

O-134-13

TRADE MARKS ACT 1994

**IN THE MATTER OF THE UNITED KINGDOM DESIGNATION OF
INTERNATIONAL REGISTRATION NO 998196
BY GRUPA LOTOS SPÓLKA AKCYJNA IN RESPECT OF THE TRADE MARK**



IN CLASSES 1, 2, 3, 4, 19 AND 43

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 72051
BY GROUP LOTUS PLC**

BACKGROUND

1) Grupa Lotos Spółka Akcyjna (“GLSA”) is the holder of international registration (“IR”) 998196 in respect of the following mark:



2) Protection in the UK was requested on 31 October 2008. The request for protection was published in the United Kingdom, for opposition purposes, in the Trade Marks Journal on 24 July 2009. Protection is sought in respect of the following goods:

Class 1

Non-organic and organic chemical products and petrochemical products manufactured as a result of crude oil processing, included in this class, e.g. alcohols, glycols, ketones, dienes, olefins, polyolefines, ethers; sulphur, nitrogen, hydrogen, petroleum plasticizers; chemical products destined for industry, included in this class; fatty acids, organic solvents, furfural extract for the production of softeners in industry; de-greasing preparations used in technological processes; fluids: brake, hydraulic, for car radiators, vehicle engine coolants, chemical additives for fuels, detergent additives for fuels; antiperspirants; windscreen defrosting products; preparations and oils for metal hardening; preparations facilitating demoulding; sealing and impregnating agents for wood and fibreboard; preparations for decolouration of waste paper; coolants; preparations and additional liquids for abrasive materials; grain esters; raw plastics.

Class 2

Antirust oils and greases included in this class; maintenance and cleaning preparations with defrosting properties; metal protecting preparations; anticorrosion agents.

Class 3

Car care fluids; car shampoo; liquids: for cleaning all types of engines and car windows, upholstery cleaning fluids, rim cleaner; windscreen washer fluids; rust remover; windscreen defrosting products and defrosting preparations for car locks.

Class 4

Crude oil (raw or refined); gas fuel; products of crude oil refining; industrial oil, process oil, lubricants, fuels and greases, included in this class; lubricating oils, diesel oil, fuel oil, base oil, gear oil, hydraulic oil, hydraulic gear oil, compressor, turbine, machine and shipping oils, oils for graphic paints, for preservation of masonry, leather, fabrics, oils used for facilitating the removal from moulds, moistening oils; oils for petrol and internal combustion engines: mineral, semi-synthetic, synthetic; oils for agricultural, road equipment, and small auxiliary equipment; oils for metalworking and guides, petrolatum oil; oil as heat carrier; oils for honing and lapping in metalworking, for machining; oils and greases for lubricating machinery in food industry; multifunctional synthetic greases; grease for cutting instruments; technical gases: propane, butane; propane-butane liquid gas; petrols; light petrol and naphtha; components for petrol production; fuels, biofuels, alcohol-based fuels, aviation and marine fuels; bunker fuel; slack wax; paraffin; wax; candles; lighting materials included in this class; rape oil for industrial purposes; sunflower oil for industrial purposes; soya oil for industrial purposes.

Class 19

Road asphalt, industrial asphalt, binder preparation asphalt, industrial insulating asphalt, modified asphalts and elastomero asphalts, elastomero asphalt binders, asphalt adhesive compound, tar, bitumen, asphalt bitumen solutions and emulsions, road construction and surfacing materials.

Class 43

Catering services provided by gas retailing stations; snack bars, canteens, self-service restaurants, cafes and restaurants; catering services; hotels, motels; temporary accommodation.

