

**O-042-17**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 3113920  
BY HEADLAM GROUP PLC  
TO REGISTER THE TRADE MARK  
LIFESTYLE FLOORS  
IN CLASSES 19, 27 & 35  
AND**

**IN THE MATTER OF OPPOSITION  
THERE TO UNDER No. 405545 BY  
SUPPORT IN SPORT GROUP LIMITED**

## BACKGROUND

1) On 18 June 2015, Headlam Group Plc (hereinafter the applicant) applied to register the trade mark LIFESTYLE FLOORS in respect of the following goods and services:

- Class 19: Non-metallic building materials; materials for covering floors, walls and stairs; flooring (non-metallic); wooden flooring; ceramic tiles; laminated and engineered wood flooring; damp proof membranes.
- Class 27: Carpets; rugs; mats; matting; linoleum; floor coverings; vinyl floor coverings and tiles; floor tiles; underlay.
- Class 35: Wholesale and retail services connected with floor coverings; retail services, wholesale services, mail order retail and wholesale services, electronic shopping retail services, telephone shopping retail services, all connected with the sale of non-metallic building materials, materials for covering floors or walls or stairs, flooring (non-metallic), wooden flooring, ceramic tiles, laminated and engineered wood flooring, damp proof membranes, carpets, rugs, mats, matting linoleum, floor coverings, vinyl floor coverings and tiles, floor tiles, underlay, machined wood floor coverings, ceramic floor coverings, mosaic floor coverings, carpet protectors, carpet protection products, floor protection products, carpet inlays, grip rods, thresholds, threshold profiles, adhesives, floor cleaning products; consultancy, information and advisory services relating to the aforesaid.

2) The application was examined and accepted, and subsequently published for opposition purposes on 28 August 2015 in Trade Marks Journal No.2015/035.

3) On 27 November 2015 Support In Sport Group Limited (hereinafter the opponent) filed a notice of opposition. The opponent is the proprietor of the following trade mark:

Mark	Number	Dates of filing and registration	Class	Specification relied upon
LIFESTYLE	2464938	22.08.07 25.01.08	27	Artificial grass.
			37	Installation of artificial grass.

a) The opponent contends that its mark and the mark applied for are very similar and that the goods and services applied for include artificial grass or floor coverings. They point out that artificial grass is a floor covering and is used as such both indoors and outdoors. Hence the goods and services of the two parties are also similar. As such the mark in suit offends against Section 5(2)(b) of the Act.

4) On 5 February 2016 the applicant filed a counterstatement, basically denying that the marks are similar, and, following an amendment to the specification, the application no longer covers artificial grass. The applicant requested proof of use.

5) Both sides filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard. Both sides provided written submissions which I shall refer to as and when necessary in my decision.

#### **OPPONENT'S EVIDENCE**

6) The opponent filed a witness statement, dated 25 April 2016, by Philip Michael Nichols the Chief Financial Officer of the opponent, a position he has held since July 2007. He states that he is also a Director of Artificial Grass Ltd which is authorised by the opponent to use its mark on artificial grass and the installation of artificial grass in the UK. He states that he has access to the records of both companies and is authorised to speak on behalf of them both. He states that the mark LIFESTYLE has been used on artificial grass since March 2007 throughout the UK. He provides the following sales figures for the mark LIFESTYLE regarding artificial grass:

Year ending	Amount £
April 2010	290,000
April 2011	280,000
April 2012	355,000
April 2013	480,000
April 2014	500,000

7) The above figures include sales to the general public as well as to distributors and installers. They do not include the costs of installing the product. The product is sold to the domestic and leisure markets. He states that a sister company sells artificial grass under the mark SIS PITCHES to

schools, universities, sports clubs etc. Mr Nichols states that the artificial grass is produced on machines that also manufactures carpets, the only difference being the pile height being greater for artificial grass. The artificial grass contains traditional carpet yarn and is used by customers for lawns, paths, on patios, garden roofs, terraces, balconies etc. It is also used indoors as a floor covering in offices, conservatories and children's indoor play areas. His company manufactures artificial grass with a shorter pile height specifically for indoor use. He provides the following exhibits:

