

**O-312-17**

**TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION NO. 3146477  
BY CKL HOLDINGS N.V.  
TO REGISTER THE TRADE MARK:**

**Alexander**

**IN CLASSES 18, 20 AND 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 406934 BY MORRIS AND ALEXANDER LIMITED**

## **Background and pleadings**

1. On 27 January 2016, CKL Holdings N.V. (“the applicant”) applied to register the trade mark **Alexander** for goods in classes 18, 20 and 25. A priority date of 20 October 2015 is claimed. The application was published for opposition purposes on 8 April 2016.

2. The application is opposed by Morris and Alexander Limited (“the opponent”). The opposition was filed on 6 July 2016 and is based upon sections 5(1), 5(2)(a), 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). It is a partial opposition, directed against the following goods in the application:

Class 20      Divans; sofas; armchairs; beds; ottomans; tables; chairs; chaise longues; furniture.

3. Under ss. 5(1) and 5(2)(a), the opponent relies upon its UK trade mark registration number 2288627 for the trade mark **ALEXANDER**, which has a filing date of 20 December 2001 and for which the registration procedure was completed on 14 February 2003.

4. Under s. 5(2)(b), the opponent relies upon its earlier UK trade mark number 2288626 for the trade mark **MORRIS & ALEXANDER**, which also has a filing date of 20 December 2001. The registration procedure for this mark was completed on 2 August 2002.

5. The opponent’s trade marks are registered for goods in class 20; the specifications for both marks are identical. The opponent relies upon all of the goods in the registrations, namely:

Class 20      Apparatus for lifting, lowering, stabilising, and varying the attitude or positioning of chairs, beds, sofas and other items of furniture; all being

intended or adapted for use with or forming part of furniture; and parts and fittings for any of the aforesaid goods.

6. Given their dates of filing, the opponent's trade marks qualify as earlier marks in accordance with s. 6 of the Act. The opponent states in its Notice of Opposition that it has used its trade marks in relation to all of the goods relied upon. This statement is made because the earlier marks are subject to the proof of use provisions contained in s. 6A of the Act.

7. Under s. 5(4)(a), the opponent relies on the use throughout the UK, since 2000, of the sign **ALEXANDER** in respect of:

“Chair, bed, settee and furniture raisers and base frames being parts of furniture and parts and fittings for the aforesaid”.

8. The opponent's claims are, in essence, that:

- The trade marks are visually, aurally and conceptually identical or highly similar.
- The goods are identical or similar.
- The earlier trade marks have enhanced distinctiveness because of the use that has been made of them.
- There is a likelihood of confusion, including a likelihood of association.
- The opponent acquired goodwill in the sign prior to the date of application; the application offends under s. 5(4)(a).

9. The applicant filed a counterstatement denying the claims. It put the opponent to proof of use of the two earlier trade marks. The applicant states:

- That the opponent's “MORRIS & ALEXANDER” mark is not highly similar to the application.

- That the goods are dissimilar.
- That the “level of dissimilarity [between the goods at issue] is sufficient to offset the potentially [sic] similarities and identity between the marks” and there is no likelihood of confusion.
- “[C]onsumers will not experience a misrepresentation of the earlier mark when seeing the Subject mark” and the claim under s. 5(4)(a) should be dismissed.

10. The opponent has been represented throughout by ip21 Ltd, the applicant by Trademarkers Merkenbureau C.V. Only the opponent filed evidence; both parties filed written submissions during the evidence rounds. Whilst neither party asked to be heard, the opponent filed submissions in lieu of a hearing. I have read all of the papers carefully and I will bear both parties’ comments in mind, referring to them, as necessary, below.

## **The evidence**

### Opponent’s evidence

11. This consists of the witness statements of Philip Nixon, Debra Nixon, Alexander Nixon and Tim Edwards. As some of the evidence is repetitive or irrelevant, it is only summarised to the extent that I consider necessary.

#### *Philip Nixon’s evidence*

12. Mr Nixon’s witness statement is accompanied by four exhibits. Mr Nixon states that he is a Director of the opponent company, a position which he has held since the incorporation of the opponent on 1 August 2000. Mr Nixon states that the incorporated company was preceded by a partnership, in which he was a partner, and that the business has traded since 1998.