3) A mark description is included in the registration, as follows:

“The trademark consists of a stylised flower with two petals in a drop shape and the third petal in a flame shape; the left drop and the flame are

red and the right drop is navy blue; below the red printed word LOTOS is situated”

4) On 26 October 2009, Group Lotus Plc (“GLP”) filed notice of opposition to the granting of protection in the UK. The single ground of opposition is that the designation offends under Section 5(2)(b) of the Trade Marks Act (“the Act”) because it is in respect of a mark that is very similar to three earlier marks in the name of GLP and in respect to goods and services that share the same trade channels and end users. As a result, it is claimed that there is a likelihood of confusion. The relevant information relating to these three earlier marks is

- a) 2500405 LOTUS in respect of services in Class 41; Filing date 17 October 2008; Registration date 13 February 2009;

Class 41: *Education; providing of training; entertainment; on-line entertainment; sporting and cultural activities; lottery services; electronic games services provided by means of the Internet; the provision of on-line electronic publications; organisation and conducting of exhibitions, shows and conferences regarding automobiles, motor racing and vehicle engineering; organising and conducting events relating to automobiles and motor sport; motor racing; advanced driving instruction for drivers of motor cars; entertainment services provided at a motor racing circuit; organising of motor racing events; organisation of competitions relating to motor vehicles; provision of information relating to motor racing; provision of information relating to motor sports; training for automobile competitions; driving training services; driver tuition; vehicle handling instruction; education and instruction regarding vehicles and driving of vehicles; providing information regarding vehicles and the driving and handling of vehicles; filming services, videotaping services; organising and running of a motor racing team.*

- b) Community Trade Mark (“CTM”) 3025541 LOTUS in respect of goods and services in classes 7, 12 and 42; Filing date 27 December 2002; Registration date 21 October 2004;

Class 7: *Machines and machine tools; motor and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); parts and fittings for all of the aforesaid goods.*

Class 12: *Apparatus for locomotion by land, air or water; parts and fittings for all the aforesaid goods.*

Class 42: *Vehicle engineering services; technological services and research and design relating to vehicles*

- c) CTM 3842317 LOTUS-POW'R in respect of goods in Class 3; Filing date 29 June 2004; Registration date 11 January 2007.

Class 3: *Cleaning, polishing and scouring preparations for motor land vehicles.*

5) All three of GLP's marks are registered and have a filing date that is earlier than the UK designation date and therefore qualify as earlier marks as defined by Section 6 of the Act. All three completed their registration procedures within five years of the publication of GLSA's designation in the Trade Marks Journal. Consequently, they are not subject to the proof of use provisions in Section 6A of the Act.

6) GLSA subsequently filed a counterstatement denying all of GLP's claims.

7) Neither side filed evidence in these proceedings, but written submissions were provided on behalf of GLSA. Both sides ask for an award of costs. Neither party requested a hearing and I give my decision after consideration of all the papers on file.

DECISION

8) Section 5(2)(b) reads:

“(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.”

9) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (CJEU) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) C-334/05 P (*LIMONCELLO*). It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel BV v Puma AG*,
- (g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,
- (i) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,
- (j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *LIMONCELLO*

Comparison of goods

10) In assessing the similarity of goods, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods and services should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* (“*Canon*”) the CJEU stated at paragraph 23:

„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.’

11) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] RPC 281).

12) I also bear in mind the following guidance of the General Court (“GC”) in *G rard Meric v OHIM*, T-133/05:

“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 the trade mark application (Case T-388/00 *Institut f r Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

13) Finally, in terms of understanding what a "complementary" relationship consists of, I note the judgment of the GC in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06*, where it was stated:

"It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 *Segio Rossi v OHIM - Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM - Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Ingles v OHIM - Bolanos Sabri (PiraNAN diseño original Juan Bolanos)* [2007] ECR I-0000, paragraph 48)."

