

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF PROCEEDINGS

FOR TRADE MARK APPLICATION NO. UK3943365

IN THE NAME OF TANZEEL MAHROOF FOR THE TRADE MARK

Loyal To The Oil

IN CLASS 3

AND THE OPPOSITION THERETO UNDER NO. 600003122

BY AMAL MAHMOUD AND RAED KHALEEL CO.

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF S WILSON (O/0592/24) DATED 25 JUNE 2024.

DECISION

Introduction

1. This is an appeal by Amal Mahmoud & Raed Khaleel Co. ("**Appellant**") from decision O/0592/24 of Ms S. Wilson ("**Decision**") concerning the opposition by the Appellant to Tanzeel Mahroof's ("**Respondent**") application for the mark "Loyal To The Oil" ("**Application**"), applied for on 8 August 2023 in respect of the following goods in class 3:

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 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 or laundry purposes; Eau de Cologne; Eau de cologne; Sachets for perfuming linen; Linen (Sachets for perfuming -); Perfumed powder; 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.

2. On 29 November 2023, the Application was opposed under the fast track opposition scheme by the Respondent under section 5(2)(b) of the Trade Marks Act 1994. The Respondent relied upon UK trade mark number 3842482 shown below (the “**Earlier Mark**”), which has a filing date of 25 October 2022 and a registration date of 13 January 2023.

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3. The Respondent relied upon all goods for which the earlier mark is registered, namely “*Aromatics [essential oils], bleaching preparations [laundry], cleaning preparation, drains preparations, refurbishing preparations, laundry preparations, polish for furniture and flooring, shampoos, soap, stain removers, soap*”, all in class 3.
4. Neither side filed evidence, and a hearing was not requested. Neither party filed written submissions, and a decision was made on the papers. In the Decision, S. Wilson for the Registrar held that the opposition was unsuccessful.
5. On 24 July 2024 the Appellant filed a Notice to Appeal to the Appointed Person against the Decision under Section 76 of the Trade Marks Act 1994.

The Hearing Officer’s decision

6. The Hearing Officer held as follows (in summary, and insofar as is relevant to this appeal):
 - a. The average consumer of the goods will be members of the general public or manufacturers within the perfume industry. A medium degree of attention will be paid during the purchasing process;
 - b. The purchasing process will be dominated by the visual component, although aural considerations cannot be discounted as some consumers may seek advice from retail assistants;
 - c. The marks are visually similar to a low degree, aurally similar to a low to medium degree and conceptually similar to a medium degree;

- d. The Earlier Mark is inherently distinctive to a medium degree, with no enhanced distinctiveness through use;
- e. The Hearing Officer carried out the assessment of likelihood of confusion by taking the Appellant's best case, considering the "*aromatics [essential oils]*" in the Earlier Mark's specification to be self-evidently identical to "*aromatics for perfumes*" in the Application;
- f. The Hearing Officer held that there is no likelihood of direct or indirect confusion for the above identical goods, and therefore the same finding would apply for the rest of the Respondent's specification.

Grounds of Appeal

- 7. The Appellant's Grounds of Appeal are as follows:
 - a. **Ground 1:** When determining whether the marks are similar under s.5(2)(b), the Hearing Officer failed to consider that while the average consumer normally does not dissect a mark into its constituent elements, the average consumer will break down a mark into elements which suggest a concrete meaning or resemble known words.
 - b. **Ground 2:** When determining whether the marks are similar under s.5(2)(b), the Hearing Officer failed to turn her mind to the fact that as a result of the average consumer's sole familiarity with the English word "loyal" in the Appellant's mark rather than the Arabic script  and as the word "loyal" is also the first element/beginning of the mark, it would be perceived as the dominant distinctive element in the overall impression.
 - c. **Ground 3:** When determining whether the marks are similar under s.5(2)(b), the Hearing Officer failed to consider that because the word "loyal" in the Respondent's mark is the first element/beginning of the mark and because the words "to the oil" would be perceived as descriptive/non-distinctive (or at least of lower distinctiveness) for the goods at issue, the word "loyal" would also be perceived as the dominant distinctive element in the overall impression.
 - d. **Ground 4:** In view of the foregoing, the Hearing Officer failed to make a proper global assessment of the marks when determining likelihood of direct confusion for the purposes of s.5(2)(b) of the Act.
- 8. The Appellant's Trade Mark Attorney, Mr Syed, expanded upon the above in his skeleton argument and at the hearing, and I set out below further details as are necessary to understand my overall conclusions. The Respondent did not file a skeleton argument nor attend the hearing.