13. Mr Nixon states that “[t]he sales of our ALEXANDER range of products far exceed the sales of our MORRIS product range”.<sup>1</sup> He gives evidence that the opponent “has supplied in excess of 250,000 ALEXANDER individual frames and/or associated apparatus within the UK in the last 5 years alone” (the witness statement is dated 16 January 2017).<sup>2</sup> Mr Nixon states that “in 2009, just before the recession hit the UK our sales were £1.5 millionm [sic] under the ALEXANDER brand which is equivalent to a significant number of product sales”.<sup>3</sup>

14. Mr Nixon submits that the opponent’s customers include the general public, social services, the NHS and “large equipment suppliers such as Nottingham Rehab Supplies, just one example of a third party who retail the ALEXANDER Furniture Raiser to the public directly on our behalf”.<sup>4</sup> He does not provide any documentary evidence to support the claim but nor has it been challenged by the applicant.

15. At exhibit PN2, Mr Nixon exhibits price lists for each of the years 2001 to 2016. The price lists for 2001 to 2004 are headed “RETAIL PRICE LIST – UK”/“RETAIL PRICE LIST & ORDER FORM – UK”, whilst the examples from 2005 onwards are headed “PUBLIC PRICE LIST & ORDER FORM – UK”.<sup>5</sup> Each of these price lists comprises two pages. The first page contains prices (in sterling) for items identified as “ALEXANDER CHAIR/SETTEE RAISER” and “ALEXANDER BED RAISER”. There are also accessories, such as “Twin Cup Assembly” and “Angle Bracket”. The second page of the price list is an application form for VAT exemption where the goods being supplied, including the accessories, are identified by name, such as “Alexander Bed Raiser”, “Alexander Square Cup Assembly” and “Alexander Flat Plate”.

16. In addition, the same exhibit contains five price lists headed “TRADE PRICE LIST”, for 2009, 2010, 2012, 2015 and 2016, though the last of these is dated 1 July 2016 (i.e.

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<sup>1</sup> Paragraph 10.

<sup>2</sup> Paragraph 11.

<sup>3</sup> Idem.

<sup>4</sup> Paragraph 12.

<sup>5</sup> The exception is 2009, for which there is no retail/public price list.

after the relevant dates).<sup>6</sup> A range of goods are identified, including “Alexander Universal Bed Raiser” and, under the headings “CHAIR RAISERS” and “SETTEE RAISERS”, the “Alexander Universal Raiser (frame only without cups)”. Various accessories are also listed. Some of these indicate that they are “for use with Alexander products only” (pp. 24, 27) and “for Alexander Universal Raiser” (p. 35). Others indicate that they are “for use with Alexander & FDR products” (p. 32). All of the 2009-2015 trade price lists show the “Alexander Cup” for sale as a spare part.

17. Exhibit PN3 consists of patent information and design registration certificates, all in the name of Mr Nixon, which are said to be licensed to the opponent for use under the ALEXANDER brand. The patent was published in 1998 and the designs were registered in 2006.

18. Exhibit PN4 contains a list of websites said to offer for sale “our ALEXANDER product range”. There are also screen prints from amazon.co.uk, completecareshop.co.uk, essentialaids.com, nrshealthcare.co.uk, shop4support.com and valuemobility.co.uk. The goods shown on the amazon.co.uk website are headed “NRS Morris & Alexander Bed Raiser” (pp. 62-63). The nrshealthcare.co.uk web page also identifies the goods as “Morris & Alexander Universal Bed Raiser”/“Morris & Alexander Bed Raiser” (pp. 70-72). The remaining websites identify the products as “Alexander” chair or settee raisers. However, the prints are not dated, except for a 2017 copyright shown at p. 73.

#### *Debra Nixon’s evidence*

19. Ms Nixon’s witness statement is accompanied by two exhibits. Ms Nixon is the Company Secretary and Finance Director of the opponent, positions which she has held since 1 August 2000 and 1 January 2001, respectively.

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<sup>6</sup> pp. 24, 27, 32, 35 and 38.

