

**O-588-21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3491817**

**BY ADVANCED HYDROCARBON FUELS LTD**

**FOR THE TRADE MARK:**

**KEROCLEAN**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 421435**

**BY BASF SE**

## **Background and pleadings**

1. On 20 May 2020 (“the relevant date”), Advanced Hydrocarbon Fuels Ltd (“the applicant”) applied to register the word “KEROCLEAN” as a trade mark, under number 3491817. Registration is sought in respect of the following goods:

Class 4: Fuels and illuminants; hydrocarbon compositions; hydrocarbon fuels; synthetic fuels; fuel mixtures; liquid fuels; aviation fuel; motor fuel; automotive fuel; domestic fuel; domestic heating fuel; kerosene; kerosene for domestic heating; diesel fuel; diesel oil; gasoline; fuel oil; engine oils; fuel gas; compressed fuel gas; hydrocarbon fuels derived from waste material; hydrocarbon fuels derived from waste plastic; lubricants and industrial greases, waxes and fluids; synthetic lubricants; synthetic oils; industrial lubricants; lubricants for machines.

2. The application is opposed by BASF SE (“the opponent”). The opposition is based upon s. 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against all of the goods in the contested specification. The opponent relies upon the following trade marks:

| <b>Trade mark details</b>  | <b>Representation of mark</b> | <b>Specification relied upon</b>  |
|--|-------------------------------|---|
| European Union (“EU”) trade mark number 58487<br><br>Filing date: 1 April 1996<br><br>Registration date: 18 May 1999 | KEROFLUID                     | <u>Class 1:</u> Chemical auxiliary agents for the petroleum industry, namely preparations for improving odour, anti-knock resistance, stability and viscosity, for preventing the formation of sedimentation and for ignition acceleration; chemical additives and improvers for solid and liquid |

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|  |          | motor fuels, and for solid and liquid lubricants.  |
| <p>EU 58537</p> <p>Filing date: 1 April 1996</p> <p>Registration date: 18 May 1999</p>     | KEROPUR  | <p><u>Class 1:</u> Chemical auxiliary agents for the petroleum industry, namely preparations for improving odour, anti-knock resistance, stability and viscosity, for preventing the formation of sedimentation and for ignition acceleration; chemical additives to and preparations for improving solid and liquid motor fuels, and for solid and liquid lubricants.</p> |
| <p>EU 61762</p> <p>Filing date: 1 April 1996</p> <p>Registration date: 14 October 1998</p> | KEROCOM  | <p><u>Class 1:</u> Chemicals used in industry being auxiliary agents for the petroleum and mineral oil industry and additives for mineral oil products.</p>  |
| <p>EU 58784</p> <p>Filing date: 1 April 1996</p>   | KEROFLUX | <p><u>Class 1:</u> Chemical agents for the mineral oil industry, namely agents for improving odour, knock resistance, resistance and viscosity, to</p>   |

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| Registration date: 4 June<br>1998 |  | prevent the formation of deposits as well as to accelerate ignition; chemical additives and enhancing agents for solid and liquid fuels and for solid and liquid lubricants. |
|-----------------------------------|--|--|

3. The opponent claims that the marks at issue are visually, aurally and phonetically similar, because they share the prefix “KERO” and have a descriptive suffix. It asserts that the contested goods are “either similar or complementary” to those of the earlier marks and that there is a likelihood of confusion. Further, the opponent claims that its earlier trade marks constitute a “family” of marks and the relevant public will believe that the contested mark is another member of the opponent’s family of marks.

4. The applicant filed a counterstatement denying the grounds of opposition.

5. A hearing was requested and held before me, by videoconference, on 8 June 2021. The opponent was represented at the hearing by Chris McLeod of Elkington & Fife LLP. The applicant was represented by David Gwilliam of Adamson Jones. Both parties also filed written submissions during the evidence rounds, which I will bear in mind.

### **Relevance of EU law**

6. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

## **Witnesses**

7. Only the opponent filed evidence. The opponent's witness is Ludwig Völkel, the opponent's Director of Global Marketing and Product Development for Fuel Additives. Mr Völkel gives evidence concerning the use which has been made of the earlier marks.

## **Proof of use**

8. All of the earlier trade marks had been registered for five years at the date of application for the contested mark. They are, as a consequence, subject to the use provisions at s. 6A of the Act. Evidence of the use made of the marks was requested by the applicant, though some concessions (detailed below) were made at the hearing. The relevant legislation reads:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”.

9. Section 100 is also relevant. It reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it”.

10. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114. [...] The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the

consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use:



*Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]”.

11. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Geoffrey Hobbs Q.C. as the Appointed Person summed up the law regarding a fair specification as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned”.

12. The relevant period for the assessment of genuine use is 21 May 2015 to 20 May 2020.

#### EU 58487 “KEROFLUID”

13. The evidence is that the turnover in the EU for goods sold under the “KEROFLUID” mark was in excess of €600,000 in both 2016 and 2017, rising to over €1 million per

annum from 2018 to 2020.<sup>1</sup> The evidence shows that the “KEROFLUID” product is an icing inhibitor, or an anti-icing additive, for aviation fuel.<sup>2</sup> On the opponent’s website, the goods are classed under the heading “industrial solutions”. Web prints show the product available from a retailer with a company address in Birmingham. The goods are sold in 200l drums costing £1283 ex. VAT for a single drum and must be purchased in multiples of four. These prints are not dated apart from a 2021 copyright date. Prints from the opponent’s website have a copyright date of 2020. However, a brochure said to have been distributed throughout the EU during the relevant period is dated 2018 and shows the mark used in connection with aviation fuel icing inhibitor, including on the can.

