

O-373-18

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**TRADE MARK APPLICATION No. 3203990**

**BY MARSHALLS MONO LIMITED**

**TO REGISTER THE FOLLOWING TRADE MARK**

**IN CLASSES 6, 11, 19 & 20:**

**NATURAL ELEMENTS**

**AND**

**OPPOSITION THERETO (No. 409531)**

**BY FURNITUBES INTERNATIONAL LIMITED**

## Background and pleadings

1) On 23 December 2016 Marshalls Mono Limited ('the applicant') applied to register the trade mark NATURAL ELEMENTS in the UK. It was accepted and published in the Trade Marks Journal on 24 March 2017 in respect of the following goods:

*Class 6: Metallic building materials; transportable buildings of metal; metal bollards; metal furniture fittings; street furniture (predominantly of metal); canopies (structures) of metal; walkways; shelters; canopies [structures] of metal; storage shelters of metal; cycle storage products/racks of metal; metal bins; metal litter bins; metal hoardings; post caps, being caps of metal for posts; metal gratings; metal street furniture, or street furniture made predominantly of metal, such as of aluminium and/or steel, including, bins, litter bins, planters, telephone boxes, booths, kiosks, advertising pillars, advertising columns, banner columns, stands for motorcycles/bicycles, parking installations for bicycles and motorcycles, vehicle racks, bollards, shelters, bus shelters, signs, signage, fingerposts, notice boards, railings, fencing, balustrades, guardrails, handrails, posts, gates, barriers, gratings, grilles, tree support frames, manhole covers, display panels, display boards, gazebos; street furniture made of metal; steel and/or cast iron street furniture; parts, components, fixtures and fittings for any or all the aforesaid goods.*

*Class 11: Apparatus for lighting; lamps, luminaires; lamp support columns and brackets; street lamps; parts, components, fixtures and fittings for any or all of the aforesaid goods.*

*Class 19: Building materials (non-metallic); non-metallic transportable buildings; parts, components, fixtures and fittings for any or all of the aforesaid goods.*

*Class 20: Street furniture (non-metallic); street furniture (predominantly of non-metal, including of timber and metal); street furniture made of timber and metal; street furniture (non-metallic or predominantly non-metallic, including of timber and metal), including, planters, bollards, bins, litter bins, telephone*

*boxes, booths, kiosks, advertising pillars, advertising columns, banner columns, vehicle racks, stands and racks for motorcycles/bicycles, signs, signage, finger posts, notice boards, railings, fencing, balustrades, guardrails, handrails, posts, gates, barriers, gratings, grilles, tree support frames, manhole covers, shelters, bus shelters, display panels, display boards, gazebos, and parking installations Street furniture, including, benches, seats and tables, notice boards, bulletin boards, planters, bins, litter bins, signs, signage, display boards, display panels; street furniture, including, benches, seats and tables, notice boards, bulletin boards, planters, bins, litter bins, signs, signage, display boards, display panels, including such made of (or predominantly made of) timber or a combination of metal and timber; street furniture (of timber and metal), including, benches, seats and tables, notice boards, bulletin boards, planters, bins, litter bins, signs, signage, display boards, display panels; parts, components, fixtures and fittings for any or all the aforesaid goods.*

2) On 15 June 2017 Furnitubes International Limited ('the opponent') oppose the trade mark on the basis of Section 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ('the Act'). This is on the basis of its earlier UK no. 3001799 for the mark 'ELEMENTS'. The following class 20 goods are relied upon in this opposition:

*Class 20: Outdoor furniture, outdoor benches, outdoor seats*

3) The opponent argues that the respective goods are the same or similar and that the marks are similar.

4) In respect of its section 5(3) claim, the opponent states that it 'has a long established reputation in the trade mark for the goods in question' and that 'a person seeing the Applicant's trade mark would think that the Applicant's goods in all classes were related to the goods provided by the Opponent.'

5) Finally, with regard to the section 5(4)(a) claim, the opponent states that it is selling 'outdoor furniture, outdoor benches, outdoor seats' under the sign ELEMENTS since 2013 and that it has acquired goodwill throughout the UK. By

virtue of the goodwill accrued, it claims that there will be a misrepresentation before the relevant public so that they will think that there is an economic connection between them which will result in damage.