- PN1: The exhibits consists of a number of individual pages. The first is a price list from 2008 showing use of the mark LIFESTYLE with a number of secondary marks such as City, Multi, Landscape, Lawn and Play which I take to indicate their usage. The second shows an exhibition stand, the photo is undated but is said to date from 2008. The front page and price list from a brochure dated 2010 which again shows the LIFESTYLE range including the secondary marks. A trade price list dated 2015 which shows the LIFESTYLE range including the secondary marks, a sheet of sample labels dated 2013, which all have the company name of Artificial Grass Ltd and "Lifestyle Excel" upon them. Lastly three pages (undated) from the website of Artificial Grass Ltd showing the range of LIFESTYLE artificial grass products under the secondary marks.
- PN2: This consists of a variety of undated photographs which show a variety of indoor uses such as in schools/playgroups/nurseries, sports halls, theatres and offices.

## **APPLICANT'S EVIDENCE**

8) The applicant filed a witness statement, dated 23 August 2016, by Jackie Tolson, its Trade Mark Attorney. She states that she accessed the opponent's internet website ([www.artificialgrass.com](http://www.artificialgrass.com)) and found that the opponent was using "the word LIFESTYLE in combination with other elements". She also found an EU trade mark registration for LIFESTYLE LAWNS covering goods and services in classes 16, 27 & 37 which includes floor coverings and artificial grass. She also provides submissions which I shall refer to as and when necessary in my decision.

## **OPPONENT'S EVIDENCE IN REPLY**

9) The opponent filed a second and third witness statement, dated 23 September 2016 and 28 September 2016, both by Mr Nichols who has previously provided evidence in this case. He reiterates

that sales to domestic customers is via Artificial Grass Ltd whilst sales to installers are through its sister company Support in Sport (Manufacturing) Co Ltd both of which are wholly owned subsidiaries of the opponent company which owns the LIFESTYLE trade mark. He states that in the 1970s artificial grass was made from polypropylene whereas now it is also made from polyethylene and also a mixture of both. Polyethylene is softer and more resilient outdoors. He states that many carpets are made from polypropylene. He states that artificial grass and carpets are both floor coverings, produced in the same way with, often, the same materials and sometimes sold by the same retailers.

- PN3: Examples of invoices dated 28 February 2013 – 9 July 2015 issued by Artificial Grass Ltd and Support in Sport (Manufacturing) Co Ltd. These show sales throughout the UK under the brands: Lifestyle Deluxe; Lifestyle Luxe; Lifestyle Elite; Lifestyle Shock Pad; Lifestyle Delight; Lifestyle Excel and Lifestyle City.
- PN4: a Brochure titled “Greatness in the world of carpet” from the website [www.bonaryarns.eu](http://www.bonaryarns.eu) from the company Bonar Yarns & Fabrics Ltd, Dundee which supplies yarns for the artificial grass produced by the opponent company and also for the manufacture of domestic carpets.
- PN5: Copies of pages from the websites: [www.carpets-direct.co.uk](http://www.carpets-direct.co.uk); [www.carpetright.co.uk](http://www.carpetright.co.uk) and [www.diy.com](http://www.diy.com) (B&Q) which shows they supply both carpets and artificial grass.
- PN6: This consists of a price list issued by Artificial Grass Ltd to domestic customers, and a price list dated 2014 from Support in Sport (Manufacturing) Co Ltd to installers and distributors.

10) That concludes my summary of the evidence filed, insofar as I consider it necessary.

## **DECISION**

11) The only ground of opposition is under section 5(2)(b) which reads:

“5.-(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.”

12) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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.”

13) The opponent is relying upon its trade mark listed in paragraph 3 above which is clearly an earlier trade mark. The applicant requested that the opponent provide proof of use and, given the interplay between the date that the opponent’s mark was registered (25 January 2008) and the date that the applicant’s mark was published (28 August 2015), the proof of use requirement bites. Section 6A of the Act states:

“6A Raising of relative grounds in opposition proceedings in cases of non-use.

