

BL O/0014/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3641196

BY

HANS NICHOLAS PURDOM

TO REGISTER THE FOLLOWING TRADE MARK:

LIGNA

AND

OPPOSITION NO. 428250 THERETO

BY

LIGNADECOR ÜRETİM VE PAZARLAMA ANONİM SİRKETİ

Background and pleadings

1. On 13 May 2021, Hans Nicholas Purdom (the “Applicant”) applied to register the trade mark **LIGNA**. The contested application was accepted, and published for opposition purposes in the Trade Marks Journal on 17 September 2021. Registration of the mark was sought in respect of goods in classes 6, 19 and 20.

2. On 16 November 2021, LIGNADECOR ÜRETİM VE PAZARLAMA ANONİM ŞİRKETİ (the “Opponent”) filed a notice of opposition, opposing the application under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) on the basis of its earlier International Registration (IR):

IR WO0000000857115



International Registration date: 8 September 2004

UK Designation date: 8 September 2004

UK Protection date: 19 February 2006

3. For the purposes of its opposition, the Opponent relied upon all of the goods for which the earlier mark is registered, namely:

Class 19 *Natural or synthetic surface coating in the form of layers or strips, heat-adhesive synthetic coatings included in this class.*

4. The opposition is partial, and is aimed against the goods in class 19 of the contested application only. The statement of grounds was worded in the following terms:

“The Opponent submits that the mark applied for LIGNA is highly similar to the trade mark LignaDecor (logo), and the goods covered by the marks are identical or highly similar. As a result, there is a risk of confusion on the part of the public between the Application and the Opponent’s earlier registration, which includes

a likelihood of association between the marks. Accordingly, the Application the Application [sic] contravenes section 5(2)(b) of the Act and should be refused for all goods in class 19. The Opponent therefore requests that the Application be partially refused and an award of costs be made in its favour.”

5. On 24 November 2021, the Applicant submitted a form TM21b requesting to amend the applied for specification in Class 19. A second TM21b was submitted on 9 December 2021, requesting to amend the applied for specification in each of the classes, i.e., 6, 19 and 20. Following exchanges of correspondence between the Applicant and Registrar, the final specification was acknowledged on 15 December 2021, with the amendments appearing in *Correction to published marks* section of the Trade Marks Journal (see **Comparison of goods and services**).

6. On 20 December 2021, the Opponent informed the Registrar that it wished to maintain its opposition “regardless of the specification amendment made”.

7. On 4 March 2022, the Applicant filed its counterstatement, in which it requested the Opponent be put to proof of use for its goods in Class 19. The Applicant denied “each and every claim” made by the Opponent. The Applicant submitted that the goods of the earlier mark are wholly different to the contested goods insofar as they differ in nature, intended purpose and method of use. Further, the Applicant submitted that the contested goods are neither in competition with, nor are they complementary to, the goods of the earlier mark. The Applicant argued that the contested mark differs visually, aurally and conceptually from the earlier mark due to the inclusion of “a circle above a slash and the word ‘DECOR’”.

8. Both parties provided submissions. The Opponent also filed evidence for the purpose of establishing proof of use. The submissions and evidence of each party shall be summarised to the extent that it is considered necessary at the appropriate time.

9. No Hearing was requested.

10. Both parties are professionally represented. The Applicant is represented by Mathys & Squire LLP, and the Opponent is represented by Forrester IP LLP.

Proof of use

11. The relevant statutory provisions are as follows:

Section 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 relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(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 relevant period 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 (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade

mark in the variant form is also registered in the name of the proprietor),
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.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(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.”

12. Further, Section 100 of the Act states that:

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

13. Considering the above, it is incumbent on the Opponent to establish proof of use of its earlier IR WO0000000857115 in the 5-year period ending on the date of application of the contested mark, i.e., between 14 May 2016 and 13 May 2021.