14. Mr Gwilliam accepted at the hearing that use had been made of this mark for additives for aviation fuel. There is no evidence that the mark has been used in relation to any goods other than aviation fuel icing inhibitors. I consider that the category of “additives for aviation fuel” represents a fair specification for the goods on which the mark has been used.

#### EU 58537 “KEROPUR”

15. Turnover for goods under the “KEROPUR” mark in the EU has been in excess of €35 million each year between 2016 and 2020.<sup>3</sup> The evidence shows the mark in use in relation to a fuel additive which helps remove existing deposits and prevent the formation of new deposits.<sup>4</sup> Prints from amazon.co.uk show that the petrol additive was first available for sale on the site in May 2017.<sup>5</sup> These prints also mention a “KEROPUR BASF D DIESEL Fuel Additive”.<sup>6</sup> Promotional/product information brochures, which are dated within the relevant period and are said to have been distributed throughout the EU, also discuss a diesel and biodiesel version of the product sold under the mark.<sup>7</sup>

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<sup>1</sup> Völkel, §5.

<sup>2</sup> Exhibits LV1-LV3.

<sup>3</sup> Völkel, §10.

<sup>4</sup> LV4-LV6.

<sup>5</sup> LV4.

<sup>6</sup> P. 24.

<sup>7</sup> LV6.

16. Mr Gwilliam accepted at the hearing that the mark has been used in respect of fuel additives for cars/motor vehicles. Despite containing detailed information about product performance, the evidence suggests that this is a product intended for use by end consumers of fuels, rather than as a part of the manufacturing/refining process. There are, for example, multiple references to fuel economy in passenger cars and filling up at the petrol pump. References to fuel handling do not appear to concern industrial uses so much as simply filling up a vehicle's fuel tank and, whilst there is some evidence that the opponent provides specialist solutions for industry, the evidence is insufficient to show that the "KEROPUR" mark is used for such goods.<sup>8</sup> I accept that both petrol and diesel may be used in motors other than for vehicles but there is no evidence that the goods are either intended or marketed for such uses. Similarly, although there is some evidence of testing in a salt water environment (p. 76) and the product appears to be suitable for any diesel or petrol fuel, none of the marketing information suggests that it is intended for use in vehicles other than land vehicles.

17. In light of the applicant's concession and bearing in mind all of the evidence, I consider that a fair specification is "chemical additives for motor vehicle fuel".

#### EU 61762 "KEROCOM"

18. Sales under this mark for goods sold in the EU are said to have been in excess of €2 million each year between 2016 and 2020.<sup>9</sup> Three invoices, dated within the relevant period, show sales of "Kerocom" goods, each for quantities in excess of 21,000kg.<sup>10</sup> The invoices are to recipients in France. There is also part of a promotional brochure, ostensibly for the "KEROPUR" product, which is dated May 2019 and is said to have been circulated in the EU in the relevant period.<sup>11</sup> It mentions the "[new] deposit control additive KEROCOM®", which appears to be a component of the "KEROPUR" product.<sup>12</sup>

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<sup>8</sup> See, for example, p. 99.

<sup>9</sup> Völkel, §23.

<sup>10</sup> LV9.

<sup>11</sup> LV10.

<sup>12</sup> P. 127.

19. It was accepted at the hearing that there had been use of the “KEROCOM” trade mark in relation to fuel additives for cars/motor vehicles. There is very little evidence about the “KEROCOM” product itself: the evidence shows that it is an ingredient in the opponent’s “KEROPUR” additive but there is nothing specific about the “KEROCOM” product’s purpose or features. Bearing all of that in mind, I consider that “chemicals used in industry being additives for fuel for motor vehicles” is a fair specification for this trade mark.

#### EU 58784 “KEROFLUX”

20. Sales in the EU of goods bearing this mark are said to have been at least €11 million each year between 2016 and 2020, the figures showing a yearly decline from €21 million.<sup>13</sup>

21. The evidence shows “KEROFLUX®” (cold) flow improvers and wax anti-settling additives marketed as “refinery additives for middle distillates”.<sup>14</sup> It appears that the opponent offers custom-made products under the “KEROFLUX” trade mark: in addition to references to such products, the opponent operates a “Keroflux® blending plant [enabling the opponent] to offer new product without significant delay”.<sup>15</sup> Although there is some evidence that the fuels treated with “KEROFLUX” products may be used in cars, I can see no evidence that “KEROFLUX” goods are themselves sold to the general public. The prints from the opponent’s website have a 2020 copyright date but the product brochure is dated April 2016.

22. The applicant accepted at the hearing that the “KEROFLUX” trade mark has been used in respect to fuel additives for fuel refining. There is no indication that the mark has been used in respect of other goods. Consequently, I consider that a fair specification is “chemical additives for the fuel refining industry”.

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<sup>13</sup> Völkel, §18.

<sup>14</sup> LV7, LV8.

