

O-116-19

TRADE MARKS ACT 1994

IN THE MATTER OF:

TRADE MARK APPLICATION No. 3254584

BY FURNITURE 2 INSPIRE LIMITED

TO REGISTER THE FOLLOWING SERIES OF TWO TRADE MARKS

IN CLASS 35

HomeFurnitureLand

HOMEFURNITURELAND

AND

OPPOSITION THERETO (NO. 410952)

BY FURNITURE VILLAGE LIMITED

Background and pleadings

1) On 5 September 2017, Furniture 2 Inspire Limited ('the applicant') applied to register the series of two trade marks HomeFurnitureLand and HOMEFURNITURELAND in the UK. It was accepted and published in the Trade Marks Journal on 22 September 2017 in respect of the following services:

Class 35: Retail services connected with the sale of furniture; The bringing together, for the benefit of others, of a variety of goods, namely furniture, enabling customers to conveniently view and purchase those goods.

Furniture Village Limited ('the opponent') opposes the trade mark on the basis of sections 3(6) and 5(2)(b) of the Trade Marks Act 1994 ('the Act').

2) The section 5(2)(b) claim is based on two of its earlier UK trade mark registrations. Pertinent details of the registrations are as follows:

UK TM: 1550700

Mark: FURNITURELAND

Date of filing: 15 October 1993

Date of entry in the register: 17 February 1995

Goods: Class 20: *Furniture; all included in Class 20.*

UK TM: 2573522

Mark: FURNITURELAND

Date of filing: 25 February 2011

Date of entry in register: 3 June 2011

Goods and services

Class 20: Furniture; mirrors; picture frames; goods of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics; beds; sofa beds; mattresses; bed heads; bed bases; bed frames; bedsteads; bedding; divan sets, namely, beds comprising a base and mattress; pillows; ornaments; cushions; fittings for curtains; parts and fittings for all the aforesaid goods.

Class 35¹: The bringing together, for the benefit of others, of a variety of furniture, beds, sofa beds, bed heads, bed bases, bed frames, bedsteads, divan sets, namely, beds comprising a base and mattress enabling customers to conveniently view and purchase those goods in a retail furniture store or by means of telecommunications; the bringing together, for the benefit of others, of a variety of furniture, furnishings, beds enabling customers to conveniently view and purchase those goods in via the Internet and other communications networks.

The opponent argues that the respective goods/services are identical or similar and since the marks “differ only in the addition of the word ‘HOME’ to the sign for which registration is sought” there is a likelihood of confusion.

3) The bad faith claim under section 3(6) of the Act is set out as follows:

“The Applicant made its application for the sign ‘HOMEFURNITURELAND’ (the “Sign”) in full knowledge of the trade mark registrations of which the Opponent is the proprietor (the “Marks”), which are relied on in this opposition. By letter dated 3 July 2017, the Opponent complained about the use of the Sign by the Applicant and threatened to sue the Applicant for infringement of the Marks.

The Applicant did not make the application until after this letter and so did so in full knowledge of the Marks and the fact that the Opponent asserts the use of the Sign amounts to infringement of the Marks.

By letter dated 12 October 2017, the Applicant admitted that the purpose of the application was to provide a defence to infringement under section 11(1) of the Trade Marks Act 1994. It appears therefore that the purpose of the application was to frustrate efforts by the Opponent to protect its brand under the Marks, requiring it to incur further expense in the process.

Furthermore, the earlier of the Marks has been registered since 1993 and has been in continuous use nationwide since prior to that time.

¹ The class 35 services include further services but these are the ones that the opponent seeks to rely upon.

In the circumstances the application was not made in accordance with honest business practices and the Opponent requests that the application be refused under section 3(6) of the Trade Marks Act 1994.”

4) The applicant filed a counterstatement denying the claims made and requesting that the opponent provides proof of use of the earlier trade mark registrations relied upon.

5) The applicant claims that “The Applicant’s use of its Mark since about 2007 gives rise to a defence of honest concurrent use”. It states that “The Opponent has been aware of the use being made of the Applicant’s Mark since at least 2011, at which point the trade mark attorneys for the Opponent stated that “our client will immediately sue any third party should they begin to use the HOME FURNITURE LAND sign [...]”. No such litigation was commenced and no further complaint was raised until the Opponent’s solicitor’s letter of 3 July 2017, over six years later”. The applicant therefore claims that the opponent is “barred” from objecting to the application since it has acquiesced and the unreasonable delay in bringing proceedings established a defence of laches.

6) In relation to the opponent’s bad faith claim, the applicant states that there have not been any instances of confusion and that it has acted in the bona fide belief that it was entitled to apply for a trade mark registration.

7) Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. A hearing took place via video-link on 5 December 2018 with Mr Pearson of Downing IP Limited representing the applicant and Mr Muir Wood of counsel, instructed by Bracher Rawlins LLP, representing the opponent.

Evidence


Opponent’s evidence

8) The opponent’s evidence-in-chief consists of a witness statement from Mr Eamon Wynne who is the Director of Operations for the opponent, a position he has held since

1 October 2017. Prior to this he held various directorships with the opponent since January 2004.

9) Mr Wynne sets out the history of the opponent whereby Finaware Limited was incorporated in 1973 then changed its name to Furnitureland Limited in 1986. On 3 March 2006 the opponent's trade mark registration number 1550700 was assigned from Furnitureland Limited to the opponent². Furnitureland Limited was subsequently dissolved on 22 June 2010. On 7 January 2011 the opponent "set in train the relaunch of the FURNITURELAND trade mark in relation to furniture and retail services relating thereto and on 15 February 2011, the domain name www.furnitureland.uk.com was registered...³". He goes on to state that the "FURNITURELAND business went live on 25 March 2011". Since then he claims that the opponent has sold a wide range of furniture products under the FURNITURELAND trade mark, including living room furniture, dining room furniture and bedroom furniture.