14) The respective goods and services are:

GLP's Goods and Services	GLSA's goods and services
<p>2500405 LOTUS</p> <p>Class 41: <i>Education; providing of training; entertainment; on-line entertainment; sporting and cultural activities; lottery services; electronic games services provided by means of the Internet; the provision of on-line electronic publications; organisation and conducting of exhibitions, shows and conferences regarding automobiles, motor racing and vehicle engineering; organising and conducting events relating to automobiles and motor sport; motor racing; advanced driving instruction for drivers of motor cars; entertainment services provided at a motor racing circuit; organising of motor racing events; organisation of competitions relating to motor vehicles; provision of information relating to motor racing; provision of information relating to motor sports; training for automobile competitions; driving training services; driver tuition; vehicle handling instruction; education and</i></p>	<p>Class 1: <i>Non-organic and organic chemical products and petrochemical products manufactured as a result of crude oil processing, included in this class, e.g. alcohols, glycols, ketones, dienes, olefins, polyolefines, ethers; sulphur, nitrogen, hydrogen, petroleum plasticizers; chemical products destined for industry, included in this class; fatty acids, organic solvents, furfural extract for the production of softeners in industry; de-greasing preparations used in technological processes; fluids: brake, hydraulic, for car radiators, vehicle engine coolants, chemical additives for fuels, detergent additives for fuels; antisweating agents; windscreen defrosting products; preparations and oils for metal hardening; preparations facilitating demoulding; sealing and impregnating agents for wood and fibreboard; preparations for decolouration of waste paper; coolants; preparations and additional liquids for abrasive materials; grain esters; raw plastics.</i></p>

<p><i>instruction regarding vehicles and driving of vehicles; providing information regarding vehicles and the driving and handling of vehicles; filming services, videotaping services; organising and running of a motor racing team.</i></p>	<p>Class 2: <i>Antirust oils and greases included in this class; maintenance and cleaning preparations with defrosting properties; metal protecting preparations; anticorrosion agents.</i></p>
<p>CTM 3025541 LOTUS</p> <p>Class 7: <i>Machines and machine tools; motor and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); parts and fittings for all of the aforesaid goods.</i></p> <p>Class 12: <i>Apparatus for locomotion by land, air or water; parts and fittings for all the aforesaid goods.</i></p> <p>Class 42: <i>Vehicle engineering services; technological services and research and design relating to vehicles</i></p>	<p>Class 3: <i>Car care fluids; car shampoo; liquids: for cleaning all types of engines and car windows, upholstery cleaning fluids, rim cleaner; windscreen washer fluids; rust remover; windscreen defrosting products and defrosting preparations for car locks.</i></p> <p>Class 4: <i>Crude oil (raw or refined); gas fuel; products of crude oil refining; industrial oil, process oil, lubricants, fuels and greases, included in this class; lubricating oils, diesel oil, fuel oil, base oil, gear oil, hydraulic oil, hydraulic gear oil, compressor, turbine, machine and shipping oils, oils for graphic paints, for preservation of masonry, leather, fabrics, oils used for facilitating the removal from moulds, moistening oils; oils for petrol and internal combustion engines: mineral, semi-synthetic, synthetic; oils for agricultural, road equipment, and small auxiliary equipment; oils for metalworking and guides, petrolatum oil; oil as heat carrier; oils for honing and lapping in metalworking, for machining; oils and greases for lubricating machinery in food industry; multifunctional synthetic greases; grease for cutting instruments; technical gases: propane, butane; propane-butane liquid gas; petrols; light petrol and naphta; components for petrol production; fuels, biofuels, alcohol-based fuels, aviation and marine fuels; bunker fuel; slack wax; paraffin; wax; candles; lighting materials included in this class; rape oil</i></p>
<p>CTM 3842317 LOTUS-POW'R</p> <p>Class 3: <i>Cleaning, polishing and scouring preparations for motor land vehicles.</i></p>	<p><i>materials included in this class; rape oil</i></p>

	<p><i>for industrial purposes; sunflower oil for industrial purposes; soya oil for industrial purposes.</i></p> <p>Class 19:<i>Road asphalt, industrial asphalt, binder preparation asphalt, industrial insulating asphalt, modified asphalts and elastomero asphalts, elastomero asphalt binders, asphalt adhesive compound, tar, bitumen, asphalt bitumen solutions and emulsions, road construction and surfacing materials.</i></p> <p>Class 43:<i>Catering services provided by gas retailing stations; snack bars, canteens, self-service restaurants, cafes and restaurants; catering services; hotels, motels; temporary accommodation.</i></p>
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GLSA's Class 1 goods