<sup>15</sup> See, for example, pp. 107, 112.

## **Section 5(2)(b)**

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

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

[...]

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

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

24. Section 5A is also relevant and reads:

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

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

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

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

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

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

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

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

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

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

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

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

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

### **The average consumer and the nature of the purchasing act**

26. The average consumer is a legal construct deemed to be reasonably well informed and reasonably circumspect: *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch) at [60]. For the purposes 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 and services in question: *Lloyd Schuhfabrik*.

27. The opponent submits that the goods target both the general public and specialists. It says that most of the goods will be purchased off the shelf or in a self-service environment.<sup>16</sup> The applicant submits that the average consumer for the goods does not necessarily overlap, as some of the goods will be purchased by the general public and some by “separate and non-overlapping specialists in the aviation and refining industries”.<sup>17</sup>

28. The general public and industry professionals, such as mechanics or purchasing specialists for refineries, will be average consumers of the respective goods. For some of the goods, such as “fuels and illuminants”, both groups are relevant consumers. For others, such as aviation fuel and associated additives, the average consumer will be a business purchaser only.

29. The purchasing process is likely to vary considerably for the goods at issue. Goods such as additives for passenger car fuel may be selected from shelves in retail premises or their online equivalents, whilst additives for aviation fuel, for example, will be selected from websites and marketing information without inspection of the goods themselves. However, for all of the goods, exposure to the trade marks is likely to be mainly visual.

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<sup>16</sup> Written submissions dated 1 February 2021, §26.

<sup>17</sup> Submissions dated 1 April 2021, §4.

There may be an aural component to the purchase of consumer goods but it is likely to be subordinate to the visual. For those goods bought by industry professionals, who are more likely to place telephone orders or discuss their requirements verbally with sales representatives, the aural component is likely to be more significant, even as significant as the visual element, though it will not be dominant.

30. None of the goods strikes me as an everyday or casual purchase. On the contrary, even those goods which may be bought with some frequency (the opponent’s evidence indicates its car fuel additives should be used each time the fuel tank is filled) will still require that the consumer pay some attention to the choice of particular product and its suitability for their vehicle/fuel. The general public will pay a medium degree of attention. For the business or professional purchaser of the goods at issue, there will be attention to the technical specifications of the products as well as costs, which may be significant, and at least a reasonably high degree of attention will be paid.

**Comparison of goods**

31. The goods to be compared are:

| <b>Earlier specifications</b>  | <b>Contested specification</b>  |
|--|---|
| <p><u>EU 58487 “KEROFLUID”</u><br/>Class 1: Additives for aviation fuel.</p> <p><u>EU 58537 “KEROPUR”</u><br/>Class 1: Chemical additives for motor vehicle fuel.</p> <p><u>EU 61762 “KEROCOM”</u></p> | <p><u>Class 4:</u> Fuels and illuminants; hydrocarbon compositions; hydrocarbon fuels; synthetic fuels; fuel mixtures; liquid fuels; aviation fuel; motor fuel; automotive fuel; domestic fuel; domestic heating fuel; kerosene; kerosene for domestic heating; diesel fuel; diesel oil; gasoline; fuel oil; engine oils; fuel gas; compressed fuel gas; hydrocarbon fuels derived from waste material; hydrocarbon fuels derived from waste plastic; lubricants and industrial</p> |



|  |  |
|--|--|
| Class 1: Chemicals used in industry being additives for motor vehicle fuel.<br><br><u>EU 58784 “KEROFLUX”</u><br><br>Class 1: Chemical additives for the fuel refining industry. | greases, waxes and fluids; synthetic lubricants; synthetic oils; industrial lubricants; lubricants for machines. |
|--|--|

32. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

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

33. Other relevant factors are the users of the goods and the trade channels through which they reach the market: *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case) [1996] EWHC 387 (Ch).

34. A further relevant factor is whether there is a complementary relationship between the respective goods and/or services. It was explained by the CJEU in *Kurt Hesse v OHIM*, Case C-50/15 P, EU:C:2016:34, that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods, which also applies by analogy to services. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, EU:T:2009:428, the General Court 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”.

35. The applicant submits that the goods are not similar as the intended purpose and method of use are different. It contends that any connection between the goods is “negligible”. The opponent’s position is that the goods coincide in intended purpose, method of use and distribution channels. Further, it argues that the goods are commonly used together and are complementary.

36. EU 58487 “KEROFLUID” (“additives for aviation fuel”)

*Fuels and illuminants; hydrocarbon compositions; hydrocarbon fuels; synthetic fuels; fuel mixtures; liquid fuels; aviation fuel; motor fuel; kerosene; gasoline; hydrocarbon fuels derived from waste material; hydrocarbon fuels derived from waste plastic*

37. As I understand it (there is no evidence to assist me), kerosene, or at least a particular type of kerosene, is aviation fuel. My understanding is also that aviation fuel may be known as “aviation gasoline”. Therefore, the above goods all appear either to be or to include aviation fuel. The purpose of fuel, which is to power an engine, differs from that of additives, the purpose of which is to alter the fuel itself, for example by making it less likely to leave deposits or by altering its flashpoint. As both may be liquids, there is an overlap in the nature of the goods, though their composition will obviously differ. The users of aviation fuel and aviation fuel additives will be the same. It seems to me that a fuel refiner may market a range of fuels which feature different approved additives (such as icing inhibitors) or that it may provide for customers to request that certain additives be added to their fuel to meet, for example, the requirements of particular airlines or aircraft operators, or that such additives may be sold alongside fuel at the point of refuelling, especially for small aircraft. Similarly, it is also plausible that distributors of aviation fuel would offer fuel additives as part of their business. It follows from the above that the goods are both sold through the same channels of trade and that they are complementary, as they are important for one another’s use and may be considered to be the responsibility of the same undertaking. These goods are similar to a reasonably high degree.