(1) This section applies where-

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

(b) there is an earlier trade mark 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 Community trade mark, 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.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

14) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of its mark has been made. In the instant case the publication date of the application was 28 August 2015, therefore the relevant period for the proof of use is 29 August 2010 – 28 August 2015. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

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

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



of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

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

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

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

15) In *Naazneen Investments Ltd v OHIM*, Case T-250/13, the General Court upheld a decision by the OHIM Board of Appeal that the sale of EUR 800 worth of non-alcoholic beverages under a mark over a 5 year period, which had been accepted was not purely to maintain the trade mark registration, was insufficient, in the economic sector concerned, for the purposes of maintaining or creating market share for the goods covered by that Community trade mark. The use was therefore not genuine use. The relevant part of the judgment of the General Court is as follows:

“46. In the fifth place, the applicant argues that, in accordance with the case-law cited in paragraph 25 above, use of a trade mark is to be regarded as token if its sole purpose is to preserve the rights conferred by the registration of the mark. It claims that the Board of Appeal contradicted

itself by stating, on the one hand, in paragraph 31 of the contested decision, that the total amount of transactions over the relevant period seemed to be token, and by stating, on the other hand, in paragraph 42 of the contested decision, that it did not doubt the intention of the proprietor of the mark at issue to make real use of that mark in relation to the goods in question.

47. In this connection, suffice it to point out that the applicant's argument is based on an incorrect reading of the contested decision. The Board of Appeal used the term 'token' to describe the total amount of transactions, approximately EUR 800, and not to categorise the use of the mark at issue.

48. In the sixth place, the applicant claims that the Board of Appeal, by relying solely on the insufficient use made of the mark at issue, did not comply with the case-law according to which there is no quantitative threshold, determined a priori and in the abstract, that must be chosen in order to determine whether use is genuine. The Board of Appeal also failed to comply with the case-law according to which even minimal use may be sufficient in order to be deemed genuine.

49. According to the case-law, the turnover achieved and the volume of sales of the goods under the mark at issue cannot be assessed in absolute terms but must be assessed in relation to other relevant factors, such as the volume of commercial activity, the production or marketing capacities or the degree of diversification of the undertaking using the trade mark and the characteristics of the goods or services on the relevant market. As a result, use of the mark at issue need not always be quantitatively significant in order to be deemed genuine (see, to that effect, judgments in *VITAFRUIT*, cited in paragraph 25 above, EU:T:2004:225, paragraph 42, and *HIPOVITON*, cited in paragraph 27 above, EU:T:2004:223, paragraph 36). Even minimal use can therefore be sufficient in order to be deemed genuine, provided that it is warranted, in the economic sector concerned, to maintain or create market shares for the goods or services protected by the mark. Consequently, it is not possible to determine a priori, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine. A de minimis rule, which would not allow OHIM or, on appeal, the General Court, to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, to that effect, order of 27 January 2004 in *La Mer Technology*, C-259/02, ECR, EU:C:2004:50, paragraphs 25 and 27, and judgment of 11 May 2006 in *Sunrider v OHIM*, C-416/04 P, ECR, EU:C:2006:310, paragraph 72).

50. In the present case, contrary to what the applicant claims, the Board of Appeal did not determine a minimum threshold 'a priori and in the abstract' so as to determine whether the use

was genuine. In accordance with the case-law, it examined the volume of sales of the goods in question in relation to other factors, namely the economic sector concerned and the nature of the goods in question.

51. The Board of Appeal accordingly took the view that the market for the goods in question was of a significant size (paragraph 28 of the contested decision). It found also that the goods in question, namely non-alcoholic beverages, were for everyday use, were sold at a very reasonable price and that they were not expensive, luxury goods sold in limited numbers on a narrow market (paragraph 29 of the contested decision). Furthermore, it took the view that the total amount of transactions over the relevant period, an amount of EUR 800, seemed to be so token as to suggest, in the absence of supporting documents or convincing explanations to demonstrate otherwise, that use of the mark at issue could not be regarded as sufficient, in the economic sector concerned, for the purposes of maintaining or creating market shares for the goods covered by that mark (paragraph 31 of the contested decision).

52. It is therefore apparent, contrary to what the applicant claims, that it was in accordance with the case-law cited in paragraph 49 above that the Board of Appeal took the view that, in the present case, minimal use was not sufficient to be deemed genuine.”