10) Mr Wynne states that the opponent is "a leading furniture retailer in the United Kingdom, which trades through both physical stores and its successful online website at www.furniturevillage.co.uk. The first 'Furniture Village' store was opened in 1989 and, since this date, the company has grown to 52 stores throughout the United Kingdom" and that "The core products offered by FV are sofas, chairs, dining furniture, beds, bedroom furniture, occasional furniture and office furniture." He goes on to state that its goods are sold online via its websites www.furniturevillage.co.uk and www.furnitureland.uk.com, and in its Furniture Village stores (Furniture Village being a "collection of niche shops under one roof"). He states that the www.furnitureland.uk.com website has been in continuous operation since 25 March 2011. Exhibit K to the witness statement consists of print outs from the websites which Mr Wynne claims to be dated 31 January 2013. The print outs are not clear so I cannot see the date but I can see reference to the furnitureland collection which appears with

the following device  ("red house device") directly to the right, various pictures of furniture and the prices being shown in sterling. The second website print out is largely

² Exhibit D comprises a deed of assignment evidencing the transfer and exhibit E consists of a printout from the UK IPO website confirming recordal of the assignment.

³ Exhibit F is a Whois' record for the domain name.

the same. Further website print outs are provided under exhibits L and M which Mr Wynne states are dated March 2015 and April 2018 (after the relevant period) respectively. They show various items of furniture such as wardrobes, chairs, sideboards, etc with prices in sterling. Each of the website prints show that the various Furnitureland collections are sold via the Furniture Village website.

11) In April 2012 the opponent launched the FURNITURELAND collection of furniture in 39 of its stores located throughout England and by the time that the witness statement had been executed the goods were sold in all 52 stores. He states that the goods offered in store “consist of a broad selection of distinct products (such as tables, chairs, cupboards, sideboards, display units, bookcases, mirrors, wine racks, bedsteads, wardrobes, etc.)”.

12) In terms of turnover, Mr Wynne states “that sales of furniture products under the FURNITURELAND trade [mark] since September 2012 are as follows”:

Period	Total (inc. VAT)
Sept – Dec 2012	£927,219
2013	£3,435,588
2014	£2,315,204
2015	£2,804,398
2016	£2,631,608
2017	£3,208,152
Jan – Apr 2018	£1,379,762

13) Mr Wynne then provides the numbers of items sold in each calendar month under the FURNITURELAND trade marks in the UK since September 2013. I shall not duplicate the table here but the number of items sold run into the thousands.

14) Exhibit I to the witness statement consists of product information stands which are placed in-store to promote the FURNITURELAND branded products. They include a document dated 31 January 2013 which is headed ‘Furnitureland’ (word) above the

words 'Oak Collection Lyon Bedstead' with a sale price of £699. A further example, dated 30 January 2013 is as follows:

New Orleans
from Furnitureland

Do not be deceived by the compactness of New Orleans as it is the perfect solution, given it extends to sit up to 8 people. Finished in a fantastic warm finish created from solid and veneered oak with a choice of chairs, this is a casual dining experience exclusive to Furniture Village.

furnitureland 

On show -	Suggested Retail Price	Sale Price
2 Door sideboard	£1199	£699
Small extending table	£799	£599
Loom chair laminated leather	£269	£159
Standard chair laminated leather	£169	£129
Also available -		
Bookcase	£1395	£799
Large sideboard	£1399	£799
Large extending table	£1209	£699

15) Exhibit T to the witness statement consists of 17 advertisements placed between January 2013 and August 2013 in the following newspapers: The Times, the Mail on Sunday, the Daily Weekend Magazine, the Daily Telegraph, the Daily Star, the Daily Mail, the Daily Express, the Sun and the Mirror. The total cost of the advertisements is in the tens of thousands. The advertisements themselves all follow the same theme insofar that they appear as an advertisement placed by Furniture Village which include four or five other branded articles of furniture, including "furnitureland" with the red house device. The goods being offered under this mark are dining tables and chairs. Once again, the copies of the advertisements are not particularly clear.

16) Mr Wynne details further advertisements placed throughout 2015, spring of 2016 and autumn 2017⁴ in the Radio Times, Guardian, Telegraph, Sunday Times, Saga, House and Garden, Good Homes, Sainsburys, Mail on Sunday and the Express. The advertisement costs are in the tens of thousands and follow the same theme as the newspaper publications, i.e. Furniture Village appear as the retailer selling the furnitureland (plus house device) dining room table and chairs.

17) Mr Wynne then states that the opponent produced 1 million catalogues in October 2012 with 250,000 sent directly to previous customers, 500,000 distributed with You

⁴ Exhibit U to the witness statement

Magazine and 250,000 handed out in store. 6 million copies of the January 2013 catalogue were produced with 5.5 million distributed via national press publications, 250,000 sent to previous customers and the remaining 250,000 handed out in store. 500,000 copies of the Autumn 2013 catalogue were produced, and for Christmas 2013 4 million copies were produced, 6 million produced for Winter 2013/2014 and 500,000 copies of the Spring 2014 catalogue. Exhibit N consists of extracts from the October 2012, exhibit O are from January 2013 and exhibit P are a selection of extracts from the remaining catalogues listed above. They show use of the FURNITURELAND mark together with the red house device used in relation to dining tables and chairs plus beds. The images are not particularly clear but you can see the mark and the goods.

18) Mr Wynne claims that the total cost of producing and distributing the six catalogues detailed above was £2,383,886 and “I estimate that the cost attributable to FURNITURELAND products was £61,386”.