Standard of review

- 9. The approach to be adopted in an appeal hearing has been laid down a number of times in case law. It was summarised in *Axogen v Aviv* [2022] EWHC 95 (Ch) at §24-25:

"Appellate Function

- 24. Although I was referred to numerous cases on the subject (including *English v Emery Demibold & Struck Ltd* [2002] 1 WLR 2409, *REEF Trade Mark* [2003] RPC 5, *Fine & Country Ltd v Okotoks Ltd* [2014] FSR 11, *Fage UK Ltd v Chobani UK Ltd* [2014] EWCA Civ 5, *Shanks v Unilever Plc* [2014] RPC 29, *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17,

Apple Inc v Arcadia Trading Limited [2017] EWHC 440 (Ch), *Actavis Group PTC v ICOS Corporation* [2019] UKSC 1671 and *NINEPLUS O/039/21*), the approach of the appeal court to a statutory appeal under section 76(1) of the TMA is uncontroversial. I bear the following principles, relevant to the issues before me, firmly in mind:

- i) The appeal is by way of a review, not a rehearing (see *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17) at [52(i)]);
- ii) The appeal court will allow an appeal where the decision of the lower court was "wrong" (see CPR 52.11). Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffices to justify interference (*NINEPLUS O/039/21* at [14]);
- iii) The decision of the lower court will be "wrong" if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. Absent an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was "outside the bounds within which reasonable disagreement is possible" (*Actavis Group* at [81]);
- iv) The approach required by the appeal court depends on a number of variables including the nature of the evaluation in question (*REEF Trade Mark* [2003] RPC per at [26]). There is a "spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision" (*TT Education* at [52(ii)]), with decisions of primary fact at one end of the spectrum and multi-factorial decisions (of the type which the parties agree were made in this case by the Hearing Officer) being further along the spectrum.
- v) In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions (*TT Education* at [52(iv)], *REEF* at [28] and *Fine & Country* at [50]-[51]).
- vi) An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. The evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible (*Actavis Group* at [80]).
- vii) Another variable to be taken into account will be "the standing and experience of the fact-finding judge or tribunal" (*REEF* at [26], *Actavis Group* at [78]). Expert tribunals are charged with applying the law in the specialised fields and their decisions should be respected unless it is quite clear that they have misdirected themselves in law. Appellate courts should not rush to find such misdirections simply because they might have reached a different conclusion on the facts (*Shanks* at [28] citing the warning given by Baroness Hale in *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49).

- viii) The appellate court should not treat a judgment as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed; "The duty to give reasons must not be turned into an intolerable burden" (see *REEF* at [29]). The reasons need not be elaborate. There is no duty on a judge, in giving her reasons, to deal with every argument presented by counsel in support of his case. It is sufficient if what she says shows the basis on which she has acted (*English* at [17], *Fage* at [115]). The issues the resolution of which were vital to the judge's conclusions should be identified and the manner in which she resolved them explained (*English* at [19]).
 - ix) In evaluating the evidence, the appellate court is entitled to assume, absent good reason to the contrary, that the first instance judge has taken all of the evidence into account (*TT Education* at [52(vi)]).
25. In the context of appeals relating to the likelihood of confusion, an evaluative issue described by Mr Iain Purvis QC sitting as an Appointed Person in *ROCHESTER Trade Mark* BL O/049/17 at [31] as "indeterminate and open to debate", Mr Purvis QC went on to say this at [33]:

"...the reluctance of the Appointed Person to interfere with a decision of a Hearing Officer on likelihood of confusion is quite high for at least the following reasons:

- (i) The decision involves the consideration of a large number of factors, whose relative weight is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case
- (ii) The legal test 'likely to cause confusion amongst the average consumer' is inherently imprecise, not least because the average consumer is not a real person
- (iii) The Hearing Officer is an experienced and well-trained tribunal, who deals with far more cases on a day-to-day basis than the Appellate tribunal
- (iv) The legal test involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade. Any wise person who has practised in this field will have come to recognize that it is often very difficult to make such a prediction with confidence. Jacob J (as he then was) made this point in the passing off case *Neutrogena v Golden* [1996] RPC 473 at 482:

'It was certainly my experience in practice that my own view as to the likelihood of deception was not always reliable. As I grew more experienced I said more and more "it depends on the evidence."'