*Automotive fuel; domestic fuel; domestic heating fuel; kerosene for domestic heating; diesel fuel; diesel oil; fuel oil*

38. All of the goods listed above are types of liquid fuel. To the rather limited extent that they are liquids, there is some overlap in nature with fuel additives. However, the purpose differs: not only are aviation fuel additives used to change the properties of fuel but they will not be used in any type of fuel other than aviation fuel. The goods are not complementary as they are neither essential nor important for one another's use. There is no competition and there appears to be little scope for their channels of trade to overlap to a meaningful degree: whilst fuel refineries may produce aviation fuel additives or distributors of fuels may also sell aviation fuel additives, including those for aviation fuel, aviation products are likely to be a separate part of a refiner's business and appear in separate categories on websites and catalogues from those relating to, for example, passenger cars. These goods are not similar. If that is not right, there is, at most, a low degree of similarity between these goods.

*Engine oils; lubricants and industrial fluids; synthetic lubricants; synthetic oils; industrial lubricants; lubricants for machines*

39. These goods are likely to be more viscous liquids than aviation fuel additives. Although both parties' goods may improve the performance of an engine, one alters the quality of the fuel, the other reduces friction between moving parts. Their purpose is, therefore, different and they are not in direct competition. Their users and channels of trade may overlap, since all of the above may be used in aircraft maintenance and be available from oil refiners and distributors, albeit in different sections of catalogues/websites which, however, still relate to aviation products. These goods do not strike me as complementary in the sense defined in the case law: although I have no reason to doubt that refiners produce oils and lubricants, the goods do not appear to me to be important or essential for the use of the other in the way required for a finding of complementarity. They are similar to a fairly low degree.

*Lubricants and industrial greases and waxes*

40. The same considerations apply to these goods as for the oils and lubricants considered immediately above, save that these goods are different in nature, being solid or semi-solid. They are similar to a low degree.

41. *Fuel gas; compressed fuel gas*

42. I am not aware that either of these goods are used as aircraft fuel. Accordingly, the goods differ in both nature and purpose. The users are unlikely to overlap, save at a fairly general level. Whilst I accept that consumers of both may be professional users, those wanting to purchase fuel gas for, for example, power stations are not the same people as those who wish to refuel aircraft. Similarly, whilst the general public may purchase fuel gas, the average consumer of aviation fuel additives is not the general public. The goods are not in competition, nor are they complementary. Any overlap in channels of trade is likely to be superficial. These goods are not similar.

EU 58537 “KEROPUR” (“chemical additives for motor vehicle fuel”) and EU 61762 “KEROCOM” (“chemicals used in industry being additives motor vehicle fuel”)

43. *Fuels and illuminants; hydrocarbon compositions; hydrocarbon fuels; synthetic fuels; fuel mixtures; liquid fuels; motor fuel; automotive fuel; diesel fuel; diesel oil; gasoline; fuel oil; hydrocarbon fuels derived from waste material; hydrocarbon fuels derived from waste plastic*

44. All of the above include motor vehicle fuel. There is a difference in purpose between these goods. There is some overlap in nature, both being liquids. Users will overlap and the goods will both be found in, for example, ordinary filling stations, though I accept that fuel additives may also be sold elsewhere. They are not in competition but are complementary, fuel being essential for a fuel additive and the consumer being likely to believe that the goods are the responsibility of the same undertaking. They are similar to a reasonably high degree.

*Domestic fuel; domestic heating fuel; kerosene; kerosene for domestic heating*

45. The purpose of the goods at issue differs; their nature only overlaps to the extent that both may be liquids. The users of the respective goods will be the same but the goods are neither in competition nor complementary. The channels of trade are unlikely to coincide to a material degree: domestic heating fuel is likely to be purchased from specialist power companies, either directly or through third parties, or from, for example, heating oil or coal merchants, whilst additives motor vehicle fuel will be purchased through entirely different retailers. These goods are not similar.

*Aviation fuel; kerosene*

46. Users of aviation fuel will overwhelmingly be business customers. Whilst the consumer of motor vehicle fuel additives includes both the general public and business customers (only business customers in the case of the “KEROCOM” mark), those professionals are very unlikely to be the same professionals who purchase aviation fuel, which is a specialist product for a particular purpose. The products have some similarity in nature but do not have the same purpose. They are not in competition, they are not complementary, nor is it likely they would be sold through the same trade channels or in close proximity to one another, whether in physical shops or sections of catalogues and websites. These goods are not similar.

