducting engineering surveys; analysis and testing services relating to engineering apparatus; testing of apparatus and instruments; testing the functionality of machines and instruments; oil spill contingency planning services; provision of information, advice and consultancy services relating to the aforesaid.

28. Before turning to the comparison of the goods and services, I should clarify that, although the opponent has pleaded that the competing goods and services are similar, it has not expanded upon or explained the basis on which it considers the applicant's services in class 36 to be similar to its own goods and services. These are the only services remaining at issue in these proceedings, following the filing of the Forms TM21B by the applicant, by which the goods and services in classes 9, 35, 39 and 42 were deleted from the applied-for specifications. This is significant because in *SMARTX*, BL-O/0911/24, Mr Iain Purvis KC, sitting as the Appointed Person, stated that if multiple combinations can be argued in relation to the similarity of the goods

and services, it is not the Hearing Officer's job to depart from those argued by the opponent. He stated:

> "…it is for the Opponent to put forward the combinations of goods on which it relies for similarity (or identicality). If it fails to identify a particular combination, it cannot expect the Hearing Officer to do the job for it. The approach for which Mr Wood contends would place an intolerable burden on Hearing Officers in cases of this nature in which there will be thousands of potential combinations of goods which could be relied on, and for each combination a slightly different argument for similarity could be made. Furthermore, such an approach would be unfair on the Applicant for the mark, since they will have had no opportunity to address points on similarity taken by the Hearing Officer if those points are not first raised by the Opponent."

29. Accordingly, unless the similarity between the applicant's services and the goods and services relied upon by the opponent is self-evident, I will conclude that the goods and services are dissimilar.

30. I also bear in mind that:

a) Section 60A of the Act makes clear that goods or services falling within different classes are not necessarily dissimilar - this is particularly relevant in the present case as the earlier mark does not cover class 36, whereas the services at issue fall within that class.

b) Although in its submissions in lieu, the opponent elaborates on the reasons why it considers the applied-for services in class 36 to be similar to its registered goods and services, those arguments were neither pleaded in the notices of opposition nor raised during the evidence rounds. In my view, it is not appropriate for the opponent to introduce those arguments for the first time in its final submissions. This is unfair to the applicant, who has not had an opportunity to file evidence or make submissions in response. This approach is consistent with the guidance set out in Tribunal Practice Notice 1/2018 ("the TPN") which states that in circumstances where the similarity of goods/services

is not obvious or explained, the casework examiner may require the party filing the form TM7/26(I) to provide further information or, in the alternative, direct the same party to provide the required information by the deadline for filing evidence. The TPN goes on to say:

> "10. Either of the above courses of action will permit the other side to properly address the claimed identity, or similarity, of the goods/services in its own evidence of fact and/or written arguments (submissions) in response. This is fairer to the applicant/proprietor than revealing the reasons why the respective goods/services are claimed to be similar for the first time at a hearing, or in final written submissions in lieu of a hearing, i.e. after the other side's opportunity to file evidence or written submissions in response has passed."

Whilst I acknowledge that the opponent was not specifically referred to that TPN, the underlying principle of fairness remains applicable.

31. Consequently, given the procedural issue, I will adopt a cautious approach notwithstanding I might agree with some of the point raised by the opponent in its final submissions.

32. In its final submissions the opponent argues as follows:

1. *"It is common practice/knowledge that car sellers and manufacturers in the automotive sector provide financing to the buyer for the purchase of cars and financing brokering or long-term rental or leasing services. Car manufacturers frequently provide financial offers for the purchase of a car, such as leasing or renting options - this has been acknowledged in caselaw (paragraph 27 of the Decision of the Fourth Board of Appeal of 12 February 2020 in case R 1283/2019-4)."*

   I reject the opponent's argument. The opponent's mark is not registered for services relating to the provision of vehicles to consumers, including vehicles (class 12) and retail services in relation to vehicles (class 35). The case-law

cited by the opponent is irrelevant in this respect, as it merely establishes that 'hire-purchase financing; arranging of lease agreements; automobile lease-purchase financing' are similar to vehicles to a low degree. Even if that decision states that consumers may believe that the contested services are provided by the car manufacturer and that car manufacturers frequently offer financial arrangements for the purchase of vehicles, such as leasing or renting options, this does not assist the opponent. The services in question are not covered by the opponent's registration.