15) Firstly, I consider GLSA's *Non-organic and organic chemical products and petrochemical products manufactured as a result of crude oil processing, included in this class, e.g. alcohols, glycols, ketones, dienes, olefins, polyolefines, ethers.* The only argument put forward by GLP is that both parties' goods and services relate to apparatus for locomotion by land, air or water. However, it is not clear to me how GLSA's goods relate to such apparatus, other than at the most general of levels. In the absence of further information of how such specialist goods are related to such apparatus, it is not possible for me to conclude anything other than there is no similarity with any of GLP's goods or services. The respective trade channels are likely to be different and the end users, nature and methods of use are also different. Further, they are not in competition or complementary to each other.

16) In respect of GLSA's *sulphur, nitrogen, hydrogen, petroleum plasticizers; chemical products destined for industry, included in this class; fatty acids, organic solvents, furfural extract for the production of softeners in industry; de-greasing preparations used in technological processes; [...] antisweating agents,* most of these goods are limited to being for use in industry or in technological processes. GLP have made no specific submissions on this point, but it appears to me that its best case lies with its Class 7 goods (in CTM 3025541 LOTUS) that could include machines involved in industry and such technological processes. Nevertheless, this does not appear to provide GLP with a particularly strong case for similarity because. It is self evident that the nature of these respective goods

is very different and their uses are likely to be different. Whilst there may be some limited overlap in terms of users and trade channels where, for example, industrial machines and de-greasing preparations may be sold by the same trader, it is not obvious to me that similarity to any of GLP's goods and services is anything other than minimal.

17) No specific submissions have been provided regarding the level of similarity between GLSA's *preparations and oils for metal hardening; preparations facilitating demoulding; sealing and impregnating agents for wood and fibreboard; preparations for decolouration of waste paper; [...]; preparations and additional liquids for abrasive materials; grain esters; raw plastics* and any of GLP's goods and services. However, similarly to my above considerations, I am unable to conclude that any similarity is anything other than very low.

18) Finally, I consider the similarity between GLSA's *fluids: brake, hydraulic, for car radiators, vehicle engine coolants, chemical additives for fuels, detergent additives for fuels; [...] windscreen defrosting products; [...] coolants* and what appears to me to be GLP's best case, namely *cleaning and polishing preparations for motor land vehicles* (CTM 3842317 LOTUS-POW'R). Whilst the respective goods differ in their intended purpose, they may be some overlap in consumers and trade channels and they may appear on adjacent shelves in retail outlets. Consequently, they share a moderate level of similarity.

GLSA's Class 2 goods

19) GLSA's *Antirust oils and greases included in this class; maintenance and cleaning preparations with defrosting properties; metal protecting preparations; anticorrosion agents* may be used upon some of GLP's goods or they may be the product of its research services, nevertheless, this is not a sufficient reason to find similarity.

20) Regarding GLSA's *cleaning preparations with defrosting properties*, it is my view that GLP's best case lies with its *maintenance and cleaning preparations for motor land vehicles* in Class 3 of its CTM 3842317 LOTUS-POW'R. Here, there may be a reasonably close association with goods that are *cleaning preparations for motor land vehicles*. They may share similar users, and may have overlapping trade channels. Further they may be similar in nature and may also be in competition. Consequently, I conclude that these goods share a high level of similarity.

21) In respect of GLSA's remaining goods in this class, namely, *antirust oils and greases included in this class; ...; metal protecting preparations; anticorrosion agents*, I conclude that there is no similarity with any of GLP's goods and services. Certainly, no case has been presented to suggest otherwise, other than GLP's very broad contention in its statement of case that both sets of goods are used in relation to apparatus for locomotion.