19) Exhibit Q to the witness statement consists of a schedule identifying further brochures produced during the period Summer 2015 to Spring 2018 which include furniture products provided under the FURNITURELAND trade marks. There are 12 brochures on the schedule with many of them being printed millions of times, costing hundreds of thousands of pounds. Examples of the furnitureland mark (with the red house device) appear in the brochures as follows:



ARLINGTON Extending table and 4 chairs.
Was £649 **SAVE £100 Sale £549**

dinner party time

PROVENCE Extending table and 4 chairs. Was £995 SAVE £300

sale £695

Style menu
Whether you want to throw dinner parties, or just eat as a family, you're sure to find your perfect dining set at furniturevillage.co.uk/dining

COMPTON DINING

"Extremely helpful staff - prompt delivery and good quality product."

feefo[®]
Independent reviews

furnitureland

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20) Large proportions of the rest of the witness statement refer to sales and promotional activities between 2000 and 2005 which is at least seven years prior to the commencement of the relevant period. This is a sufficiently long period before the relevant period that it has little evidential value in assessing the position at the time I must consider. Therefore, I shall not review these parts of the evidence.

21) Finally, Mr Wynne refers to the applicant's counterstatement whereby it refers to other users of signs similar to the sign 'FURNITURELAND'. To this end, Mr Wynne states:

- a) The opponent has reached an agreement with JB Global Limited in respect of its use of the sign 'OAK FURNITURELAND', the terms of which are confidential;
- b) The opponent has been since 2010 and remains engaged in ongoing domain name and trade mark disputes with Furnitureland.co.uk about its use of the sign 'FURNITURELAND',

⁵ The following statement appears at the foot of the print out "Was' is the price at which these goods have been offered from 1 – 28 June 2015 in all Furniture Village stores and online"

- c) The opponent has taken action in respect of the use of the sign 'DIRECTFURNITURELAND'; by Your Home Direct limited, which has since been dissolved.

Applicant's evidence

22) Mr Dhatt is a director of the applicant. He states that he began retailing furniture in 1993 via a retail store in Shrewsbury under the name Creative Collection. In February 2011 Mr Dhatt saw an advertisement in the local furniture magazine ("The Cabinet Maker") that CH Enterprises Ltd, an SME on-line furniture business, had gone into administration. The business had operated 4 websites, Home Furniture Land, ClickOak.co.uk, Click-Bathroom.co.uk and CH-Enterprises.co.uk. They also sold via eBay and Amazon.

23) Mr Dhatt states that in April 2011 he purchased (via the administrators) the IP of CH Enterprises Ltd 'including the trade marks and trading names, domain names, goodwill and websites as a package'. No stock was purchased. He then states that "In the course of the insolvency of CH Enterprises Ltd and my purchase of its intellectual property, Furniture Village Limited contacted the liquidator on 3 February 2011 to assert their trade mark rights". Exhibit SSD2 to the witness statement is effectively a cease and desist email from Mr Ben Britter of Keltie (a firm of patent and trade mark attorneys) to "Helen E. Fyles" dated 3 February 2011 stating that the opponent was the proprietor of trade mark registration number 2401897 (FURNITURELAND) and that:

"We have advised our client that the supply of retail services (online or otherwise) relating to furniture under the HOME FURNITURE LAND sign constitutes an infringement of its UK Trade Mark Registration No. 2401897 under inter alia Section 10(2)(b) of the Trade Marks Act 1994."

24) Mr Britter, on behalf of the opponent, then states 1) "the sign HOME FURNITURE LAND is highly similar to our client's FURNITURELAND trade mark"⁶, 2) "the services

⁶ Exhibit SSD2

provided by your client under this sign are identical and highly similar to the goods and services covered by UK Trade Mark Registration No. 2401897” and therefore there is a likelihood of confusion. In view of this “we require your client to cease and desist from using the HOME FURNITURE LAND sign in connection with furniture goods or retail services relating thereto”. It was also requested that the applicant “transfer the ownership of the www.homefurnitureland.co.uk domain to our client.”

25) Mr Dhatt then states at paragraph 12 of his witness statement that:

“The liquidator responded on 4 February 2011 to note that she had “received an offer from a third party purchaser for the intellectual property of the Company, including its web domains” and inviting Furniture Village to make a better offer. Furniture Village responded later that day, declining the invitation and warning that they “will immediately sue any third party should they begin to use the HOME FURNITURE LAND sign in a manner which infringes its own rights”. I note that no such litigation has ever commenced, and none was threatened until they wrote to my company on 3 July 2017, over six years later.”

Turnover

26) Mr Dhatt states that the sales turnover achieved has been as follows:

Year	Sales turnover
2011	£80,236.88
2012	£378,981.83
2013	£235,096.14
2014	£225,434.00
2015	£426,033.18
2016	£407,174.10
2017	£421,473.93

27) Mr Dhatt makes various criticisms of the opponent’s website. Exhibit SSD4 to the witness statement relates to the website traffic for the opponent’s furnitureland.uk.com

as reported by SEM Rush (Mr Dhatt does not state who this company is but it reasonable to infer that they monitor and report on website usage). Mr Dhatt states that the report shows that “After an initial modest interest of circa 150 visitors per month was expressed after the site was set up (between 2011-2014), there has been substantially no activity over the last 4½ years or so.” The same report also shows the level of traffic for www.furniturevillage.co.uk/brands/furnitureland “shows a total of ten visits over a period of one month” which compared to the total traffic for the Furniture Village website as being around 570,000 visits per month. Mr Dhatt argues that “This suggests that the “Furnitureland” brand is buried so deep within the website, it is simply not being found or seen and cannot be credited with any significant sales.”⁷

28) A further criticism raised by Mr Dhatt is the website’s lack of functionality. He demonstrates this by filing a number of historic screen captures from the opponent’s www.furnitureland.uk.com website obtained through the “Way Back Machine”. Mr Dhatt refers to a screen capture print dated 21 March 2011 stating that it “is notable that the site does not allow online purchase, merely having a link at the upper right that says “Ready to buy? Ask us to call you”⁸. Mr Dhatt states that by 11 April 2011 the site contained two new links, “Order Online” and “Request a call back”. However, Mr Dhatt highlights that both links point to the same “Call back” location. He states that the position was still the same on 13 January 2014, the earliest available capture date within the last 5 years. In view of this, Mr Dhatt argues that there is not and has never been a function to purchase items via the website.