Opponent submissions and evidence

14. On 7 June 2022, the Opponent filed evidence containing the witness statement of Funda Selçuk, the Vice President of LIGNADECOR ÜRETİM VE PAZARLAMA

ANONIM SİRKETİ. The witness statement explained that the Opponent is a manufacturer of edgebanding and melamine papers for the furniture and wood-based panel industries, and is one of the leading suppliers of edgebanding in PVC, ABS, Acrylic and PP. According to the witness statement, the Opponent company has 370 employees, serving both local and export markets, and is the largest independent impregnator in Eastern Europe with an annual capacity of 75 million m². The witness statement explained that with an annual production of 14,000 tons, the Opponent is the second largest edgebanding producer in Turkey, and is growing by more than 20% each year. According to the witness statement, the Opponent company opened a sales office in Moscow in 2017, and in 2020 opened in Germany. Further information regarding the origin of the Opponent's business was included in the witness statement.

15. The witness statement referred to seven exhibits, FS1 – FS7.

- FS1 – consists of screenshots of the Opponent company's website. The screenshots confirm a number of the details contained in the witness statement. The mark that appears on the website is the following:

The logo for Lignadecor, featuring the word "lignadecor" in a blue, lowercase, sans-serif font. The "i" in "lignadecor" has a dot above it. The logo is set against a white background with a thin blue underline.

- FS2 – consists of historical screenshots of the Opponent company's website, extracted using Wayback Machine. The dates of the website are periodic and range from October 2016 to April 2021. It is noted that the earlier international registration WO0000000857115 does not appear on any occasion in the form as registered – the mark referred to was the word 'LignaDecor'.
- FS3 – contains a copy of an email correspondence between Alber Atat, export manager at LIGNADECOR ÜRETİM VE PAZARLAMA ANONİM SİRKETİ, and a UK agent named Steve Willis, dated 21 January 2013. The email from Alber Atat offers Steve Willis a commission-based agent agreement for 6 months, as of 21 January 2013. The 6-month commission agreement was entirely outside of the relevant period. The email refers to the company name as Lignadecor, and includes the mark as indicated in FS1.

The exhibit also includes an email from Steve Willis to Alber Atat, on 3 March 2013. It includes a list of UK manufacture companies that Steve Willis had “dealt with over the last 26 years as a Sales Manager & Sales Director in the UK furniture industry”. Steve Willis asked for a price list in order to allow him to “be successful in the UK” in relation to Lignadecor.

- FS4 – a selection of invoices showing sales to UK companies between 26 February 2016 and 2 April 2021. The majority of goods sold are PVC edgbanding, with a smattering of PVC HighGloss and PVC Kenar Bendi. The total sales equated to €606,702.06. The sales involved 4 companies: *David Clouting L.T.D*, Essex; *DERALAM Laminate Limited*, Bedfordshire; *Marlborough Furniture Surfaces*, Northamptonshire; and *Ney Limited*, Coventry. The invoices were headed with the mark as identified in exhibit FS1.
- FS5 – a map of where the Opponent company would have had a stand at the *W Exhibition 2022*. The witness statement explained that the exhibition was delayed until 2023 due to the Coronavirus pandemic. However, both the original date and postponed date were outside of the relevant period, as the exhibition was scheduled for after the date of filing of the contested application, and therefore not relevant for proving use.
- FS6 – a script for the voice-over wording that would have appeared on a YouTube video that was scheduled to be played at the Opponent’s stand in the *W Exhibition 2022*. The script explains the origin and development of the Opponent company. The *W Exhibition 2022*, and subsequently the YouTube video and voice-over script, are not from within the relevant period. It is noted that the mark which appears in the YouTube video is that which was identified in FS1, rather than in the form as registered.
- FS7 – consists of screenshots of a Lignadecor video available on YouTube. No date is referred to. The first and last screenshots contain an image of the mark as identified in exhibit FS1. The link to the video (https://www.youtube.com/watch?v=ZIKoXeh_sCQ) results in the message “This video isn’t available any more”.

Applicant submissions

16. On 8 August 2022, the Applicant filed submissions. The Applicant argued that the goods at issue are dissimilar and provided detailed submissions to support this position. These submissions shall not be summarised here, but rather will be called upon if they provide assistance during my own comparison of the goods at issue. The Applicant argued that the earlier mark is visually dissimilar to the contested mark on account of the inclusion of the word ‘DECOR’, which presents five additional letters and two additional syllables that have no counterpart in the contested mark. In addition, the Applicant argued that the earlier mark contains a distinctive figurative element consisting of “a light green circle above a darker green backslash”, which also has no in the contested mark.



DECISION

18. 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.