20. Ms Nixon asserts that the opponent sells “our ALEXANDER furniture raisers to Social Services, the NHS, the general public (an increasing market) and third party suppliers who sell on to the general public”.<sup>7</sup> She states that the opponent’s total turnover reached a high point of £1.46 million in 2006 but that there has been a decline in sales since that date. She gives the following figures for sales “under the ALEXANDER Brand”:

<b>Year</b>	<b>Sales</b>	<b>% of turnover</b>	<b>No. of individual frames</b>	<b>No. of accessories</b>
<b>31.3.12</b>	£660,000	67	21,737	19,135
<b>31.3.13</b>	£683,000	69	26,732	21,441
<b>31.3.14</b>	£814,000	74	31,663	27,954
<b>31.3.15</b>	£759,000	76	30,010	28,019
<b>31.3.16</b>	£658,000	72	26,115	23,698

21. Ms Nixon also provides the following figures for advertising spend in relation to ALEXANDER for the same periods:

31.3.12	£21,278
31.3.13	£15,508
31.3.14	£9,688
31.3.15	£7,105
31.3.16	£7,408

22. Exhibit DN2 is said to contain examples of advertising under ALEXANDER and MORRIS & ALEXANDER since 2001. The documents are as follows:

- A letter to the opponent from Business Link for Norfolk, dated 31 August 2001. The letter apparently enclosed an “Export Market Strategy document”; the front page of the document is attached and is also dated August 2001.

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<sup>7</sup> Paragraph 6.

- A letter to the opponent from Southern Derbyshire Acute Hospitals NHS Trust, dated 17 September 2002. It relates to a draft report upon which the opponent has apparently commented.
- A letter dated 19 September 2002 to Coventry City Council's Social Services department. The recipient is advised "[y]ou may be interested to learn of our Alexander range, which is easy to fit and is very adaptable". The product literature referred to in the letter is not exhibited (p. 14).
- A report by the Medical Devices Agency dated October 2002 entitled "CHAIR AND BED RAISERS" (pp. 15-90). Two of the furniture raisers tested are identified as "Alexander" raisers/bed raisers (p. 72). At p. 33, the report indicates that the raisers are "suitable for most types of furniture" and that one of the raisers is for use with "single beds, chairs or recliner chairs on castors or gliders" and the other is for use with beds of different sizes.
- A promotional letter to Cheshire Social Services, dated 15 January 2003. The letter states that the opponent is a supplier of furniture raisers. The product literature which accompanied the letter is not exhibited.
- Product information about "Morris" chair, settee and bed raisers. It appears to be from a leaflet by a company called SmitCare. There is a handwritten date of 2004 at p. 92. The word "Alexander" is not present. A further example is at pp. 112-113, dated May 2012.
- An advertisement for the opponent, where "Morris & Alexander" appears at the top of the advertisement and images of furniture raisers are shown. The same advertisement appears to have been placed in *Disability Product News* (May 2006), *Disability Directory 2008*, *Able* magazine (May/June 2008), and *Disability Product News* (December 2008, February 2010). Ms Nixon provides the wording for a *Disability Product News* article in May 2008 separately, at p. 96. It refers to the "Alexander Universal Raiser" which, it states, has the "ability to raise all kinds of furniture". This article appears to be in relation to an exhibition (Naidex) in Birmingham NEC in 2008, at which the opponent had a stand.
- An article in *Disability Product News* dated May 2009 about Morris & Alexander, which appears to be in relation to the Naidex exhibition of 2009. It states that



“[p]roducts by Morris & Alexander include chair, settee and bed raisers, as well as a variety of accessories” (p. 103).