29) Exhibit SSD8 to the witness statement comprises a number of screen shots from the website www.furniturevillage.co.uk They are not dated, save for the date that they were printed: 24 May 2018. Mr Dhatt states that the ‘furnitureland’ brand is at sub-sub category page level and on the fourth tier. Therefore, Mr Dhatt claims that he cannot see how the opponent can claim that sales were generated by the opponent through this website.

⁷ Paragraph 26 of the witness statement

⁸ Paragraph 29 of the witness statement

30) In relation to the physical stores, Mr Dhatt states that he visited a store in Telford and took a series of photographs⁹ showing what he believes to be a typical customer experience. The photographs show the front of the store (the opponent's mark not being present), the lobby of the store, and various sections of the store. Of the 35 photographs two include the furnitureland mark (with the red house device) which promotes its California range of goods, such as dining tables, chairs, sideboards and a bed frame. Mr Dhatt states that he also visited the Furniture Village store in Wednesbury and he found it to be substantially the same as the Telford branch. Exhibit SSD10 to the witness statement is a copy of the leaflet available to Telford customers, which includes reference to the furnitureland mark with the red house device.

31) Mr Dhatt then details third-party use of the mark FURNITURELAND, which includes use of OAK FURNITURELAND and the domain names www.furnitureland.co.uk and www.directfurnitureland.co.uk. The opponent's evidence includes statements that confirm it has an agreement with the proprietor of "OAKFURNITURELAND" and there is an ongoing dispute with "DIRECTFURNITURLEAND", therefore the third-party use referred to by Mr Dhatt is not relevant.

32) The rest of the statement contains various submissions criticising the opponent's evidence, arguments relating to likelihood of confusion and bad faith. I have read these and shall keep them in mind.

Opponent's evidence in reply

33) Mr Wynne's second witness statement is intended to counter some of the arguments raised by Mr Dhatt.

34) Exhibit V to the witness statement consists of various extracts from the opponent's website. The majority of the extracts are undated, save for the date of printing (28 August 2018), though some have been obtained from the Wayback Machine. It is noted that on the left-hand side of some of the extracts, one of the options, under the

⁹ Exhibit SSD9

heading “brands”, is “furnitureland”. The extract dated 3 June 2017 includes reference to “Furnitureland dining table and chairs”. A copy is duplicated below:

The screenshot shows a web browser window with the address bar containing `http://www.furniturevillage.co.uk/`. The page header includes a 'Go' button and a calendar showing the date '03 JUN 2017'. Below the header, there are two red buttons: 'Shop offers' and 'Shop bedroom'. The main content area is titled 'Our sale top picks' and features three product listings:

Product Name	Original Price	Current Price	Savings
Moreno Fabric Recliner Corner Sofa	£1735	£1295	£540
Furnitureland Provence Extending Oak Table & 4 Chairs	£995	£695	£300
Silentnight Mirapocket Serenity 2000 Memory Half Ottoman Divan Set	£799	£219	£580

Additional promotional text for each item includes 'Extra Sale Offer £1195' for the sofa, 'Stock Clearance Price £695' for the dining table, and 'Extra Sale Offer £639' for the bed set.

35) A further example dated 31 March 2016 is as follows:



Sign up for news and offers and receive your
£25 welcome voucher*

Enter email address [No thanks](#)

*Your £25 voucher is redeemable at any Furniture Village store or online for six weeks from the date of receipt. £250 minimum spend required. Not valid in conjunction with any other offer.

By submitting your email, you are also agreeing to receive our latest exclusive offers, vouchers and interior trends. You are also agreeing to our terms and conditions which can be found [here](#)

Early bird offers

			
<small>Apoth Leather 1 Seater Sofa EARLY BIRD PRICE £349</small>	<small>Furnitureland Provence Dining Table and 4 Chairs EARLY BIRD PRICE £595</small>	<small>Athena 2 Seater Recliner Sofa SALE PRICE £1,245</small>	<small>Hygrox Revere Deluxe Cotton King Size Duvet Set EARLY BIRD PRICE £495</small>

36) The remaining exhibits are either undated or after the relevant period. That completes my summary of the evidence to the extent I feel necessary.

Proof of use

37) The first issue is whether, or to what extent, the applicant has shown genuine use of its earlier marks. The relevant statutory provisions for proof of use in opposition proceedings are as follows:

“Section 6A: 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 European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(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.”

38) Section 100 of the Act states that:

“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.”

Case law

39) What constitutes genuine use has been subject to a number of judgments. 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. *The law with respect to genuine use* . In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439 , Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has

issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and 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).

218. An important preliminary point to which Prof Annand draws attention in her decision is that, whereas the English versions of Articles 10(1) and 12(1) of the Directive and Articles 15(1) and 51(1)(a) of the Regulation use the word “genuine”, other language versions use words which convey a somewhat different connotation: for example, “ernsthaf” (German), “efectivo” (Spanish), “sérieux” (French), “effettivo” (Italian), “normaal” (Dutch) and “sério/séria” (Portuguese). As the Court of Justice noted in *Ansul* at [35], there is a similar difference in language in what is now recital (9) of the Directive.

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 Radetzky-Orden v Bundesvereinigung Kameradschaft 'Feldmarschall Radetzky'* [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].”

40) Essentially, the case law states that proven use of the earlier mark which fails to establish “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

Relevant period

41) The relevant period is the five-year period ending on the date of publication of the application being opposed. Consequently, since the application was published on 22 September 2017, the relevant period under these provisions is 23 September 2012 to 22 September 2017.

Form of the mark

42) In *Colloiseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union (“CJEU”) found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1). (emphasis added)

43) The General Court’s (“GC”) judgment in *Castellblanch SA v OHIM, Champagne Louis Roederer SA* [2006] ETMR 61 is a further acceptable example of a registered mark being used in conjunction with another mark.

