

O-718-18

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3267499

BY ENGIE REGENERATION LIMITED

TO REGISTER THE FOLLOWING TRADE MARK:

Canvas Lifestyle (Retirement Living)

IN CLASSES 19, 36, 37, 42, 43 AND 44

AND

OPPOSITION THERETO UNDER NO. 600000816

BY JAMES MOTTRAM

Background and pleadings

1. On 01 November 2017, ENGIE Regeneration Limited (“the applicant”) filed trade mark application number UK00003267499 for the mark above, for the following goods and services:

Class 19: Buildings, not of metal.

Class 36: Residential real estate agency services; rental of homes; rental of apartments; letting of flats; management of apartments.

Class 37: Construction of houses; building refurbishment services; building; property development services (construction); maintenance of buildings; repair of buildings.

Class 42: Architectural design services; design of buildings; design services for the interior of buildings; planning and design of residential communities.

Class 43: Retirement homes; homes for the elderly (retirement).

Class 44: Nursing homes; rest homes.

2. The application was accepted and published for opposition purposes on 12 January 2018. James Mottram (“the opponent”) opposes the application under section 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”), relying upon UK Trade mark (“UKTM”) registration 3262705, the pertinent details of which are as follows:

Mark: Canvas Homes

Filing date: 11 October 2017

Date of registration: 19 January 2018

A list of the goods and services covered by the specification can be found in **Annex A**.

3. By virtue of having a filing date that predates the filing date of the contested mark, the opponent's UKTM qualifies, under section 6 of the Act, as an earlier mark for the purposes of these proceedings. As the earlier mark completed its registration procedure less than five years before the publication of the contested mark, it is not subject to the proof of use provisions set out in section 6A of the Act. The consequence of this is that the opponent is entitled to rely upon all of the goods and services for which its earlier mark is registered.

4. The opponent claims that the applied for mark is either identical or similar to its earlier mark and is applied for for identical or similar goods and services, leading to a likelihood of confusion. In its notice of opposition, the opponent stated that it only opposes some of the goods and services in the application: classes 19, 37, 42 and 43.

5. The applicant filed a counterstatement in which it denies that the goods and services applied for are similar to those covered by the earlier mark and denies that there exists a likelihood of confusion.

6. The opponent has used the fast track procedure for this opposition.

7. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013/2235, disapplied paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008 but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.

8. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

9. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings

requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

10. Neither party requested a hearing and only the opponent filed written submissions. I therefore make this decision following a careful review of all the papers on file.

11. In addition to this opposition (no. 600000818), the opponent has filed two further oppositions (no. 600000817 and no. 600000816) against two other applications made by the applicant. All three oppositions will be decided and issued separately.

12. The applicant is represented by Ward Hadaway Solicitors. The opponent is represented by Rebian Solicitors.

The correct approach

The opponent's submissions

13. The opponent has not opposed the registration of the applied for mark in classes 36 and 44. However, in its written submissions, the opponent makes an assessment of those services and draws conclusions as to whether, and to what extent they should be registered. Contrary to the opponent's understanding, I am not required to conduct an assessment of the similarity of the class 36 or class 44 services with the earlier mark's goods/services as they were not opposed at the outset and no subsequent request has been made by the opponent to amend its pleadings. I will say no more about this submission.

The applicant's submissions

14. The applicant makes submissions in its counterstatement relating to the validity of the opponent's earlier mark and suggests how this opposition should be dealt with. Before going any further, it is necessary to explain why, as a matter of law, these points will have no bearing on the outcome of this opposition:

- i. The Applicant is the owner of earlier rights in CANVAS HOMES and CANVAS LIFESTYLE and intends to issue an application for invalidity against the Opponent's registered trade mark number 3262705, upon which the opposition is based

Section 72 of the Act provides that registration shall be taken as *prima facie* evidence of the validity of a registered mark. The applicant has not sought to invalidate the earlier trade mark on the basis of a claim to an earlier common law right. Consequently, the opponent's trade mark must be regarded as a validly registered mark. In this situation the law requires priority to be determined according to the filing dates of the applications for registration. This means that the opponent's mark has priority and a likelihood of confusion between the marks based on their notional use will be enough to justify the refusal of the applicant's later filed trade mark.