- A poster about the National Association of Equipment Providers National Conference 2009 in Blackpool. It is not clear whether the opponent attended or whether the advertisement at p. 107 (the same as in the other publications, detailed above) was distributed there.
- A poster about the Disability North Exhibition in Newcastle upon Tyne in September 2011. It is not clear whether the opponent attended, or whether the advertisement at p. 111 was circulated at the event.
- “Event preview” details of the Naidex South exhibition, scheduled for October 2012 at the ExCel exhibition centre in London. At p. 115, the “Morris & Alexander Riser Recliner Chair” is highlighted as a new product and the stand number is provided.
- An undated product page from a brochure entitled NRS Healthcare. The “Alexander Universal Chair/Settee Raiser” is offered for sale.
- Two advertisements which appear to have featured in *ABILITY NEEDS* magazine’s spring and summer 2015 editions. Both refer to the “Morris Recliner Chair Raiser”.
- An article from *The OT Magazine*, which describes the Recliner Chair Raiser by Morris & Alexander. The date is not visible.
- Advertising information for a range of the opponent’s goods, including the “Alexander® Universal Chair/Settee Raiser” (p. 127) and “Attachments for Alexander® Universal Furniture Raisers” (p. 128). However, none of the advertisements is dated.

#### *Alexander Nixon’s evidence*

23. Mr Alexander Nixon’s statement is accompanied by three exhibits. He states that he is employed in Customer Services for the opponent and that he has held the position in a full-time capacity since 2015, though he has been employed by the opponent sporadically for almost five years.

24. Exhibit AN1 consists of prints from the opponent's website showing a range of "Alexander" raisers and accessories for sale. The exhibit is not dated; it appears from the witness statement that this exhibit shows the website current at the time (the statement is dated 16 January 2017). As a consequence, it falls after the relevant period.

25. Exhibit AN2 consists of prints from the opponent's website. It shows a printing date of 29 October 2009. At p. 21 is a list of products which include the name "Alexander". The products are chair, settee and bed raisers, as well as, for example, "Alexander Angle Bracket" and "Alexander 3 Inch Square Cup". At pp. 22-27 are further details of these products, all of which feature the name "Alexander" in their title.

26. Exhibit AN3 contains prints from the opponent's website. The "last modified" date on the web pages is May 2003. At p. 31, the page shows links for "ALEXANDER RAISER" and "ALEXANDER ACCESSORIES" and at p. 32 are details of the "Alexander Armchair Raiser" and "Alexander Accessories" including brackets, cups and plates.

*Tim Edwards' evidence*

27. Mr Edwards states that he is Audit Manager in the accountancy and business advisory firm Price Bailey LLP. Mr Edwards has held his position since 1997. Mr Edwards states that his firm has acted for the opponent since 2002.<sup>8</sup>

28. Exhibit TE1 is a print from the Companies House website containing details of the opponent company. The date of incorporation is given as 1 August 2000 and its status is "Active".

29. Exhibit TE2 and TE3 contain details of the same patent as exhibited at pp. 40- 53 of PN3. Mr Edwards confirms in his witness statement that the opponent produces goods in accordance with the patent under licence from Mr Nixon.

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<sup>8</sup> Paragraph 7.

30. The applicant having filed no evidence, that concludes my summary of the evidence.

### **My approach**

31. I intend to focus, first, on the opponent's case under ss. 5(1) and 5(2)(a) for its earlier trade mark "ALEXANDER". If the opposition fails in respect of this mark, it is unlikely that the opponent will be in a better position under s. 5(2)(b) with the mark "MORRIS & ALEXANDER", which is clearly less similar to the mark applied for. I will then go on to consider the opponent's grounds under 5(4)(a), if necessary.

### **Decision**

#### **Proof of use**

32. The first issue is whether, or to what extent, the opponent has shown genuine use of the earlier mark. The relevant statutory provisions are as follows:

"Raising of relative grounds in opposition proceedings in case of non-use

6A- (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 period of five years ending with the date of publication.

(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 period of five years ending with the date of publication of the application 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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 Community 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.

(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”.

33. Section 100 of the Act is also relevant, which 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”.

34. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“217. In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch); [2013] F.S.R. 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *Pasticceria e Confetteria Sant Ambroeus Srl v G&D Restaurant Associates Ltd (SANT AMBROEUS Trade Mark)* [2010] R.P.C. 28 at [42] of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV (C-40/01)* [EU:C:2003:145]; [2003] E.T.M.R. 85, *La Mer Technology Inc v Laboratories Goemar SA (C-259/02)* [EU:C:2004:50]; [2004] E.T.M.R. 47 and *Silberquelle GmbH v Maselli-Strickmode GmbH (C-495/07)* [EU:C:2009:10]; [2009] E.T.M.R. 28 (to which I added references to *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (C-416/04 P)* [EU:C:2006:310]). I also referred at [52] to the judgment of the CJEU in *Leno Merken BV v Hagelkruis Beheer BV (C-149/11)* EU:C:2012:816; [2013] E.T.M.R. 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (C-141/13 P)* EU:C:2014:2089 and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd (O/528/15)* [2016] E.T.M.R. 8.

