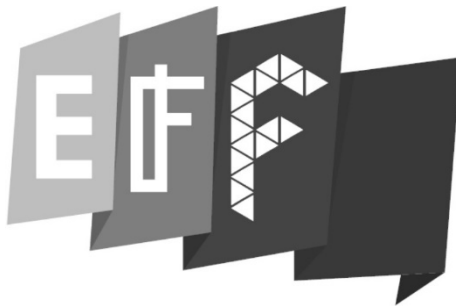


O-553-22

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3223020
BY THE INSTITUTE OF PRACTITIONERS IN ADVERTISING
FOR THE TRADE MARK**



IN CLASSES 35 and 41

**AND IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 409775
BY ASSET PROTECTION & LICENCING LTD**

BACKGROUND AND PLEADINGS

1. On 4th April 2017, The Institute of Practitioners in Advertising (“**the Applicant**”) applied for the following figurative mark as a UK trade mark:



2. On 14th April 2017, the mark was published for opposition purposes in the Trade Marks Journal in respect of the following services:

Class 35: Market research; marketing studies; consumer surveys; analysis and tabulation of market research data and statistics; data collection; conducting of interviews; provision of statistical information relating to business; advertising and marketing; provision of marketing information; business research; business inquiries; business investigations; business appraisals; advisory services for business management; business management assistance; planning of marketing strategy; business planning and business administration services; advertising, promotional, publicity and marketing services, and the analysis of the effectiveness thereof; business advisory, consultancy, research and information services; compilation, provision and retrieval of business and commercial information; compilation of, and systemisation of, information into computer databases; database management services; interactive database information services; advisory and consultancy services all relating to the above services.

Class 41: Education, examination and training services; conducting, organising and administering training, continuing professional development schemes, programs, courses and events; conducting and organising examinations; organising and the provision of conferences and seminars; organising and provision of sporting events, art exhibitions, cultural opportunities; publication of books and printed matter; information services relating to education and professional development; provision of online teaching and training; online publication; hire or rental of teaching apparatus and materials.

3. On 13th July 2017, the application was opposed, in full, by Storage Solutions Limited. Since these proceedings commenced, the rights relied upon have been transferred to Asset Protection & Licencing Ltd, who is now “**the Opponent**”. On 9th May 2019, the Opponent filed a Form TM7G, requesting the addition of a second earlier right, and an additional ground of opposition. The Tribunal admitted the Form and the opposition is therefore brought under sections 5(2)(b) and 5(3) of the Trade Marks Act (“**the Act**”), and is based upon two UK trade marks owned by the Opponent:

(i) The “word mark”

Eff

UK trade mark no. 2319221

Filing date 18/12/2002

Registration date 03/10/2003

Relying on goods in Class 9 and services in Class 42

(ii) The “figurative mark”



Filing date 05/07/2001

Registration date 30/11/2001

Relying on goods in classes 6, 16 and 20

4. An “earlier trade mark” is defined in section 6(1) of the Act as:

“(a) a registered trade mark, international trade mark (UK), a European Union trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks”

5. The Opponent's trade marks have filing dates which predate that of the Applicant's trade mark. The Opponent's marks therefore constitute earlier trade marks under the Act.

The Opponent's case

6. Under section 5(2)(b) the Opponent relies on its word mark and opposes all of the Applicant's services under classes 35 and 41. The Opponent submits that:

- (i) the marks are visually similar and phonetically identical;
- (ii) the Applicant's services in Class 35 include marketing, commercial and business activities, which are broad in scope and so confusingly similar to the Opponent's goods and services;
- (iii) due to these factors, there is a likelihood of confusion on the part of the public.

7. Under section 5(3) the Opponent relies on its word mark and figurative mark and opposes all of the Applicant's services under Classes 35 and 41. The Opponent claims that its evidence shows the rich history of use of its marks, over 20 years, particularly in respect of furniture in the business sector, including in the educational sector. The Opponent states that its marks and the contested mark are visually and phonetically highly similar; and due to the reputation of its marks, it submits that:

- (i) the Applicant's mark will take an unfair advantage;
- (ii) the Applicant's mark will be detrimental to the distinctive character or repute of its marks.

8. The Opponent's statement of grounds filed with Form TM7G makes allegations about the conduct of the Applicant, first in filing a mark that is so similar to an earlier registration and second, in filing four further applications for marks including the element "EFF". The Opponent has not formally brought a claim of bad faith in these proceedings and, as the Applicant highlights in its submissions in lieu of a hearing, the marks that have been registered by the Applicant since filing the mark presently under consideration, are not a relevant consideration in these proceedings.