6) The applicant filed a counterstatement denying the claims made.

7) Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate/necessary.

8) A hearing via video-link took place on 4 May 2018, with the opponent represented by Mr Graham Jones of Graham Jones & Co. The applicant filed submissions in lieu of attending the hearing. These shall not be summarised but I shall bear them in mind and refer to them where necessary.

## **Evidence**

*Witness statement of Anna Majella Curran plus exhibits AMC1 – AMC12*

9) Ms Curran is the managing director of the opponent. Ms Curran states that sales under the mark ELEMENTS commenced in 2013 for its outdoor range, namely furniture, outdoor benches and outdoor seats. Exhibit AMC1 consists of a product brochure which has 'Furnitubes' at the top of the front cover with 'Elements seating range' in the middle, also on the front cover. The brochure is undated except for a copyright date of 2013 on each page apart from the last page which states 2012. The brochure includes pictures, dimensions and other information on outdoor benches which appear to be placed in public places. At the top of each page it is headed 'Elements seating range' and on the final page it states 'UK made'.

10) Exhibit AMC2 to the witness statement is a table containing sales figures for goods (outdoor furniture, outdoor benches and outdoor seats) sold under the sign ELEMENTS since 2013. The table is reproduced below:

<b>Year</b>	<b>Sales (excluding VAT)</b>
2013	£34,754
2014	£62,929
2015	£85,070
2016	£67,122
2017	£89,262
<b>Total</b>	<b>£339,138</b>

11) Exhibit AMC3 consists of a number of invoices which Ms Curran states are indicative of sales for its office furniture, outdoor benches and outdoor seats under the mark ELEMENTS being all over the United Kingdom, i.e. Cambridge, Dundee, Surrey, South Wales, etc.

12) Exhibit AMC4 consists of a copy of an e-brochure which shows use of the mark ELEMENTS on outdoor seating and benches. Ms Curran states that the brochures have been available on-line since the product launched in 2012. Exhibit AMC5 also consists of an e-brochure which was placed on the ISSUU platform (the world's largest digital discovery and publishing platform).

13) Exhibit AMC6 to the witness statement is a copy of the product pages relating to goods sold under the mark ELEMENTS. The print out includes the date of printing (17 October 2017) which is well after the relevant date. The goods advertised under the mark 'Elements' all appear to be outdoor seats & benches.

14) Exhibit AMC7 includes details of various case studies for larger scale projects which include the mark Elements as sole or key products within each project. The exhibit includes a print out for benches being placed in Eastbourne. Reference is also made to other case studies in Cambridge, Cardiff, Enfield, etc but no specific details are provided.

15) Exhibit AMC8 consists of print outs from the opponent's website under the heading 'Blogs'. The blog page is headed 'Understanding the Elements range'. It includes the date of printing of 17 October 2017.

16) Ms Curran states that the opponent issues direct marketing emails aimed at promoting the 'Elements' mark. There are a choice of two email templates to issue, both refer to 'Elements' seating ranges. Details of the emails are below<sup>1</sup>:

<b>Date sent</b>	<b>Number sent</b>	<b>Open rate</b>
21/02/2013	9,936	12.9%
07/03/2013	4,409	11.4%
14/03/2013	6,216	5.7%
06/06/2013	9,189	6.3%
16/03/2016	13,303	17.8%

17) Exhibit AMC10 consists of extracts from various third party websites. It is not clear what the relevance of these extracts is.

18) Ms Curran refers to various advertisements placed in three trade publications – RIBA (Royal Institute of British Architects) Public Real 2016, External Works and Landscape, Summer 2016<sup>2</sup>. The publications each refer to the ELEMENTS brand though it is not known when and where they were published or the publication figures.

19) Ms Curran also states that the outdoor furniture, outdoor benches and outdoor seats, sold under the trade mark ELEMENTS, are to local authorities and also to private developers.

20) The final exhibit<sup>3</sup> to the witness statement comprise of a collection of letters between the parties prior to the notice of opposition being filed. The exhibit is not relevant to the issues before me and I do not take its content into account in these proceedings.