218. [...]

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, 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]; *Centrotherm* at [71]; *Leno* 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]; *Centrotherm* at [71]; *Leno* at [29].

(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]. 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].

(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]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(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]; *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]”.

35. In *Awareness Limited v Plymouth City Council*, Case BL O/230/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use [...]. However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public”

and further at paragraph 28:

“28. [...] I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable



only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted”.

36. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can

legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not 'show' (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use".

37. In *Laboratoire de la Mer Trade Mark* [2006] FSR 5, the Court of Appeal held that sales under the mark to the trade may qualify as genuine use. Mummery L.J. stated that:

"31. After some hesitation I have reached a different conclusion from Blackburne J. on the application of the Directive, as interpreted in *Ansul* and *La Mer* , to the rather slender facts found by Dr Trott.

32. Blackburne J. interpreted and applied the rulings of the Court of Justice as placing considerably more importance on the market in which the mark comes to the attention of *consumers and end users* of the goods than I think they in fact do. I agree with Mr Tritton that the effect of Blackburne J.'s judgment was to erect a quantitative and qualitative test for market use and market share which was not set by the Court of Justice in its rulings. The Court of Justice did not rule that the retail or end user market is the only relevant market on which a mark is used for the purpose of determining whether use of the mark is genuine.

33. Trade marks are not only used on the market in which goods bearing the mark are sold to consumers and end users. A market exists in which goods bearing the mark are sold by foreign manufacturers to importers in the United Kingdom. The goods bearing the LA MER mark were sold by Goëmar and bought by Health Scope Direct on that market in arm's length transactions. The modest amount of the quantities involved and the more restricted nature

of the import market did not prevent the use of the mark on the goods from being genuine use on the market. The Court of Justice made it clear that, provided the use was neither token nor internal, imports by a single importer could suffice for determining whether there was genuine use of the mark on the market.

34. There was some discussion at the hearing about the extent to which Goëmar was entitled to rely on its intention, purpose or motivation in the sales of the goods bearing the mark to Health Scope Direct. I do not find such factors of much assistance in deciding whether there has been genuine use. I do not understand the Court of Justice to hold that subjective factors of that kind are relevant to genuine use. What matters are the objective circumstances in which the goods bearing the mark came to be in the United Kingdom. The presence of the goods was explained, as Dr Trott found, by the UK importer buying and the French manufacturer selling quantities of the goods bearing the mark. The buying and selling of goods involving a foreign manufacturer and a UK importer is evidence of the existence of an economic market of some description for the goods delivered to the importer. The mark registered for the goods was used on *that* market. That was sufficient use for it to be genuine use on the market and in *that* market the mark was being used in accordance with its essential function. The use was real, though modest, and did not cease to be real and genuine because the extinction of the importer as the single customer in the United Kingdom prevented the onward sale of the goods into, and the use of the mark further down, the supply chain in the retail market, in which the mark would come to the attention of consumers and end users”.

38. Neuberger L.J. (as he then was) stated that:

“48. I turn to the suggestion, which appears to have found favour with the judge, that in order to be “genuine”, the use of the mark has to be such as to

be communicated to the ultimate consumers of the goods to which it is used. Although it has some attraction, I can see no warrant for such a requirement, whether in the words of the directive, the jurisprudence of the European Court, or in principle. Of course, the more limited the use of the mark in terms of the person or persons to whom it is communicated, the more doubtful any tribunal may be as to whether the use is genuine as opposed to token. However, once the mark is communicated to a third party in such a way as can be said to be “consistent with the essential function of a trademark” as explained in [36] and [37] of the judgment in *Ansul*, it appears to me that genuine use for the purpose of the directive will be established.