The Applicant's case

9. On 19 July 2018, the Applicant filed a notice of defence and counterstatement. In respect of the Opponent's word mark, under section 5(2)(b), the Applicant:

- (i) denies the marks are visually similar;
- (ii) denies that there is any similarity between the Opponent's goods and services and the Applicant's services;
- (iii) requests that the Opponent show proof of use of all of the goods and services under its word mark.

10. In its submissions filed on 17 December 2021, the Applicant addressed the addition of the second mark and section 5(3) ground of opposition. The Applicant expressed surprise and disappointment that the additional grounds were admitted at such a late stage in the proceedings, however I note that a case management conference was not requested to discuss this.

11. In respect of section 5(3), the Applicant submits that:

- (i) the Opponent has not shown that its earlier marks have a reputation in the UK;
- (ii) even if the Opponent had established that it had a reputation in respect of its marks, the Opponent has failed to show that the Applicant's mark would take unfair advantage of, or cause detriment to either of its earlier marks;
- (iii) there is no suggestion of an economic, or other link between the Applicant's mark and the Opponent's marks.

Representation and papers filed

12. Only the Opponent filed evidence in these proceedings. The evidence comprises two witness statements of Peter Sully, Director of the Opponent company. The first witness statement dated 1 October 2018 sets out the Opponent's evidence in chief and includes 18 exhibits, numbered 1 to 18. The second witness statement of Mr Sully is dated 30 May 2019. This witness statement is provided as evidence in reply to the Applicant's submissions. It introduces four exhibits, A to D, intended to show how the

Applicant uses its mark, how web addresses (urls) are shortened, and how the parties' goods and services are similar.

13. Almost four years have elapsed since the Applicant joined the proceedings in 2018, with changes to the grounds of opposition being made during this time and a suspension in 2021 to address the dissolution of the company which previously held the Opponent's marks. During the proceedings, the Opponent has filed submissions dated 14 February 2019¹ and 3 June 2019. On 14 March 2022, the Opponent filed submissions in lieu of a hearing, with further submissions filed by the Opponent on 7 April 2022. The Applicant filed submissions dated 4 April 2019 and 17 December 2021. On 23 March 2022, the Applicant filed submissions in lieu of a hearing. Neither party requested a hearing and this decision is therefore taken following careful consideration of the papers filed. I will refer to the submissions and evidence where I consider it warranted to do so.

14. The Applicant is represented by MW Trade Marks Limited; the Opponent by IPTogether Limited.

DECISION

Relevance of EU law

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

Section 5(2)(b)

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

¹ Re-submitting submissions filed with the Opponent's evidence in chief on 1 October 2018.

“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”.

Proof of use:

17. Since these proceedings were launched before 14 January 2019, the relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use”

6A(1) This section applies where

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

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

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

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

(3) The use conditions are met if –

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

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

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

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

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

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

18. Section 100 of the Act is also relevant, it reads:

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

19. Since the Opponent's marks had been registered for more than five years when the contested mark was applied for, they are subject to the use provisions under section 6A of the Act. Through Form TM7 and TM7G, the Opponent provided statements of use of its marks in respect of all of its goods and services. In its notice of defence and counterstatement, the Applicant requested that the Opponent provide evidence that it had used the word mark. Therefore, the Opponent must show use of its word mark during the five years up to the date when the contested mark was published, that is 15 April 2012 to 14 April 2017 ("**the relevant period**").

20. Following the addition of the figurative mark and section 5(3) ground to the proceedings, the Applicant did not file a further TM8 notice of defence, and instead addressed and denied these grounds through submissions. The Applicant did not make a request for proof of use of the Opponent's figurative mark, however, as section 5(3) is an evidenced based ground, I will assess the Opponent's use of its figurative mark later in my decision.

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

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

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

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

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

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

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

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in

accordance with the commercial raison d'être of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: Ansul at [37]-[38]; Verein at [14]; Silberquelle at [18]; Centrotherm at [71]; Reber at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: Ansul at [38] and [39]; La Mer at [22]-[23]; Sunrider at [70]-[71], [76]; Leno at [29]-[30], [56]; Centrotherm at [72]-[76]; Reber at [29], [32]-[34].

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

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

22. The Opponent is required to show proof of use of its word mark in respect of:

Class 9: Computer programs and software relating to downloadable on-line electronic publications and information provided by way of such publications relating to products including cash boxes, metal containers, lockers, cabinets, screens, partitions, catalogues, magazines, periodicals, files, placards, plastic film for wrapping, furniture for office, school and domestic locations, shelving, display stands, ladders, tables, trolleys, workbenches and bins.