2. *"It is well-known that automotive companies (including fuel/petrol/lubricant manufacturers) including Shell, Volkswagen, Renault and the FCA Group (car manufacturers Fiat and Chrysler) offer goods/services as those covered by the Opponent's marks as well as Class 36 financing services including in relation to vehicles. Therefore, we submit that as such goods/services are provided by the same provider, have the same purpose and distribution channels and are directed at the same public such that the average consumer has been educated to know and identify that such entities in the automotive industry will provide Class 36 services as part of their offering. As such, there is a complementary relationship between the Opponent's Class 01, 04, 07, 09, 35, 37, 39, 40, 41 & 42 goods/services and the relevant public would perceive the relevant goods/services as having a common commercial origin (4/11/2003, T-85/02, Castillo, EU:T:2003:288, § 38). Further, the contested services in Class 36 are related to the automotive industry in which the Opponent has a reputation and goodwill. Therefore, this further supports that the Class 36 services are similar to the earlier goods and services. The entities act in the same business sector."*

   There are several issues with the opponent's submissions.

   First, there is no evidence that automotive companies, including fuel, petrol and lubricant manufacturers, offer financial services in relation to vehicles.

   Secondly, the case law cited by the opponent concerns entirely different goods, as the goods at issue in that decision fell within class 29 and 30. Paragraph 38 of that decision merely sets out the general principle that the relevant public

may perceive the goods concerned as having a common commercial origin. However, the goods considered in that case were materially different from the goods and services at issue in the present proceedings.

Lastly, the opponent's argument that the contested services are related to the automotive industry in which its mark enjoys reputation, cannot support a finding of similarity. The reputation of a trade mark does not, in itself, increase the degree of similarity between the goods and services. Reputation is a factor relevant to the assessment of likelihood of confusion, but it is not relevant to the assessment of similarity between goods and services.

Finally, the argument that the parties operate in the same business sector is equally irrelevant. Operating within the same business sector is not in itself one of the criteria identified by the case-law for assessing the similarity of goods and services.

3. *"The contested services in Class 36 inherently facilitate financial operations, their defining characteristic is the dependence on technology which dictates its functionality as well as being transaction and payment services that are inherently linked to and reliant on technological innovation and solutions. These services are related to some of the Opponent's IT/technology goods/services in Class 09 (e.g. software, management software for the field of lubricants and oils; platform software; databases; database management software; data and file management software; reporting software), Class 35 (e.g. retail services; sales promotion services; import and export services; sales promotion services, marketing services, import and export services for the automotive industry; business planning, administration and organisation; purchasing services; trade promotional services; personnel services; business assistance, management and administrative services; outsourcing services [business assistance]; outsourcing services in the nature of arranging service contracts for others; inventory management and control; data processing, systematisations and management; labour exchange services; business auditing; provision of information, advice and consultancy services relating to the aforesaid) & 42 (e.g. technology services; industrial analysis; industrial research and industrial*

design services; quality control and authentication services, design and development of computer hardware and software; software as a service; database design and development; updating of software databases; research services; provision of information, advice and consultancy services relating to the aforesaid). With regard to Class 09 & 42, there is a complementary connection between the contested services and the earlier software goods/services. The relevant public can be the same and the goods/services may originate from the same providers and use the same distribution channels. Companies nowadays develop and offer digital goods services which can include payment processing and audit solutions or other transactions that allow businesses and individuals to send and receive money electronically or manage their finances (e.g. payment gateways). As such, it is considered that the services under comparison are complementary since IT or technological services provide the necessary software and infrastructure that enable digital transaction and payment and financing services including in relation to the automotive sector. Moreover, they may have the same providers in charge of developing and providing both services, and target the same relevant public, either professionals (e.g. finance and automotive professionals or ecommerce platforms) or the public at large. Therefore, they are similar/complementary."

The strongest point of the opponent's submission is that there is a complementary relationship between the contested financial services in class 36 and the earlier software goods and services in class 9 and 42.

I accept that the opponent's term *software* is similar to the applicant's term *providing financial services via an app* insofar as the latter qualifies the financial services by reference to the means through which they are provided (i.e. app/software) – an example is digital banking services provided through a banking app. However, I do not consider that this finding can automatically be extended to all the services covered by the applied-for specifications.