Tribunal Practice Notice ("TPN") 4/2009 is titled "*Trade mark opposition and invalidation proceedings – defences*" and is also relevant to these proceedings. Under the heading "*The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker's mark*", the following is stated:

“4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that

earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark."

That is the case here. In these proceedings, the opponent's mark has priority as the earlier registered mark and, as the applicant has not sought to invalidate the earlier mark, any claim that the opponent's earlier mark should be declared invalid is not relevant to the matter before me.

- ii. Upon filing the application for invalidity referred to above, the Applicant will request that the invalidity application should be consolidated with the current opposition and dealt with at the same time, so that the outcome of this opposition should not be determined until the outcome of the invalidity application.

At the date of the issuing of this decision, no such application has been received. Consequently, I will not say any more about these submissions.

Decision

Section 5(2)(a)

15. Section 5(2)(a) of the Act is as follows:

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

(a) it is identical with an earlier mark and is to be registered for goods or services 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."

16. Firstly, I must consider whether the respective marks are identical. In *S.A. Société LTJ Diffusion v Sadas Vertbaudet SA*¹, the Court of Justice of the European Union (“CJEU”) held that:

“54. A sign is identical with the trade mark when 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.”

17. It is self-evident that ‘Canvas Homes’ in the earlier mark is not identical to ‘Canvas Lifestyle (Retirement Living)’ in the applied for mark. The marks share the first word ‘Canvas’ but the earlier mark is followed by ‘Homes’, while the applied for mark follows ‘Canvas’ with ‘Lifestyle (Retirement Living)’. These clearly are differences which are not so insignificant that they would go unnoticed by the average consumer. The opponent’s case fails under section 5(2)(a).

Section 5(2)(b)

18. Section 5(2)(b) of the Act states that:

“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.”

¹ Case C-291/00

The principles

19. The following principles are gleaned from the judgment of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V*, Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L.Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(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 the 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.

Comparison of goods and services

20. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*², that, even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“29. In addition, the goods can be considered as identical when the goods designated by the earlier trade mark are included in a more general category, designated by trade mark application (Case T-388/00 *Insitut fur Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

² Case T-133/05

21. When making the comparison of goods and services, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer*³ is also relevant. 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.”

22. Guidance on this issue has also come from Jacob J in the *Treat*⁴ case, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (a) The respective users of the respective goods or services;
- (b) The physical nature of the goods or acts of service;
- (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.

23. I also bear in mind the Appointed Person’s comments in *Separode Trade Mark*⁵:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the

³ Case C-39/97

⁴ [1996] R.P.C 281

⁵ BL O-399-10

extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

24. In relation to establishing whether the goods may be regarded as ‘complementary’, I bear in mind *Kurt Hesse v OHIM*⁶, in which the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. I also bear in mind *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)*⁷, in which the 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.”

25. In its notice of opposition, the opponent submitted, in relation to the goods and services at issue, that the applicant and the opponent operate within the same industry. However, in its written submissions, the opponent submits:

“6.2.20 The likelihood of confusion is all the greater because both the Trade Mark and Proposed Mark are essentially registered within the same classes; namely:

Class 19 Building materials (non-metallic); non-metallic rigid pipes for building; asphalt; pitch and bitumen; non-metallic transportable buildings; monuments, not of metal

Class 37 Building construction; repair; installation services

⁶ Case C-50/15 P

⁷ Case T-325/06. See also *Sanco SA v OHIM*, Case T-249/11.

Class 42 Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software

Class 43 Services for providing food and drink; temporary accommodation.”

26. These submissions by the opponent are neither a list of the applicant's goods and services nor the opponent's goods and services. As a consequence, they do not assist me in reaching a decision on this point.

27. The applicant, in its counterstatement, denied that the goods and services applied for are identical or similar to the goods and services in the opponent's specification.

