

O/491/20

TRADE MARKS ACT 1994 (AS AMENDED)

TRADE MARK APPLICATIONS 3376060, 3376455 & 3376215

BY INDUSTRIAL FLOOR PREP SCOTLAND LIMITED

AND

OPPOSITIONS 416444, 416445 & 416830

BY INDUSTRIAL FLOOR TREATMENTS LIMITED

AND

TRADE MARK REGISTRATION 3348690

IN THE NAME OF INDUSTRIAL FLOOR TREATMENTS LIMITED

AND

APPLICATION 502916


BY INDUSTRIAL FLOOR PREP SCOTLAND LIMITED

FOR A DECLARATION THAT REGISTRATION 3348690 IS INVALID

Background and pleadings

1. These are consolidated opposition and invalidation proceedings between Industrial Floor Treatments Limited (“IFT”) and Industrial Floor Prep Scotland Limited (“IFPS”).

2. On 16th February 2019, IFPS filed three applications to register the following trade marks.

Trade mark No.	Mark	Classes of goods/services
3376060	IFP Scotland	16, 17, 19, 25, 27, 35, 37, 40 & 42
3376455	IFP	25, 35, 37, 40 & 42
3376215		35, 37, 40 & 42

3. IFT opposes these applications. The grounds of opposition are based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). IFT relies on its trade mark 3348690, which consists of the letters IFT. The application to register this mark was filed on 26th October 2018, so it is an earlier trade mark. The earlier mark was registered on 11th January 2019. It is registered for:

Class 11: Underfloor heating installations and apparatus.

Class 17: Resin and polymers for use in flooring; resin and polymers for use in forming dust proof and hardened skins in flooring; resin and polymer sealants for use in connection with the installation of flooring including car park decking, raised access flooring, industrial and food safe flooring.

Class 19: Non-metallic wall cladding panels; synthetic flooring and wall cladding materials; hygienic non-metallic wall cladding panels.

Non-metallic wall cladding panels; synthetic flooring and wall cladding materials; hygienic non-metallic wall cladding panels.

Class 37: Floor treatment services, namely the installation, maintenance, application, levelling and repair of flooring screeds, car park decking, industrial and food safe flooring; installation, maintenance and repair of underfloor heating installations and apparatus; installation, maintenance, application and repair of wall cladding panels, synthetic flooring and hygienic wall cladding panels;

Class 40: Floor finishing services.

4. According to IFT:

- (i) Some of the goods/services covered by the opposed applications; namely, those in classes 17, 19, 37 and 40, are identical or similar to the goods and services covered by the earlier trade mark;
- (ii) The opposed trade marks are similar to the earlier trade mark;
- (iii) Bearing in mind the possibility of imperfect recollection of the respective marks and the phonetic similarity between the letters 'P' and 'T', there is a likelihood of confusion on the part of the public, including the likelihood of association;
- (iv) There have been instances of actual confusion;
- (v) The earlier trade mark has a reputation and use of the opposed trade marks in relation to any of the goods/services covered by the opposed applications would, without due cause, take unfair advantage of the reputation and/or highly distinctive character of the earlier mark and/or be detrimental to its distinctiveness or repute;
- (vi) Registration of the opposed marks would therefore be contrary to sections 5(2) and/or 5(3) of the Act.

5. The oppositions under section 5(4)(a) of the Act are based on the opponent's claimed earlier right in the signs 'IFT' and the logo shown below.



6. According to IFT, it has used the sign IFT since 1993 in Scotland and Northern England, initially as an acronym for its company name - Industrial Floor Treatments Limited and, since 2016, as (or as part of) its adopted trading name – IFT Integrated Flooring Technologies.

7. The logo shown in paragraph 5 above is said to have been in use in the same geographical area since the change of trading style in 2016.

8. These signs are claimed to have been used in relation to:

'Underfloor heating installations and apparatus; resin and polymers for use in flooring; non-metallic wall cladding panels; synthetic flooring and wall cladding materials; hygienic non-metallic wall cladding panels; floor treatment services, namely the installation, maintenance, application, levelling and repair of flooring screeds, car park decking, industrial and food safe flooring; installation, maintenance and repair of underfloor heating installations and apparatus; installation, maintenance, application and repair of wall cladding panels, synthetic flooring and hygienic wall cladding panels; flooring finishing services.'

9. IFT claims that:

- (1) the signs shown above have become distinctive of its business;
- (2) the use of the opposed trade marks in relation to any of the goods/services covered by the opposed applications would constitute a misrepresentation to the public that IFPS is IFT, or is economically linked to IFT;
- (3) such use would damage IFT's goodwill in its business;
- (4) use of the opposed trade marks would therefore constitute passing off.

10. IFPS filed counterstatements denying the grounds of opposition. I note the following points:

- (1) IFPS accepts that parts of the specifications of its applications in classes 17, 19, 37 and 40 are similar to some of the goods/services covered by the earlier trade mark in the same classes (but it does say which goods/services it accepts are similar);
- (2) IFPS denies that the respective trade marks are similar enough to engage sections 5(2)(b) or 5(3) of the Act;
- (3) IFPS relies on the fact that the goods/services at issue will be purchased by senior business people making important business decisions, who will therefore pay an above average degree of attention during the selection process;
- (4) It is claimed that IFT is low in distinctive character, especially the letters 'IF-', which will be understood by industrial customers to stand for 'industrial flooring';
- (5) IFT was put to proof of the claimed reputation of 'IFT';
- (6) IFT was put to proof of the alleged instances of actual confusion;
- (7) IFPS claims that prior to the date of the applications for their registration its marks were the subject of honest concurrent use with IFT's mark and had acquired their own distinctive character through such use;
- (8) IFPS claims that IFT was one of its customers and thereby consented to the registration of the opposed trade marks, or is otherwise barred from opposing the marks under the laws of Scotland.

11. On 20th November 2019, IFPS applied to invalidate IFT's earlier trade mark 3348690 on the grounds that the mark was registered in bad faith, contrary to section 3(6) of the Act. The pleading is re-produced below.

"The applicant incorporated and commenced trading on 12.12.16 under its "IFP" family of marks for flooring goods and services. The proprietor filed evidence in OP000416444, OP000416445 & OP000416830 confirming awareness of the applicant's incorporation and business "for many years", but never objected. Not only that, but the proprietor specifically contracted the

applicant (e.g. in March 2018) to provide flooring related goods and services under the IFP marks to the proprietor and its customers (using similar trade suppliers). At no point was there any objection. To the contrary, consent was implied. Aware of the applicant's on-going success, the proprietor then filed UK3348690, which was entered in the register on 11.01.19. Very shortly after, on 28.01.19, the proprietor issued (actionable) threats of trade mark infringement proceedings. On 30.05.19, contrary to a legal warning re s.21A, the proprietor raised opposition proceedings against the registration of the very trade marks the use of which it had previously consented to. Contrary to further warnings in three counter-statements, the proprietor continues proceedings at great cost and expense of the applicant. Bad faith includes dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. The proprietor's duplicitous dealings support the applicant's claim that UK3348690 was filed in bad faith."

12. IFT filed a counterstatement denying that it had applied to register trade mark 3348690 in bad faith. I note that:

- (1) IFT denied knowing of IFPS "for many years";
- (2) IFPS was put to proof of when it started trading;
- (3) IFT admitted that it had engaged IFPS to provide services, but denied that this amounted to consent to register the opposed marks.

13. Following a case management conference held on 26th February 2020 the opposition and invalidation proceedings were consolidated.

14. Both sides seek an award of costs.

The evidence

15. IFT's evidence consists of two witness statements (with 23 exhibits) by its Managing Director, Mr Greg Love.

16. IFPS's evidence consist of two witness statements (with 20 exhibits) by Mr Michael McPake, who is a director of the company.

17. I have read all the evidence. I note the following points from Mr Love's evidence:

- IFT has traded since 1993 providing flooring systems and installations to commercial and industrial clients in Scotland and England;
- It has offices in East Kilbride and Bishop Auckland;
- Annual turnover between 2013 and 2018 ranged between £3.6m and £6.4m;
- Over the same period, over £90k was spent advertising IFT's goods/services;
- Up until 2016, IFT was used as an acronym for the company name, Industrial Flooring Treatments Limited;
- Up until March 2016, the home page of IFT's website welcomed visitors to "Industrial Floor Treatments Limited" and carried this mark:



- In 2016 IFT adopted the trading name 'Integrated Flooring Technologies';
- It was reported at the time that:¹

"IFT has evolved considerably from just industrial flooring and now provides clients with a variety of services including floor screeds and levelling, resin flooring, food safe flooring, car park decking systems, raised access flooring, underfloor heating and hygienic wall cladding."