16) The above judgment of the General Court was upheld on further appeal to the CJEU: see Case C-252/15 P. The applicant contends in its submissions that the use shown has been in a form differing in elements which alter the distinctive character of the mark in the form in which it is registered. In particular it points out that the mark LIFESTYLE is used as a prefix with a variety of suffixes. In determining this issue I look to *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union found that:

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

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

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

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

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

17) I fully accept that the opponent uses its LIFESTYLE mark with a suffix or secondary brand. It is clear from the evidence outlined earlier in this decision that the mark LIFESTYLE is the dominant distinctive element as the suffix tends to be a word with laudatory connotations such as “Excel; Elite; Luxe; Deluxe”. The suffix is used to provide clarification regarding the type of artificial grass referred to, as artificial grass has a number of different lengths of pile available. To my mind, the use of a secondary trade mark does not alter the distinctive character identified, and that the term LIFESTYLE would be seen as the indicator of origin.

18) On the issue of the evidence in general the applicant contended that none of the evidence related to the installation of artificial grass; that traditional carpet yarn would be wool not man-made fibres; that artificial grass is used mostly in relation to sport or gardens and that the goods of the two parties are not in competition; and that the maintenance of artificial grass requires brushing, aerating, raking,

surface sweeping, cleaning and sanitising and often anti-static conditioners are required whereas traditional floor coverings can be swept, vacuumed or shampooed.

19) When considering the evidence filed I take into account the comments in *Awareness Limited v Plymouth City Council*, Case BL O/230/13, where Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. .... I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

20) I also look to the case of *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, where Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

21) The opponent’s evidence was not challenged by the applicant other than its use of suffixes and reference to “state of the Register” submissions, nor was cross examination sought. The opponent has provided sales figures for the period in question, and whilst not overwhelming they are significant. It has backed up these sales figures by providing samples of invoices throughout the relevant period which show sales across the UK. It has also provided price lists within the relevant period and copies of its website. All of the documentation relates to the supply of artificial grass and the additional items such as tape required to install the product. In my opinion the opponent has shown use of its mark in the relevant period.

22) I must now consider the goods on which use has been shown. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

23) In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all

possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

24) The opponent's mark is registered for "artificial grass" in class 27 and "installation of artificial grass" in class 37. It has clearly not used its mark in respect of the class 37 services and has only used it on artificial grass. Therefore, in the ensuing comparison of goods and services the opponent can only rely upon "artificial grass" in class 27.

25) When considering the issue under section 5(2)(b) I take into account the following principles which 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

## **The average consumer and the nature of the purchasing decision**

26) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

27) Both parties have specifications, broadly speaking, of flooring and floor coverings although the applicant's includes the retailing/ wholesaling of same and building materials. Flooring and floor coverings will be sold in, inter alia, traditional retail outlets on the high street, through builder's merchants, DIY stores, catalogues and on the Internet. The specifications of both parties goods are unlimited, and so I must keep all of these trade channels in mind. The average consumer of the goods and services at issue is a member of the general public (including businesses) who is likely, in my opinion, to select the goods and services mainly by visual means, although I accept that they may be an interaction with a salesperson if advice is sought on the suitability of certain floor coverings for particular areas and so aural considerations must be taken into account. Clearly, the average consumer's level of attention will vary considerably depending on the cost and nature of the item at issue. However, to my mind even when selecting inexpensive floor coverings for a small seldom used room, the average consumer will pay attention to considerations such as size, colour, fabric and cost. **Overall the average consumer is likely to pay a medium degree of attention to the selection of such goods and a low degree of attention to the selection of the retail outlet as convenience in terms of closeness is likely to play a part in the selection.** With regard to the selection of wholesalers of such goods, I have already stated that this will be mainly visual. I believe that the average business seeking to purchase flooring and floor coverings from a wholesaler will pay considerable attention to the source, as pricing will only be one factor. To my mind of greater importance will be the quality and speed of service as their businesses will fail very quickly if they have no stock to show to customers in their retail outlet or cannot supply the goods ordered by the

customer. **Therefore, the average consumer will pay a high degree of attention to the selection of the wholesaler of such goods.**

### **Comparison of goods and services**

28) 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”.

29) 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 users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

30) In *Kurt Hesse v OHIM*, Case C-50/15 P, The CJEU stated that complementarity is an autonomous criteria 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 General Court 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”.

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

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

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.

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

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

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”

34) However, on the basis of the European courts’ judgments in *Sanco SA v OHIM* (Case C-411/13P) and *Assembled Investments (Proprietary) Ltd v. OHIM* (Case T-105/05, at paragraphs [30] to [35] of the judgment), upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*<sup>1</sup>, Mr Hobbs concluded that:

- i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;
- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent’s goods and then to compare the opponent’s goods with the retail services covered by the applicant’s trade mark;
- iii) It is not permissible to treat a mark registered for ‘retail services for goods X’ as though the mark was registered for goods X;
- iv) The General Court’s findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party’s trade mark was registered (or proposed to be registered).