49. A wholesale purchaser of goods bearing a particular trademark will, at least on the face of it, be relying upon the mark as a badge of origin just as much as a consumer who purchases such goods from a wholesaler. The fact that the wholesaler may be attracted by the mark because he believes that the consumer will be attracted by the mark does not call into question the fact that the mark is performing its essential function as between the producer and the wholesaler”.

39. The relevant period for proving use is 9 April 2011 to 8 April 2016.

40. There are certainly weaknesses in the opponent’s evidence. None of the website prints is dated within the relevant period. Given the stated turnover, it is surprising that there are no invoices or comparable documents to show orders and sales. However, Ms Nixon has given unchallenged evidence regarding the number of items sold under the mark “ALEXANDER”, along with the opponent’s sales figures under that mark. The latter are consistently in excess of £650,000 for the financial years ending 2012 to 2016. It is not clear whether those sales were to wholesalers, retailers or directly to the end users, though, as the case law above indicates, that is not fatal. There is evidence, in the form of both public and trade price lists, that a range of items were offered for sale under the mark “ALEXANDER”/“Alexander” throughout the relevant period.

41. Advertising material is exhibited, although I note that the majority of it pre-dates the relevant period. The evidence does not explicitly state that the opponent either attended or had its products displayed at two trade fairs in the relevant period (Disability North in Newcastle in September 2011 and Naidex in London in 2012), or that the goods promoted were under “ALEXANDER”/“Alexander”. However, taking into account the totality of the evidence, which suggests that the opponent attended similar exhibitions in 2009, and which shows just two brands (“Morris” and “Alexander”), it seems more likely than not that that was the case. I also bear in mind that the decreasing advertising expenditure over the relevant period and the absence of printed advertising material in the relevant period is partly explained by Ms Nixon, when she states that “[w]hilst we continue to distribute brochures and leaflets, the majority of our communications when not via word-of-mouth are now digital with our website [www.morrisandalexander.com](http://www.morrisandalexander.com) being the heart of this process”.<sup>9</sup> Ms Nixon’s evidence regarding advertising spend in relation to the “ALEXANDER” mark is also unchallenged. Taking the evidence as a whole, as I must,<sup>10</sup> my view is that the opponent has provided evidence of sales which, while not overwhelming, is sufficient to constitute genuine use in the relevant period.

42. There is evidence that the opponent has used the mark “Alexander”/“ALEXANDER” in word-only form in its price lists in the relevant period. The mark is registered in upper case but the use in the form “Alexander” falls within fair and notional use, which would permit the use of title case. The use of “Alexander” is, from this perspective, acceptable. I find that the use as shown is use of the mark as registered, upon which the opponent is entitled to rely.

#### *Fair specification*

43. The next step is to decide whether the opponent’s use entitles it to rely on all of the goods for which it is registered. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK)*

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<sup>9</sup> Paragraph 9.

<sup>10</sup> See the comments of Mr Geoffrey Hobbs QC, sitting as the Appointed Person in *Brandconcern BV v Scooters India Limited (“Lambretta”)* BL O/065/14.

*Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law 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”.

44. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46".

45. Ms Nixon admits in her evidence that "we do not ourselves sell items of furniture to which our furniture raisers are attached".<sup>11</sup> That is borne out by the evidence: there is nothing to suggest that the opponent has used the mark on or in relation to items of furniture themselves, or indeed that it has sold goods (for example, to furniture manufacturers) which are component parts of furniture. What the evidence shows is that the mark has been used on or in relation to chair, settee/sofa and bed raisers. There is also evidence that the opponent sells various parts and accessories to be used with its raisers. These parts and fittings allow the raiser to accommodate a range of different shapes and types of furniture. The base frames themselves are telescopic and would not be limited to use on chairs, settees and beds but would accommodate, for example, chaises longues, ottomans and pouffes. I note that at least one product sold under the mark is advertised as a "universal" raiser and that one bed raiser is height-adjustable. In

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<sup>11</sup> Paragraph 12.

those circumstances, I think it would be overly restrictive to limit the specification upon which the opponent may rely to chair, bed and settee raisers, as they would not be perceived by the average consumer as in substance different from raisers for other types of furniture, including those listed above. Accordingly, I consider that the opponent may rely upon “apparatus for lifting, lowering, stabilising, and varying the attitude or positioning of chairs, beds, sofas and other items of furniture; all being intended or adapted for use with furniture; and parts and fittings for the aforesaid goods”.