*Engine oils; lubricants and industrial greases, waxes and fluids; synthetic lubricants; synthetic oils; industrial lubricants; lubricants for machines*

47. These goods have a different purpose from that of motor vehicle fuel additives and only limited similarity in nature. They do not compete and are not complementary in the sense defined in the case law, as they are not important or essential for one another’s use. However, users and trade channels will intersect. They are similar to a fairly low degree.

*Lubricants and industrial greases and waxes*

48. The same considerations apply to these goods as for the oils and lubricants considered immediately above, save that these goods are different in nature, being solid or semi-solid. They are similar to a low degree.

EU 58784 “KEROFLUX” (“chemical additives for the fuel refining industry”)

*Fuels and illuminants; hydrocarbon fuels; synthetic fuels; fuel mixtures; liquid fuels; aviation fuel; motor fuel; automotive fuel; domestic fuel; domestic heating fuel; kerosene; kerosene for domestic heating; diesel fuel; diesel oil; gasoline; fuel oil; fuel gas; compressed fuel gas; hydrocarbon fuels derived from waste material; hydrocarbon fuels derived from waste plastic*

49. “Fuels and illuminants; hydrocarbon compositions; hydrocarbon fuels” include unrefined fuels such as crude oil. The specific purpose differs from that of additives for refining, though both are used to produce refined fuel. Both will be purchased by refining companies. I have no evidence concerning the supply chains of such goods. Whilst I accept that producers of unrefined fuels may also produce, for example, petroleum derivative products, I am doubtful that the very specialist nature of raw fuel production allows for the parallel production of fuel additives: the techniques and equipment required for fuel extraction do not strike me as offering a natural extension into distinct chemical additives. The nature of commodity trading and the specialist infrastructure needed for the transportation of unrefined fuels also point towards an exclusive trade in such fuels rather than parallel trade by the same companies in additives or other chemicals which are required for the refining process. In the absence of any evidence, my view is that the supply of unrefined fuel and the ancillary goods such as those covered by the earlier specification are separate markets. The goods are neither complementary nor do they share channels of trade. There is no similarity between these goods. If that is not right, they are similar only to a low degree.

50. As regards the goods listed above insofar as they are refined fuels, the users will differ. The purpose of the goods differs. There may be some overlap in nature (liquid,

solid) but their composition will not be similar. I do not consider it likely that the channels of trade will overlap: the routes to the market for end-consumer fuels will be wholly separate from those for additives used by industry professionals. The goods do not compete, nor are they complementary. These goods are not similar.

*Hydrocarbon compositions; engine oils; lubricants and industrial greases, waxes and fluids; synthetic lubricants; synthetic oils; industrial lubricants; lubricants for machines.*

51. Hydrocarbon compositions include the oils and lubricants also listed above. All of these goods may be used in industry and are not limited to specific applications. They may be purchased by the same commercial customers. There is also likely to be some overlap in channels of trade: whilst I accept that fuel additives and oils/lubricants are distinct categories of goods, it is not difficult to envisage the same relatively specialist supplier to the fuel refining industry providing all of these goods. They are neither in competition nor complementary. They are similar to a low degree.

### **Distinctive character of the earlier trade marks**

52. In *Lloyd Schuhfabrik*, the Court of Justice of the European Union (“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)".

53. The opponent submits that its trade marks have an above average level of distinctive character. It says that the "KERO-" element of its marks is distinctive and dominant and that the suffixes are non-distinctive. Mr McLeod's submissions were that there is "clearly a natural division between the prefix that the marks have in common and the suffix" and (albeit in relation to the conceptual comparison) that the marks all allude to kerosene. It appears to accept that "KERO-" is allusive of kerosene but denies it is descriptive. For its part, the applicant's position appeared to have shifted by the hearing and Mr Gwilliam submitted that "KERO-" is weakly distinctive and at least allusive of kerosene.<sup>18</sup> It further submits that the suffixes "-PUR", "-FLUX" and "-COM" have no meaning, or no descriptive meaning, in relation to the goods.

54. The goods covered by the earlier marks are all fuel additives of various types. The parties appear to agree that the average consumer will identify "KERO" within the marks as an element alluding to kerosene. Although "kero" may not be a common abbreviation, my view is that, given the goods at issue, it will be perceived as descriptive or non-distinctive, indicating that the goods are for use in connection with kerosene or, by extension, fuel.

55. The distinctive character of the "KEROFLUID" trade mark derives from the combination of the element "KERO" and the known word "FLUID". It is likely to be perceived as indicating goods which are fluids to be used in conjunction with fuel, or which make fuel more fluid. Given the goods, that is a non-distinctive meaning. The mark as a whole is weakly distinctive. "KEROPUR" does not have quite so clear a meaning. However, "PUR" is likely to be perceived as a misspelling of or reference to "pure". The

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<sup>18</sup> See also applicant's skeleton argument, §3.4.



mark is likely to be perceived as allusive of goods which purify fuel. The distinctiveness lies in the whole, which has a low degree of distinctive character.

56. Similarly, the distinctiveness of “KEROFLUX” is due to the combination of elements. It is likely to be perceived as indicative of goods concerned with the flow of fuel (for example, making fuel flow better). That is particularly the case given that the goods are directed at industry professionals whose exposure to concepts such as flux/flow is likely to be more frequent than among the general public. It is low in inherent distinctiveness.