- Since the re-branding IFT has used the logo shown below, including on its headed note paper and on its website:²

¹ See exhibit GL3

² See exhibits GL5 and GL17



- IFT's advertisements also used the above mark;³
- IFT appears to have worked on large projects, such as the Macallan whisky and visitor centre, the government hub at Edinburgh Waverley station, Edinburgh Airport, Newcastle International Airport and Gleneagles hotel;⁴
- Even IFT's smaller projects appear to have been on a significant scale;⁵
- IFT has a small following on social media;⁶
- There are examples in evidence of third parties using the letters IFT to refer to IFT where it can be seen that they understand them to stand for 'Integrated Flooring Technologies';⁷
- There are also examples in evidence of third parties referring to the company as IFT alone;⁸
- There is also an example of IFT being used in such a way that it was recognised as part of IFT's trading name, not just as an acronym for 'Integrated Flooring Technologies';⁹

³ See exhibit GL4, which consists of an advertisement from Premier Construction News from November 2018

⁴ See GL8

⁵ See the invoices in GL17, the lowest of which is for £14k

⁶ IFT's LinkedIn page was set up in 2016 under Integrated Flooring Technologies (IFT) and by November 2019 had 396 followers

⁷ See exhibit GL8, which consists of an article from Scottish Construction Now dated December 2018 which refers to the company as 'IFT' in the title, but as 'Integrated Flooring Technologies (IFT)' in the text of the article

⁸ See exhibits GL11, which consists of an extract from the Resin Flooring Association's website about work completed at Glasgow Southern General Hospital in 2015 and exhibit GL18, which consists of a letter of commendation from a customer dated December 2016

⁹ See exhibit GL3 which includes an article from Scottish Construction Now dated November 2016 which reported that "Specialist flooring company Industrial Floor Treatments Ltd has rebranded as IFT- Integrated Flooring Technologies and will now provide integrated flooring solutions" and GL10, which consists of an extract from an article in Commercial Property Monthly from 2017 in which IFT is referred to as 'IFT- Integrated Flooring Technologies' (as opposed to Integrated Flooring Technologies (IFT))

- There are examples in evidence of three invoices from two third party suppliers having been sent to IFT in response to orders placed by IFPS during 2019;¹⁰
- As regards IFPS's use of the opposed marks, Mr Love says that:

"I am of the view that the conscious adoption by the Applicant of the confusingly similar name IFP for [the director's] new competing company is liable to cause damage to the goodwill and reputation which IFT has built up over many years."

18. I note the following points from Mr McPake's evidence:

- IFPS was incorporated in December 2016 and is claimed to have conducted public-facing trade under the opposed trade marks since January 2017;
- No further information is provided about the use that is said to have started in January 2017 and the earliest documentary evidence of any use of the opposed marks is dated May 2017, which shows use of IFPS's corporate name on an invoice from a supplier of machinery;¹¹
- The earliest documentary evidence of use of an IFPS's mark with a customer is dated 12th June 2017 and the earliest document which clearly shows use of the mark in relation to flooring services is dated 27th June 2017;¹²
- IFPS was trading in a small way in 2017 and in a larger, but still relatively modest way, by the end of 2018;¹³
- In February and March 2018, IFT sub-contracted IFPS to provide flooring services to two of its customers at a cost of around £2800;¹⁴
- IFPS's standard terms and conditions of trade include the following term:

¹⁰ See exhibit GL20, which consists of two invoices addressed to IFPS having been posted to IFT following an email order placed with a third-party supplier, and GL22 and 23, which consist of a sales invoice from another third-party supplier which was addressed and sent to IFT apparently as a result of an order placed by IFPS

¹¹ See exhibit IFP-14

¹² See exhibit IFP-15, which consists of an invoice to a customer bearing the logo version of the IFP mark (see trade mark application 3376215) and exhibit IFP-16 showing use of the same mark in relation to flooring services

¹³ See exhibit IFP-19

¹⁴ See exhibit IFP-03, the invoice bore the logo version of the IFP mark (see trade mark application 3376215)

“The customer shall ensure that the use to which the company’s product are to be put does not contravene any local or national laws, bye laws or regulations or planning consents for the time being in force and will indemnify the company against any such contravention.”

- According to IFPS, by contracting with it on these terms, IFT agreed to indemnify IFPS against contravention of any laws, including the Trade Marks Act;
- IFT sent IFPS a cease and desist letter on 28th January 2019 in which it drew IFPS’s attention to trade mark registration 3348690.¹⁵

Representation

19. IFT is represented by Cameron Intellectual Property. IFPS is represented by Cloch Solicitors. Neither side wished to be heard on the substantive matters. However, I have the benefit of written submissions from both sides.

IFPS’s application to invalidate IFT’s earlier trade mark 3348690

20. It is convenient to start with IFPS’s application 502916 to invalidate IFT’s earlier trade mark under s.47(1) of the Act on the grounds that it was applied for in bad faith, contrary to s.3(6) of the Act.

21. 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.”

22. The relevant part of section 47 of the Act states:

¹⁵ See exhibit IFP-20

“47. (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).”

23. IPFS’s pleading is re-produced at paragraph 11 above. It essentially amounts to this:

- IFT was aware of IFPS’s use of IFP Scotland and the logo version of the mark (see trade mark application 3376215) in March 2018;
- IFT sub-contracted work to IFPS, indicating it was not concerned about the use of the name/mark;
- By accepting IFPS’s terms of trade, IFT indemnified IFPS against contraventions of the Trade Marks Act;
- These actions amounted to IFT consenting to IFPS’s use of the opposed marks;
- IFT’s subsequent opposition to the use and registration of the opposed marks is duplicitous and amounts to an act of bad faith.

24. The relevant case-law covering trade mark applications made in bad faith can be found in the following cases: *Chocoladefabriken Lindt & Sprüngli*, CJEU, Case C-529/07, *Malaysia Dairy Industries*, CJEU, Case C-320/12, *Koton*, CJEU, Case C-104/18P, *Sky v Skykick*, CJEU, Case C-371/18, *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others*, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16), *Trump International Limited v DDTM Operations LLC*, [2019] EWHC 769 (Ch), *Copernicus-Trademarks v EUIPO*, General Court of the EU, Case T-82/14, *Daawat Trade Mark, The Appointed Person*, [2003] RPC 11, *Saxon Trade Mark*, [2003] EWHC 295 (Ch), *Mouldpro ApS v EUIPO*, General Court of the EU, Case T-796/17, *Alexander Trade Mark, The Appointed Person*, BL O/036/18, *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch) and *Sky v Skykick* [2020] EWHC, 990 (Ch).

25. The law appears to be that:

(a) While in everyday language the concept of 'bad faith' involves a dishonest state of mind or intention, the concept of bad faith in trade mark law must be understood in the context of trade: *Sky* CJEU.

(b) The mere fact that the applicant knew that another party used the same or similar trade mark in the UK does not establish bad faith: *Lindt, Koton* (paragraph 55).

(c) The applicant may have reasonably believed that it was entitled to apply to register the mark, e.g. where there had been honest concurrent use of the marks: *Hotel Cipriani*.

(d) However, an application to register a mark is likely to have been filed in bad faith where the applicant knew that a third party used the mark in the UK, or had reason to believe that it may wish to do so in future, and intended to use the trade mark registration to extract payment/consideration from the third party, e.g. to lever a UK licence from an overseas trader: *Daawat*, or to gain an unfair advantage by exploiting the reputation of a well-known name: *Trump International Limited*.

(e) An application may also have been filed in bad faith where the applicant acted in breach of a general duty of trust as regards the interests of another party, including his or her own (ex) company or (ex) partners, or a party with whom there is, or had recently been, a contractual or pre-contractual relationship, such as a licensor, prospective licensor or overseas principal: *Saxon, Mouldpro*; or where a legal agreement prohibits such a filing.

26. According to *Alexander Trade Mark*, the key questions for determination in assessing a bad faith case are:

(a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?

(b) Was that an objective for the purposes of which the contested application could not be properly filed? and

(c) Was it established that the contested application was filed in pursuit of that objective?

27. The applicant's intention is a subjective factor which must be determined objectively by the competent authority. An overall assessment is required, which must take account of all the factual circumstances relevant to the particular case: *Lindt*.

28. The matter must be judged at the relevant date, which is the date of the application for registration: *Lindt*.

29. It is necessary to ascertain what the applicant knew at the relevant date: *Red Bull*. Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani*.

30. An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull*.

Assessment

31. The relevant date is 26th October 2018. It is not denied that IFT knew that IFPS was using (at least the logo version of) its mark from March 2018. It therefore knew about this mark when it applied to register IFT as a trade mark. However, the case-law makes it clear that mere knowledge that another party is using a similar mark does not establish that the application for registration was made in bad faith.

32. It appears from Mr Love's evidence, and the cease and desist letter sent to IFPS shortly after the IFT mark was registered, that the application for registration was intended to help IFT to protect its mark from what it perceived as confusion with the opposed marks. In its written submissions, IFPS likens IFT's behaviour to 'blocking' registrations of the kind considered in *Copernicus-Trademarks v EUIPO*. However, that case was concerned with the filing of speculative trade mark applications for the purpose of blocking other traders' use of the same or similar marks. The applicant in that case had no intention of using the marks in accordance with their essential

function of distinguishing the applicant's goods/services from those of other undertakings.