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<sup>1</sup> Filed under exhibit AMC9

<sup>2</sup> Exhibit AMC 11

<sup>3</sup> Exhibit AMC 12

*2<sup>nd</sup> witness statement of Anna Majella Curran (no exhibits)*

21) Ms Curran's second witness statement does not include any further exhibits. It reiterates her view that there is a likelihood of confusion. Further, she questions the motives for the applicant, as a direct competitor, to choose the mark NATURAL ELEMENTS.

### **Applicant's evidence**

*Witness statement of Mr David Moy and exhibits DM1 – DM9*

22) Mr Moy is a trade mark attorney at Appleyard Lees IP LLP, the applicant's professional representative.

23) Exhibits DM1 – DM4 consists of trade mark register print outs for the application, correspondence relating to the prosecution of the case, search results for all EUIPO and UK marks containing the words 'element' and 'elements'. These shall be referred to more later in this decision.

24) Exhibit DM5 consists of details/pages found via an internet search conducted by Mr Moy on 29 December 2017. The search was conducted for the terms 'Elements seating', 'Elements outdoor seats' and 'Elements outdoor furniture'. Examples of use include UK websites such as Lesco which refers to 'Team Seating Elements' the website Emergent, which refers to 'Elements Seating'. The exhibit also includes extracts from the opponent's website and various other websites.

25) Exhibits DM6 and DM7 comprise of UK and EU trade mark register search results. Mr Moy points out that the results show that 'in at least one of Classes 6,11, 19 and 20 and being ELEMENT or ELEMENTS as the sole wording'.

### **DECISION - Section 5(2)(b)**

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

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

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

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

27) In the judgment of the Court of Justice of the European Union (‘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”.

28) 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.



29) In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

30) In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

31) In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

32) The respective goods are as follows:

<b>Opponent's goods</b>	<b>Applicant's goods</b>
<p><i>Class 20: Outdoor furniture, outdoor benches, outdoor seats</i></p>	<p><i>Class 6: Metallic building materials; transportable buildings of metal; metal bollards; metal furniture fittings; street furniture (predominantly of metal); canopies (structures) of metal; walkways; shelters; canopies [structures] of metal; storage shelters of metal; cycle storage products/racks of metal; metal bins; metal litter bins; metal hoardings; post caps, being caps of metal for posts; metal gratings; metal street furniture, or street furniture made predominantly of metal, such as of aluminium and/or steel, including, bins, litter bins, planters, telephone boxes, booths, kiosks, advertising pillars, advertising columns, banner columns, stands for motorcycles/bicycles, parking installations for bicycles and motorcycles, vehicle racks, bollards, shelters, bus shelters, signs, signage, fingerposts, notice boards, railings, fencing, balustrades, guardrails, handrails, posts, gates, barriers, gratings, grilles, tree support frames, manhole covers, display panels, display boards, gazebos; street furniture made of metal; steel and/or cast iron street furniture; parts, components, fixtures and fittings for any or all the aforesaid goods.</i></p>
	<p><i>Class 11: Apparatus for lighting; lamps, luminaires; lamp support columns and brackets; street lamps; parts, components, fixtures and fittings for any or all of the aforesaid goods.</i></p>
	<p><i>Class 19: Building materials (non-metallic); non-metallic transportable buildings; parts, components, fixtures and fittings for any or all of the aforesaid goods.</i></p>
	<p><i>Class 20: Street furniture (non-metallic); street furniture (predominantly of non-metal, including of timber and metal); street furniture made of timber and metal; street furniture (non-metallic or predominantly non-metallic, including of timber and metal), including, planters, bollards, bins, litter bins, telephone boxes, booths, kiosks, advertising pillars, advertising columns, banner columns, vehicle racks, stands and racks for motorcycles/bicycles, signs, signage, finger posts, notice boards, railings, fencing, balustrades, guardrails, handrails, posts, gates, barriers, gratings, grilles, tree support frames, manhole covers, shelters, bus shelters, display panels, display boards, gazebos, and parking installations Street furniture, including, benches, seats and tables, notice boards, bulletin boards, planters, bins, litter bins, signs, signage, display boards, display panels; street furniture, including, benches, seats and tables, notice boards, bulletin boards, planters, bins, litter bins, signs, signage, display boards, display panels, including such made of (or predominantly made of) timber or a combination of metal and timber; street furniture (of timber and metal), including, benches, seats and tables, notice boards, bulletin boards, planters, bins, litter bins, signs, signage, display boards, display panels; parts, components, fixtures and fittings for any or all the aforesaid goods.</i></p>