The applicant's goods in class 19

28. Whilst *buildings, not of metal* in the applicant's specification are not identical to any of the goods/services in the opponent's specification, there is a possibility of similarity between the parties' class 19 goods. The opponent's class 19 goods, which are *construction elements of plastic; construction elements of timber; construction materials of artificial stone; construction materials of natural stone; construction materials, not of metal; construction timber and constructional components of reinforced cement mortar*, are at least some of the materials used to build non-metal buildings. The physical nature of the goods in question differs in that one is a completed building and the other consists of the building components individually. However, there may be some overlap between the users, uses and nature of the respective goods. A consumer could purchase, for example, a non-metal building in a 'flat-pack' form which needs to be put together or they may purchase the non-metal construction materials with which to construct such a building, so there is some degree of competition between the goods. They are also complementary to the extent that non-metal construction materials will be necessary to build a non-metal building, though there is nothing before me to suggest that these goods are routinely provided

by the same undertaking. Overall, I find the parties' class 19 goods to be similar to a medium degree.

The applicant's services in class 37

29. The applicant has the following terms in its specification:

Construction of houses; building; building refurbishment services; maintenance of buildings; repair of buildings.

30. The same terms are included in the opponent's specification. These are clearly identical services.

31. In accordance with *Meric*, *construction of property* in the opponent's specification falls within the scope of *property development services (construction)* in the applicant's specification.

32. Accordingly, the parties' services in class 37 are identical.

The applicant's services in class 42

33. The GC's comments in *Meric* are also relevant here in that the services are not worded identically but may fall within the scope of one another.

(i) *'Architectural design services'*.

I understand architecture to be the designing and constructing of buildings. Therefore, I am of the view that *'architectural design services'* in the applicant's specification relates solely to the design of buildings rather than the construction as well. *'Development of land (architectural services relating to the-)'* in the opponent's specification refers, more generally, to architecture in relation to the development of land. Developing land may include the construction of buildings. I am of the view that *'architectural design services'* in the applicant's specification falls within the scope of *'development of land (architectural services relating to the-)'* in the opponent's specification. I find that these services are identical.

(ii) *'Design of buildings' and 'design services for the interior of buildings'*.

The opponent's specification includes *'house design'*, which may include the exterior and/or interior of a house. I find that *'house design'* in the opponent's specification falls within the scope of *'design of buildings'* or *'design services for the interior of buildings'* in the applicant's specification. These services are identical.

(iii) *'Planning and design of residential communities'*.

Since residential communities fall within the scope of the development of land, I find that *'planning and design of residential communities'* is included within *'architectural services relating to the development of land'*, *'construction planning'* and *'construction design'* in the opponent's specification. These services are identical.

34. In conclusion, the parties' services in class 42 are identical.

The applicant's services in class 43

35. *'Retirement homes'* and *'homes for the elderly (retirement)'* in the applicant's specification are identical to *'Homes (Retirement-)'* in the opponent's specification.

The average consumer and the nature of the purchasing act

36. It is necessary for me to determine who the average consumer is for the respective parties' goods and services. 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.”

37. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer’s level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*⁸.

38. The opponent submits that the average consumer “will typically be an individual with the financial means to purchase a property, but one from the public at large”. The applicant has not commented on who, in its view, the average consumer would be.

39. In making a finding with regard to the average consumer of the goods and services at issue, I must consider the specification as registered. The specification is not just for a property, it also covers a variety of construction materials and a wide range of services relating to real estate, construction, architecture, design and advisory services. Some of these goods and services will be highly specialist, whilst others will be less so. Accordingly, I conclude that the average consumer may be a member of the general public or a professional.

40. The nature of the purchase is likely to be primarily visual though I do not rule out an aural element. The consumer may encounter the goods and services online, via a catalogue, at a trade fair or via a salesman. Some of the goods and services are expensive and infrequent and may require months of tendering and meetings before a choice is made, demanding a relatively high level of attention. In addition, some of the goods purchased by members of the public from builders’ merchants or DIY stores will require a lower level of attention to be paid to the purchase. The purchasing process is likely to be reasonably well considered given that the choice, in each case, is an important one and the goods and services (despite varying significantly in cost) are, on the whole, relatively expensive and purchased infrequently. I find that, taking all of these factors into account, the level of care and consideration that will be adopted during the purchasing process would vary from average to high.