33. By contrast, IFT had been using the letters IFT as a prominent part of its trade mark since 2016.¹⁶ There is also some evidence that IFT was known to its customers by those letters. In these circumstances, the application to register the mark appears to be entirely in line with the essential function of the trade mark. It also accords with the very purpose of the registration system, which is to protect the functions of trade marks, particularly from the risk of confusion. IFT was therefore perfectly entitled to apply to register its mark, irrespective of whether its main or only motivation in doing so was to prevent IFPS's continued use of the opposed marks.

34. IFPS's claim that IFT consented to its use of the opposed marks does not stand scrutiny. The mere fact that a director of IFT engaged IFPS to undertake some work on its behalf does not amount to consent to use, or to continue to use, the opposed marks. Even if it had consented to IFPS's use of the opposed marks, there is nothing duplicitous in applying to register a mark you were already using. Consequently, I reject IFPS's claim that in any applying to register its mark, IFT was acting duplicitously.

35. IFPS's also appears to rely on the terms and conditions on which IFT engaged it as somehow preventing any claim that IFT could bring under the Trade Marks Act. However, it is clear from the wording of the term in question (see paragraph 18 above) that it relates to the use of IFPS's products. This has nothing to do with IFPS's trade marks or trade name, let alone with IFT's application to register its own mark.

36. I therefore find there is no merit whatsoever in IFPS's bad faith claim and I reject it. IFPS's application to invalidate IFT's earlier trade marks fails accordingly.

¹⁶ There is nothing wrong *per se* in applying to register part of a trade mark: see *Société des Produits Nestlé SA v Mars UK Ltd*, Case C-353/03 CJEU (*Have a Break*)

IFT's oppositions to IFPS's trade mark applications under section 5(2)(b) of the Act

37. 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".

38. Section 5A of the Act is as follows:

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

39. It is convenient to start by considering the opposition under s.5(2)(b) based on earlier trade mark 3348690 against IFPS's trade mark application 3376060 (IFP Scotland). The relevant date for the purposes of the s.5(2) (and s.5(3)) grounds is the date of IFPS's applications, i.e. 16th February 2019.

Comparison of goods/services

40. The earlier mark is not yet subject to proof of use under s.6A of the Act. Consequently, it is entitled to protection for all the goods and services for which it is registered. The respective specifications showing (only) the classes of goods/services on which IFT relies, and the classes of IFPS's applications opposed by IFT under s.5(2)(b) of the Act are set out below.

IFT	IFPS
<p data-bbox="204 309 555 338">Trade Mark 3348690 - IFT</p> <p data-bbox="204 416 778 678">Class 17: Resin and polymers for use in flooring; resin and polymers for use in forming dust proof and hardened skins in flooring; resin and polymer sealants for use in connection with the installation of flooring including car park decking, raised access flooring, industrial and food safe flooring.</p> <p data-bbox="204 1379 770 1641">Class 19: Non-metallic wall cladding panels; synthetic flooring and wall cladding materials; hygienic non-metallic wall cladding panels. Non-metallic wall cladding panels; synthetic flooring and wall cladding materials; hygienic non-metallic wall cladding panels.</p>	<p data-bbox="809 309 1294 338">Trade Mark 3376060 - IFP Scotland</p> <p data-bbox="809 416 1385 1216">Class 17: Adhesive anti-slip tape for flooring applications; Adhesive tapes for securing floor coverings to prevent slippage; Adhesive tapes for use in securing floor coverings; Adhesive tapes for use with floor coverings; Expansion joints for use in floor constructions; Insulating floor coverings; Insulation in the form of floor coverings; Resins for use in flooring; Resins for use in forming a dust proof skin on flooring; Resins for use in forming a hardened skin on flooring; Polymers for use in flooring; Polymers for use in forming a dust proof skin on flooring; Polymers for use in forming a hardened skin on flooring; Resin and polymer sealants for use in connection with the installation of flooring; Sound absorbing flooring underlayment; Sound control flooring underlayment; Under flooring sheets of rubber; parts, fittings and accessories for the aforesaid.</p> <p data-bbox="809 1279 1294 1308">Trade Mark 3376060 - IFP Scotland</p> <p data-bbox="809 1379 1374 2022">Class 19: Artificial wood flooring; Athletic flooring, not of metal; Bamboo flooring; Blocks (Non-metallic -) for use in flooring construction; Ceramic tiles for flooring of building; Ceramic tiles for flooring and facing; Ceramic tiles for flooring and lining; Fabric for underlayment of flooring; Floors, not of metal; Flooring underlays; Flooring underlay made of cork; Flooring underlay; Flooring tiles (Non-metallic -); Flooring screeds; Flooring (Parquet -); Flooring (Non-metallic -); Floor screed; Floor tiles (Non-metallic -) for building; Floor tiles, not of metal; Floor tiles of wood; Floorboards; Flooring made of wood; Flooring materials (Non-metallic -); Flooring (Non-metallic -); Flooring (Parquet -); Flooring screeds;</p>

<p>Class 37: Floor treatment services, namely the installation, maintenance, application, levelling and repair of flooring screeds, car park decking, industrial and food safe flooring; installation, maintenance and repair of underfloor heating installations and apparatus; installation, maintenance, application and repair of wall cladding panels, synthetic flooring and hygienic wall cladding panels.</p>	<p>Flooring tiles (Non-metallic -); Flooring underlay; Flooring underlay made of cork; Flooring underlays; Floors, not of metal; Glazed ceramic floor tiles; Hardwood flooring; Laminate flooring; Laminate flooring, not of metal; Laminated parquet flooring; Laminated parquet floorboards; Mosaic floor tiles; Non-metal floor panels; Parquet flooring; Parquet flooring and parquet slabs; Parquet flooring made of cork; Parquet flooring made of wood; Parquet flooring of cork; Parquet flooring of wood; Parquet wood flooring; Rubber flooring; Synthetic flooring materials or wall-claddings; Tile flooring, not of metal; Tile floorings, not of metal; Veneer for floors; Vinyl flooring; Wood flooring; Wood tile flooring; Wood veneer parquet flooring; Wooden flooring; parts, fittings and accessories for the aforesaid.</p> <p>Trade Marks 3376060 - IFP Scotland & 3376215 - IFP logo</p> <p>Class 37: Application of flooring; Installation of flooring; Maintenance of flooring; Repair of flooring; Application of coatings for the repair of surfaces of buildings and floors; Application of coatings for the repair of floors; Application of coatings for the repair of walls; Application of coatings to buildings; Application of coatings to floors; Application of protective coatings to cavity surfaces; Application of protective coatings for buildings; Application of protective coatings to building surfaces; Application of protective coatings to floors; Application of surface coatings; Application of waterproof coatings for floors; Application of slip-resistant safety floor sealers; Cleaning of floor coverings; Cleaning of floor surfaces; Construction of floors; Fitting of artificial wood flooring; Fitting of floor coverings; Fitting of laminate flooring; Fitting of wood flooring; Floor coating services; Floor layering; Floor maintenance services; Floor</p>
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<p>Class 37: Floor treatment services, namely the installation, maintenance, application, levelling and repair of flooring screeds, car park decking, industrial and food safe flooring; installation, maintenance and repair of underfloor heating installations and apparatus; installation, maintenance, application and repair of wall cladding panels, synthetic flooring and hygienic wall cladding panels.</p>	<p>polishing; Floor sanding; Installation of mezzanine floors; Installing wood flooring; Maintenance and repair of flooring; Maintenance of artificial wood flooring; Maintenance of laminate flooring; Maintenance of wood flooring; Preparation of floor surfaces for lining and covering; Providing information relating to floor polishing services; Remedial services for floor coverings; Repair or maintenance of power-driven floor cleaning machines; Repair of artificial wood flooring; Repair of laminate flooring; Repair of wood flooring; Floor treatment services, namely the installation, maintenance, application, levelling and repair of flooring screeds, car park decking, industrial and food safe flooring; Buffing and polishing; Floor buffing; Floor polishing; Concrete polishing; Polishing (cleaning); Providing information relating to floor polishing services; Floor coating services; Coating of concrete; advisory, information and consultancy services for all the aforesaid services including such services, information and advice provided online from a computer network and/or via a computer database or the Internet, extranets or via other communications.</p> <p>Trade Mark 3376455 - IFP</p> <p>Class 37: Application of flooring; Installation of flooring; Maintenance of flooring; Repair of flooring; Application of coatings for the repair of surfaces of buildings and floors; Application of coatings for the repair of floors; Application of coatings for the repair of walls; Application of coatings to buildings; Application of coatings to floors; Application of protective coatings to cavity surfaces; Application of protective coatings for buildings; Application of protective coatings to building surfaces; Application of protective coatings to floors; Application of surface coatings; Application of waterproof</p>
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	<p>coatings for floors; Application of slip-resistant safety floor sealers; Cleaning of floor coverings; Cleaning of floor surfaces; Construction of floors; Fitting of artificial wood flooring; Fitting of floor coverings; Fitting of laminate flooring; Fitting of wood flooring; Floor coating services; Floor layering; Floor maintenance services; Floor polishing; Floor sanding; Installation of mezzanine floors; Installing wood flooring; Maintenance and repair of flooring; Maintenance of artificial wood flooring; Maintenance of laminate flooring; Maintenance of wood flooring; Preparation of floor surfaces for lining and covering; Providing information relating to floor polishing services; Remedial services for floor coverings; Repair or maintenance of power-driven floor cleaning machines; Repair of artificial wood flooring; Repair of laminate flooring; Repair of wood flooring; Floor treatment services, namely the installation, maintenance, application, levelling and repair of flooring screeds, car park decking, industrial and food safe flooring; Buffing and polishing; Floor buffing; Floor polishing; Concrete polishing; Polishing (cleaning); Providing information relating to floor polishing services; floor coating services; coating of concrete; application, construction, installation, fitting, maintenance, cleaning, repair of walls, wall surfaces and partitions; application of coatings to walls, cladding, wall surfaces; installation, maintenance, repair of partitions; application of protective and waterproof coatings to walls and partitions; wall coating services; Floor layering; wall maintenance services; wall and partition polishing; wall sanding; construction of temporary walls and partitions; maintenance and repair of walls and partitions; preparation of wall surfaces for lining and covering; providing information relating to wall polishing services; remedial services for wall coverings; wall treatment services, namely the installation,</p>
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<p>Class 40: Flooring finishing services.</p>	<p>maintenance, application, levelling and repair of wall screeds, cladding, panelling, industrial partitions; wall buffing; wall polishing; providing information relating to wall cladding and polishing services; wall coating services; advisory, information and consultancy services for all the aforesaid services including such services, information and advice provided online from a computer network and/or via a computer database or the Internet, extranets or via other communications.</p> <p>Trade Marks 3376060, 3376455 & 3376215</p> <p>Class 40: Treatment of floors; Polishing; Surface polishing; Abrasive polishing; Metal polishing; Flooring finishing services; advisory, information and consultancy services for all the aforesaid services including such services, information and advice provided online from a computer network and/or via a computer database or the Internet, extranets or via other communications.</p>
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41. I find that the resins and polymers covered by class 17 of IFT's trade mark are identical to the following descriptions of goods in class 17 of Trade Mark 3376060:

Resins for use in flooring; Resins for use in forming a dust proof skin on flooring; Resins for use in forming a hardened skin on flooring; Polymers for use in flooring; Polymers for use in forming a dust proof skin on flooring; Polymers for use in forming a hardened skin on flooring; Resin and polymer sealants for use in connection with the installation of flooring.

42. The remaining goods in class 17 are not identical. In deciding whether Trade Mark 3376060 covers similar goods I bear in mind the judgment of the CJEU in *Canon*¹⁷ in which the court stated at paragraph 23 of its judgment that:

¹⁷ Case C-39/97

“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”.

43. In *Boston Scientific Ltd v OHIM*¹⁸ the General Court (“GC”) stated that “complementary” means:

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

44. I find that the following goods are similar in purpose to the resins and polymers covered by the earlier trade mark because they are all for use in laying flooring. Additionally, insulating floor coverings in the specification of Trade Mark 3376060 appear to be alternative floor coverings to those formed from the resins and polymers, which are covered by the specification of the earlier mark. All the goods at issue are also likely to be provided by the same undertaking to the same users. The following goods in application 3376060 are therefore similar to a medium degree to the goods in class 17 for which the earlier trade mark is registered:

Adhesive anti-slip tape for flooring applications; Adhesive tapes for securing floor coverings to prevent slippage; Adhesive tapes for use in securing floor coverings; Adhesive tapes for use with floor coverings; Expansion joints for use in floor constructions; Insulating floor coverings; Insulation in the form of floor coverings.

45. I find that the following goods are similar in purpose to the resins and polymers covered by the earlier trade mark. This is because they are complementary and

¹⁸ Case T-325/06

likely to be provided by the same undertaking to the same users. The respective goods are therefore similar to a medium degree.

“Sound absorbing flooring underlayment; Sound control flooring underlayment; Under flooring sheets of rubber.”

“Parts, fittings and accessories for [all] the aforesaid [goods].”

46. Turning to class 19 of Trade Mark 3376060, I find that “*synthetic flooring and wall cladding materials*” covered by the earlier trade mark covers any man-made materials for use in flooring (and/or wall cladding) which fall in class 19. It therefore covers “*flooring materials*”, “*flooring screeds*” and similar terms in class 19 of the later trade mark, but not finished products, such as “*artificial wood flooring.*” Nevertheless, once set flooring screeds become *Floors, not of metal*, which are included in class 19 of application 3376060. Such goods must therefore be regarded as highly similar to *synthetic flooring... materials*. Similarly, although different in nature (being materials), *synthetic flooring... materials* are similar in purpose to all of the types of flooring covered by class 19 of application 3376060 which can be laid using such materials. Additionally, the goods in class 19 of application 3376060 are complementary (in the sense described in the case-law) to the services in class 37 of the earlier mark, especially to:

“installation, maintenance, application, levelling and repair of flooring screeds, car park decking, industrial and food safe flooring; installation, maintenance, application and repair of... synthetic flooring.”

47. I therefore find that all the goods covered by class 19 of application 3376060 are identical or similar to a medium degree to the goods and services covered by classes 19 and 37 of the earlier trade mark.

48. Turning to the class 37 specifications of all three opposed applications, I bear in mind the guidance provided in *Gérard Meric v OHIM*¹⁹ where the General Court of the EU stated that:

“29.the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut 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”.

49. In interpreting the terms in the specification of the earlier mark I also bear in mind that:

- *maintenance* [of flooring, especially food-safe flooring] includes cleaning;
- the repair of floors appears to include the application of coatings;²⁰
- *industrial and food safe flooring* and *synthetic flooring* are wide enough to cover many types of natural and man-made flooring;
- *floor screeds* are a type of floor covering;
- *floor finishing services* includes *floor polishing*.

50. Taking these points into account I find that, except for those set out below, all the services in class 37 of the opposed applications are identical or highly similar to the services in class 37 and/or class 40 for which the earlier trade mark is protected.

51. The exceptions are:

- *providing information relating to floor polishing services;*
- *providing information relating to wall polishing services;*
- *providing information relating to wall cladding and polishing services;*

¹⁹ Case T-133/05

²⁰ See the applicant's specifications in class 37

- *advisory, information and consultancy services for all the aforesaid services including such services, information and advice provided online from a computer network and/or via a computer database or the Internet, extranets or via other communications;*
- *repair or maintenance of power-driven floor cleaning machines.*

52. The information and advisory services that fall in classes 37 and 40 relate to the services that fall in those classes. These are technical advice/information services in the nature of building/materials treatment advice. Therefore, given the relatively specialist nature of the primary services, the first four descriptions of services are complementary to those services in the sense described in the case-law. I find they are similar to a medium degree to the services in classes 37 and 40 covered by the earlier trade mark.

53. By contrast, I am not satisfied that average consumers of the services covered by the earlier trade mark would expect the same undertaking that provides those services to also provide *repair or maintenance of power-driven floor cleaning machines*. These services appear more likely to be provided by a machine repair company than a flooring company. I therefore find that these services are not complementary (again in the sense described in the case-law) to the goods or services covered by the earlier trade mark. The services are not similar in any other material way. Therefore, they are dissimilar.

54. Most of the respective services in class 40 are identical. This is because *floor finishing* includes *floor polishing*, and *floor polishing* covers *polishing; surface polishing; abrasive polishing; metal polishing*. *Advisory, information and consultancy services* in class 40, are specialist advisory services, in this case about floor treatments and floor finishing. These services are similar to a medium degree to the *floor finishing services* for which the earlier mark is protected.

Average consumer and the selection process

55. 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*.²¹

56. IFT submits that the average consumer could be a trade professional, such as a building contractor, or a member of the general public seeking flooring goods/services or closely related goods/services. IFPS submits that the only relevant average consumer is a trade user.