44) In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under s.46(2) of the Act as follows:

"33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

45) Although this case was decided before the judgment of the CJEU in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

46) Notional and fair use of the opponent's earlier marks will include use in any standard typeface and so differences created by capitalisation are not relevant. The applicant argues that the opponent's evidence shows that primary use of the mark is in one of the following variant forms. It argues that both of these variant forms alter the distinctive character of the opponent's mark to the extent that they do not qualify as use for the purposes of assessing genuine use under section 6A. More specifically, the applicant argues that "in each case the prefix or suffix or other distinguishing word or feature added to the word FURNITURELAND (in O's case, the colour, font, house device, or house device with slogan) sets those marks apart in the eyes of the average consumer...".



47) There are many examples of furnitureland (word) being used without the red house device and/or the slogan. Such use in itself would be sufficient to establish genuine use of the mark. However, I am of the view that use of furnitureland in conjunction with the red house device would nevertheless be considered to be genuine use as per the criteria set out in *Colloseum*. Further, use in conjunction with the house device and the non-distinctive promotional slogan beneath furnitureland is also considered to be genuine use.

Sufficient use

48) The applicant argues that the opponent's use of the mark is token, on a low scale and infrequent. Therefore, it argues that the opponent has failed to demonstrate that it has demonstrated genuine use of its earlier marks.

49) More specifically, it refers to the applicant's evidence which demonstrates that in its initial stages the opponent's website only had 150 visitors per month and for the last 4½ years there was no activity at all. Further, the website was not functional and customers were unable to purchase products from it. Therefore, it argues that the website is merely a placeholder, consistent with a strategy solely to preserve the rights conferred by the opponent's registrations.

50) The applicant also argues that the opponent's claimed use on the website www.furniturevillage.co.uk is so difficult to find (fourth tier sub-sub category level) that it is highly unlikely that consumers would be exposed to the opponent's mark. In fact, Mr Dhatt's evidence indicates that it has around "ten visits over a period of one

month”¹⁰. During the hearing Mr Pearson referred to it as a “*Where’s Wally?*”¹¹ exercise.

51) An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.¹²

52) As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.

53) The opponent’s evidence does include turnover figures for the period 2012 to 2017 ranging from one to three million per annum as a result of tens of thousands of items sold per month. During the hearing Mr Pearson stated that these sales figures may also be for sales made under the Furniture Village brand rather than all being attributable to the FURNITURELAND brand. The witness statement states that the turnover figures are for “sales of furniture products under the FURNITURELAND trade since September 2012¹³”. This statement has not been challenged and there is no evidence to the contrary. Notwithstanding this, the evidence also clearly demonstrates advertising and promotion of the mark through national press, plus millions of catalogues being produced and circulated. Therefore, whilst I acknowledge that the sales may not be through its own website (due to the lack of functionality) or through furniture village’s website, I find that when taking the evidence as a whole it creates a picture that there has been genuine use of the mark by the opponent during the relevant period.

¹⁰ Paragraph 26 of the witness statement

¹¹ *Where’s Wally?* Is a British series of children’s books whereby the reader is challenged with finding Wally, identifiable by his red and white striped shirt, hat and glasses.

¹² *New Yorker SHK Jeans GmbH & Co KG v OHIM, T-415/09*

¹³ Paragraph 30 of Mr Wynne’s statement

Fair specification

54) I must now consider whether, or the extent to which, the evidence shows use for all of the relied upon goods and services. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) 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.”

55) 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."

56) The earlier registrations relied upon cover the following goods and services:

Class 20: Furniture; mirrors; picture frames; goods of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics; beds; sofa beds; mattresses; bed heads; bed bases; bed frames; bedsteads; bedding; divan sets, namely, beds comprising a base and mattress; pillows; ornaments; cushions; fittings for curtains; parts and fittings for all the aforesaid goods.

Class 35: The bringing together, for the benefit of others, of a variety of furniture, beds, sofa beds, bed heads, bed bases, bed frames, bedsteads, divan sets, namely, beds comprising a base and mattress enabling customers to conveniently view and purchase those goods in a retail furniture store or by means of telecommunications; the bringing together, for the benefit of others, of a variety of furniture, furnishings, beds enabling customers to conveniently

view and purchase those goods in via the Internet and other communications networks.

57) The evidence includes numerous references to the advertising of dining tables and chairs, sideboards and beds (national press publications, catalogues and product information stands placed in-store). There are also examples of additional items (such as mirrors, coffee tables, wardrobes and bookcases) but as highlighted by the applicant the picture quality of the some of the evidence is not clear and some of the exhibits are not dated. Notwithstanding this, it is clear that the opponent has demonstrated use for class 20 *dining tables and chairs, sideboards and beds*.

58) The position is less clear with regard to the opponent's class 35 services. During the hearing Mr Muir Wood made reference to the opponent's Furniture Village website¹⁴ which lists Furnitureland as being one of its "brands" which when following the link leads to further products under sold this brand. This indicates the FURNITURELAND is a brand retailed by the opponent under it's Furniture Village brand. I acknowledge that the evidence does include reference to various collections, such as Oak Collection and "New Orleans from Furnitureland" but I do not consider this to be retailing of furniture or the bringing together for the benefit of others of furniture. Further, I refer to the following guidance from Mr Daniel Alexander Q.C., sitting as the Appointed Person, in *Awareness Limited v Plymouth City Council*, Case BL O/236/13 whereby he stated the following and conclude that the opponent has failed to demonstrate genuine use of its earlier registrations for the services they cover.

"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

¹⁴ Exhibit V to the witness statement

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.”

59) In view of the above, I consider that a fair specification for the earlier mark is: Class 20: *Dining tables and chairs; sideboards; beds.*

DECISION

60) Section 5(2)(b) of the Act is as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

The case-law

61) The following principles are gleaned from the decisions 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 C-3/03, *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.