In adopting this cautious approach, I bear in mind that the registered term *software* upon which the opponent relies covers a broad category of goods, encompassing products with entirely different functions and purposes. In

Galileo International Technology, LLC v European Union [2011] EWHC 35 (Ch), the judge considered the scope of a broad specification for computer software. He stated:

> "The unrestricted specification is of enormously wide scope. The Hearing Officer wisely reminded himself of what Laddie J had said about wide specifications for computer software *in Mercury Communications Ltd v Mercury Interactive (UK) Ltd* [1995] FSR 850. Laddie J considered that:
>
> "… there is a strong argument that a registration of a mark simply for "computer software " will normally be too wide. In my view the defining characteristic of a piece of computer software is not the medium on which it is recorded, nor the fact that it controls the computer, nor the trade channels through which it passes but the function it performs. A piece of software which enables a computer to behave like a flight simulator is an entirely different product to software which, say, enables a computer to optically character read text or design a chemical factory. In my view it is thoroughly undesirable that a trader who is interested in one limited area of computer software should, by registration, obtain a statutory monopoly of indefinite duration covering all types of software, including those which are far removed from his own area of trading interest. If he does he runs the risk of his registration being attacked on the ground of non-use and being forced to amend down the specification of goods. I should make it clear that this criticism applies to other wide specifications of goods obtained under the 1938 Act. I understand that similar wide specifications of goods may not be possible under the 1994 Act."
>
> That was a case decided under the Trade Marks Act 1938, but, like Laddie J, I see no reason why the views there stated should not apply under the Act."

33. Taking all of the above into account, I consider that the term *software* as relied upon by the opponent in class 9 is expressed in sufficiently broad terms that its scope requires careful consideration in the context of the other goods and services covered by the earlier mark which have nothing to do with financial services. Further, as I have noted, the opponent did not explain the basis on which it considered the contested services in class 36 to be similar to its registered goods and services until its final submissions, thereby depriving the applicant of the opportunity to respond to those arguments. Furthermore, the evidence of use filed by the opponent indicates that the opponent has used its mark primarily in relation to chemical goods and lubricants as opposed to software in class 9.

34. Against this background, I find that the applicant's services of *providing financial services via an app* are similar to a low degree to the opponent's software in class 9 for the reasons which I have set out above. The same conclusion applies to the term *financial services* which is sufficiently broad to encompass financial services provided through an app.

35. However, I reach a different conclusion in relation to the remaining contested services, namely *loan financing; micro-loan financing; financing services; micro-financing services; auto financing services; automobile lease-purchase financing; hire purchase financing services; providing financial information via a website; non-advisory financial services for riders and drivers.* In the absence of evidence that such services would normally be provided, or are in fact provided, through a software, I do not consider that the mere fact that software could potentially be used in their provision is sufficient to establish a degree of similarity. Accordingly, I find that those services have a different nature, purpose and use compared to the opponent's goods and services (including software), target different users, are neither complementary nor in competition and do not share trade channels. These services are dissimilar.

36. Under section 5(2) grounds, some similarity of goods and services is essential.[2] Since I have found that there is no similarity between the opponent's goods and services and the applicant's *loan financing; micro-loan financing; financing services;*

[2] eSure Insurance v Direct Line Insurance, [2008] ETMR 77 CA

micro-financing services; auto financing services; automobile lease-purchase financing; hire purchase financing services; providing financial information via a website; non-advisory financial services for riders and drivers, the oppositions under Section 5(2)(a) and 5(2)(b) fail in relation to these services.

37. Accordingly, the oppositions under Section 5(2)(a) and 5(2)(b) will proceed in relation to *Financial services; providing financial services via an app*.

Average consumer

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

39. In *Iconix Luxembourg Holdings* (cited above), the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

> (a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;
>
> (b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;
>
> (c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

40. The average consumer for the goods and services for which I found similarity in classes 9 and 36 is the general public or a business user, for example, users downloading a software application onto their devices to access financial/banking services. However, the relevant consumers of the opponent's software goods may also be businesses (e.g., banks) wanting specialist software for their business operations (e.g., banks or financial institutions that use specialised software to offer their financial services).

41. The goods and services are likely to be obtained by self-selection from websites, app stores as well as physical financial institutions (e.g., banks) or their online equivalents. The goods and services may also be purchased following advertisements. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase of the goods and services through advice sought from a sales assistant or representative, and word-of-mouth recommendations.

42. The cost and frequency of purchase for the goods and services will vary depending on the type of financial services the consumers intend to access (being provided via the applications/software) and from the speciality of the financial-related software. The costs of the goods and services may vary from lower for basic financial services (and related basic software functions such as, for example, banking apps) to relatively high for more technical financial services and more specialised software. With regard to the

app/software, although consumers would pay more attention to the financial services being purchased rather than to the mobile applications relating to these financial services, nonetheless consumers will take into account several factors when purchasing the financial-related software goods, such as suitability, technical function, user interface, and the compatibility of the software with existing systems. As regards the services, customers will pay close attention to charges, interest rates, price comparisons, accessibility of services, quality, etc. before entering into the purchasing act. Overall, at least a medium degree of attention will be paid to the selection of the goods and services; in this connection, for both goods in class 9 and services in class 36, the professional public will pay a higher degree of attention. However, I will assess the likelihood of confusion from the perspective of the general public since they are the group who will pay the lower degree of attention.