Sections 5(1) and 5(2)(a)

46. The opposition under the trade mark “ALEXANDER” is based upon ss. 5(1) and 5(2)(a) of the Act, which read as follows:

“5.—(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because—

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

(b) [...]

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



## **Comparison of trade marks**

47. The applicant has not admitted that the opponent's mark is identical to the application. However, the applicant has also neither denied that the marks are identical nor provided any submissions to explain why the marks should not be considered identical.

48. The marks in question are "ALEXANDER" and "Alexander". They are both the same word, with the only difference being the case used to present them. Notional and fair use of either mark would include use in upper case, title case or lower case. There is, therefore, no difference between them. If there were any doubt on that point, the Court of Justice of the European Union ("CJEU") held in *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, that:

"54 [...] a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer".

49. Even if I am wrong regarding the use of upper and lower case, I consider that the differences between the marks inherent in their respective cases are so insignificant that they may go unnoticed by the average consumer. As a consequence, the marks may still be considered identical.

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

50. It is necessary for me to determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the

average consumer's level of attention is likely to vary according to the category of goods in question: *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.*, Case C-342/97.

51. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

52. The opponent submits that the users will be both members of the public and “medical professionals, and councils responsible for medical and care facilities a subset of the general public having a far greater attention to detail and fastidious in their specialist requirements”.<sup>12</sup>

53. The applicant submits that “it is obvious and clear that the products of the Opponent are aimed at a much smaller market than the goods of the Applicant” and that they will be sold “in highly specialized stores, or even solely on specialist websites”.<sup>13</sup>

54. I consider that the average consumer for the goods in question will be either a member of the public or a professional user. I do not accept that the opponent’s goods are restricted to the professional user only: it would not be unreasonable to expect that members of the public will wish to purchase such equipment on their own behalf.

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<sup>12</sup> Submissions dated 16 January 2017, paragraph 3.

<sup>13</sup> Submissions, paragraph 4.

55. The goods are likely to be offered for sale in bricks and mortar retail environments, such as furniture shops and specialist independent living shops, as well as their online equivalents. It is also possible that the goods will be purchased following the inspection of product details in catalogues and brochures, or that the marks will be encountered in print advertisements or on signage in physical shops. The purchase is, therefore, likely to be primarily visual, though word of mouth recommendation or discussion with sales representatives (particularly for the professional user) may play a part, so I do not discount that there may be an aural component.

56. The cost of furniture may vary across the category; the opponent's goods are not terribly expensive. In purchasing the goods at issue, the average consumer is likely to be concerned about a number of factors, such as cost, comfort and functionality. Since furniture raisers are likely to be used by those with injury or infirmity, the consumer will wish to ensure that they are suitable and safe. I consider that the goods at issue are likely to be purchased with an above average degree of attention.

### **Comparison of goods**

57. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, 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”.

58. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

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

59. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

60. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

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

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

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

whilst on the other hand:

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

62. In addition, I bear in mind the guidance given by Mr Alexander in the same case, where he warned against applying too rigid a test when considering complementarity:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may

think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston”.

63. The opponent has made conflicting submissions, on the one hand admitting that the goods are not identical but, on the other hand, claiming that all of the goods at issue constitute “furniture”.<sup>14</sup> Notwithstanding the opponent’s submissions to the contrary, the various articles of furniture in the specification applied for are plainly not the same as the equipment in the opponent’s specification.

64. The goods in question differ in both nature and purpose. However, as the users of both parties’ goods include the general public, there is an overlap in this regard. In addition, the applicant’s goods are not restricted in any way and could include goods which are already adapted to assist mobility, such as riser recliner chairs. I therefore see no reason why the goods would not reach the market through the same channels, as both could equally be sold in general furniture shops or in shops which specialise in furniture and aids for independent living. There may be a degree of competition between the goods, as furniture raisers could be purchased as an alternative to adapted furniture. The goods are also complementary, as raisers for furniture must by their very nature be used with furniture. I consider that the relationship between the goods is of the type where the average consumer may assume that responsibility lies with the same undertaking. The goods are similar to a fairly low (i.e. between low and medium) degree.