57. As for the “KEROCOM” mark, this strikes me as less obviously divisible into prefix/suffix than the other marks because “COM” does not have a clear meaning in this context. Having said that, the parties appear to agree that “KERO” will be identified as an element in the mark. The mark as a whole does not have a clear meaning, nor is it obviously allusive as a whole, other than having an unspecified connection with fuel. It is distinctive to no more than a medium degree.

58. Despite the evidence of significant sales, at least for some of the marks, in the EU, there is little evidence concerning the position in the UK. The only evidence which is both dated within the relevant period and clearly concerns the UK are prints from Amazon. The evidence is that the brochures were distributed throughout the EU but there is no evidence of the scale or particular geographical scope of that distribution. None of the brochures in evidence shows a UK contact address. The evidence is insufficient to establish that any of the earlier marks has acquired distinctiveness in the UK.

### **Comparison of trade marks**

59. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel* (particularly paragraph 23). *Sabel* 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 *Bimbo*, 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”.

60. It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take into account the distinctive and dominant components of the marks. Due weight must be given to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

| <b>Earlier marks</b>  | <b>Contested mark</b> |
|---|-----------------------|
| (i) KEROFLUID<br>(ii) KEROPUR<br>(iii) KEROCOM<br>(iv) KEROFLUX | KEROCLEAN             |

61. The opponent stresses that all of the marks begin with the letters “KERO”. Mr McLeod said at the hearing that the opponent “would take” a medium degree of visual similarity because that was sufficient for the case to prevail, though in its earlier written submissions the opponent had argued that there is a high degree of visual and aural similarity. Mr McLeod argued that there is a medium degree of conceptual similarity due to the allusion to kerosene. The applicant says that there is a medium degree of visual similarity and a low-medium degree of aural similarity. Mr Gwilliam’s position at the hearing appeared to be that all of the marks at issue were at least allusive of kerosene.

62. The contested mark consists of the single word “KEROCLEAN”, which is where the overall impression lies. That said, “clean” is a very common word which will be readily

identified within the mark by the average consumer. As with the earlier marks, I consider that “KERO” will be seen as indicating kerosene and, by extension, fuel more generally. Given the specification, the mark as a whole is likely to be perceived as indicative of the quality or characteristics of the goods, e.g. fuels which are free from contaminants or which burn without leaving deposits or, for goods such as lubricants, of goods which either clean or do not contaminate fuel.

63. The overall impression of each of the earlier trade marks lies in the combination of the prefix “KERO-” with another element.

64. The respective marks all share the same first four letters “KERO”. The second part of the marks differs, with the suffix “CLEAN” being five letters and those of the earlier marks between three and five letters long. Although the suffixes do contain some of the same letters as “CLEAN”, there is no real visual or aural resemblance between “CLEAN” on the one hand and “FLUID”, “PUR”, “FLUX” or “COM” on the other. The marks will be viewed and verbalised in their entirety. They are visually and aurally similar to a medium degree.

65. Whilst there is a conceptual similarity because of the common meaning of “KERO”, “CLEAN” introduces a clear concept. In respect of the “KEROFLUID” mark, “FLUID” also has a meaning. These marks are conceptually similar to a medium degree. However, the conceptual similarity arising from the shared element “KERO” is not a distinctive conceptual similarity.

66. Turning to the “KEROPUR” mark, “KERO” conveys the same meaning in both marks. Further, purification and cleaning are similar concepts. These marks are conceptually similar to a reasonably high degree, though my comments regarding the distinctive similarity arising from “KERO” also apply here.

67. “KEROFLUX” will, I have found, be perceived as meaning goods for fuel flow. Flowing and cleaning are distinct concepts. As wholes, these marks have a medium degree of conceptual similarity but the shared concept arising from “KERO” is not a distinctive concept.

68. “KEROCOM”, as a whole, has no meaning. It is not conceptually similar to “KEROFLUID”, considered as a whole. To the extent that there is any perceived conceptual similarity arising from the shared “KERO” element, it is not a distinctive conceptual similarity.

### **Likelihood of confusion**

69. In determining whether there is a likelihood of confusion, all of the above factors need to be borne in mind. They must be considered globally (*Sabel*), from the perspective of the average consumer. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik*). The factors considered above have a degree of interdependency (*Canon*): for example, a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

70. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *LA Sugar Limited v Back Beat Inc.*, BL O/375/10, where Iain Purvis Q.C., sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”.

71. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C. (as he then was), sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls another mark to mind. That is mere association, not indirect confusion.

#### EU 58487 “KEROFLUID”

72. I found, above, that the contested “automotive fuel; domestic fuel; domestic heating fuel; kerosene for domestic heating; diesel fuel; diesel oil; fuel oil; fuel gas; compressed fuel gas” are not similar to the goods for which the earlier mark be relied upon. Without similarity between the goods, there can be no confusion.<sup>19</sup> The opposition against these goods is dismissed accordingly.