Any sensible Appellate tribunal will therefore apply a healthy degree of self-doubt to its own opinion on the result of the legal test in any particular case.

34. I shall therefore approach this appeal on the basis that in the absence of a distinct and material error of principle, I ought not to interfere with the decision of the Hearing Officer unless I consider that his view on the issue of likelihood of confusion was clearly wrong in the sense that it was outside the range of views which could have been reasonably taken on the established facts."

2. To the above should be added:

- The judgment of the Court of Appeal in *Lidl Great Britain Ltd v. Tesco Stores Ltd* [2024] EWCA Civ 262, where Arnold LJ said at §110 “It is common ground that, in so far as the appeals challenge findings of fact made by the judge, this Court is only entitled to intervene if those findings are rationally insupportable”; and
- The Supreme Court’s guidance in *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8 where it stated at §49 “...on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out the balancing exercise afresh but must ask whether the decision of the judge was wrong by reason of an identifiable flaw in the judge’s treatment of the question to be decided, such as a gap in logic, a lack of consistency, or a failure to take into account some material factor, which undermines the cogency of the conclusion”.

10. I shall bear all the above in mind when reviewing the Decision.

Discussion

(1) Failure to break Earlier Mark down into elements which suggest a concrete meaning or resemble known words

11. The Hearing Officer set out, at §14, the familiar principles for determination of a likelihood of confusion, gleaned from the decisions of the EU Courts in *Sabel BV v Puma AG* and other cases. These include:

“(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;”.

12. At §§20-21 she said:

“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”.

13. Applying the above, at §23 she said:

“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”.

14. It is clear, therefore, that the Hearing Officer approached this issue in a methodical, stepwise and legally-correct manner. Having reminded herself of the general rule – that a mark is normally perceived as a whole – she recognised that the Earlier Mark is an exception to that rule, given that it comprises a word in the English language and a word in Arabic, the latter of which will not be understood by the average consumer. Accordingly, I do not accept the Appellant’s contention that the Hearing Officer failed to pay appropriate attention to this principle.

15. As a fallback position, the Appellant contends that the Hearing Officer should have held that the word LOYAL is the dominant distinctive element. The Hearing Officer held that the word LOYAL would play the greater role, but did not go as far as the Appellant contends she should have gone. However, having recognised that the average consumer would only comprehend the meaning of the word LOYAL, it was a matter for the Hearing Officer to decide what precise role each element played in the overall distinctive character of the Earlier Mark. The Hearing Officer made no error of principle in deciding that, whilst LOYAL plays the greater role, it is not necessarily the dominant distinctive element, and nor was she wrong in making that finding.

16. I therefore dismiss this first ground of appeal.

(2) Failure to recognise that as a result of the average consumer’s sole familiarity with the English word “loyal” in the Appellant’s mark rather than the Arabic script , and as the word “loyal” is also the first element/beginning of the mark, it would be perceived as the dominant distinctive element in the overall impression

17. This second ground overlaps with the first, insofar as it relates to the average consumer’s familiarity with the English word “loyal”, and I have addressed that point above. In relation to the second point – that the word “loyal” is at the beginning of the mark – I do not agree that the Hearing Officer failed to take it into account. Indeed, it is clear from the following passage at §23 that she did:

“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” (my underlining).

18. As with the first ground of appeal, it was a matter for the Hearing Officer, having recognised that “loyal” is the first word, to decide what weight to give to each element. In deciding that

the word LOYAL plays the greater role, but is not necessarily the dominant distinctive element, she made no error of principle and was not wrong.

19. I dismiss this second ground of appeal.

(3) Failure to consider that because the word “loyal” in the Respondent’s mark is the first element/beginning of the mark and because the words “to the oil” would be perceived as descriptive/non-distinctive (or at least of lower distinctiveness) for the goods at issue, the word “loyal” would also be perceived as the dominant distinctive element in the overall impression

20. The Hearing Officer said at §23:

“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”.