⁸ Case C-342/97

Comparison of marks

41. It is clear from *Sabel BV v Puma AG* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to their overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

43. The trade marks to be compared are as follows:

Earlier mark	Applied for mark
Canvas Homes	Canvas Lifestyle (Retirement Living)

Overall impression

44. Both the applicant’s mark and the opponent’s mark are plain word marks. The opponent’s mark consists of the plain words ‘Canvas’ and ‘Homes’. ‘Homes’ is descriptive for the majority of the goods and services for which the earlier mark is

registered. Consequently, the word 'Canvas' plays the greatest role in the overall impression of the opponent's mark.

45. The applicant's mark consists of the plain words 'Canvas' and 'Lifestyle', followed by the plain words 'Retirement Living' contained within brackets. 'Lifestyle' is not descriptive of the goods and services for which the application is registered. However, it is allusive of the way in which a person lives and, therefore, I find it to have a lower than average degree of distinctive character in relation to the goods and services at issue. The words 'Retirement Living' in brackets at the end of the applicant's mark are descriptive for the majority of the goods and services. The word 'Canvas' plays the greatest role in the overall impression of the applicant's mark.

Visual comparison

46. Visually, the similarity rests in the first word in both marks, which is the word 'Canvas' and is identical. The differences between the two marks are the second words ('Homes' in the earlier mark and 'Lifestyle' in the applied for mark) and the addition of a third and fourth word, contained within brackets, in the applicant's mark: '(Retirement Living)'. Overall, I consider there to be a low degree of visual similarity between the marks.

Aural comparison

47. Both marks begin with the word 'Canvas', which will be pronounced identically as CAN-VASS. The opponent's mark includes the additional word 'Homes', the applicant's has three additional words, 'Lifestyle' and 'Retirement Living'. The applicant's mark is considerably longer being nine syllables in total, the first two of which are in common with the first two in the opponent's mark. I am of the view that the average consumer is unlikely to articulate 'Retirement Living' in the applicants mark and shorten the mark to 'Canvas Lifestyle', resulting in a medium degree of aural similarity between the marks. In the alternative, if the average consumer does articulate the applicant's mark in full, I would find a low degree of aural similarity between the marks.

Conceptual comparison

48. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgements of the GC and the CJEU including *Ruiz Picasso v OHIM*⁹. The assessment must be made from the point of view of the average consumer.

49. Whilst neither the opponent nor the applicant have offered submissions explaining the concept of their respective marks, I am of the view that the concept represented by the word 'Canvas' in both the opposed mark and the earlier mark will be the same. Canvas is an ordinary dictionary word which will be known to the average consumer as a heavy duty fabric or material often used to make items or as a surface for painting. This concept will be immediately grasped by the average consumer. The additional words 'Homes' in the earlier mark and 'Lifestyle' and 'Retirement Living' in the applicant's mark will be understood as either descriptive or allusive of the goods/services at issue. The conceptual message in these marks rests primarily in the word 'Canvas' which will be given the same meaning in both marks. There is a high degree of conceptual similarity between the marks.

Distinctive character of the earlier trade mark

50. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, the greater the likelihood of confusion (see *Sabel BV v Puma AG*, paragraph 24). 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-

⁹ [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

108/97 and C-109/97 *Windsurfing Chiemsee 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).”

51. As no evidence has been filed by the opponent, I have only the inherent distinctiveness of the earlier mark, ‘Canvas Homes’, to consider. ‘Canvas’ is an ordinary dictionary word which will be known to the average consumer and is not descriptive or allusive of the goods and services. ‘Homes’ is descriptive for the majority of the goods and services for which the earlier mark is registered. In its totality, I find the earlier mark to possess an average degree of inherent distinctive character.

Likelihood of confusion

52. 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* 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]).

53. *Kurt Geiger v A-List Corporate Limited*¹⁰ is also relevant. Mr Iain Purvis Q.C., as the Appointed Person, pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

54. There are two types of confusion that I must consider. The difference between them was explained by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*¹¹:

“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 recognised 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

¹⁰ BL O/075/13

¹¹ BL O/375/10

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'."