57. I accept that the goods covered by class 17 of application 3376060 are likely to be used mainly by trade professionals. However, I see no reason why a member of the public with an interest in DIY should not also be considered a potential purchaser of the goods in class 19. Similarly, householders are users of flooring services and most of the services in classes 37 and 40 could be used by members of the general public. Admittedly, this does not apply to *the installation, maintenance, application, levelling and repair of car park decking, industrial and food safe flooring and the installation, maintenance, application, levelling and repair of industrial partitions* in class 37. Subject to that exception, I accept IFT's submission about the type of consumers for the goods/services in classes 19, 37 and 40 of IFPS's applications, albeit with the caveat that business users are likely to account for a larger proportion of customers than the general public. IFT reminds me that where the relevant public is composed of different categories of users paying different degrees of attention, it is necessary to also consider the likelihood of confusion amongst all categories of consumers, including the category liable to pay the lower level of attention.²²

58. It appears to be common ground that the average consumer in this case will pay a higher-than-usual degree of attention when selecting the goods/services at issue.

²¹ Case C-342/97

²² See *Golden Balls Ltd v OHIM*, Case T-448/11

However, implicit in IFT's submission I have recorded in the previous paragraph is the suggestion that members of the general public may pay a little less attention than a professional buyer. I agree.

59. The goods/services covered by the opposed marks are likely to be selected through visual means, such as signage on premises or vehicles, brochures or internet sites. IFT submits that word-of-mouth recommendations also play a significant part in the selection process. Given that the goods are unlikely to be regular purchases and that the services are likely to be selected partly based on the level of confidence that the user has in the likelihood of the provider doing a good and safe job, I accept that oral recommendations are likely to play a significant role in the selection process.

Distinctive character of the earlier mark

60. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*²³ 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

²³ Case C-342/97

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)."

61. IFT submits that the earlier mark has acquired a high level of distinctiveness through use.

62. IFPS denies that the earlier mark is highly distinctive through use or otherwise. In its written submissions, IFPS says that it expects me to find from the evidence or from *"the public record"* that many traders were using *"industrial floor"* or *"industrial flooring"* or *"IFT"* as part of their trade name or trade mark at the time of IFT's application. It may well be the case that other traders in industrial flooring use those words in their trade names. However, even if that is so, it does not follow that they use the letters IFT in their trading names (or at all). There is no evidence of any third-party use of the letters IFT, either as part of a trading name or as an abbreviation for 'integrated (or industrial) flooring technology'.

63. Considered simply as a three-letter string, which is how it is registered and must be regarded for the purposes of this comparison, the letters IFT are not descriptive of the goods/services covered by the earlier mark. On the face of it, the letters IFT are therefore averagely distinctive in relation to the goods/services at issue.

64. IFT's use of those letters as a prominent part of its composite trade mark, which includes the words 'Integrated Flooring Technologies', will have led a section of the public composed of traders in Scotland and the North of England, to associate those letters with 'Integrated Flooring Technologies'. I accept that those words are descriptive of flooring and flooring services. However, the nature of IFT's use of the letters IFT was as part of its trade name rather than simply as an abbreviation of a descriptive term. Although descriptive, there is no evidence that 'Integrated Flooring Technologies' was in customary use at the relevant date. This makes it more likely that those consumers encountering IFT's mark would have regarded the prominent IFT element as having trade mark significance, i.e. as being IFT's brand. I do not, therefore, believe that IFT's use of its mark had the effect of making the letters IFT

less distinctive than they would have been without any use as part of IFT's composite mark.

65. It is well established that a trade mark may acquire an enhanced distinctive character as a result of its use as part of another mark.²⁴ However, I do not consider that the use of the composite mark in question materially enhanced the distinctive character of the earlier IFT mark. This is because:

- The use of the IFT composite mark only commenced in 2016, less than 3 years prior to the relevant date;
- Even though IFT's previous logo included the letters IFT in highly stylised form, this did not amount to the use of the letters IFT *per se* as part of that mark or otherwise;
- Although IFT traded on a significant scale during the period it used the new logo, the actual number of customers is likely to have been relatively small and was mainly confined to large business customers;
- The amount spent promoting the IFT mark was very modest;
- Although the mark received some attention in the media, this was mainly in specialised publications aimed at businesses and the trade;
- There is little evidence that the general public would have been aware of IFT's mark, but they also constitute average consumers of many of the goods and services in classes 19, 37 & 40 of the registration;
- Most of the use was confined to Scotland and the North of England and there is little evidence that this use resulted in IFT's mark becoming any more distinctive to consumers in other parts of the UK.

66. Therefore, whilst I accept that the earlier mark probably acquired a modest uplift in distinctiveness to a section of the relevant public in parts of the UK, the mark had not become highly distinctive through use as claimed by IFT.

²⁴ *Société des Produits Nestlé SA v Mars UK Ltd*, Case C-353/03 CJEU (*Have a Break*)

Similarity of marks

67. I will first compare **IFT** to **IFP Scotland**.

68. 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.”

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 give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

69. The mere fact that a word denotes a geographical place does not necessarily mean that it is lacking in distinctive character. However, given that Scotland is not just a place but a whole country, it seems very unlikely that average consumers in the UK would regard it as having any trade mark character for the goods/services covered by application 3376060. Rather, I find that the ‘Scotland’ element of the opposed trade mark would be perceived as descriptive of the geographical area in which the user of the mark provides goods/services and/or the geographical origin of the goods. It therefore lacks distinctive (trade mark) character. By contrast, I find that IFP has an average or ‘normal’ degree of distinctive character in relation to the opposed goods/services. I also note that IFP is the first part of the IFP Scotland mark. It is therefore positioned more prominently than ‘Scotland’ in the composite mark. I accept that ‘Scotland’ makes a more-than-negligible contribution to the overall impression created by the IFP Scotland mark. However, for the reasons given above, I find that IFP is the dominant and distinctive element of that mark.

70. IFPS raises a number of policy-based arguments as to why the marks should not be considered similar. The first is that IFT should be regarded as an acronym for 'Industrial Floor Treatments' (IFT's corporate and previous trading name) and should, therefore, be treated as a 'unit' which cannot be "*dissected*" so as to create any similarity with IFP. This argument is misconceived. As I have already explained, the earlier mark is not registered as an acronym for 'Industrial Floor Treatments' (or 'Integrated Flooring Technologies – IFT's current trading name). It is well established that I must consider all normal and fair use of the respective marks, not just their use as acronyms or abbreviations for something else.²⁵ The letters IFT do not therefore form a 'unit' with a different meaning to that of the constituent letters.

71. The second policy-based argument is that a finding that the marks are similar because they both begin with IF- would grant an unfair monopoly over the use of those letters, bearing in mind they are the first letters of the descriptive words 'industrial flooring'. I agree that the marks must be compared as wholes. It would therefore be wrong in principle to excise the letters IF- from the marks and reduce the comparison to just '-T' against '- P Scotland'. I will bear in mind that the letters IF are the first letters of the words 'industrial flooring'. However, in determining how much weight to give to this point I will also bear in mind that there is no evidence that 'I.F.' is a recognised abbreviation for 'industrial flooring', or that the letters are used as such by anyone other than these parties.

72. IFPS also suggests that the marks should be compared on the basis that they are members of 'families' of marks. There is only one earlier mark. So there is no question of it being a member of a family of marks. In reality this is another attempt to bring into consideration matters extraneous to the marks at issue. That is wrong in principle.²⁶ Although there are circumstances in which the existence of a 'family' of earlier marks may increase the likelihood of confusion with a later mark, it is trite law that the likelihood of confusion with a number of later marks must be assessed individually in respect of each such mark. I therefore decline the invitation to compare the earlier IFT mark to the three opposed marks collectively.

²⁵ *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220 and *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, CJEU

²⁶ *J.W.Spear & Sons Ltd and Others v Zynga Inc.* [2015] EWCA Civ 290 at paragraph 47

73. Turning back to the marks under consideration – IFT and IFP Scotland – I note that both marks begin with the letters IF- and that IFT and IFP are the same length. However, the addition of the second word - Scotland - means that the later mark as a whole is much longer than the earlier mark. I also take into account that, although visually distinguishable (at least on their own), the letters ‘T’ and ‘P’ are not as visually different as ‘T’ and (say) ‘A’. Overall, I consider that there is a medium degree of visual similarity between these marks.

74. I note that the letters ‘T’ and ‘P’ are pronounced TEE and PEE, which sound quite similar. Comparing the marks as wholes, EYE-EFF-TEE v EYE-EFF-PEE SCOT-LAND, I find that the marks are also aurally similar to a medium degree.

75. Conceptually, neither IFT nor IFP have any meaning. The meaning of Scotland is obvious. However, it is not a very distinctive concept in trade (particularly in Scotland) so it does not constitute a very distinctive conceptual difference from a trade mark perspective.

76. Turning to the comparison between IFT and IFP alone, as in application 3376455, I reach broadly similar findings, except that the absence of the word ‘Scotland’ increases the degree of visual similarity between these marks to medium-to-high and the degree of overall aural similarity to high.