73. Turning to the remaining goods, there are varying degrees of similarity, from only a low degree to a reasonably high level of similarity. The average consumer who is common to both parties’ goods is a business purchaser who will pay at least a reasonably high level of attention to the purchase. The earlier mark is weakly distinctive. Whilst I accept that there is a medium degree of visual, aural and conceptual similarity between the marks, the common element “KERO” is not distinctive for fuels and connected goods. The differences between the words “FLUID” and “CLEAN” will prevent direct confusion. As to indirect confusion, whilst I acknowledge that the marks have the same construction, “KERO” has an obvious meaning for fuels and related goods which, even if not already in use, will be not in the least surprising to the consumer. I do not consider that the relevant consumer would conclude that the use of “KERO” was anything more than a coincidence for such goods. Nor is it likely that the use of a different non-distinctive suffix would point the consumer towards an economic connection rather than chance. Some of the goods in the contested specification are not fuels and, therefore, “KERO” is not strictly descriptive of them. Nonetheless, I see no reason why a consumer would assume that a word used descriptively or non-distinctively in the earlier mark indicated a trade connection when used allusively or distinctively in a later mark, notwithstanding the

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<sup>19</sup> See, for example, *Waterford Wedgwood plc v OHIM* – C-398/07 P, EU:C:2009:288.

similarities between the marks themselves and a reasonably high degree of similarity between the goods. As Mr Purvis, sitting as the Appointed Person, pointed out in *Terence Patrick O'Halloran v Volkswagen Aktiengesellschaft*, BL O/001/21 at [18], the average consumer is not just attentive but circumspect and “[c]ircumspection includes not leaping to conclusions which are not justified by the known facts and taking reasonable precautions (bearing in mind the nature of the goods and the importance of the purchase) to resolve uncertainties”. For the record, I would have drawn the same conclusion even if the consumer were a member of the general public paying a medium degree of attention. The opposition based on this mark fails.

#### EU 58537 “KEROPUR”

74. I have found that “aviation fuel; domestic fuel; domestic heating fuel; kerosene; kerosene for domestic heating” are not similar to the goods of the earlier mark. The opposition against these goods is dismissed.

75. The average consumer for the remaining goods includes the general public who will pay a medium degree of attention. As the least attentive consumers, that is the relevant group for the assessment of confusion. There is a reasonably high degree of conceptual similarity between the “KEROPUR” mark and the contested mark. However, the shared element is non-distinctive. The different endings of the marks are sufficient to avoid direct confusion. Whilst I acknowledge the similarities between the marks, I am not persuaded that the average consumer would attribute the shared presence of “KERO” to an economic connection between the parties. It is also my view that the evolution of a brand from “PUR”, a misspelling, to “CLEAN” is not an obvious or expected one likely to result in the consumer supposing that the entities offering the goods are connected. The opposition based upon this mark is rejected.

#### EU 61762 “KEROCOM”

76. The opposition against “aviation fuel; domestic fuel; domestic heating fuel; kerosene; kerosene for domestic heating” is dismissed, these goods having no similarity to the goods of the earlier mark.

77. I draw similar conclusions in respect of this mark as for the “KEROPUR” mark. The common consumer will pay a reasonably high degree of attention. Despite a medium degree of visual and aural similarity, the marks as wholes are not conceptually similar. The common element “KERO” conveys a descriptive or non-distinctive message. The marks will not be mistaken for one another, the different endings sufficing to distinguish them. The descriptive or non-distinctive nature of the common element will not lead the consumer to believe that the respective marks are used by the same trader, even where the goods are similar to a reasonably high degree.

#### EU 58784 “KEROFLUX”

78. My primary conclusion is that “fuels and illuminants; hydrocarbon compositions; hydrocarbon fuels; synthetic fuels; fuel mixtures; liquid fuels; aviation fuel; motor fuel; automotive fuel; domestic fuel; domestic heating fuel; kerosene; kerosene for domestic heating; diesel fuel; diesel oil; gasoline; fuel oil; fuel gas; compressed fuel gas; hydrocarbon fuels derived from waste material; hydrocarbon fuels derived from waste plastic” are not similar to the goods of the earlier mark and that the opposition insofar as it is directed against these goods is dismissed.

79. If it is not right that the above goods are dissimilar, they are only similar to a low degree, as are the remaining goods (“engine oils; lubricants and industrial greases, waxes and fluids; synthetic lubricants; synthetic oils; industrial lubricants; lubricants for machines”). For much the same reasons as given previously, I do not consider that there is a likelihood of confusion, whether direct or indirect. The at best limited distinctiveness of the common “KERO” element is unlikely to give rise to a perception that the marks are used by the same undertaking, whilst the different endings are both too different to result in consumers mistaking the marks for one another and not likely to be perceived as logical steps in a brand extension where there is only limited similarity between the goods. The opposition based upon this mark fails.

## Confusion based on a “family” of marks

80. The leading case on a “family” of trade marks is *Il Ponte Finanziaria SpA v OHIM* (“*Bainbridge*”), case C-234/06 P, EU:C:2007:514, where the CJEU said:

“62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a ‘family’ or ‘series’ of marks.

63 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a ‘family’ or ‘series’ of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64 As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a ‘family’ or ‘series’, the earlier trade marks which are part of that ‘family’ or ‘series’ must be present on the market.



65 Thus, contrary to what the appellant maintains, the Court of First Instance did not require proof of use as such of the earlier trade marks but only of use of a sufficient number of them as to be capable of constituting a family or series of trade marks and therefore of demonstrating that such a family or series exists for the purposes of the assessment of the likelihood of confusion.

66 It follows that, having found that there was no such use, the Court of First Instance was properly able to conclude that the Board of Appeal was entitled to disregard the arguments by which the appellant claimed the protection that could be due to ‘marks in a series’.