Class 42: Design, planning, development and consultancy services relating to office, school and storage equipment and locations involving such equipment.

Class 9

23. There are two ways of interpreting the list of goods under Class 9 of the Opponent's mark. The first is as a specific type of computer program and software both related to electronic publications, where the electronic publications are limited to being related to certain products, examples of which cover equipment for offices, work, or school settings. The second understanding is that the specification covers "computer programs" at large and not limited in purpose, with only the Opponent's "software" in the list being limited to publications in the manner described. For this interpretation, one would usually expect the specification terms to be separated by a semi-colon. To allow the Opponent the broadest opportunity to show use of its word mark in Class 9, I will use the second interpretation in my assessment.

24. The Opponent's evidence refers to a customer, Peter Yates Leather Goods, who Mr Sully describes as the first software customer and explains that the client was provided with a fully serviced website. I have noted above that the relevant period during which the Opponent is required to show use begins on 15 April 2012. Mr Sully states that this transaction took place "in 2011-12". It is not clear therefore that this transaction took place within the relevant period, and I am not able to take it into account for the purposes of assessing use. Even if the evidence showed the transaction took place during the relevant period, it is not clear from the evidence, at

Exhibit 3, that the software program purchased by Peter Yates Leather Goods was sold under the trade mark “Eff”, and I note that the Opponent’s previous company name, Storage Solutions appears on the data file.

25. Mr Sully goes on to describe a contract with the Commercial Bank of Qatar, which he describes as being for the purpose of writing operating procedures for the bank, in accordance with ISO 9001 standards. Mr Sully indicates that this evidence shows the diverse activity of the Opponent. There is no evidence to indicate that this client, based in Qatar, purchased a software program from the Opponent under the Eff brand. Even if this evidence were provided, it would not support a finding that the Opponent’s mark had been used in the territory of the UK.

26. Other references to software within the evidence indicate that Mr Sully has made reference to the Eff brand at meetings with other businesses, and his LinkedIn page refers to his development of software. I have seen nothing in these exhibits to confirm that sales of software were actually made under the “Eff” trade mark. In Exhibit 2, a range of products, described as data files are shown. This appears to relate to a content management system, provided by the Opponent to their customer Fast2Stationery.co.uk. Mr Sully refers to a range of websites being “Eff” branded, but no evidence of this is provided and I note that on the data file the Opponent’s previous company name, Storage Solutions appears. There is no evidence of when this contract was carried out, with Mr Sully only stating his belief that the data was used on shops into 2012/2013.

27. I have given a broad interpretation of the Opponent’s goods in Class 9 but have not identified genuine use of the Opponent’s word mark during the relevant period. As stated by the Applicant in its submissions of 4 April 2019, the Opponent’s evidence consistently refers to only an intention to market its software, with the witness statements of business associates being examples of this. Where the evidence does show a data system, it is shown to be under the Storage Solutions name, and not the trade mark relied upon in these proceedings. I find that there is nothing to show that the Opponent’s goods are already marketed or, in accordance with *Ansul*, to show that preparations are under way to secure customers, for example, in the form of

advertising campaigns. I conclude that the Opponent has failed to show that it has made genuine use of its word mark for its goods under Class 9.

Class 42

28. Under Class 42, the Opponent's word mark is registered essentially in respect of design services relating to storage and equipment for offices and schools. The evidence before me indicates that the supply of these forms of storage and equipment is the focus of the Opponent's business activity, with stock lists and product enquiries provided. Advertisements/company listings in the evidence state that the Opponent offers design and project management services in relation to office and storage equipment, however there is no evidence, for example contracts, designs or enquiries to show that these services have actually been provided by the Opponent. Additionally, the services are in some cases shown to be offered by Storage Solutions, rather than under the Eff trade mark and while Mr Sully explains that the eff.eu website address directs the customer to the Storage Solutions website (third screen shot below), it is not clear that the consumer is aware that they are accessing services provided under the Eff trade mark. Additionally, the evidence includes no information on the number of UK visitors to the eff.eu website:

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Storage Solutions Consultants

Storage Solutions Consultants are particularly recognised for their skill in the design of warehouses and distribution centres. Using our considerable experience to maximise both the operational efficiency, space utilisation. We also have knowledge of best practice and operational experience warehouse and manufacturing.

The combination of these skills and our knowledge of equipment costs enables us the unique ability to optimise efficiency and minimise maintenance costs, whilst offering excellent value for money.