GLSA's Class 3 goods

22) GLSA, in its written submissions, concedes that the goods covered by GPL's CTM 3842317 LOTUS-POW'R are contained in GLSA's specification. I concur that GLSA's *car care fluids* can include cleaning fluids for cars and, further, because the other terms in GLSA's specification all describe cleaning products of one kind or another, when applying the guidance in *Meric*, these goods are all identical to GPL's *cleaning ... preparations for motor land vehicles*.

23) GLSA's *rust remover* may be covered by GPL's *scouring preparations for motor land vehicles*. However, I cannot see how GLSA's *windscreen defrosting products and defrosting preparations for car locks* are either cleaning, polishing or scouring preparations. Consequently, they cannot be covered by GPL's specification. However, whilst they have a different intended purpose to GPL's goods, their nature may be similar to some goods listed in GPL's Class 3 specification of its CTM 3842317 LOTUS-POW'R. For example, windscreen defrosting products and a *car cleaning preparation* may both be packaged in aerosol cans. Further, they may also share trade channels, being sold either from specialist vehicle goods traders or from the same area of a supermarket. Further, it is common for car care products to be sold in combination packs or gift packs and windscreen or car lock defrosting products may appear in the same packs as car cleaning preparations. Consequently, I conclude that GLSA's *windscreen defrosting products and defrosting preparations for car locks* share a moderate level of similarity to GPL's *car cleaning preparation*.

GLSA's Class 4 goods

24) In respect of GLSA's list of goods in Class 4, there is little similarity with any of GPL's goods and services. Whilst many items in the list could be used in the motor vehicle industry, there any similarity ends with GPL's goods and services. Even this common element would not result in similarity because it is not normal, for example, for a motor vehicle fuel trader to also trade in any *apparatus for locomotion*. Whilst the retail of the two may occur from adjacent premises, for example, a garage selling petrol and diesel may also have a car showroom on the same site, this is as close as the respective trade channels will get. Taking all of this into account, I conclude that there is no similarity.

GLSA's Class 19 goods

25) Once again, the high point of GPL's case as expressed in its statement of grounds is that GLSA's goods are for use in relation to apparatus for locomotion and its goods and services also relate to apparatus for locomotion. Such a high level connection between the respective goods cannot result in GLSA's Class 19 goods as being similar to any of GPL's goods and services. When considering nature, intended purpose, methods of use, trade channels and whether they are

in competition or are complementary to each other, it is very obvious there is no similarity.

GLSA's Class 43 goods


26) Once again, the only possible argument that GLSA's Class 43 services are similar to any of the goods or services relied upon by GLP is the fact that GLSA's services are or may be provided from the same or adjacent premises as GLP's goods and services. As I have already discussed, such a high level connection is insufficient to conclude similarity. When applying the guidance provided in *Canon* and *Treat* it is very evident that these services share no similarity with any of GLP's goods and services.

The average consumer

27) As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who the average consumer is for the goods and services at issue. GLSA submit that the level of attention paid by the consumer during the purchasing process of most of the goods and services will be at an average level. However, it does recognise that some goods are more specialised and in respect to such goods the attention level would be significantly higher. This will certainly be the case where the goods or services are provided on a large scale to other businesses, such as in respect of *raw crude oil* or *industrial asphalt*. Here, the goods are likely to be bought in large volumes with the associated high costs. Such purchases will therefore command a high level of attention. However, other goods and services such as *car shampoo* or *snack bar services* are goods and services regularly used by the general public and where the cost is much lower. Here, the purchasing act is not normally particularly well considered and I concur with the submission of GLSA.