55. The marks are visually similar to a low degree, aurally similar to a medium degree (or aurally similar to a low degree where the average consumer articulates the applicant's mark in full) and conceptually highly similar. The differences in the marks are such that there will not be direct confusion. However, despite the differences, the distinctive character of both marks rests primarily in the word Canvas and this is the common element. The logical conclusion of this is that the average consumer will, considering the similarity between the goods and services, think they are economically linked undertakings.

Conclusion

56. There is a likelihood of indirect confusion.

57. The opposition to the application was directed only at some of the goods and services for which registration is sought. With that in mind, the opposition succeeds in relation to the following goods and services:

Class 19: Buildings, not of metal.

Class 37: Construction of houses; building refurbishment services; building; property development services (construction); maintenance of buildings; repair of buildings.

Class 42: Architectural design services; design of buildings; design services for the interior of buildings; planning and design of residential communities.

Class 43: Retirement homes; homes for the elderly (retirement).

58. The application will proceed to registration for:

Class 36: Residential real estate agency services; rental of homes; rental of apartments; letting of flats; management of apartments.

Class 44: Nursing homes; rest homes.

Costs

59. As the opponent has been successful it is entitled to a contribution towards its costs. As per paragraph 11 above, the opponent has filed three related oppositions, which are being decided separately. However, the opponent has filed three sets of identical written submissions and, therefore, costs will be apportioned accordingly. Awards of costs are governed by Annex A of Tribunal Practice Notice (“TPN”) 2/2016. For fast track opposition proceedings, costs are capped at £500, excluding the official fee. Using TPN 2/2016 as a guide, and bearing in mind my comments regarding the written submissions, I award costs to the opponent on the following basis:

Official fee:	£100
Preparing a statement and considering the other side’s statement:	£100
Written submissions:	£100 ¹²
Total:	£300

60. I order ENGIE Regeneration Limited to pay James Mottram the sum of **£300**. 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.

¹² This represents a third of the award of the submissions for which I consider £300 to be appropriate.

Dated this 13th day of November 2018

Emily Venables

For the Registrar,

The Comptroller-General

Annex A

Goods and services covered by the Opponent's mark

Class 19: Construction elements of plastic; Construction elements of timber; Construction materials of artificial stone; Construction materials of natural stone; Construction materials, not of metal; Construction timber; Constructional components of reinforced cement mortar.

Class 37: Advisory services relating to asphaltting; Advisory services relating to building demolition; Advisory services relating to building refurbishment; Advisory services relating to excavating; Advisory services relating to pipe laying; Advisory services relating to surfacing projects; Advisory services relating to the alteration of buildings; Advisory services relating to the installation of building automation equipment; Advisory services relating to the installation of fixings; Advisory services relating to the maintenance of buildings; Advisory services relating to the renovation of property; Advisory services relating to the repair of buildings; Advisory services relating to the repair of civil engineering structures; Assembling [installation] of building framework; Assembly of prefabricated houses; Bricklaying; Building; Building consultancy; Building consultancy services; Building damp-proofing; Building demolition; Building insulating; Building insulation; Building maintenance; Building maintenance and repair; Building maintenance and repair services provided by a handyman; Building of apartment buildings; Building of bridges; Building of canal locks; Building of commercial properties; Building of factories; Building of fair stalls and shops; Building of foundations; Building of hospitals; Building of houses; Building of industrial properties; Building of motorway networks; Building of multi-storey car parks; Building of naval vessels; Building of offices; Building of railways; Building of roads; Building of schools; Building of shops; Building of underground structures; Building refurbishment services; Building reinforcing; Building repair; Building repair and renovation; Building repairs; Building restoration; Building sealing; Building sealing and caulking services; Building services; Building services relating to building for habitation; Building services relating to building for industry purposes; Buildings (Cleaning of -) [exterior surface]; Buildings (Cleaning of -) [interior]; Buildings (Construction of -); Buildings (Damp-proofing of -) during construction; Buildings (Fire-