21. It is clear, therefore, that she considered that the Earlier Mark forms a composite whole, in which no individual word plays a greater or lesser role.

22. The contention that the Hearing Officer should nonetheless have gone on to analyse the distinctive and dominant components of the Earlier Mark is a contention that she should have fallen into the trap identified by Iain Purvis QC (as he then was) in *Kurt Geiger Limited v A-List Corporate Limited* O-075-13. In *Kurt Geiger*, Mr Purvis QC said:

“29. The Hearing Officer appeared to proceed on the basis that it was necessary to determine what were the ‘distinctive and dominant’ elements of the two marks before making any assessments of similarity and likelihood of confusion ...

30. I believe that this approach was wrong in principle. It is not necessary to identify one particular element of a mark as being its ‘distinctive and dominant element’. It is right of course that *“in certain circumstances”* there may be such an element which dominates the overall impression of a mark (see the quote from *Matratzen* above), but that is very often not the case, and even if it is the case it does not absolve the tribunal from the obligation to consider the overall impression given by the marks as a whole.

31. The problem with forcing marks through an analysis such as that carried out by the Hearing Officer in paragraphs 38 and 39 is that it necessarily involves mentally dividing the mark into its component parts, thus losing the overall impression given by the combination of those parts and by the way in which they are combined. This is not the approach which the average consumer is deemed to take, nor the approach he or she would actually take in real life. When assessing likelihood of confusion, this approach is therefore likely to lead to error”.

23. I am fortified in this view by the Appellant’s contention that *“the HO failed to consider the descriptive meaning of the term “oil” in the Applicant’s mark and makes no mention of this when determining likelihood of direct confusion. The word “to” is merely a preposition and the word “the” is merely the definite article, both of which do not add distinctiveness to the word (emphasis added) “oil” or otherwise changes its descriptive significance in the mark as a whole. They are used extensively in everyday speech”.*

24. The above analysis strikes me as wholly artificial, and not in accordance with the manner in which the average consumer would approach the Earlier Mark.

25. In my view, once the Hearing Officer had decided that the words in the Earlier Mark “come together to form a unit”, she would have fallen into error had she gone on to analyse each word separately. The only challenge which could be made to her decision is to contend that she was simply wrong in deciding that the overall impression lies in the words together. No such challenge is made by the Appellant, and nor could it be – her decision was clearly one within the bounds within which reasonable disagreement is possible.
26. I accordingly dismiss this third ground of appeal.

(4) Failure to make a proper global assessment of the marks when determining likelihood of direct confusion

27. Given that I have dismissed each of the foregoing grounds, it is clear that there was no error of principle which would entitle me to revisit the Hearing Officer’s overall analysis of likelihood of confusion. Having said that, I wish to add a few words in support of the Hearing Officer’s analysis. The Hearing Officer dismissed any likelihood of direct confusion. Given the differences between the marks, and in particular the presence of the Arabic script in the Earlier Mark, which will not go unnoticed by the average consumer, she was clearly correct in this regard.
28. As for indirect confusion, she cited the familiar decision of Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10. She correctly identified that the marks in this matter do not fall within any of the example categories identified by Mr Purvis QC. She further said at §34 that “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”.
29. In my view, she adopted the correct approach – if it is contended that there is a likelihood of indirect confusion for reasons other than those set out in *LA Sugar* (and perhaps the further example given by Arnold LJ at §12 in *Sazerac Brands v Liverpool Gin* [2022] R.P.C. 5), it is incumbent on a party to identify them in its submissions before the hearing officer. If a party fails to do so, it cannot then contend on appeal that the hearing officer failed to take such reasons into account.
30. Accordingly, I dismiss this fourth ground of appeal.

Conclusion

31. The appeal is dismissed. The Application will proceed to registration for all goods applied for in class 3.

Costs

32. Clearly, the Respondent has been the successful party. However, as it took no part in the appeal, I make no order as to costs.
33. The Hearing Officer’s order that the Appellant shall pay the Respondent the sum of £175 still stands. The Appellant shall make that payment within 21 days of this decision.

Dr. Brian Whitehead

19 November 2024

Representation

Kashif Syed, Trade Mark Attorney, of Beck Greener LLP for the Appellant/ Opponent

Briffa for the Respondent/Applicant, who did not participate in the appeal