Comparison of marks

28) For ease of reference, the respective marks are:

GLP's marks	GLSA's mark
LOTUS LOTUS-POW'R	

29) When assessing the extent of similarity between the respective marks, I must do so with reference to their visual, aural and conceptual similarities bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23). GLP relies on three registrations, two of which are in respect of the single word LOTUS, obviously being their dominant and distinctive element. GLP's third registration is in respect of the mark LOTUS–POW'R. The POW'R element is likely to be perceived as an abbreviated form of the word POWER and, therefore, as an allusive reference to a quality of the goods. The dash that appears between the two words is such that it is negligible in the overall impression created by the mark. Taking all of this into account, together with the fact that the word LOTUS appears at the start of the mark, it results in the word LOTUS being the dominant and distinctive element in this mark also.

30) In respect of GLSA's mark, this consists of the device element and the word LOTOS appearing below it. The word appears to be invented and as such is clearly distinctive. Whilst the device element is the largest part of the mark, both the device element and the word element share an equal dominance within the mark.

31) Having identified the dominant and distinctive elements of the respective marks, I now consider the level of similarity. From a visual perspective, GLSA's mark has the device element, in red and blue, positioned on the top of the mark and is about twice the height as the letters that form the word element. GLSA submit that as a result that this would be the first element that the consumer would focus upon. As I have already said, it is my view that the device and word element share equal dominance and consequently, it is also my view that the device element is no more likely to be the primary focus than the word. The word consists of the five letters L-O-T-O-S in the colour red. GLP's first mark consists of the word LOTUS and this word shares four of its five letters with the word element of GLSA's mark. The fourth letter of the respective marks is different and, further, GLP's mark has no device element. Taking all of this into account, I conclude that the respective marks share a moderate level of visual similarity.

32) In respect of GLP's third mark, this contains the additional element POW'R that is absent in GLSA's mark and introduces a further point of difference. I conclude that the visual similarity between this and GLSA's mark is moderately low to moderate.

33) Aurally, GLSA's mark will be pronounced LO-TOS or LOT-OS where as GLP's first two marks will be pronounced LO-TUS or LOT-US. Consequently, they share the same first syllable. In respect to the second syllable of each mark, these are not aurally identical, but they are very similar or even virtually identical. I reject GLSA's submission that there is any difference in the division between the first and second syllables or that GLSAS's mark will have a "hard" pronunciation, whereas GLP's mark will have a soft pronunciation. Taking all of

this into account, I find that these respective marks share a very high level of aural similarity.

34) In respect of GLP's third mark, the additional element will be pronounced as POW-R or POW-ER depending on whether it is perceived as being an abbreviation for the word POWER or not. Either way, it provides a point of aural difference between the marks, and when considering the marks as a whole, I conclude that they share a relatively high level of aural similarity.

35) Conceptually, GLP's first two marks consist solely of the name of a type of large water lily¹. GLSA submits that this meaning would be easily perceived by the consumer, however, it is not obvious to me that this is so, and there is no evidence to support this submission. Consequently, taking account of the guidance of Ms Anna Carboni, sitting as the Appointed Person in BL O-048-08 *CHORKEE Trade Mark*, I am unable to conclude that the consumer will perceive the word LOTUS as anything other than a made up word. GLSA's mark consists of an undefinable globe device together with a made up word. The device element is described in the registration as "a stylized flower", but it is my view that such a concept will not be apparent to the average consumer. Rather it will be perceived as no more than an abstract globe device with three "tear-drop" shaped elements. Consequently, it does not contribute to the conceptual identity in any way. The respective word elements differ by only one letter, but because neither are likely to convey a conceptual message to the consumer, I conclude there is no conceptual similarity. Even if I am wrong about how the consumer perceives the word LOTUS, there is still no conceptual similarity between the marks

36) GLP's third mark has the addition of the POW'R element and as I have mentioned earlier, is likely to be interpreted as a shortened version of the word POWER, but as this is absent in GLSA's mark, the conclusion regarding conceptual similarity is the same, namely, there is none.

37) In summary, I have found that GLP's first two marks and GLSA's mark share a moderate level of visual similarity, a very high level of aural similarity and no conceptual similarity. This all combines to create a moderate to moderately high level of similarity overall.