Comparison of marks

43. 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."

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

The applied-for mark	The earlier mark
MOOVE 	MOOVE

45. The applicant acknowledges that the applicant's word-only mark and the opponent's mark are identical.

46. As regard the applicant's second mark, the applicant acknowledges that the applicant's figurative mark and the opponent's mark both contain the word 'MOOVE'. This is the dominant and distinctive element of both marks. In the application, the stylisation of the two-letters 'OO' as two dots incorporated within an oblong device contribute to the overall impression although to a lesser degree that the word 'MOOVE'.

47. Visually, the marks coincide in the three letters 'M', 'V' and 'E'. They differ in the stylisation of the two-letters 'OO' as two dots incorporated within an oblong device. Overall, I consider the marks to be visually similar to a medium degree. Aurally, given the applicant's concession that its application will be understood as the word 'MOOVE' the marks are aurally identical. Conceptually, the word 'MOOVE' has no meaning, so the conceptual position is neutral. Nevertheless, insofar as the word 'MOOVE' in both marks might evoke the English word 'MOVE' which *"means to (cause to) change position"* (Cambridge online dictionary) the marks are conceptually identical.

Distinctive character of the earlier mark

48. 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 *WindsurfingChiemsee* 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)."

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

50. The earlier mark consists of the plain word 'MOOVE'. The word 'MOOVE' has no meaning. Alternatively, if it evokes the word 'MOVE' (which is neither descriptive of, nor has any clear semantic correlation with the opponent's software goods), it will be perceived as a distinctive misspelling. Either way it has an above average, i.e. medium to high, degree of distinctiveness.

51. The distinctiveness of a mark may be enhanced as a result of it having been used in the market. The opponent has filed evidence of use to which I will now turn to assess whether the distinctiveness of the earlier mark has been enhanced to any material extent.

52. Mr Sodhi states that his evidence of use relates to goods and services other than those which I have found to be similar to the applicant's services, namely:

- Chemical goods in Class 01;
- Industrial oils, greases, fuels and lubricants in Class 04;
- Retail and online retail services of Classes 01 and 04 goods, sales promotion, marketing services; advertising services, import and export agency and business services, import and export agency and business services for the automotive industry; business planning, administration and organisation; purchasing services; trade promotional services in Class 35;
- lubrication services in Class 37;
- Distribution services in Class 39;
- Scientific and technology services and research, diagnostic testing for industrial lubricants and advice and consultancy in Class 42.

53. Mr Sodhi says that the opponent is a leading multinational manufacturer and distributor of chemicals, industrial oils, greases, lubricants, fuels, and ancillary products worldwide, with interests in the automotive, aviation, energy, infrastructure, and logistics sectors. He states that the opponent also manufactures lubricant and chemical goods, and that it offers (a) distribution services including in relation to fuels and lubrication services; (b) retail of goods (including chemicals, industrial oils, greases, lubricants, fuels, and ancillaries), (c) sales promotion, marketing services, advertising services, import and export agency and business services, import and export agency, business services for the automotive industry, business planning, administration and organisation, purchasing services, trade promotional services, and (d) scientific and technology services and research, diagnostic testing for industrial lubricants.

54. Mr Sodhi says that the MOOVE trade marks have been put to use continuously since 2012 in the UK.

55. In terms of sales, Mr Sodhi says that the **annual turnover figures** in GBP for the opponent relating to the sale and distribution of chemical goods, industrial oils,

greases, fuels and lubricant products for the UK are set out in the table below. This, Mr Sodhi says, includes goods that the opponent has manufactured as well as third party goods:

2018	2019	2020	2021	2022	2023
Sales Value	Sales Value	Sales Value	Sales Value	Sales Value	Sales Value
116,671,559	121,498,800	103,672,516	121,002,255	139,809,920	159,368,757

56. This, Mr Sodhi says, total over £760 million worth of sales throughout the UK.

57. Mr Sodhi says that the annual **sales volume** of chemical goods, industrial oils, greases, fuels and lubricant products sold by the opponent in the UK for the period 2018 to 2023 are set out in the table below. This, Mr Sodhi says, total over 320 million units of chemical goods, industrial oils, greases, fuels and lubricant products sold in the UK:

2018	2019	2020	2021	2022	2023
Volume	Volume	Volume	Volume	Volume	Volume
62,020,307	59,205,695	50,281,105	52,538,499	49,937,750	50,514,172

58. Mr Sodhi says that the opponent has continually marketed the Moove brand through its website and marketing materials. Annual marketing/advertising expenditure figures in GBP for the years between 2018-2023 are set out in the table below:

2018	2019	2020	2021	2022	2023
2,211,436	2,205,786	2,116,007	1,967,924	1,569,981	2,391,706

59. Mr Sodhi also talks about the lubricants and fuel additives market in Europe. Insofar as it is relevant for the purpose of this decision, Mr Sodhi says that ExxonMobil Corporation is listed as one of the top companies in such market and that the opponent is one of ExxonMobil's biggest sales and marketing distribution partners worldwide, with a presence in *inter alia* the UK. This, Mr Sodhi argues, supports the claims that the opponent's 'MOOVE' trade marks have become well-known "*within ExxonMobil'*

field" which is that of the lubricant market.[3] Mr Sodhi says that within such field, the opponent's earlier marks have gained immense goodwill and reputation by way of long-standing use, as well as the success of the opponent's activities evidencing the opponent's market share in the chemical, lubricant and fuel additives sector. Mr Sodhi further refers to an online article from www.mordorintelligence.com which lists ExxonMobil Corporation at number 3 in the UK Lubricants Top Companies (dated 21 August 2024). Further, Mr Sodhi points out that the article looks at statistics from 2015 and states that "*the automotive sector dominated the UK lubricant market and accounted for around 46.85% of the total lubricant consumption in the country"* and that *"the UK Lubricants Market is moderately consolidated, with the top five companies occupying 61.06%. The major players in this market are… ExxonMobil Corporation…"*.

60. The main issue with the opponent's evidence is that whilst significant turnover figures are provided, they appear to include third party goods sold under different brands.

61. Further, as the opponent claims to be the biggest sales and marketing distribution partners of ExxonMobil, which is the third major company in the UK lubricant market, a percentage of that turnover must relate to the distribution of ExxonMobil's goods under ExxonMobil's brands. This conclusion is corroborated by the following screenshots from MOOVE marketing material which refers to Mobil as a trade mark, and shows the mark Mobil on the relevant lubricant products distributed by the opponent; the goods appear to be mainly lubricants for the automotive and industrial sector:



[3] RS18



62. Consequently, it is not possible to determine what percentage of the turnover figures relate to goods sold under the earlier mark MOOVE, but a significant part of the opponent's turnover is likely to have been generated by the distribution of ExxonMobil products.

63. Admittedly, the UK marketing figures appear to relate specifically to the brand MOOVE and are consistently high, amounting to approximately £2 million per annum in each of the six years prior to the relevant date. However, given that a proportion of the opponent's turnover was generated through the distribution of ExxonMobil's products, it is unclear what proportion of the reported marketing expenditures was attributable to the promotion of the opponent's own goods marketed under the brand MOOVE as opposed to the promotion of third party goods distributed by the opponent, or alternatively, the promotion of the opponent's business in its capacity as a distributor.

64. Whilst the evidence demonstrates that the earlier mark has been used to a commercially significant extent, I am not satisfied that it has acquired an enhanced degree of distinctiveness through use in relation to any of the registered goods and services. In particular, the absence of reliable evidence identifying the proportion of the turnover attributable to goods sold under the earlier mark as opposed to third party brands, make it difficult to assess the true extent of the market penetration. Nor is there any sufficient evidence from which I can conclude that the relevant public has come to recognise the earlier mark to an extent greater than it would result from its inherent distinctiveness.

Likelihood of confusion

65. 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, including that a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I must keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

66. Confusion can be direct or indirect. In *L.A. Sugar Limited v By Back Beat Inc*, 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)."

67. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, 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."

68. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

69. Earlier in this decision I found that:

- The applicant's word-only mark and the opponent's word-only mark are identical. The applicant's figurative mark and the opponent's word-only mark are visually similar to a medium degree and aurally identical. Conceptually, if the coinciding verbal element 'MOOVE' is perceived as an invented word the

position is neutral, if it is perceived as a misspelling of the word 'move' the mark are conceptually identical.

- The applicant's services of *providing financial services via an app* and *financial services* are similar to a low degree to the opponent's *software* in class 9.