33) The opponent's outdoor benches and seats are self-explanatory insofar that they cover benches and seats to be used outdoors and are therefore typically made of more durable or weather resistant materials. The opponent's outdoor furniture is a broad term which covers furniture *per se* that would be used outdoors. The opponent's goods used for sitting, resting, eating etc and have a functional purpose. Since they will be used outside they are also likely to be more durable or weather resistant.

## **Class 6**

34) The applicant's goods include street furniture *per se*. Generally street furniture are items which are placed in streets which are there for the benefit of others, i.e. the general public. Whilst they do cover furniture in the generic sense (for example benches and seats) it is a broad term which also covers items which would not generally be considered as items of furniture that you would typically associate with a home, for example, bollards, signs, banner columns, etc. Further, a key difference between goods of class 6 and class 20 are that class 6 goods are predominantly made of metal whereas class 20 are not.

35) I find *street furniture (predominantly of metal); metal street furniture, or street furniture made predominantly of metal, such as of aluminium and/or steel; street furniture made of metal; steel and/or cast iron street furniture* to be highly similar to the opponent's goods, particularly since street furniture would include benches and seats (which would be made from metal).

36) The contested class 6 goods includes the term 'including' which is after '*street furniture*'. Use of 'including' indicates that the specific goods listed are only examples of items included in the category and that protection is not restricted to them. It may be that once the principles set out in *Treat* are applied, the goods listed after 'including' may not be similar to the opponent's goods and I am therefore required to assess each term. These goods are *bins, litter bins, planters, telephone boxes, booths, kiosks, advertising pillars, advertising columns, banner columns, stands for motorcycles/bicycles, parking installations for bicycles and motorcycles, vehicle racks, bollards, shelters, bus shelters, signs, signage, fingerposts, notice boards,*

*railings, fencing, balustrades, guardrails, handrails, posts, gates, barriers, gratings, grilles, tree support frames, manhole covers, display panels, display boards, gazebos.* None of these goods would be used to sit, eat or rest on. They are goods which serve entirely different purposes and they therefore differ in nature with the opponent's goods. They are not in competition with one another, nor are they complementary. Whilst they may be sold in the same establishments as the opponent's goods, they are unlikely to be purchased by the same end user. They are not similar.

37) The contested *Metallic building materials* is a broad term which covers goods which are used for construction purposes. Therefore, they are goods which differ in nature to the opponent's goods. They are not in competition nor are they complementary, i.e. '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'<sup>4</sup>. They are not similar.

38) During the hearing Mr Jones argued since *transportable buildings of metal* may have seats or benches within them, which would be either a part, component, fixture or fitting, they are similar to the opponent's outdoor seats and benches. However, I remind myself of the passage cited above from the judgment of Floyd J in *YouView TV Ltd v Total Ltd* and the need to focus on the ordinary and natural, or core, meaning of terms so as to avoid the limits of trade mark registrations becoming fuzzy and imprecise.

39) Finding that components, fixtures and fittings of transportable buildings are similar to outdoor furniture, benches and/or seats would be too liberal an interpretation of the applicant's goods. Further, if the transportable building has a bench or seat within it then it is not an outdoor bench. Therefore, I find that the respective goods are not similar.

40) The applicant's *metal furniture fittings* are goods used as a part or attached to another piece of furniture. They are used to either hold other constituent parts

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<sup>4</sup> *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

together or to provide some ancillary purpose for metal furniture. They are likely to coincide in relevant publics and distribution channels with the opponent's outdoor furniture. Further, since fittings are an essential element for furniture to function, I consider them to be complementary. They are not in competition. Therefore, I consider them to be similar to a medium degree.