77. Finally, turning to the comparison between IFT and IFPS’s logo mark, as in application 3376215, I find that the format of the logo itself is unremarkable and not distinctive. The mark is dominated by the letters IFP presented in an unremarkable typeface. The words underneath these letters are presented in a much smaller typeface making it clear that IFP are used to distinguish the trade origin of the services and not just as an abbreviation for ‘industrial flooring preparation’. However, the addition of these words and the presentation of the mark in logo form creates a further point of visual distinction from the earlier mark. I therefore reach broadly similar findings about the level of visual similarity between these marks as I did in my comparison between IFT and IFP Scotland (i.e. a medium degree of visual similarity).

78. As regards aural similarity, I find it is likely that the logo mark will be referred to as an IFP mark rather than as 'IFP industrial floor preparation'. This is mainly because of the relative size of the letters IFP compared to the word element, which invites users to refer to it by the letters, especially as the word element is a bit of a mouthful. Therefore, for the reasons given in paragraphs 74 and 76 above, I find that the marks are aurally similar to a high degree.

79. I accept that the addition of the words 'industrial flooring preparation' gives the opposed mark a concept that the earlier mark does not have, at least to those who look closely enough to read the words beneath the letters. The logo mark is therefore conceptually dissimilar to IFT.

Global assessment - likelihood of confusion

80. I will again start with the **IFT** and **IFP Scotland** marks. As I noted earlier, the dominant and distinctive element of the opposed mark (IFP) is visually similar to the earlier mark to a medium-to-high degree and aurally similar to a high degree. The earlier mark is distinctive to an average or 'normal' degree. In these circumstances I find there is a likelihood of confusion through imperfect recollection of one or other of the marks, and through aural confusion. I do not consider that the higher-than-usual degree of attention paid by consumers during the selection process is sufficient to exclude the likelihood of confusion through imperfect recollection. Indeed, this is partly offset by the fact that the respective goods/services will often be irregular purchases, which means that there is plenty of scope for imperfect recollection. Nor do I consider that the higher-than-usual degree of attention paid by consumers during the selection process is sufficient to exclude the likelihood of aural confusion. This is because IFP sounds very similar to IFT and the secondary 'Scotland' element of the opposed mark is a very weak distinguishing element from a trade mark perspective.

81. My findings apply to all the goods/services I have found to be identical, highly similar or similar to a medium degree. They do not apply to *repair or maintenance of*

power-driven floor cleaning machines in class 37, which I have found to be dissimilar to any of the goods/services covered by the earlier mark.

82. The opposed IFP mark is marginally more similar to the earlier mark than the IFP Scotland mark I have already considered. It follows that my findings in relation to application 3376060 (IFP Scotland) also apply to application 3376455 (IFP), again with the exception of *repair or maintenance of power-driven floor cleaning machines*.

83. The IFP logo mark, the subject of application 3376215, is a little less similar to the earlier IFT mark than the two marks I have already considered. This is mainly because it includes the words 'Industrial Floor Preparation'. IFPS's submission that the letters IFP in its marks form a 'unit' (because they have a meaning over and above the letters themselves) bears closer examination in this case. I have carefully considered whether this is sufficient to negate a likelihood of confusion with the earlier IFT mark. I have concluded that it does not. This is because:

- The words 'Industrial Floor Preparation' are so small relative to the letters IFP that many average consumers are likely to remember the letters rather than the words;
- The words are unlikely to be verbalised and therefore will not avoid aural confusion with IFT;
- Confusion in either direction is sufficient to engage s.5(2) in favour of the owner of the earlier mark and, therefore, if consumers imperfectly recollect the earlier mark as IFP the addition of the small words 'Industrial Floor Preparation' in the opposed mark will not avoid a likelihood of relevant confusion.

84. I therefore reach the same findings as regards application 3376215 as I have in relation to applications 3376060 and 3376455.

85. In reaching these findings I attached no weight to the evidence IFT put forward about instances of actual confusion. This is because I am not satisfied that the evidence in question amounts to any more than mis-addressed mail. The fact that

the mistakes were made by suppliers rather than customers further reduces the value of this material as evidence of confusion amongst consumers. At most, it is consistent with my finding that there is a likelihood of such confusion.

86. For its part, IFPS relies on the absence of any evidence of confusion amongst consumers to show that there is no likelihood of confusion. In *Roger Maier and Another v ASOS*²⁷ Kitchen L.J. stated that:

“80.the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in Specsavers at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

87. The use of the earlier marks relied on in this case appears to have started publicly around the middle of 2017, about 20 months prior to the relevant date. Therefore, there has not been a long period of side by side use. Further, although the extent of use of IFPS’s marks is not entirely clear, it appears to have been on a modest scale. In my view, there has not been sufficient side by side use of the marks, especially of the IFP (alone) and ‘IFP Scotland’ marks, without evidence of confusion, to show that there is no likelihood of confusion.

²⁷ [2015] EWCA Civ 220

88. IFPS relies on honest concurrent use of its marks. In *Victoria Plum Ltd v Victorian Plumbing Ltd*,²⁸ 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*.²⁹ Having done so, he noted that a defence of honest concurrent use can, in principle, defeat an otherwise justified claim of trade mark infringement. Having reviewed the case-law the judge stated that:

"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."*

The *Budweiser* case shows that honest concurrent use may also be relevant in trade mark opposition and cancellation proceedings. Consequently, Carr J.'s guidance in *Victoria Plum* must also be kept in mind in proceedings of this kind.

89. However, in my view, there is insufficient evidence of concurrent use to justify a finding that the marks at issue had come to be recognised by the relevant date as indicating the goods/services of both undertakings to average UK consumers. I therefore reject the defence based on honest concurrent use.

²⁸ [2016] EWHC 2911 (Ch)

²⁹ [2014] EWCA Civ 1403

90. Part of IFPS’s case on bad faith appears to amount to a claim that IFT consented or acquiesced to its use of the opposed marks. Consent may be implied, but it must be unequivocal.³⁰ The evidence does not come near to supporting a finding that IFT gave IFPS implied consent to use or register the opposed marks. As to a possible defence of statutory acquiescence, there is no evidence that IFT knew about the use of IFPS’s marks prior to March 2018. Even where a later conflicting mark is registered, section 48 of the Act permits the owner of a relevant earlier trade mark or right a period of five years in which to bring an application for invalidation before it is deemed to have acquiesced to the use and registration of the later mark. IFPS’s marks were not registered when IFT found out about them. And the period between finding out about them and IFT applying to register its own mark was only 8 months. Therefore, there is no possible basis for a claim of statutory acquiescence. I see no scope for any other kind of bar based on purely national law.³¹

IFT’s oppositions to IFPS’s trade mark applications under section 5(3) of the Act

91. IFT claims that the earlier mark has a reputation for all the goods/services for which it is registered. This ground of opposition is directed at all the goods/services covered by the applications. The goods/services covered by classes 17, 19, 37 and 40 of IFPS’s applications are set out above. The goods/services covered by the earlier mark and those covered by the other classes of IFPS’s applications are set out below.

IFT	IFPS
<p>Trade Mark 3348690 - IFT</p> <p>Class 11: Underfloor heating installations and apparatus.</p> <p>Class 17: Resin and polymers for use in flooring; resin and polymers for use in</p>	<p>Trade Mark 3376060 - IFP Scotland</p> <p>Class 16: Printed pages downloaded from the Internet; printed matter; printed publications; advertising and promotional materials; books; notebooks; pop up stands made from paper or cardboard; diagrams;</p>

³⁰ See *Joined Cases C-414 to 416/99 Zino Davidoff SA v A&G Imports Ltd and Levi Strauss & Co v Tesco Stores Ltd*, CJEU, particularly at [35] to [47] and [53] to [58]

³¹ See, by analogy, *Marussia Communications Ireland Limited v Manor Grand Prix Racing Limited*, [2016] EWHC 809 (Ch) and the case-law cited therein

forming dust proof and hardened skins in flooring; resin and polymer sealants for use in connection with the installation of flooring including car park decking, raised access flooring, industrial and food safe flooring.

Class 19: Non-metallic wall cladding panels; synthetic flooring and wall cladding materials; hygienic non-metallic wall cladding panels. Non-metallic wall cladding panels; synthetic flooring and wall cladding materials; hygienic non-metallic wall cladding panels.

Class 37: Floor treatment services, namely the installation, maintenance, application, levelling and repair of flooring screeds, car park decking, industrial and food safe flooring; installation, maintenance and repair of underfloor heating installations and apparatus; installation, maintenance, application and repair of wall cladding panels, synthetic flooring and hygienic wall cladding panels.

Class 40: Flooring finishing services.

plans; drawings; flyers; newsletters; pamphlets; manuals; printed manuals; printed technical manuals, technical bulletins and technical advisories; reference guides; catalogues; periodical publications; brochures; booklets; posters and prints; stationery; bags; writing paper; paper; marketing stands made from paper or cardboard; calendars; paper ornaments; printed guides; printed programs; printed certificates; diaries; organisers; pens and pencils; instructional and teaching materials; information books; promotional literature; programmes; leaflets; labels; stickers; photographs; posters; graphic drawings; graphic prints; graphic representations; graphic reproductions; reproductions (graphic -); banners and wall hangings made of paper or cardboard; office requisites; binders and folders; book markers; envelopes; maps; stationery and educational supplies; articles of stationery; instructional and teaching materials (other than apparatus); document files and printed forms; writing or drawing books; address books; manuscript books; pocket memorandum books; activity books; log books; pocket books [stationery]; bags and materials for packaging (not included in other classes); parts, fittings and accessories for the aforesaid.