38) In respect of the similarity between GLP's third mark, LOTUS POW'R, and GLSA's mark, I have found that they share a moderately low to moderate level of visual similarity, a relatively high level of aural similarity and no conceptual similarity. This all combines to give the respective marks an overall moderate level of similarity.

¹ "lotus". Oxford Dictionaries. April 2010. Oxford Dictionaries. April 2010. Oxford University Press. 15 March 2013
<<http://oxforddictionaries.com/definition/english/lotus>>.

Distinctive character of the earlier trade mark

39) I must consider the distinctive character of the earlier marks because the more distinctive they are, either by inherent nature or by use the greater the likelihood of confusion (*Sabel BV v Puma AG* [1998] RPC 199). The distinctive character of the earlier trade mark must be assessed by reference to the goods for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91). GLP make no claim to enhanced reputations and, therefore, I only have to assess the inherent level of distinctive character in the marks LOTUS and LOTUS-POW'R.

40) I have already found that the word LOTUS is the name of a type of lily, but that I cannot find that it is likely to be recognised as such by the average consumer. Consequently, it is likely to be perceived as a made up word with a high level of inherent distinctive character. Even if I am wrong and the word LOTUS is understood by the average consumer, it is still a word with no meaning in respect of GLP's goods and services. Consequently, it would still be endowed with a reasonably high level of inherent distinctive character. I reach the same conclusion when considering GLP's third mark. The addition of the possibly allusive POW'R element has little impact upon the overall level of distinctive character.

Likelihood of confusion

41) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27).

42) I have found that the nature of the purchasing act in respect of the parties' goods and services will vary depending on the nature of the goods and services. I have found that the following goods listed in GLSA's application to be either identical or share a moderate or high level of similarity to GLP's goods:

Class 1

fluids: brake, hydraulic, for car radiators, vehicle engine coolants, chemical additives for fuels, detergent additives for fuels; [...] windscreen defrosting products; [...] coolants

Class 2

maintenance and cleaning preparations with defrosting properties

Class 3

car care fluids; car shampoo; liquids for cleaning all types of engines and car windows, upholstery cleaning fluids, rim cleaner and windscreen washer fluids; rust remover; windscreen defrosting products and defrosting preparations for car locks.

43) In respect of these goods and the relevant goods of GPL's earlier CTM 3842317 LOTUS-POW'R, namely, *cleaning ... preparations for motor land vehicles*, they are likely to be purchased by members of the general public. Whilst these goods are not every-day disposable items, they are nonetheless purchased not infrequently and their cost is not normally high. Consequently, at least in relation to these respective goods, the purchasing act may involve more than average consideration, but not to any great extent.

44) GLP's goods, identified in paragraph 42 above, are listed in its earlier CTM 3842317 registration in respect of the mark LOTUS POW'R. I have found that this mark shares a moderate level of similarity to GLSA's mark. The respective goods may be requested aurally or, more likely, selected visually from a shelf in a retail outlet. As a result, the visual perception of the marks is likely to be the most important in the consideration of the likelihood of confusion. The earlier mark has a reasonably high level of distinctive character.

45) Taking into account the differences between the marks and the level of attention which will be paid to the goods, there is no likelihood that the marks will be confused directly with one another. However, in the case of the goods identified in paragraph 42 above, I find that it is likely that the average consumer will expect the goods identified by the respective marks to originate from the same or linked undertaking. This is because the single letter difference in the LOTUS/LOTOS component of the respective marks is likely to go unnoticed when imperfect recollection is taken into account, even though the other components of the respective marks will alert the average consumer to the fact that the marks are not the same. Taking account of the reasonably high level of distinctive character of the LOTUS/LOTOS component in both marks I, therefore, conclude that there is a likelihood of indirect confusion in respect of the goods listed in paragraph 42, above.