The principles

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

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

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

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

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

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

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

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

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

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

(k) if the association between the marks creates a risk that the public might 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

62) In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

63) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) 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;
- (f) 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.

64) 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 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”.

65) 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-0-255-13:

“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.”

66) 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.

67) In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

68) In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services

for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are 'similar' to goods are not clear cut."

69) The respective goods and services are as follows:

Applicant's services	Earlier goods
Class 35: <i>Retail services connected with the sale of furniture; The bringing together, for the benefit of others, of a variety of goods, namely furniture, enabling customers to conveniently view and purchase those goods.</i>	Class 20: <i>Dining tables and chairs; sideboards; beds.</i>

70) The earlier goods are all items of furniture, the retail of which is covered by the applicant's list of services. Retailers of furniture are sometimes also the party responsible for the goods themselves. It follows that the goods covered by class 20 of the contested mark and the services covered by the earlier mark are 'complementary' in the sense described in the case law. Further, the respective goods in class 20 and services in class 35 are usually directed to the same types of consumers. There is therefore a low to medium degree of similarity between the applicant's goods in class 20 and the opponent's services.

Comparison of marks

71) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The

CJEU stated at paragraph 34 of its judgment in 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.”

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

73) The respective trade marks are shown below:

Application (series of two)	Earlier mark
HomeFurnitureLand HOMEFURNITURELAND	FURNITURELAND

74) The application is a series of two with the only minor difference between them being capitalised H, F and L. Nothing turns on this. Each mark in the series includes the words HOME, FURNITURE and LAND which are conjoined. When marks comprise of conjoined words, consumers will naturally dissect the words into ones that it recognises. In other words, the average consumer would view the mark as three separate words Home, Furniture and Land conjoined. It is in the combination of these words where its overall impression rests.

75) The earlier mark consists of the words FURNITURE and LAND which are conjoined. As stated above, consumers will naturally dissect the mark into the words

FURNITURE and LAND. It is in this combination of words that its overall impression rests.

76) Visually, the applicant argues that the marks are different lengths and “the addition of the word HOME is an important distinguishing feature”. Therefore, they are not similar. The opponent argues that “the single syllable short prefix ‘HOME’ will not create a markedly different visual impression. As a result, it is submitted that the Signs and the Mark are visually similar to a high degree”. The respective marks coincide with the conjoined words FURNITURE and LAND. They only differ insofar that the application begins with the word Home/HOME. Therefore, I am more inclined to agree with the opponent, though I consider the degree of visual similarity to be medium.

77) Aurally, the opponent argues that the “The single syllable short prefix ‘HOME’ will not make a marked change to the aural difference between the Signs and the Mark”. The applicant argues that the marks are not aurally similar. I consider there to be a medium degree of aural similarity between the marks.

78) Conceptually, the applicant argues that “The word HOME excludes the concept of other furniture, such as commercial office furniture, and thus there is a conceptual difference between the marks.” The opponent argues that “the Mark (FURNITURELAND) itself is unusual, being a concatenation of the words ‘FURNITURE’ and ‘LAND’ to create a word without a dictionary meaning but which would be recognised to mean a place relating to furniture.” I am in agreement with the opponent. Use of the word/s “HOMEFURNITURE” and “FURNITURE” followed by “LAND”, in my view, create the concept of a place which relates to furniture and home furniture. This impression is created by virtue of the use of the word FURNITURE (or HOME FURNITURE) following by the word LAND. Therefore, I find that the respective marks are conceptually similar to a medium degree.

Average consumer and the purchasing act

79) 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 or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

80) 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.”

81) The goods and services at issue are ordinary goods/services which relate to furniture. Therefore, the average consumer is likely to be a member of the public who is in the market for furniture. Such items are not an everyday purchase so it is likely that the average consumer will pay a higher than an average degree of attention when selecting the goods, though I do not consider it to be high.

82) All of the goods and services in question will normally be selected by the consumer either in a retail outlet, online or from a catalogue. The selection process will therefore be predominately visual since consumers will purchase the goods based on look. However, I do not ignore the potential for aural use of the marks during the purchasing process, and aural considerations will not be ignored in my analysis.

Distinctive character of the earlier trade mark

83) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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-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).”

84) The opponent does not claim to have an enhanced degree of distinctive character by virtue of the use made of the mark. Even if it had claimed enhanced distinctiveness, the evidence does not support such a claim.

85) In view of the above, I only have the inherent distinctive character to consider. The opponent argues that, from an inherent perspective, the earlier mark has at least a reasonable or above average degree of inherent distinctiveness. This is on the basis that “it is a concatenation of two words leading to a made-up word which, whilst it implies a place relating to furniture, has no dictionary meaning¹⁵”.

86) The applicant has the opposite view in that it claims that the earlier mark has little or no distinctive character. It claims that the earlier mark comprises two ordinary English words, neither of which dominate the other, and when combined, they are descriptive. More specifically, Mr Pearson argued that FURNITURE is clearly

¹⁵ Paragraph 60 of the skeleton argument

descriptive, and stated that “Land’ is colloquial. It is well known to be used as a word that means a place you go to to find whatever it is that is there; in this case furniture, preceded by the thing that is in that place.”

87) In *Formula One Licensing BV v OHIM*, Case C-196/11P, the CJEU found that:

“41.it is not possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack of distinctive character, provided by Article 7(1)(b) of Regulation No 40/94 and Article 3(1)(b) of Directives 89/104 and 2008/95. In this respect, it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43. However, as the appellant rightly points out, their verification has limits.

44. Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii).”

88) I am in general agreement with Mr Pearson’s argument, however not to the extent that it is descriptive and devoid of distinctive character. Bearing in mind the guidance provided by the *F1* case above, whilst the combination of FURNITURE and LAND is not strikingly distinctive, it is an unusual combination and it has a low degree of inherent distinctive character.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

89) Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. Confusion can be direct (when 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). To determine whether there is a likelihood of confusion I now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the factors I set out in paragraph [enter paragraph number].