19. The case law on genuine use was summarised by Arnold J (as he then was) in *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch):

“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 Marken 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].”

Form of use

20. When demonstrating examples of purported use, and when citing the mark under which it provides its goods, the Opponent’s evidence refers exclusively to either the word LignaDecor/Lignadecor, or the figurative mark:



The earlier mark in the form as registered does not appear on any occasion in the evidence within the relevant period of time. This does not necessarily mean that the evidence cannot nevertheless be considered for the purposes of assessing proof of use. In the *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) acting as the Appointed Person summarised the test of use in a differing form from the trade mark as registered:

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

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark

and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

21. The answer to the first question is simple enough: the signs presented in the evidence were either the plain word version of the term LignaDecor/Lignadecor, or a figurative representation of the same term utilising a shade of blue for both the word 'decor' and an off-centre tittle above the letter 'i'. The answer to part (a) of the second question is more complex, and depends on whether the average consumer perceives the distinctive character of the earlier mark as resting more in its overall impression, or in either one of its two constituent parts, i.e., the word LignaDecor/Lignadecor or the figurative green circle above a green backslash. It is noted that neither party has provided submissions as to any possible meaning for the term LignaDecor/Lignadecor, and therefore by way of being a seemingly invented term I consider it to be inherently distinctive to a high degree. In addition, I consider it to be the more distinctive, and also the more dominant, of the two elements.

22. In answer to part (b) of the second question, the difference between the mark as registered and the form in which the mark is used is that the figurative element of "light green circle above a darker green backslash" is absent. In order to answer part (c) of the second question, it is useful to first consider what Phillip Johnson, acting as the Appointed person in *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, considered to be the correct approach to the test of a different form in use under s 46(2). He said:

"13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

23. The first principle identified in paragraph 15 of the cited decision does not apply to the forms of use in these proceedings, as neither element of the earlier mark is considered to be non-distinctive. Equally, the fourth principle as identified in paragraph 16 does not apply, as neither element of the earlier mark is either descriptive or suggestive. The second principle as identified in paragraph 15, however, does apply to the form of use in these proceedings. With this principle in mind, it is important to

acknowledge that the absence of the figurative element in the form as used is less impactful on the distinctive character of the earlier mark than the absence of the word element would have been. As for the third principle as identified in paragraph 16, whilst it is relevant insofar as the earlier mark comprises two distinctive elements and only one of them appears in the form as used, I remind myself that the element which is not used is the less distinctive figurative element, the absence of which is less likely to alter the distinctive character of the earlier mark (see second principle).

24. In *Menelaus BV v EUIPO*, Case T-361/13, the General Court found that use of the marks shown on the left and middle below constituted use of the registered mark on the right.



The court held that the word VIGAR was the dominant and distinctive element of all the marks. As regards the other features, the court held that:

“73 [The first sign] sign differs from the earlier mark as registered only in the ascending orientation of its oval background, the use of standard lower-case instead of standard capital letters and the replacement of the crown element by a sequence of three dots. As the Board of Appeal rightly found, a different orientation of the same background, the use of upper-case or lower-case letters when they are standard letters which reproduce the same term, or the substitution of an ornamental element (the sequence of dots) for a laudatory element when both of those elements serve to reinforce the term ‘vigar’, are minor differences that do not alter the distinctive character of the earlier Community trade mark as it was registered.

74 That finding is not called into question if the second form of use, reproduced in paragraph 63 above, is taken into account inasmuch as, even though, in that case, the basic background disappears and the word ‘spain’ is present, the latter will be understood as a merely descriptive addition.”

25. Whilst I acknowledge that the figurative element of the earlier mark possesses a degree of distinctive character, I consider it to be more akin to the ornamental element of three sequential dots in the *Vigar* example, whereby its absence is a relatively minor difference that does not alter the distinctive character of the earlier mark. Referring back to part (c) of Mr Richard Arnold Q.C.'s (as he then was) test in *Nirvana*, I do not consider the differences in use to alter the distinctive character of the earlier mark, because the differences are limited to the less distinctive (and less dominant) figurative element.