81. On the face of it, this is the opponent’s strongest case, since the limited distinctiveness of an element in a trade mark may be compensated for by use of multiple marks featuring the same element and construction. The applicant disputes that the opponent has a “family” of trade marks, on the basis that the consumers of the goods do not overlap for all four marks. It contends that the two marks where consumers do overlap are insufficient to constitute a “family”.<sup>20</sup>

82. As any opposition based upon s. 5(2)(b), whether based upon a “family” case or not, requires that there be some similarity between the respective goods, the opposition against “domestic fuel; domestic heating fuel; kerosene for domestic heating” must be dismissed as there is no similarity between those goods and any of the goods which may be relied upon by the opponent.

83. Further, “aviation fuel; automotive fuel; kerosene; diesel fuel; diesel oil; gasoline; fuel oil” are only similar to the goods of no more than two of the earlier marks. The other earlier marks have not been on the market in relation to similar goods and services. As two marks do not make a family, the opposition against these goods is also dismissed.

84. All of the remaining goods in the contested specification are similar to the goods of at least three of the earlier marks. Three marks are sufficient to constitute a family. However, the applicant is right that the users of aviation fuel additives are different from those of the

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<sup>20</sup> See applicant’s skeleton argument §§2.3-2.6.

goods in the other earlier specifications. I do not agree that the users of additives for motor vehicle fuel and for the fuel refining industry are different: as well as covering additives available on a retail basis, additives for motor vehicle fuel may be mixed with petrol or diesel at the refining stage, making them additives for the fuel refining industry.

85. Whether there is an overlap in users is not, however, the only consideration. “FLUID”, “PUR” and “FLUX” are descriptive or semi-descriptive words attached to the non-distinctive prefix “KERO”. I am doubtful that the average consumer would perceive “KEROCOM”, where “COM” does not have an obvious meaning related to the goods, as a part of the family. Any family of at least three marks would, therefore, be restricted to “KEROFLUID”, “KEROPUR” and “KEROFLUX” and the claim of a family of marks on the market in relation to all of the fuels remaining in issue would have to be dismissed.

86. Regardless of my view of the extent of the family expressed in the previous paragraph, the more significant issue is the presence of the marks on the market. The applicant accepts some use of the earlier marks. However, they are all EU marks and, therefore, the relevant market for assessing genuine use is the EU. The assessment of confusion must be made for the average consumer in the relevant market. In an opposition against a UK trade mark application, that is the UK market. Given the way in which the concession as to use was given at the hearing and that the question of whether the earlier marks were present on the UK market was not addressed specifically, I do not think it would be safe for me to conclude that it was accepted that the marks were present on the UK market at the relevant date.

87. The evidence of use in the UK is scant. There is a website print showing aviation fluid additives available from a UK company but it is not clearly dated within the relevant period. Moreover, it indicates that the goods are not in stock and have a lead time of 52 days: that hardly suggests significant consumer demand. None of the brochures has a named UK office, nor do they indicate any UK stockists. There is no information regarding the extent of any distribution of the brochures in the UK. The prints taken from the opponent’s website, even were they dated within the relevant period, are simply the global site in its English version, which does not assist either way in establishing that it is directed at

English speakers in the UK. The web pages are not “shop” pages where customers may buy goods and, therefore, no currency is visible. There is some evidence that “KEROPUR” products were on sale via Amazon in the UK from May 2017. However, there is no evidence at all of turnover or sales figures relating to the UK. That need not necessarily be fatal but there is in this instance little other evidence of the presence of the marks on the UK market. I accept that it is likely that some of the EU sales included sales in the UK but without any clear evidence on the point I am not prepared to find that the opponent had more than a trivial presence in the UK at the relevant date.

88. Neither the prefix “KERO” nor the earlier marks as wholes had acquired distinctiveness in the UK through use; the earlier marks have at most an average degree of inherent distinctiveness. I find that the evidence does not show that the average UK consumer has had sufficient exposure to the earlier marks that they will be caused to believe either that the non-distinctive prefix “KERO” or that prefix in combination with another descriptive word or semi-descriptive word is indicative of the goods of the opponent, as distinct from any other trader happening to use such words or combinations. There is no likelihood of confusion based upon a family of earlier trade marks, even where there is a reasonably high level of similarity between the goods. I should add that I would have drawn the same conclusion in relation to the goods which are not similar in the event that my finding of no similarity is wrong and they are similar to a low degree.

### **Conclusion**

89. The opposition has failed. The application will proceed to registration for all of the goods and services in its specification.

### **Costs**

90. The applicant has been successful and is entitled to an award of costs, which are sought on the scale. Bearing in mind that the applicant filed no evidence, I award costs to the applicant as follows:

|   |        |
|---|--------|
| Considering the notice of opposition and filing the counterstatement: | £300   |
| Considering the opponent's evidence and filing written submissions:   | £600   |
| Preparation for and attendance at hearing:                            | £600   |
| Total:  | £1,500 |

91. I order BASF SE to pay Advanced hydrocarbon Fuels Ltd the sum of **£1,500**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 5<sup>th</sup> day of August 2021**

**Heather Harrison  
For the Registrar  
The Comptroller-General**