35) The goods and services of the two parties are:

Applicant's goods and services	Opponents' goods
Class 19: Non-metallic building materials; materials for covering floors, walls and stairs; flooring (non-metallic); wooden flooring; ceramic tiles; laminated and engineered wood flooring; damp proof membranes.	Class 27: Artificial grass.
Class 27: Carpets; rugs; mats; matting; linoleum; floor coverings; vinyl floor coverings and tiles; floor tiles; underlay.	
Class 35: Wholesale and retail services connected with floor coverings; retail services, wholesale services, mail order retail and wholesale services, electronic shopping retail services, telephone shopping retail services, all connected with the sale of non-metallic building materials, materials for covering floors or walls or stairs, flooring (non-metallic), wooden flooring, ceramic tiles, laminated and engineered wood flooring, damp proof membranes, carpets, rugs, mats, matting linoleum, floor coverings, vinyl floor coverings and tiles, floor tiles, underlay, machined wood floor coverings, ceramic floor coverings, mosaic floor coverings, carpet protectors, carpet protection products, floor protection products, carpet inlays, grip rods, thresholds, threshold profiles, adhesives, floor cleaning products; consultancy, information and advisory services relating to the aforesaid.	

36) In all my comparisons I am regarding the opponent's goods solely as artificial grass as the use shown was restricted to this product. However, the evidence of use shown included use of artificial grass indoors in homes and offices. It was also shown being used outdoors and in sports arenas but it is its use in offices, conservatories, nurseries and children's play areas that will feature most heavily in my comparison. I shall first consider the goods of the applicant in Class 19. The users of the goods of both parties are the general public including businesses and the trade channels would also appear to be identical as the evidence shows that carpet retail outlets and DIY outlets sell both floor coverings (carpets, tiles and wooden flooring as well as artificial grass). There are outlets which sell only ceramic and wooden flooring and those which sell solely carpets, but it is clear that there are those which sell all types of floor coverings. Thus, "materials for covering floors and stairs; flooring (non-metallic); wooden flooring; ceramic floor tiles; laminated and engineered wood flooring" have the same users and trade channels and are in competition with artificial grass. Whereas the balance of the goods "Non-metallic building materials, excluding flooring; materials for covering walls; ceramic

wall tiles; damp proof membranes”, whilst having the same users, and trade channels are not in competition with artificial grass.

37) Looking at the physical nature of the goods it is clear that artificial grass and carpets can share the same materials, albeit that more expensive carpets tend to use wool rather than man-made fibres. In my opinion such items are not self-service items unless one is considering off-cuts, or small quantities of tiles or flooring. Mostly such items have to be ordered to ensure that the goods are from the same batch and therefore that the colours are identical, and also as their bulk means it is difficult for stores to stock a sufficient amount for larger areas. **Overall in Class 19: The following goods are similar to a medium degree: “Materials for covering floors and stairs; flooring (non-metallic), wooden flooring; ceramic floor tiles; laminated and engineered wood flooring”, whereas “Non-metallic building materials, excluding flooring; materials for covering walls; ceramic wall tiles; damp proof membranes” are not similar nor complementary to the opponent’s goods.**

38) Moving onto the applicant’s class 27 goods it is clear from comments I have made already that the users, physical nature and trade channels of **“Carpets; rugs; mats; matting; floor coverings; floor tiles; underlay” are highly similar**, and that these goods are in competition with artificial grass. In my opinion **“linoleum; vinyl floor coverings and tiles” are similar to a medium degree** to artificial grass as they differ in physical nature as they are not woven but are purely plastic products. However they do share the same users, trade channels and are in competition with artificial grass. As stated earlier, generally, such goods are not self-service.