65. The wording of the Act clearly requires the goods to be identical in order for an opposition under s. 5(1) to succeed. I have found that the goods are not identical and

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<sup>14</sup> Submissions dated 16 January 2017, paragraph 2, and submissions dated 25 April 2017, paragraphs 2-5, respectively.

the opposition under s. 5(1) is hereby dismissed. I continue with the objection under s. 5(2)(a).

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

66. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In *Lloyd Schuhfabrik*, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the

relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)".

67. Invented words usually have the highest degree of distinctive character, while words which are descriptive of the goods normally have the lowest. Distinctiveness can be enhanced through use of the mark. The opponent has claimed that the distinctiveness of its mark has been enhanced through use, so that it is highly distinctive. I have no specific submissions from the applicant on the point. The evidence of use filed by the opponent does indicate a not insignificant turnover in the period 2011-2016. However, I have not been provided with figures showing the size of the market in the goods at issue or the market share enjoyed by goods sold under the earlier mark. There is also little in the way of advertising material for the relevant period. On the basis of the evidence provided, I am not in a position to determine that the earlier mark has an enhanced distinctive character in relation to the goods at issue in class 20.

68. Turning to the inherent position, I bear in mind that, whilst neither descriptive nor allusive of the goods, the earlier mark is a fairly common name. As a consequence, while not inherently highly distinctive, the earlier mark has an average degree of inherent distinctive character.

### **Likelihood of confusion**

69. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]) and I must make a global assessment of the competing factors (*Sabel BV v Puma AG*, Case C-251/95, at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. 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* at [26]). Confusion can be direct (where the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related).

70. The marks are identical and the earlier mark enjoys an average degree of (inherent) distinctive character. Those are factors in the opponent's favour. In the applicant's favour is that the goods are only similar to a fairly low degree and the average consumer will pay a higher than average degree of attention during the purchasing process. This is important because the interdependency principle means that a lower degree of similarity between the goods can be sufficient to offset a high degree of similarity between the marks. However, taking all of the competing factors into account, I come to the view that this is a case in which the identity between the marks is not offset by a lesser degree of similarity between the goods. Although the goods are not similar to a particularly high degree, there is sufficient similarity, bearing in mind the use in the same general field and the complementary relationship between the goods, that the average consumer will assume that the goods are from the same stable. There is a likelihood of confusion.

71. The opponent would be in no better a position under s. 5(2)(b) in respect of its "MORRIS & ALEXANDER" mark, given that its specification goes no wider and the mark itself is less similar to the application than the mark considered above. I do not consider it proportionate or necessary to consider the opponent's case under s. 5(2)(b).

### **Section 5(4)(a)**

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

"A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

73. Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously

expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

74. Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
  
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
  
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
  
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
  
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action”.

75. I will deal with this ground only briefly. Whilst it is not always the case, a successful finding under s. 5(2) will often signify a successful finding under s. 5(4)(a). In this case, I am satisfied that the opponent’s business has the requisite goodwill in respect of the mark considered above. It is identical to the mark applied for. The assessment of the goods is very similar. I come to the view that, for reasons similar to those given under s. 5(2)(a), misrepresentation will occur, causing damage. The ground under s. 5(4)(a) succeeds.

## Conclusion

76. The opposition has succeeded in full. Subject to any appeal, the application will be refused for the opposed goods, namely:

Class 20 Divans; sofas; armchairs; beds; ottomans; tables; chairs; chaise longues; furniture.

## Costs

77. The opponent has been successful and is entitled to a contribution towards its costs. Only the opponent filed evidence. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Using the above TPN as a guide but bearing in mind my comments, above, I award costs to the opponent on the following basis:

Official fees	£200
Preparing the Notice of Opposition and considering the counterstatement:	£200
Preparing and filing evidence	£300
Written submissions:	£300
<b>Total:</b>	<b>£1,000</b>

78. I order CKL Holdings N.V. to pay Morris and Alexander Limited the sum of **£1,000**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 7th day of July 2017**

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