41) The contested *canopies (structures) of metal* (appears twice in the specification) are goods hung or held over something to provide shade from the sun or rain, or be used for security purposes. Therefore, they general differ in nature to the opponent's goods. They are not in competition nor are they complementary. They are not similar.

42) I do not see any point of similarity between the contested *metal bollards; walkways; shelters; storage shelters of metal; cycle storage products/racks of metal; metal bins; metal litter bins; metal hoardings; post caps, being caps of metal for posts; metal gratings* and the opponent's goods. They are clearly different in nature since none of them would be used to sit, eat, sleep, etc. Further, the contested goods are not in competition with the opponent's goods and the users will differ. I also find that they are not likely to be sold via the same distribution channels. They are not similar.

43) With regard to the term 'parts, components, fixtures and fittings for any or all of the aforesaid goods' in this class, to the extent that the parts and fittings relate to goods where I have found similarity then there will be a degree of similarity between the parts and fittings and the opponent's goods.

**Class 11:** *Apparatus for lighting; lamps, luminaires; lamp support columns and brackets; street lamps; parts, components, fixtures and fittings for any or all of the aforesaid goods.*

44) All of the class 11 goods are either lighting or goods used in order to provide lighting. Therefore, they differ in nature to the opponent's outdoor furniture, benches and seats. I do not consider these goods to be similar to the earlier goods. Whilst street lamps may be purchased and erected by councils, which may also purchase

outdoor furniture, etc., I consider this to be too broad a generalisation and I do not consider the goods to be similar.

**Class 19:** *Building materials (non-metallic); non-metallic transportable buildings; parts, components, fixtures and fittings for any or all of the aforesaid goods.*

45) The contested class 19 goods clearly differ in nature to the opponent's goods. Applying the principles set out in the *Treat* case lead me to conclude that there is no similarity between the goods. As above, I reject the argument for similarity based on 'parts, components, fixtures and fittings' for non-metallic transportable buildings'.

**Class 20:** *Street furniture (non-metallic); street furniture (predominantly of non-metal, including of timber and metal); street furniture made of timber and metal; street furniture (non-metallic or predominantly non-metallic, including of timber and metal), including, planters, bollards, bins, litter bins, telephone boxes, booths, kiosks, advertising pillars, advertising columns, banner columns, vehicle racks, stands and racks for motorcycles/bicycles, signs, signage, finger posts, notice boards, railings, fencing, balustrades, guardrails, handrails, posts, gates, barriers, gratings, grilles, tree support frames, manhole covers, shelters, bus shelters, display panels, display boards, gazebos, and parking installations; Street furniture, including, benches, seats and tables, notice boards, bulletin boards, planters, bins, litter bins, signs, signage, display boards, display panels; street furniture, including, benches, seats and tables, notice boards, bulletin boards, planters, bins, litter bins, signs, signage, display boards, display panels, including such made of (or predominantly made of) timber or a combination of metal and timber; street furniture (of timber and metal), including, benches, seats and tables, notice boards, bulletin boards, planters, bins, litter bins, signs, signage, display boards, display panels; parts, components, fixtures and fittings for any or all the aforesaid goods.*

46) I find that the contested *Street furniture (non-metallic); street furniture (predominantly of non-metal, including of timber and metal); street furniture made of timber and metal; street furniture (non-metallic or predominantly non-metallic, including of timber and metal); Street furniture, including, benches, seats and tables; street furniture, including, benches, seats; street furniture (of timber and metal),*

*including, benches, seats and tables* to be highly similar to the opponent's class 20 goods. Since the broad term street furniture covers seats and benches which are placed in the street then they have the same nature and purpose as outdoor seats and benches. If the respective goods are not identical, due to the applicant's goods being for the street and the other for outdoor purposes, then they are highly similar.