26. It is important to acknowledge that the evidence not only demonstrated use of a mark without the figurative element that was part of the registration, but it also demonstrated use of a mark that contained additional elements which are not part of the mark as registered. These additional elements consist of the colour blue for the word 'décor' and tittle above the letter 'i'. In my opinion, such alternations are also merely minor differences (similar to the ornamental sequence of dots in *Vigar*) that do not detract, affect, manipulate, or in any other way alter the distinctive character of the earlier mark.

27. Whilst I acknowledge that the form as used contains differences from the form as registered, I tend to find these differences to be minor. In my opinion, the more distinctive and also more dominant element of the earlier mark is the word LignaDecor/Lignadecor, and it is clearly present in the form of the mark as used. I therefore consider the form of use to be an acceptable variant.

Genuine use

28. The relevant statutory provision Section 6A, 1A identifies that the relevant period for proving genuine use is the period of 5 years ending with the date of application for registration of the contested mark, or the date of priority claimed for that application. The relevant period for proving genuine use of the earlier mark IR WO0000000857115 has been established as being between 14 May 2016 and 13 May 2021. The majority of the exhibits that accompany the witness statement contain information that pertains to a period of time outside of the relevant period, and therefore shall not be considered for the purposes of establishing genuine use, i.e., FS3, FS5, FS6, and FS7. My analysis of the evidence is therefore restricted to exhibits FS1, FS2 and FS4.

29. It is clearly established in case law that the burden of furnishing the Registrar with sufficient proof lies with the proprietor of the earlier mark,¹ and that the evidence must represent the Opponent's best case.² The evidence must also satisfy the decision taker with regard to whatever it is that falls to be determined on the balance of probabilities.³ The assessment of genuine use is multifactorial and must be restricted to analysing the evidence presented before me. Having analysed the submitted evidence, I find that the screenshots of the Opponent company's website and sales invoices do constitute 'actual use'⁴ that is 'consistent with the essential function of a trade mark',⁵ i.e., the evidence demonstrates real use of an acceptable variant of the earlier mark, with the intention of identifying the origin of the goods.

30. The sales presented in the invoices equate to roughly €600,000. I am aware that use need not always be quantitatively significant for it to be deemed genuine, and that even minimal use of a mark may qualify as genuine use if it is deemed justified in the economic sector of the relevant goods or services.⁶ Further, there is no *de minimis* rule on what is or is not considered quantifiable use.⁷ In my opinion, €600,000 is not an insubstantial figure, and certainly represents use that is more than merely token.⁸ I note that the invoices themselves are for sales to four entities, being in Essex, Bedfordshire, Northamptonshire and Coventry. Based on the nature of the exchanges and businesses involved, it is my opinion that these constitute trade sales, which are certainly acceptable as an indicator of genuine use⁹. Whilst I am of the opinion that the evidence is lacking in certain areas that could have helped paint a more clear picture of genuine use, such as market share and advertising spend, for example, I believe that the overall impression of the evidence has indicated that, on the balance

¹ *Plymouth* BL O/236/13

² BL O/424/14 *Guccio Gucci SPA v Gerry Weber International AG* – Although these proceedings related to revocation proceedings, the principle is nevertheless the same for proof of use in opposition actions, whereby it is essentially incumbent on the Opponent to provide the Registrar with its best case at the earliest opportunity.

³ *CATWALK* Trade Mark, BL O/404/13

⁴ *Ansul* paragraph 35.

⁵ *Ibid* paragraph 36.

⁶ *Ansul* paragraph 39.

⁷ *Leno Marken* paragraph 55; and *Ansul* paragraph 39

⁸ *Ibid* paragraph 36.

⁹ *Laboratoire de la Mer Trade Mark* [2006] FSR 5

of probabilities, the mark has been genuinely used as a trade mark in the relevant territory during the relevant period.

Section 5(2)(b)

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

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

(a) ...

(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”.

Section 5A

32. 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.”

33. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed

and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

Earlier mark	Application
<p><i>Class 19: Natural or synthetic surface coatings in the form of layers or strips, heat-adhesive synthetic coatings included in this class.</i></p>	<p><i>Class 19: Non-metal sliding doors; glass doors; non-metal doors and door frames; doors, windows and window coverings, not of metal; non-metal folding doors; windows and window frames, doors and door frames; double glazing; internal doors made of glass; garage doors, roller doors, revolving doors, sliding doors, all of non-metallic materials; safety doors, not of metal; folding doors, not of metal; armoured doors, not of metal; outer doors not of metal; non-metallic doors for indoor use; glazed doors, not of metal; inner doors, not of metal; insulating doors, not of metal; transparent doors, not of metal; non-metallic door stops; pocket doors, not of metal; pocket door systems, not of metal; vertically raisable rolling doors; non-metallic and non-electric control apparatus for door systems; parts, fittings and accessories for all the aforesaid goods; none of the aforementioned goods in respect of laminated wood veneer for making furniture or building materials, namely</i></p>

	<p><i>laminated wood veneer for use in interior surfacing applications such as counter tops, vanity tops, wall panelling, partitions, decorative columns, flooring, shelving, wainscoting, edging and custom millwork installations.</i></p>
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34. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

36. It has also been established by the GC in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, that:

“29. In addition, 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 für 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”.

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

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

38. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e., chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. (as he then was) noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

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

Whilst on the other hand:

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

39. The goods of the earlier mark are types of surface coating, which the Opponent has referred to in their submissions and evidence as being edge banding, melamine paper, PVC high gloss, and PVC kenar bendi “for the furniture and wood-based panel industries”. The Opponent’s submissions have not provided definitions or information to establish what such goods are. Without being an expert in edgbanding, melamine paper etc., and without having before me detailed submissions as to what they may be, I have endeavoured to understand the meaning of such goods based on the most immediately obvious and available definitions found on the internet. Based on my research, it appears to me that the coatings of the earlier mark are thin materials added to certain objects for, in the majority of instances, aesthetic or protective purposes.

40. I note that other than for making the statement that the goods at issue are identical or highly similar, the Opponent has not provided any submissions as to why that may be the case. It has therefore fallen on me to make an assessment of the similarity of the goods at issue, or otherwise lack thereof, using well-established principles of case law, including those identified in paragraphs 34-38.

Class 19

41. In my opinion, the contested goods in class 19 can be fairly summarised as being non-metal doors and windows, and their subsequent parts, fittings and accessories. It is noted that they have been specifically limited to being the type which are not laminated in wood veneer, which is a type of coating. The goods of the earlier mark are thin layers of coating added to finished articles for aesthetic or protective purposes, for the furniture and wood-based panel industries. With this in mind, I find the goods at issue to differ as to their nature, intended purpose and end user. Further, I do not consider them to be in competition with one another, nor do I consider them to be

complementary to one another. Whilst I do not discount the possibility that the coatings of the earlier mark could in theory be applied to some of the goods in the contested mark, e.g., *non-metal door*, I nevertheless do not consider this to be a complementary relationship. Coatings are neither indispensable nor are they necessarily important for the use of the contested goods, and I do not consider it likely that a consumer of doors would assume the undertaking responsible for subsequent coatings would be one and the same (see *Boston Scientific Ltd.*). Further, even if the coatings of the earlier mark were to be habitually used with the contested goods, it would not automatically follow that the goods are therefore similar (see *Sanco*). In my opinion, the trade channels where a consumer would purchase a *non-metal door* or *window frame* are likely to be entirely different from where a consumer would buy a synthetic, heat-adhesive coating, for example. The contested goods in class 19 are therefore dissimilar

42. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

43. Having conducted my assessment as to the degree of similarity between the goods at issue, I have found all of the contested goods to be dissimilar to those of the earlier mark. This has included assessing whether there is a complementary relationship between the goods at issue, which I have concluded there is not. As such, there can be no likelihood of confusion, with the result being that the marks themselves do not need to be compared.

Conclusion

44. The goods at issue have been found to be dissimilar. The opposition therefore falls at the first hurdle and is dismissed accordingly. Subject to appeal, the Application will proceed to registration.

Costs

45. As the opposition has failed, the Applicant has been successful and is entitled to a contribution towards its costs. I bear in mind that the relevant scale is contained in Tribunal Practice Notice 2/2016. In the circumstances I award the Applicant the sum of £1000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering a notice of opposition and

filing a counterstatement £300

Considering and commenting on the

the other side's evidence of proof of use £700

Total £1000

46. I therefore order LIGNADECOR ÜRETİM VE PAZARLAMA ANONİM SİRKETİ to pay Hans Nicholas Purdom the sum of £1000. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 6th day of January 2023

Dafydd Collins

For the Registrar