90) I have found that the respective goods and services are similar to a low to medium degree. I have found the marks to be aurally, visually and conceptually similar to a medium degree.

91) The average consumer is the general public who will purchase the goods or seek the services following a visual inspection, though I do not discount aural recommendations. The level of attention paid when purchasing the goods will be higher than average but not high. I have also found that the earlier mark has a low degree of distinctive character which has not been enhanced by virtue of the use made of it.

92) Given the presence of the word HOME at the beginning of the application, and even taking into account imperfect recollection, I do not consider there to be a likelihood of direct confusion, i.e. I find that consumers will not mistake one mark for the other.

93) With regard to indirect confusion, I take into account the comments made in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Mr Iain Purvis Q.C., as the Appointed Person:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are

very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually 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 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.

94) I am also mindful of the comments made by Mr James Mellor Q.C., as the Appointed Person, in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, whereby he stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

95) Mr Muir Wood argued at the hearing that there will be indirect confusion since the addition of the word HOME is simply the addition of a non-distinctive element, such as light, express, worldwide or mini, and this will lead the average consumer to conclude that the sign is another brand owned by the opponent. Mr Pearson argues that indirect confusion does not arise since the earlier mark must be strikingly distinctive, either inherently or through use. He effectively echoes the approach stressed by Mr Mellor Q.C. in *Duebros*.

96) Taking all of the factors listed above into account, I find that there is a likelihood of indirect confusion. The average consumer would regard the inclusion of the descriptive word HOME to be merely qualifying the word FURNITURE and when used in conjunction with LAND, as HOMEFURNITURELAND, it would be considered a brand extension (for home furniture). The inclusion of the word HOME in the application is not sufficient to counter the impression created by the combination of FURNITURE and LAND, even when comparing goods against services.

97) This constitutes a likelihood of indirect confusion. The opposition under section 5(2)(b) succeeds.

DEFENCES

98) Having concluded that the opponent has succeeded in its section 5(2)(b) ground opposition, I will consider whether any of the defences relied upon by the applicant apply. As outlined above, the applicant seeks to rely upon a number of defences to its application due to its honest concurrent use of the mark and that the opponent is “barred” from objecting since it has acquiesced. The arguments relied upon for the defences overlap but I shall nevertheless endeavour to address each in turn.

Statutory acquiescence

99) The applicant seeks to rely upon the defence of acquiescence. Whilst it has not specifically referred to statutory acquiescence, I shall briefly touch on the provisions within the Act. Section 48(1) is set out below:

“48. - (1) Where the proprietor of an earlier trade mark or other earlier right has acquiesced for continuous period of five years in the use of a registered trade mark in the United Kingdom, being aware of that use, there shall cease to be any entitlement on the basis of that earlier trade mark or other right-

(a) to apply for a declaration that the registration of the later trade mark is invalid, or

(b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used,

unless the registration of the later trade mark was applied for in bad faith.”

100) It is clear from the above that statutory acquiescence does not apply to these proceedings because the provisions relate to the owner of an earlier trade mark

acquiescing (for more than five years) to the use of a later registration. In the present case, the application is not yet registered and therefore section 48(1) does not apply.

Common law acquiescence

101) Since there is no statutory acquiescence, this leaves common law acquiescence. The applicant argues that during the liquidation of CH Enterprises Ltd in February 2011, whereby the applicant acquired “the trade marks and trading names, domain names, goodwill and websites as a package”, the opponent contacted the liquidator to assert its trade mark rights. It states that they “will immediately sue any third party should they begin to use the HOME FURNITURE LAND sign in a manner which infringes its own rights”¹⁶. Since the applicant commenced use and no action was taken by the opponent the applicant argues that this is acquiescence and they are effectively barred from now challenging such use.

102) The opponent argues that this defence is not applicable because 1) such a defence is not compatible with the European Trade Mark Regulation and 2) the applicant would need to demonstrate that the opponent had done more than simply be silent as to the use of the signs by the applicant, i.e. it would need to show that the opponent actively encouraged it to use the signs.

103) In support of the opponent’s claim that the common law acquiescence defence is not compatible with the European Trade Mark Regulation, it relies upon the judgment of *Marussia Communications Ireland Ltd v. Manor Grand Prix Racing Ltd* [2016] EWHC 809 (Ch); [2016] E.T.M.R. 32. Guidance on the application of these defences to trade mark proceedings can be found in Kerly's Law of Trade Marks and Trade Names.

“17-107 The issue was considered by the English High Court, sitting as a EU trade mark court, in *Marussia Communications Ireland Ltd v Manor Grand Prix Racing*, in which Males J relied on the decision of the CJEU in *Martin y Paz* in coming to the conclusion that defences of estoppel and acquiescence were not

¹⁶ Paragraph 12 of Mr Dhatt’s witness statement

available to defendants under the EUTM. The defendant in that case did not argue that substantive national defences were not available to defeat infringement claims, but instead contended that estoppel and acquiescence were procedural matters which fell within art.129(3) of the EUTM Regulation. That contention was rejected by the court. As the law stands in the UK therefore, national defences of estoppel and acquiescence are not available to defendants in trade mark matters.”

104) In view of the above, I dismiss this line of argument from the applicant and do not consider it necessary to give it any further consideration, particularly since the argument was not pursued in any particular detail at the hearing.

Honest concurrent use

105) The applicant states that it made a bona fide acquisition of its mark following liquidation of CH Enterprises Ltd in April 2011. It states that following the inception and development of the applicant’s business has been undertaken by it in good faith. It claims that the ongoing use of the mark means that there is an amply long period for the market to accept honest concurrent use of the respective marks.