47) As stated in my assessment of the class 6 goods, use of the word 'including' introduces a non-exhaustive list of examples covered by the broad term. Therefore, I must consider the contested which appear after 'including'. As previously stated, the opponent's goods are functional items used to sit, rest and/or eat. Therefore, they are different in nature to all of the remaining contested class 20 goods, namely: *planters, bollards, bins, litter bins, telephone boxes, booths, kiosks, advertising pillars, advertising columns, banner columns, vehicle racks, stands and racks for motorcycles/bicycles, signs, signage, finger posts, notice boards, railings, fencing, balustrades, guardrails, handrails, posts, gates, barriers, gratings, grilles, tree support frames, manhole covers, shelters, bus shelters, display panels, display boards, gazebos, and parking installations, notice boards, bulletin boards, planters, bins, litter bins, signs, signage, display boards, display panels; notice boards, bulletin boards, planters, bins, litter bins, signs, signage, display boards, display panels, including such made of (or predominantly made of) timber or a combination of metal and timber; notice boards, bulletin boards, planters, bins, litter bins, signs, signage, display boards, display panels; parts, components, fixtures and fittings for any or all the aforesaid goods.*

48) I also find that they are not in competition with one another and the uses and users are likely to be different. Further, they are likely to be purchased by different end users via differing trade channels. They are not similar.

49) With regard to the term '*parts, components, fixtures and fittings for any or all the aforesaid goods*' in this class, to the extent that the parts, component, fixtures and fittings relate to goods where I have found similarity then there will be a degree of similarity between them and the opponent's goods.

## Comparison of marks

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

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

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

52) The respective trade marks are shown below:

<b>Opponent's mark</b>	<b>Applicant's mark</b>
ELEMENTS	NATURAL ELEMENTS

53) The opponent's mark consists solely of the word ELEMENTS. Therefore, its overall impression and its distinctiveness lie in the totality of the mark. In relation to the applicant's mark, Mr Jones argues that the word NATURAL is devoid of distinctive character since 'it implies something made of natural materials' and would be refused registration should it be applied for *solus*. Accordingly, he states, the word ELEMENTS has a far greater 'trade mark feel and distinctiveness'. I must



consider the mark as a whole and the impact the mark as a whole has on the average consumer rather than the individual words. Having said that, I find that the word ELEMENTS has greater trade mark significance than NATURAL in the overall impression of the mark.

54) Visually, the respective marks share the common word ELEMENTS which is the only word of the opponent's mark, and second word of the applicant's mark. They differ insofar that the first word of the applicant's mark is NATURAL which does not contribute to the overall impression of the mark. Therefore, I consider there to be a medium degree of visual similarity.

55) Aurally, the considerations are similar with the with the opponent's mark being the same single word which is the second word in the applicant's mark. They are aurally similar to a medium degree.

56) Conceptually, the word ELEMENTS has a number of meanings. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer.<sup>5</sup> Although the word 'ELEMENTS' will be grasped as meaningful, whatever meaning the average consumer focusses on when seeing ELEMENTS alone, they are likely to see the same meaning behind the word ELEMENTS in the application. However, the applicant's mark also includes the adjective NATURAL, which qualifies the noun ELEMENTS as being natural. Therefore, whilst the marks share the concept of ELEMENTS I find that the inclusion of NATURAL and the broad meaning of ELEMENTS renders the conceptual similarity to being low.

### **Average consumer and the purchasing act**

57) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

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<sup>5</sup> Case C-361/04 P *Ruiz-Picasso and Others v OHIM* [2006] ECR I-00643; [2006] E.T.M.R. 29

58) 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.”

59) During the hearing Mr Jones argued that the average consumer of the goods in question are professionals such as building contractors and councils. This reflects the area of commercial interest to his client. I agree that they do form part of the relevant public but do not consider them to be the only consumers of the goods. I must assess the goods on a notional basis and I find that the general public are also likely to purchase outdoor furniture, benches and seats for their gardens and other outdoor areas.

60) Professionals are likely to pay a degree of attention higher than average whereas the general public are only likely to pay an average degree of attention. Regardless of whether the goods are purchased by professionals or the general public, they are likely to be bought following a visual inspection of the goods. Consumers would visually review websites and brochures, though I do not discount aural recommendations by customer sales staff, colleagues or friends.

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

61) 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).”

62) 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.”

63) 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.