Many companies offer a seemingly free service but put forward schemes that are designed to prevent competition quoting and minimise profit when they come to install what can be a less than satisfactory solution. We, on the other hand, charge for our consultancy at a reasonable rate and spend the time and effort to gain a full understanding of our clients needs and to make them with a specification for tender. We will analyse live volumetric movement data and question convention, enabling us to offer solutions tailored to give your business long term, sustainable benefits.

On one recent contract we moved to the client, who had approached us to purchase a considerable quantity of pallet racking, that his proposal would actually reduce the capacity and flexibility of his operation. We informed him that by changing the layout of the block stacks of palletised domestic appliances, we could achieve all that he wished, saving tens of thousands of pounds. It is our view that this approach will enable us to build long term, robust relationships with our clients, bringing us long term benefits.

Many clients who use our consultancy service having built trust and in the knowledge that we are looking for a long term relationship not just a quick buck!

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Eff is your Office furniture and fit-out specialist offering Eff-ective Eff-icient solutions for projects large and small. Eff has now diversified to its range to provide office essentials as well as its traditional range of desks, office chairs, shelving and storage.



- Office Equipment
- Chairs & Seating
- Filing Cabinets
- Cupboards
- Desking
- Bookcases
- Shelving
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- Contact Us

31. In his witness statement, Mr Sully provides annual turnover figures for the UK. The figures are provided by calendar year, so I have focussed on the full calendar years within the relevant period, these being 2013 to 2016. Across these years, Mr Sully reports annual sales between £1.1 and £1.4 million. Mr Sully indicates that the figures cover “*sales of products and services under EFF*”, but then later explains that the “*figures relate to the whole company and that Eff sales will amount to approximately 1-2% of the figures*”, which would suggest annual sales in the low hundreds of thousands. At paragraph 14 of his witness statement, Mr Sully lists what he describes as “*some*” of the goods and services which have been offered under the trade mark:

FF&E (*furniture, fittings and equipment*) services including design consultancy, supply and installation, display equipment in different business sectors particularly in the educational sector; Storage and handling equipment; Office Supplies, Computer and software upgrade, software sales, business machines including computer hardware, Online marketing specifically in relation to downloadable files and publications using eff.eu as a url shortener since April 2015, e-commerce software (used in connection with the implementation of the use to sell product online from 2002) with the intention to use EFF for the Marketing content database, e-commerce and CRM system from around 2015 in the United Kingdom.

Outcome under section 5(2)(b)

33. The Opponent was required to prove that it had made genuine use of its word mark in Classes 9 and 42. I have found that the Opponent has failed to show genuine use

in respect of its goods and services under either class and therefore the opposition under section 5(2)(b) fails.

Section 5(3)

34. Section 5(3) of the Act 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.

(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”.

35. The relevant date for the assessment under section 5(3) is the date of application for the contested mark, namely 4th April 2017.

36. The relevant case law on section 5(3) can be found in the following judgments of the Court of Justice of the European Union (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* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *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*).

37. Given my finding that the Opponent has failed to show that it had made genuine use of its word mark for the goods and services in respect of which it is registered, I consider that it is not possible for the evidence to show the Opponent to have had a reputation for those goods and services under its word mark. This being the case, I will make no further consideration of the Opponent's word mark under section 5(3) and will continue to assess the ground in respect of the Opponent's figurative mark.

38. The conditions of section 5(3) are cumulative. Firstly, the Opponent must show that the earlier mark is similar to the Applicant's mark. Secondly, that the earlier mark had achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the later mark. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Eff

Class 6: Cashboxes; containers of metal; fittings of metal for furniture; metal lockers and cabinets; screens and partitions of metal; safes and strongboxes; steps and ladders of metal; tool boxes and tool chests.

Class 16: Cabinets for stationery; catalogues.

Class 20: Furniture; office furniture; school furniture; furniture of metal; desks; furniture shelves; shelves for storage; furniture partitions of wood; doors for furniture; furniture fittings, not of metal; filing cabinets; lockers; racks; seats; seats of metal; stools; armchairs; easy chairs; slatted indoor blinds; display boards; display stands; ladders; tables; tables of metal; tea trolleys; trestles; typing desks; umbrella stands; work benches; writing desk; bins of wood or plastic; boxes of wood or plastic; display boards; coat stands.

40. As I have stated earlier, the evidence indicates that the supply of storage and equipment appears to be the focus of the Opponent's business activity under the Eff trade mark. The first consideration that I must make under section 5(3) is whether the Opponent has shown that its trade mark had a reputation at the relevant date, in respect of the relevant public, for the goods listed above in classes 6, 16 and 20.