46) GLSA submits that where marks can be conceptually easily differentiated, this should be enough to avoid a finding of likelihood of confusion and refers to the judgment of the CJEU in *Claude Ruiz Picasso et al v OHIM* C-361/04 P. The CJEU stated that where one mark has a clear conceptual meaning, the conceptual differences observed *may* (my emphasis) counteract visual and phonetic similarities. It is my view that this guidance does not apply in the current case for a number of reasons. Firstly, I have found that the consumer is not likely to perceive a clear meaning in the word LOTUS. Even if I am wrong, and the consumer does perceive its meaning, the high level of similarity of the words

LOTUS and LOTOS is such that the consumer is likely to confuse the two words. When this is factored into the global consideration and when the marks are considered as their wholes, my finding of indirect confusion is undisturbed and the opposition is successful in respect of GLSA's goods listed in paragraph 42, above.

47) The opposition fails in respect of all other goods and services, namely:

Class 1

Non-organic and organic chemical products and petrochemical products manufactured as a result of crude oil processing, included in this class, e.g. alcohols, glycols, ketones, dienes, olefins, polyolefines, ethers; sulphur, nitrogen, hydrogen, petroleum plasticizers; chemical products destined for industry, included in this class; fatty acids, organic solvents, furfural extract for the production of softeners in industry; de-greasing preparations used in technological processes; ..., detergent additives for fuels; antisweating agents; ...; preparations and oils for metal hardening; preparations facilitating demoulding; sealing and impregnating agents for wood and fibreboard; preparations for decolouration of waste paper; ...; preparations and additional liquids for abrasive materials; grain esters; raw plastics.

Class 2

Antirust oils and greases included in this class; ...; metal protecting preparations; anticorrosion agents.

Class 4

Crude oil (raw or refined); gas fuel; products of crude oil refining; industrial oil, process oil, lubricants, fuels and greases, included in this class; lubricating oils, diesel oil, fuel oil, base oil, gear oil, hydraulic oil, hydraulic gear oil, compressor, turbine, machine and shipping oils, oils for graphic paints, for preservation of masonry, leather, fabrics, oils used for facilitating the removal from moulds, moistening oils; oils for petrol and internal combustion engines: mineral, semi-synthetic, synthetic; oils for agricultural, road equipment, and small auxiliary equipment; oils for metalworking and guides, petrolatum oil; oil as heat carrier; oils for honing and lapping in metalworking, for machining; oils and greases for lubricating machinery in food industry; multifunctional synthetic greases; grease for cutting instruments; technical gases: propane, butane; propane-butane liquid gas; petrols; light petrol and naphta; components for petrol production; fuels, biofuels, alcohol-based fuels, aviation and marine fuels; bunker fuel; slack wax; paraffin; wax; candles; lighting

materials included in this class; rape oil for industrial purposes; sunflower oil for industrial purposes; soya oil for industrial purposes.

Class 19

Road asphalt, industrial asphalt, binder preparation asphalt, industrial insulating asphalt, modified asphalts and elastomero asphalts, elastomero asphalt binders, asphalt adhesive compound, tar, bitumen, asphalt bitumen solutions and emulsions, road construction and surfacing materials.

Class 43

Catering services provided by gas retailing stations; snack bars, canteens, self-service restaurants, cafes and restaurants; catering services; hotels, motels; temporary accommodation.

COSTS

48) The opposition has been successful, but only to a relatively small degree. There is also a second, closely related set of proceedings between the parties (Opposition 72062). The applicant has chosen to use a different representative for each set of proceedings and this has resulted in the opponent being required to correspond separately on both cases and to consider different written submissions on ostensibly identical issues. Even when GLSA was approached by the Registry with a view of resolving the issue to allow the cases to be consolidated, GLSA did not do so.

49) Under these circumstances, whilst GLSA would normally have been entitled to a small award of costs, I find that party should bear its own costs.

Dated this 21st day of March 2013

**Mark Bryant
For the Registrar,
the Comptroller-General**