106) In *Victoria Plum Ltd v Victorian Plumbing Ltd* [2016] EWHC 2911 (Ch), Carr J. considered the CJEU’s judgment in *Budejovicky Budvar NP v Anheuser-Busch Inc.* and the Court of Appeal’s judgments in that case and in *IPC Media Ltd v Media 10 Ltd*, [2014] EWCA Civ 1403, and stated that a defence of honest concurrent use could, in principle, defeat an otherwise justified claim of trade mark infringement. Having reviewed the case law the judge stated that (my emphasis added):

“74. The case law to which I have referred establishes the following principles:

- i) Where two separate entities have co-existed for a long period, honestly using the same or closely similar names, the inevitable confusion that arises may have to be tolerated.
- ii) This will be the case where the trade mark serves to indicate the goods or services of either of those entities, as opposed to one of them alone.

In those circumstances, the guarantee of origin of the claimant's trade mark is not impaired by the defendant's use, because the trade mark does not denote the claimant alone.

- iii) However, the defendant must not take steps which exacerbate the level of confusion beyond that which is inevitable and so encroach upon the claimant's goodwill."

107) In assessing whether the defendant had acted honestly the judge directed attention to the following factors:

"i) The defendant has a duty to act fairly in relation to the legitimate interests of the trade mark proprietor.

ii) All circumstances must be considered when ascertaining whether or not the use by the defendant is honest, including whether the defendant can be regarded as unfairly competing with the trade mark proprietor.

iii) However, the question is not simply whether use of the sign complained of gives rise to consumer deception, as such deception may have to be tolerated. Similarly, the defendant may well be aware of the existence of such confusion, having lived with it for a considerable period.

iv) The question is whether the defendant has taken steps which exacerbate the level of confusion beyond that which is inevitable and so has encroached upon the claimant's goodwill.

v) Whether the defendant ought to be aware that such steps will exacerbate confusion is a relevant factor."

108) The *Budweiser* case shows that honest concurrent use may also be relevant in trade mark opposition and cancellation proceedings. Further, it also states that circumstances that give rise to this defence would have to be exceptional¹⁷. Consequently, Carr J.'s guidance in *Victoria Plum* must also be kept in mind in proceedings of this kind.

¹⁷ Paragraph 76, *Budejovicky Budvar NP v Anheuser-Busch Inc*, Case C-482/09

109) In essence, for a defence of honest concurrent use to succeed, I would need to be satisfied that the parties have traded in circumstances that the relevant public has been exposed to both marks and have been able to differentiate between them without confusion as to trade origin. Mr Dhatt's evidence states that the applicant purchased the intellectual property in Homefurnitureland in April 2011. This is 6 years prior to the relevant date. There is no evidence relating to any use of the mark prior to this date. The applicant's evidence also includes turnover figures but no evidence relating to how the mark has been used. The circumstances are far from the position in the *Budweiser* case and they are far from exceptional. Whilst it is agreed between the parties that not all cases require 30 years of coexistence, six years is certainly low. Therefore, I dismiss this line of argument.

DECISION – Section 3(6)

110) The opponent has succeeded in its entirety and I am therefore not required to determine the bad faith claim. However, for the sake of completeness I shall nevertheless assess the claim made.

The law

111) Section 3(6) of the Act states:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

The case-law

112) The parties are in agreement that the law to be followed in relation to section 3(6) of the Act (“bad faith”) is Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch), whereby he stated as follows:

“130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of

these points, see N.M. Dawson, "Bad faith in European trade mark law" [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see Case C- 529/07 *Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and Case C-192/03 *Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade

mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48)."

113) The relevant date for assessing whether the application was filed in bad faith is the date of the application for registration, namely 5 September 2017.

114) The opponent claims that the applicant filing a trade mark application after it had been warned against using the mark (the opponent's letter of 2011 refers) amounts to standards that fall short of acceptable commercial behaviour, particularly since the applicant knew about the trade mark registrations. During the hearing, I shared my serious doubts on how this could amount to bad faith with the opponent. Having carefully considered all of the evidence and submissions made at the hearing, I am still unpersuaded that the action taken by the applicant could be considered unacceptable commercial behaviour. The applicant states that it filed its trade mark application in order to protect its business and should there be any dispute it could be resolved before the UK IPO rather than the Court, which would be considerably cheaper. I do not consider this to be bad faith.

115) The section 3(6) bad faith claim fails.

FINAL OUTCOME

116) The opposition under section 5(2)(b) of the Act has succeeded in its entirety. Therefore, subject to appeal, the application shall be refused registration.

COSTS

117) The opponent has been successful and is entitled to a contribution towards its costs. Both parties are in agreement that there is no reason not to follow the published scale of costs. However, Mr Muir Wood argues that the opponent should be entitled to costs “at the higher end of the scale” because 1) the applicant ran certain arguments which are not relevant or supported by its evidence, 2) failure to admit that certain goods or services are similar or not until the skeleton arguments was filed increased the opponent’s costs, and 3) to reflect the volume of material the opponent was forced to gather to try and deal with the opposition.

118) The opponent is correct that some of the arguments raised had little (if any) chance of success. It is also apparent that the applicant admitted to there being similarity between the goods and services when filing the skeleton. However, I do not consider this to be a justifiable reason for an increase in costs. I am still required to analyse the goods and services in order for me to establish the degree (if any) of similarity, and I would usually expect submissions on this point from both parties (unless they are clearly identical or dissimilar). With regard to the material that the opponent was required to submit, the applicant is entitled to request proof of use of the earlier marks which the lion’s share of the evidence addresses. Having considered the other arguments raised by the applicant there was little evidence submitted by the opponent which was useful in rebutting such arguments.

119) In the circumstances I award the opponent the sum of £2800 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee	£200
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Preparing a statement and considering the other side's statement	£400
Preparing evidence and considering commenting on the other side's evidence	£1400
Preparing for and attending a hearing	£800
TOTAL	£2800

120) I therefore order Furniture 2 Inspire Limited to pay Furniture Village Limited the sum of £2800. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated 28 February 2019

Mark King
For the Registrar,
The Comptroller-General