proofing of -) during construction; Buildings (Insulation of -) during construction; Buildings (Insulation to existing -); Buildings (Renovation of -); Buildings (Restoration of -); Buildings (Sealing of -) during construction; Buildings (Supervision during construction of -); Buildings (Waterproofing of -) during construction; Civil construction services; Civil engineering construction; Civil engineering [construction] consultancy; Civil engineering demolition; Civil engineering maintenance involving the use of hydromechanical cutting equipment; Civil engineering relating to agricultural land; Civil engineering relating to rural land; Civil engineering relating to the prevention of inundation of buildings by flood water; Civil engineering relating to the prevention of inundation of land by flood water; Constructing [erecting and glazing] conservatories; Construction (Information relating to -); Construction advisory services; Construction consultancy; Construction consultation; Construction information; Construction land developing; Construction management [supervision]; Construction management services; Construction of airports; Construction of bridges; Construction of buildings; Construction of buildings and other structures; Construction of carriageways; Construction of ceilings; Construction of chimneys; Construction of civil engineering structures by forming concrete; Construction of civil engineering structures by laying concrete; Construction of civil engineering structures by pouring concrete; Construction of civil engineering works; Construction of complexes for business; Construction of complexes for recreational purposes; Construction of complexes for sports purposes; Construction of conservatories and greenhouses; Construction of cubicles; Construction of curtain walls; Construction of diaphragm walls; Construction of drainage systems; Construction of exploitation pipelines; Construction of exploitation platforms; Construction of factories; Construction of floors; Construction of foundations for bridges; Construction of foundations for buildings; Construction of foundations for civil engineering structures; Construction of foundations for roads; Construction of galleries; Construction of greenhouses; Construction of harbours; Construction of hard-standing areas; Construction of holiday accommodation; Construction of house extensions; Construction of houses; Construction of industrial furnaces; Construction of interior accommodation; Construction of kitchens; Construction of leisure complexes; Construction of medical establishments; Construction of motorways; Construction of nuclear boilers; Construction of nuclear power plants; Construction of nuclear reactors; Construction of partition walls for interiors; Construction of partitioning; Construction of partitions; Construction of parts

of buildings; Construction of paths; Construction of piles; Construction of pipelines; Construction of ports; Construction of power plants; Construction of pre-fabricated houses for hippopotami; Construction of property; Construction of prospecting pipelines; Construction of prospecting platforms; Construction of public facilities; Construction of public works; Construction of railway roadbeds; Construction of railways; Construction of ramparts; Construction of residential properties; Construction of roads; Construction of rural works; Construction of saunas; Construction of screens; Construction of sewerage systems; Construction of sports arenas; Construction of sports fields; Construction of sports grounds; Construction of stables; Construction of staircases of wood; Construction; Construction of steel fabrications; Construction of steel structures for buildings; Construction of swimming-pool complexes; Construction of telecommunication towers; Construction of tunnels; Construction of underground galleries; Construction of underground shafts; Construction of underground transport networks; Construction of walls; Construction of wave energy power plants; Construction of wind power plants; Construction project management services; Construction services; Construction supervision; Construction supervision of buildings; Construction supervision of civil engineering projects; Construction works for prefabricated houses; Advisory services relating to building construction; Advisory services relating to the construction of buildings; Advisory services relating to the construction of public works; Beneath ground construction work relating to cabling; Beneath ground construction work relating to drain laying; Beneath ground construction work relating to foundation laying; Beneath ground construction work relating to gas supply mains; Beneath ground construction work relating to gas supply pipes; Beneath ground construction work relating to pipework; Beneath ground construction work relating to plumbing; Beneath ground construction work relating to sewers; Beneath ground construction work relating to water supply mains; Beneath ground construction work relating to water supply pipes; Beneath ground construction work relating to wiring; Building and construction services; Building construction; Building construction advisory services; Building construction and demolition services; Building construction and repair; Building construction consultancy; Building construction services; Building construction supervision; Building construction supervision services for building projects; Building construction supervision services for real estate projects; Building inspection [in the course of building construction];

Building, construction and demolition; Development of land [construction]; House building.

Class 42: Construction design; Construction drafting; Construction draughting; Construction planning; Development of construction projects; Development of land (Architectural services relating to the -); Development of software; Development services relating to virtual reality software; House design; House design services; House plans (Drawing-up of -).

Class 43: Houses (Boarding -); Homes (Retirement -).