Class 27: Anti-slip floor coverings for use on staircases; Anti-slip material for use under floor coverings; Carpet tiles for covering floors; Chair mats [under-chair floor protector]; Coverings (Floor -); Coverings for existing floors; Decorative slip-resistant floor coverings in sheet form; Disposable absorbent floor pads; Floor coverings; Floor coverings and artificial ground coverings; Floor coverings [for existing floors]; Floor coverings having insulating properties; Floor coverings [mats] being sheet materials for use in sporting activities; Floor coverings [mats] for use in gymnastic activities; Floor coverings [mats] for use in

	<p>sporting activities; Floor mats; Floor mats, fire resistant, for fireplaces and barbecues; Floor mats, fire-resistant, for fireplaces and barbecues; Floor mats for automobiles; Floor mats for vehicles; Floor mats of cork; Floor tiles made of carpet; Floor tiles made of cork; Floors coverings of rubber; Hard surface coverings for floors; Horse stall floor mats; Interlocking floor runners; Linoleum for covering existing floors; Linoleum for use on floors; Materials for covering existing floors; parts, fittings and accessories for the aforesaid.</p> <p>Trade Mark 3376060 - IFP Scotland & Trade Mark 3376455 – IFP & Trade Mark 3376215 – IFP logo</p> <p>Class 35: Advertising; marketing; merchandising; business, customer, product and service research, analysis, assistance; provision of business, customer, product and service advice and information; Business management; Business administration; Business inquiries; Providing flooring price comparison information; Provision, storage and retrieval of business and commercial information; Publicity services; Customer loyalty services and customer club services, for commercial, promotional and/or advertising purposes; Conducting customer loyalty, reward, affinity and incentive programs for commercial promotion and for advertising purposes; Compilation of statistics; Commercial information and advice for consumers (consumer advice shop); Compilation of statistical information; Information in business matters; Marketing research; Marketing, including on digital networks; Market research; Opinion polling; Incentive schemes; Price comparison services; News clipping services; Systemization of information into computer databases; Loyalty schemes; Business consulting and management services in the</p>
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	<p>flooring preparation services; Dissemination of advertisements; Sales promotion; Advertising matter (dissemination of -); Direct mail advertising; Distribution of samples; Direct mail advertising; Advertising services, namely, promoting and marketing the goods and services of others via electronic communication networks; Compilation of information into computer databases; Digital data processing; Research in databases and on the Internet, for others; Retail services, mail order retail services, electronic retail services, online retail services, wholesale services connected with floor coverings; information, advisory and consultancy services relating to these services; the bringing together, for the benefit of others, of a variety of design, research and development, flooring consultation and advisory services enabling customers to conveniently view and purchase those services.</p> <p>Trade Mark 3376060 - IFP Scotland & 3376455 IFP</p> <p>Class 25: Clothing; footwear; headgear; parts, fittings and accessories for the aforesaid.</p> <p>Class 42: Industrial analysis and research services; Design services; floor design; design of floor coverings; Development of coatings for floorings; advisory, information and consultancy services for all the aforesaid services including such services, information and advice provided online from a computer network and/or via a computer database or the Internet, extranets or via other communications.</p> <p>Trade Mark 3376215 – IFP logo</p> <p>Class 42: Industrial analysis and research services; design services; floor design; wall design; design of floor coverings; design of</p>
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	<p>wall coverings and cladding; development of coatings for floorings; development of coatings for walls; development of resins for walls and floorings; development of polymers for walls and floorings; advisory, information and consultancy services for all the aforesaid services including such services, information and advice provided online from a computer network and/or via a computer database or the Internet, extranets or via other communications.</p>
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92. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

93. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

- a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.
- (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.
- (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.
- (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*
- (e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.
- (f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

Reputation

94. Whilst conceding that the earlier mark might have a minimal level of reputation (as an acronym for 'industrial floor treatments'), IFPS disputes that the earlier mark was known to a significant part of the relevant public at the relevant date.

95. The closest thing I can find in IFT's evidence to a clear statement of the goods/services for which the earlier mark has been used prior to the relevant date is the following statement identified by Mr Love himself, which is taken from an article dated 15th November 2016 in exhibit GL3 to his first statement.

“IFT has evolved considerably from just industrial flooring and now provides clients with a variety of services including floor screeds and levelling, resin flooring, food safe flooring, car park decking systems, raised access flooring, underfloor heating and hygienic wall cladding.”

96. IFT appears to be primarily a provider of services rather than a trader in goods. It is likely that IFT provides the materials used to lay flooring etc. for its clients, but there is no evidence of sales of goods as such under the earlier mark. Even if the provision of the materials used to provide the services counts as use of the mark in relation to goods too, any reputation attached to the IFT mark is likely to be perceived primarily as one for flooring services. Indeed, that is how it is described in the article re-produced above. The high point of IFT’s case therefore appears to be that the earlier mark has a reputation for the services for which it is registered in classes 37 and 40.

97. In *General Motors* the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade

mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

98. The final point means that the mere fact that IFT is used predominantly in Scotland and Northern England does not preclude a finding that the earlier mark has a qualifying reputation in the UK. However, the fact that any reputation appears to be geographically focussed in only parts of the UK is a relevant factor to be considered alongside other relevant factors.

99. Although there is some evidence that IFT was known by those letters, even before the re-brand in 2016, the use of the earlier mark only commenced at that time. I also note that most of the relatively few examples in evidence of people referring to IFT by just those letters post-date IFT's re-branding in 2016. I conclude that there was around 2.5 years of relevant use of the earlier mark prior to the relevant date.

100. There is no evidence about the size of the UK market in flooring services of the kinds covered by the earlier mark. I would expect it to be a large market amounting to hundreds of £millions per annum. The annual turnover achieved under the earlier mark does not appear to be insignificant, even in this context, although it appears to represent a relatively small number of projects delivered to a relatively small number of business or trade customers. On the other hand, I note that some of these projects attracted media coverage, mainly in the trade.

101. Most of the services in question are of primary interest to other traders, including contractors and businesses. However, some of the services, for example, installation of flooring screeds and synthetic flooring, are also of potential interest to the general public.

102. The amount spent promoting the earlier mark appears very modest and was less in 2017 and 2018 than in 2016.

103. In *Spirit Energy Limited v Spirit Solar Limited*,³² Mr Phillip Johnson as the Appointed Person held that the opponent had not established a qualifying reputation for s.5(3) purposes. The opponent traded in solar energy equipment and installations and had used its mark in relation to such goods/services for 7 years prior to the relevant date in the proceedings. During the 5 years prior to the relevant date it had installed solar energy generation equipment in over 1000 domestic homes and made over 700 installations for commercial customers. These sales had generated nearly £13m in income. However, there was limited evidence of advertising and promotion, and the amount spent promoting the mark had fallen in the years leading up to the relevant date. Additionally, the mark had only been used in South East England and the Midlands. Taking all the relevant factors into account, the Appointed Person therefore decided that such use of the mark was not sufficient to establish a reputation for the purposes of s.5(3).

104. Although I recognise that each case must be assessed on its own facts and the attendant risk of making comparisons with the facts in other cases, I find that my own assessment of the relevant factors in this case brings me to a similar conclusion. The evidence does not establish that the earlier mark, i.e. IFT as such, was known to a significant part of the relevant UK public at the relevant date.

105. The section 5(3) grounds of opposition fail accordingly.

IFT's oppositions to IFPS's trade mark applications under section 5(4)(a) of the Act

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

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

³² BL O/034/20

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa)

(b)

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

Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

107. The signs relied on by IFT are the letters IFT alone and the sign shown below.



108. IFT’s opposition is directed at all the goods/services covered by IFPS’s applications. The grounds of opposition under s.5(2) of the Act have already succeeded so far as nearly all the goods/services in classes 17, 19, 37 and 40 of IFPS’s applications are concerned. In my judgement, IFT has no better case under s.5(4)(a) in relation to the registration of the opposed marks in relation to these goods/services than it has under s.5(2). Therefore, I will limit my examination of the s.5(4)(a) grounds of opposition to the remaining goods/services covered by IFPS’s

application (see table at paragraph 91 above) and *repair or maintenance of power-driven floor cleaning machines* in class 37, for which the s.5(2)(b) grounds failed.

109. In *Discount Outlet v Feel Good UK*,³³ Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per Interflora Inc v Marks and Spencer Plc [2012] EWCA Civ 1501, [2013] FSR 21).”