- The average consumer is a member of the general public who will select the goods and services mainly visually, with a medium degree of attention.

- The earlier mark is inherently distinctive to a medium to high degree.

70. Having regard to the interdependency principle, and in particular, the identity of the marks, the low degree of similarity of the goods and services, and the medium to high degree of distinctiveness of the earlier mark, I consider that a finding of likelihood of direct confusion is inevitable in relation to the applicant's word-only mark.

71. The same conclusion applies to the applicant's figurative mark. Although the visual similarity between the marks is at a medium degree, the verbal element of the applicant's figurative mark is identical, or will be perceived as identical, to the earlier mark, which has a high degree of distinctiveness. In these circumstances and bearing in mind the medium degree of similarity between the goods and services, I consider that the average consumer is likely to perceive the applicant's mark as a logo version of the opponent's word mark. There is a likelihood of indirect confusion.

Section 5(3)

72. Section 5(3) states:

> "(3) A trade mark which-
>
> is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage

of, or be detrimental to, the distinctive character or the repute of the earlier trade mark".

73. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case C-252/07, *Intel,* Case C-408/01, *Adidas-Salomon,* Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; G*eneral Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68*;* whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair

advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oreal v Bellure NV*, paragraph 44.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel,* paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV,* paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

(j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and*

Spencer v Interflora, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure).*

74. In *General Motors,* Case C-375/97, the CJEU held that:

> "25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.
>
> 26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.
>
> 27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.
>
> 28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

75. I can deal with this ground very briefly. I have already commented on the applicant's evidence and said that it is not sufficient to establish enhanced distinctiveness, which refers to an increased recognition and capacity of a trade mark to identify the goods or services for which it is registered as coming from a particular undertaking as a result of extensive use. Whilst reputation and enhanced distinctiveness are different concepts, they are closely related and their assessment is based on the same factors. For the same reasons as those I have outlined above, I find that the applicant's evidence does not establish that the earlier mark benefits from reputation and the ground under Section 5(3) fails at the first hurdle.

76. Even if I am wrong, and the opponent's mark is found to enjoy a reputation, I consider that any such reputation would be limited to goods such as lubricants and chemicals. Even if a proportion of that reputation relates specifically to automotive lubricants, it would concern a field of activity too remote from the applicant's financial and financing services, for the public to make any link between the marks. In particular I consider that the users of automotive lubricants would primarily be garages and automotive manufacturers, rather than the general public who use the applicant's financial and financing services. Accordingly, given the differences between the relevant publics for the goods in respect of which the opponent might enjoy a reputation, and the applicant's financial and financing services, I do not consider that the relevant public would establish a link between the marks.

77. The opposition under Section 5(3) fails.

Section 5(4)(a)

78. Section 5(4)(a) states:

> "(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-
>
> > (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
> >
> > (aa) […]
> > (b) […]
>
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

79. In *Discount Outlet v Feel Good UK,* [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

> “55. The elements necessary to reach a finding of passing off are the ‘classical trinity' of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.
>
> 56. In relation to deception, the court must assess whether *"a substantial number"* of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

80. I can deal with this ground very briefly. It cannot put the opponent in a better position than under Section 5(2), since, as I have explained in relation to the Section 5(3) ground, the only goods in respect of which the opponent might enjoy a reputation are lubricants and chemicals. Those goods are too far removed from the applicant’s services for there to be any link, let alone any meaningful degree of closeness or similarity between them.

81. Accordingly, even if I were to find that the opponent enjoys goodwill in relation to automotive lubricants, there would be no misrepresentation, given the considerable distance between those goods and the applicant’s service. The outcome under Section 5(2)(a) and 5(2)(b) would therefore be no more favourable to the opponent than that under Section 5(2).

OUTCOME

82. The two oppositions succeed under Section 5(2)(a) and 5(2)(b) to the same extent in relation to the following services which will be refused registration in both applications:

> **Class 36:** *Financial services; financing services;*

83. The two oppositions fail to the same extent in relation to the following services which will proceed to registration in both applications:

> **Class 36:** *loan financing; micro-loan financing; micro-financing services; auto financing services; automobile lease-purchase financing; hire purchase financing services; providing financial information via a website; providing financial services via an app; non-advisory financial services for riders and drivers*.

COSTS

84. In view of the fact that both parties have achieved a measure of success I consider it appropriate to make no award of costs in favour of either party.

Dated this 11th day of November 2026

TERESA PINTO
For the Registrar