41. At Exhibit 4, Mr Sully introduces three web enquiries, two of which relate to shelving, and have a total value between them of less than £100 and a third with a value of £77, where it is not clear what the products are. In each case, the enquiry is shown to have been sent to eff@eff.uk.com. Mr Sully makes reference to a range of schools, colleges and universities that his company has provided furniture for. No evidence of enquiries (beyond the three, low value enquiries referenced above) or contracts with these entities is provided. It is also not clear how these entities viewed the Opponent's products, for example, on the Opponent's website, through a catalogue, or other means. Possibly, the website shown at Exhibit 1 was how customers viewed and selected products, however, only an opening page of a website

is provided, which is undated and no information on UK visitor number to the site is provided. It is difficult therefore to establish how the Opponent's customers have encountered its trade mark.

42. What can be seen, at Exhibit 2 is a list of products, including white boards, exhibition stands and overhead projectors, which the Opponent supplies. This appears to be an internal database of products provided by the Opponent. Mr Sully describes a business relationship with the company Acco, which he states provides products under their sub brand Nobo. There is also mention of the brand Bisley, in relation to the provision of filing cabinets. It appears from this evidence that the Opponent is providing a retail service for these products, rather than the goods themselves. I accept that it is possible that the Nobo and Bisley products bear the Opponent's trade mark when they reach the consumer, however, with no evidence to show how customers encounter the Opponent's mark in relation to the specific goods, it is not possible to confirm this.

43. At Exhibit 5, the Opponent provides a list of orders which appear from Mr Sully's witness statement to have been received via storage-solutions.co.uk, SpurShelving.co.uk, and through Eff.eu diverts. Again, it is not clear how customers have encountered the Opponent's trade mark. Mr Sully explains that all order confirmations will have been made on Eff branded templates, however examples of such are not provided. The data provided at Exhibit 5 gives no indication as to what goods were ordered, or the size of the orders. An extract of the data is shown below:

	A132	fx	181121	"196161"	"2016-04-26 11:37"
78	119901 "53869"	"2011-10-02 15:08:34"	"15"	"2011-10-02 15:01:46"	"2011-10-02 15:14:46"
79	119649 "52553"	"2011-09-23 22:12:33"	"9.95"	"2011-09-18 05:39:11"	"2011-10-02 16:14:46"
80	119905 "52553"	"2011-10-02 16:18:16"	"15"	"2011-09-18 05:39:11"	"2011-10-02 16:14:46"
81	119957 "53997"	"2011-10-04 10:34:55"	"15"	"2011-10-03 15:49:50"	"2011-10-04 10:34:55"
82	120641 "21328"	"2011-10-21 09:34:42"	"15"	"2010-09-28 12:00:49"	"2010-09-28 12:00:49"
83	120925 "56437"	"2011-10-30 10:21:23"	"8.7"	"2011-10-30 10:14:13"	"2011-10-30 10:21:23"

44. In drawing conclusions on reputation of the Opponent's figurative mark, I refer back to my earlier comments concerning the Opponent's turnover and the lack of clarity over

where sales have been made. The evidence shows sales enquiries amounting to less than £200. While Mr Sully refers to sales of tens of thousands of pounds, there is no evidence, such as contracts to corroborate this. It is not clear how the Opponent's customers have encountered the trade mark and whether it has been used in respect of the goods listed under the figurative mark, or in respect of retail services, which involve selecting an assortment of goods for sale and offering services aimed at inducing consumers to purchase products from the Opponent, rather than another trader. Given these factors, I find that the Opponent did not have the requisite reputation at the relevant date, as per the *General Motors* case.

Outcome under section 5(3)

45. As the Opponent has failed to show that it had a reputation in respect of any of the goods and services under either of its earlier marks, the section 5(3) ground fails.

COSTS

46. The Applicant has been wholly successful and is entitled to an award of costs. I note the Applicant's view in its submissions in lieu of a hearing that costs awarded should be on the normal scale. In deciding on costs, I take into account the change to the grounds of opposition and that the Applicant had to consider and respond to two notices of opposition.

Preparing a statement and considering the other side's statement	£450
Considering and commenting on the Opponent's evidence	£600
Preparation of submissions in lieu of a hearing	£400
TOTAL	£1450

47. I order Asset Protection & Licencing Ltd to pay The Institute of Practitioners in Advertising the sum of £1,450. The sum is to be paid within 21 days of the end of the period allowed for appeal, or if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated this 28th day of June 2022

Charlotte Champion

For the Registrar