39) Moving onto the services in Class 35. To my mind: “Retail services connected with floor coverings; retail services, mail order retail services, electronic shopping retail services, telephone shopping retail services, all connected with the sale of non-metallic building materials, materials for covering floors or walls or stairs, flooring (non-metallic), wooden flooring, ceramic floor tiles, laminated and engineered wood flooring, carpets, rugs, mats, matting linoleum, floor coverings, vinyl floor coverings and tiles, floor tiles, underlay, machined wood floor coverings, ceramic floor coverings, mosaic floor coverings, carpet protectors, carpet protection products, floor protection products, carpet inlays, grip rods, thresholds, threshold profiles, adhesives, floor cleaning products; consultancy, information and advisory services relating to the aforesaid” **are complementary to the opponent’s goods to a medium degree.**

Whilst:

“Wholesale services connected with floor coverings; retail services, mail order retail services, electronic shopping retail services, telephone shopping retail services, all connected with the sale of non-metallic building materials excluding flooring, materials for covering walls, ceramic wall tiles, damp proof membranes; consultancy, information and advisory services relating to the aforesaid; Wholesale services, mail order wholesale services, all connected with the sale of non-metallic building materials, materials for covering floors or walls or stairs, flooring (non-metallic), wooden flooring, ceramic tiles, laminated and engineered wood flooring, damp proof membranes, carpets, rugs, mats, matting linoleum, floor coverings, vinyl floor coverings and tiles, floor tiles, underlay, machined wood floor coverings, ceramic floor coverings, mosaic floor coverings, carpet protectors, carpet protection products, floor protection products, carpet inlays, grip rods, thresholds, threshold profiles, adhesives, floor cleaning products; consultancy, information and advisory services relating to the aforesaid” **are neither similar nor complementary to the opponent’s class 27 goods.**

### **Comparison of trade marks**

40) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

<b>Opponents’ trade mark</b>	<b>Applicant’s trade mark</b>
LIFESTYLE	LIFESTYLE FLOORS



42) Given that the vast majority of the goods and services offered by the applicant relate to flooring such as wooden floors, carpets etc. the word “Floors” which forms the second part of the applicant’s mark will be seen as descriptive and not accorded much attention by the average consumer. I note that the opponent’s mark does not have such a descriptor and so conceptually is not defined in the same manner as the applicant’s mark. Visually and orally the first words are identical although when considered as wholes there are visual, aural and conceptual differences, although these are relatively slight. Overall the marks are similar to a high degree.

### **Distinctive character of the earlier trade mark**

43) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

44) In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

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

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

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out”.

45) The opponent’s mark consists of the well-known word LIFESTYLE. The mark alludes to a set of attitudes which are desirable, and as such would be seen as verging on the laudable in respect of the goods on which it has been used. The mark is inherently distinctive to a medium degree. Although the opponent has shown use of its mark it has been at a low level and is not enough for the opponent to benefit from enhanced distinctiveness.

### **Likelihood of confusion**

46) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer for the goods and services is a member of the general public (including businesses), who will select the goods and services by predominantly visual means, although not discounting aural considerations and that the degree of care and attention they pay will vary depending upon cost but they are likely to pay a medium degree of attention to the selection of such goods and a low degree of attention to the selection of the retail outlet and services surrounding the goods. Conversely, the selection of a wholesaler is likely to be given a high degree of attention.
- the marks of the two parties are similar to a high degree.
- the opponent's mark has a medium level of inherent distinctiveness but cannot benefit from an enhanced distinctiveness through use.
- The following goods and services of the applicant are similar or complementary to the opponent's goods to a medium degree: In Class 17: Materials for covering floors and stairs; flooring (non-metallic), wooden flooring; ceramic floor tiles; laminated and engineered wood flooring. In class 27: Carpets; rugs; mats; matting; floor coverings; floor tiles; underlay, linoleum; vinyl floor coverings and tiles. In class 35: Retail services connected with floor coverings; retail services, mail order retail services, electronic shopping retail services, telephone shopping retail services, all connected with the sale of non-metallic building materials, materials for covering floors or walls or stairs, flooring (non-metallic), wooden flooring, ceramic floor tiles, laminated and engineered wood flooring, carpets, rugs, mats, matting linoleum, floor coverings, vinyl floor coverings and tiles, floor tiles, underlay, machined wood floor coverings, ceramic floor coverings, mosaic floor coverings, carpet protectors, carpet protection products, floor protection products, carpet inlays, grip rods, thresholds, threshold profiles, adhesives, floor cleaning products; consultancy, information and advisory services relating to the aforesaid.
- The following goods and services of the applicant are neither similar or complementary to the opponent's goods: In class 17: Non-metallic building materials, excluding flooring; materials for covering walls; ceramic wall tiles; damp proof membranes. In Class 35: Wholesale services connected with floor coverings; retail services, mail order retail services, electronic shopping retail services, telephone shopping retail services, all connected with the sale of non-metallic building materials excluding flooring, materials for covering walls, ceramic wall tiles, damp