Relevant dates

110. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*,³⁴ Mr Daniel Alexander QC as the Appointed Person endorsed my assessment of the relevant dates for the purposes of section 5(4)(a) of the Act in *SWORDERS TM*,³⁵ as follows:

“Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider

³³ [2017] EWHC 1400 IPEC

³⁴ BL O-410-11

³⁵ BL O-212-06

what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.”

111. In *Smart Planet Technologies, Inc. v Rajinda Sharm*,³⁶ Mr Thomas Mitcheson QC as the Appointed Person pointed out that “*the start of the behaviour complained about*” is not the same as the date that the user of the applied-for mark acquired the right to protect it under the law of passing off. Rather, it is the date that the user of that mark committed the first external act about which the other party could have complained (if it knew about it) as an act of actual or threatened passing off. Typically, this will be the date when first offer was made to market relevant goods or services under the mark. However, it could also be the date the first public-facing indication was given that sales were proposed to be made under the mark in the future. The relevant date is therefore 12th or 27th June 2017 (see evidence summary at paragraph 18 above). There is no need to decide which of these dates is correct because IFT’s goodwill did not differ materially at either date.

Goodwill

112. IFPS appears to accept that by the date of its trade mark applications, IFT had acquired at least a low level of goodwill under the signs.

113. In my view, the evidence shows that IFT has indeed acquired a protectable goodwill under the signs by the first relevant date in June 2017 and the second relevant date in February 2019. The goodwill was in relation to a business trading in:

“...services including floor screeds and levelling, resin flooring, food safe flooring, car park decking systems, raised access flooring, underfloor heating and hygienic wall cladding.”

³⁶ BL O/304/20

Distinctiveness of signs

114. I accept that the signs relied on by IFT had become distinctive of its business to a substantial number of its customers and potential customers. This was mainly because of its use of the logo version of the mark following the re-branding in 2016. However, IFT appears to have become known to some of its customers by these letters as an acronym for its longstanding corporate name (Industrial Floor Treatments limited). Most of IFT's actual customers, as well as potential customers to whom the signs were distinctive, would have known that IFT stood for 'Integrated Flooring Technologies' (because the logo version of the mark told them that it does) or its corporate and previous trading name - Industrial Floor Treatments limited. 'IFT' was, therefore, but one of the signs by which IFT's business was sometimes known. The letters IFT alone did not, therefore, enjoy the highest possible level of distinctiveness in relation to IFT's business.

Misrepresentation

115. Halsbury's Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted that:

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

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

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

116. The nature and extent of the reputation relied on are set out in paragraphs 113 – 114 above. So far as I can see, IFT has not addressed the closeness or otherwise of the respective fields of activity in which the parties carry on their business with specific regard to the goods/services listed in classes 16, 25, 27, 35 or 42 of IFPS's applications. Most of these goods/services appear to be traded in different fields of commercial activity compared to the types of flooring and wall cladding services in which IFT trades. The goods covered by classes 16 and 25 of IFPS's applications are clearly in a different field of activity to IFT's business. There is some superficial similarity between the services provided by IFT and:

- floor coverings in class 27 of application 3376060;
- retailing and wholesaling of floor coverings and *providing flooring price comparison information; business consulting and management services in the flooring preparation services; information, advisory and consultancy services relating to these services; the bringing together, for the benefit of others, of a variety of design, research and development, flooring consultation and advisory services enabling customers to conveniently view and purchase those services* in class 35 in all three of IFPS's applications;
- floor design services in class 42 in all three of IFPS's applications.

However, the goods and retail/wholesale services in classes 27 and 35 of IFPS's applications are concerned with coverings for existing floors rather than the installation etc. of the sorts of floors in which IFT trades, or they are even further

removed from the IFT's business. The information/advisory/consultancy services relating to flooring that fall in class 35 are in the nature of business information, marketing or advertising services,³⁷ such as price comparison services. I am not sure what *business consulting and management services in the flooring preparation services* means. However, in order to fall within class 35 it must be in the nature of a business consulting/management service rather than technical consultancy about floor preparation. There is no evidence that IFT provides floor design services of the kind covered by class 42 of IFPS's applications. More importantly, there is no evidence that these services are commonly provided by undertakings who also install, repair etc. flooring of the kinds supplied by IFT.

117. In the absence of any evidence or arguments directed to the point, I have not found it easy to decide if any of the goods/services in classes 27, 35 or 42 of IFPS's applications are in the same field of activity as IFT's business. At most, some of these goods and services may be similar to IFT's services to a low degree. Even if they fall within the same broad field of activity as IFT's services, they are at least one step removed from them. This is important because as Millet L.J. stated in *Harrods Limited v Harrodian School Limited*:³⁸

"Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one."

118. Turning to the similarity between the signs and the marks, I adopt my assessment of the similarity between the letters IFT as such and each of the three marks applied for by IFPS set out at paragraphs 67 – 79 above. As regards the similarity between the logo version of the IFT sign and IFPS's marks, I note that the former includes a significant device element which has no counterpart in IFPS's marks, as well as the words 'Integrated Flooring Technologies'. The logo version of the sign is therefore less similar to the opposed marks than the letters IFT alone.

³⁷ Merely advertising your own goods/services is not providing an advertising service

³⁸ [1996] RPC 697 (CA)

119. IFPS appears to use IFP mainly in the form of the IFP logo. However, the oppositions under s.5(4)(a) must be assessed on the basis that IFPS could use any of the three marks applied for. So the fact that IFPS tends to use its IFP mark in association with the words 'industrial floor preparation' is not a relevant factor so far as the IFP and IFP Scotland marks are concerned.

120. The goods/services under consideration include some which are clearly aimed at business users who will pay a high degree of attention during the selection process, e.g. *industrial analysis and research services*. However, they also include goods such as printed matter and floor tiles, which are everyday goods as much of interest to the general public as to more specialised consumers. I therefore note that some of the goods/services will be selected by the general public whilst paying only an average degree of attention.

121. IFT suggests that the IFPS's marks may have been chosen because of their resemblance to the IFT mark/name. However, there is no direct allegation that IFPS's trade mark applications were filed in bad faith. And, in my view, there is no persuasive evidence that IFPS's marks were adopted with a fraudulent intention.

122. Considering the matter in the round, I am not satisfied that the use of any of IFPS's marks in relation to the goods/services in classes 16, 25, 27, 35 or 42 of its applications would have deceived a substantial number of IFT's customers or potential customers at the relevant dates. This is because of the combination of (1) the differences between the marks, and (2) the degrees of separation between the goods/services traded in under the marks. The same applies to the use of IFPS's marks in relation to *repair or maintenance of power-driven floor cleaning machines* in class 37.

123. In the absence of a likelihood of deception there is no misrepresentation. And without misrepresentation there is no passing off. The section 5(4)(a) grounds of opposition therefore add nothing to the extent of IFT's success based on its s.5(2) grounds of opposition.

Overall outcome

124. The opposition to application 3376060 succeeds in classes 17, 19, 37 and 40, except for *repair or maintenance of power-driven floor cleaning machines* in class 37.

125. The opposition to this application fails in respect of the goods/services in classes 16, 25, 27, 35 and 42. The mark may therefore proceed to registration in these classes and for *repair or maintenance of power-driven floor cleaning machines* in class 37.

126. The opposition to application 3376455 succeeds in classes 37 and 40, except for *repair or maintenance of power-driven floor cleaning machines* in class 37.

127. The opposition to this application fails in classes 25, 35 & 42. The mark may therefore proceed to registration in these classes and for *repair or maintenance of power-driven floor cleaning machines* in class 37.

128. The opposition to application 3376215 succeeds in classes 37 and 40, except for *repair or maintenance of power-driven floor cleaning machines* in class 37.

129. The opposition to this application fails in classes 35 and 42. The mark may therefore proceed to registration in these classes and for *repair or maintenance of power-driven floor cleaning machines* in class 37.

Costs

130. IFT's oppositions to IFPS's applications have partly succeeded and partly failed. Consequently, I direct that the parties should bear their own costs so far these oppositions are concerned.

131. IFPS's application to invalidate IFT's trade mark 3348690 on grounds of bad faith has failed. In the circumstances, IFT is entitled to a contribution towards the cost of defending an unmeritorious bad faith claim. IFT does not appear to have

undertaken more than a minimal amount of additional work in defending the application; little more than filing a counterstatement. However, those representing IFT would still have had to read and consider IFPS's evidence and multiple submissions about this ground. I therefore assess costs as follows:

£600 for considering the application for invalidation and filing a counterstatement;

£400 for considering the evidence and submissions filed on behalf of IFPS in support of its bad faith claim.

132. I therefore order Industrial Floor Prep Scotland Limited to pay Industrial Floor Treatments Limited the sum of £1000. This sum to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal which is later withdrawn, within 21 days of the date of withdrawal.

Dated 5th October 2020

Allan James

For the Registrar