proof membranes; consultancy, information and advisory services relating to the aforesaid; Wholesale services, mail order wholesale services, all connected with the sale of non-metallic building materials, materials for covering floors or walls or stairs, flooring (non-metallic), wooden flooring, ceramic tiles, laminated and engineered wood flooring, damp proof membranes, carpets, rugs, mats, matting linoleum, floor coverings, vinyl floor coverings and tiles, floor tiles, underlay, machined wood floor coverings, ceramic floor coverings, mosaic floor coverings, carpet protectors, carpet protection products, floor protection products, carpet inlays, grip rods, thresholds, threshold profiles, adhesives, floor cleaning products; consultancy, information and advisory services relating to the aforesaid.

47) In view of the above, and allowing for the concept of imperfect recollection, there is a likelihood of consumers being confused into believing that the goods and services listed below, applied for under the mark in suit and provided by the applicant are those of the opponent or provided by some undertaking linked to it. **The opposition under Section 5(2) (b) therefore succeeds in relation to:**

In Class 19: Materials for covering floors and stairs; flooring (non-metallic), wooden flooring; ceramic floor tiles; laminated and engineered wood flooring.

In class 27: Carpets; rugs; mats; matting; floor coverings; floor tiles; underlay, linoleum; vinyl floor coverings and tiles.

In class 35: Retail services connected with floor coverings; retail services, mail order retail services, electronic shopping retail services, telephone shopping retail services, all connected with the sale of non-metallic building materials, materials for covering floors or walls or stairs, flooring (non-metallic), wooden flooring, ceramic floor tiles, laminated and engineered wood flooring, carpets, rugs, mats, matting linoleum, floor coverings, vinyl floor coverings and tiles, floor tiles, underlay, machined wood floor coverings, ceramic floor coverings, mosaic floor coverings, carpet protectors, carpet protection products, floor protection products, carpet inlays, grip rods, thresholds, threshold profiles, adhesives, floor cleaning products; consultancy, information and advisory services relating to the aforesaid.

48) In view of the above, and allowing for the concept of imperfect recollection, there is no likelihood of consumers being confused into believing that the goods and services listed below, applied for under the mark in suit and provided by the applicant are those of the opponent or provided by some undertaking linked to it. **The opposition under Section 5(2) (b) therefore fails in relation to:**

In class 19: Non-metallic building materials, excluding flooring; materials for covering walls; ceramic wall tiles; damp proof membranes.

In Class 35: Wholesale services connected with floor coverings; retail services, mail order retail services, electronic shopping retail services, telephone shopping retail services, all connected with the sale of non-metallic building materials excluding flooring, materials for covering walls, ceramic wall tiles, damp proof membranes; consultancy, information and advisory services relating to the aforesaid; Wholesale services, mail order wholesale services, all connected with the sale of non-metallic building materials, materials for covering floors or walls or stairs, flooring (non-metallic), wooden flooring, ceramic tiles, laminated and engineered wood flooring, damp proof membranes, carpets, rugs, mats, matting linoleum, floor coverings, vinyl floor coverings and tiles, floor tiles, underlay, machined wood floor coverings, ceramic floor coverings, mosaic floor coverings, carpet protectors, carpet protection products, floor protection products, carpet inlays, grip rods, thresholds, threshold profiles, adhesives, floor cleaning products; consultancy, information and advisory services relating to the aforesaid.

## CONCLUSION

49) As the opposition in relation to certain goods and services applied for has been successful, the application can only be registered for the goods and services shown in paragraph 48 above.

## COSTS

50) As the opponent has been mostly successful it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£300
Preparing evidence and considering the other side's evidence	£400

Expenses	£100
TOTAL	£800

51) I order Headlam Group Plc to pay Support in Sport Group Ltd the sum of £800. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 1<sup>st</sup> day of February 2017**



**George W Salthouse**  
**For the Registrar,**  
**the Comptroller-General**