64) The level of distinctive character of a trade mark can vary, depending on the particular goods at issue: a mark may be more distinctive for some goods than it is for others. Distinctiveness can also be enhanced through use of the mark. There has been no explicit claim of enhanced distinctiveness but evidence of use has been filed in support of its section 5(3) of the Act claim. Further, during the hearing Mr Jones said that the use made of the mark since 2013 does give the mark ELEMENTS greater trade mark significance.

65) The evidence demonstrates that the opponent has an operational and successful business. However, I do not consider the extent of use to be sufficient for it to enhance the distinctive character of the opponent's mark. No evidence has been filed to demonstrate the market share enjoyed by the opponent. However, I am of the view that whilst the turnover has steadily increased from over £34k in 2013 to over £89k in 2017, this is a very small market share. There is no evidence detailing the amount spent on advertising, and promotion of the mark is not particularly widespread i.e. advertisements in three trade publications, some direct marketing emails and references to the mark on third party websites.

66) Taking all of the above into account, I find that the earlier mark has not been used to the extent required for it to have an enhanced degree of distinctive character.

67) Since the opponent has not demonstrated that it has an enhanced degree of distinctive character by virtue of the use made of it, I must assess the earlier marks inherent distinctive character. The earlier mark is for single word 'ELEMENTS'. It is a common English word but does not have a precise meaning in relation to the goods. As a consequence, I find that the earlier mark has an average degree of inherent distinctive character.

## **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

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

### *The principles*

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

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

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

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

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

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

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

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

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

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

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

69) A likelihood of confusion presupposes that there is some level of similarity between goods and services (*Canon*, paragraph 22). I found no similarity between the opponent's goods and the following goods of the application:

*Class 6: Metallic building materials; transportable buildings of metal; metal bollards; metal furniture fittings; canopies (structures) of metal; walkways; shelters; canopies [structures] of metal; storage shelters of metal; cycle storage products/racks of metal; metal bins; metal litter bins; metal hoardings; post caps, being caps of metal for posts; metal gratings; bins, litter bins, planters, telephone boxes, booths, kiosks, advertising pillars, advertising columns, banner columns, stands for motorcycles/bicycles, parking*

*installations for bicycles and motorcycles, vehicle racks, bollards, shelters, bus shelters, signs, signage, fingerposts, notice boards, railings, fencing, balustrades, guardrails, handrails, posts, gates, barriers, gratings, grilles, tree support frames, manhole covers, display panels, display boards, gazebos; parts, components, fixtures and fittings for any or all the aforesaid goods.*

All of classes 11 and 19

*Class 20: Planters, bollards, bins, litter bins, telephone boxes, booths, kiosks, advertising pillars, advertising columns, banner columns, vehicle racks, stands and racks for motorcycles/bicycles, signs, signage, finger posts, notice boards, railings, fencing, balustrades, guardrails, handrails, posts, gates, barriers, gratings, grilles, tree support frames, manhole covers, shelters, bus shelters, display panels, display boards, gazebos, and parking installations, notice boards, bulletin boards, planters, bins, litter bins, signs, signage, display boards, display panels; notice boards, bulletin boards, planters, bins, litter bins, signs, signage, display boards, display panels, including such made of (or predominantly made of) timber or a combination of metal and timber; notice boards, bulletin boards, planters, bins, litter bins, signs, signage, display boards, display panels; parts, components, fixtures and fittings for any or all the aforesaid goods.*

70) There is, therefore, no likelihood of confusion; the opposition under section 5(2)(b) fails in relation to these goods and the rest of my assessment will focus against the remaining goods, namely:

*Class 6: Street furniture (predominantly of metal); metal street furniture, or street furniture made predominantly of metal, such as of aluminium and/or steel; street furniture made of metal; steel and/or cast iron street furniture; parts, components, fixtures and fittings for any or all the aforesaid goods.*

*Class 20: Street furniture (non-metallic); street furniture (predominantly of non-metal, including of timber and metal); street furniture made of timber and metal; street furniture (non-metallic or predominantly non-metallic, including of*

*timber and metal); Street furniture, including, benches, seats and tables; street furniture, including, benches, seats and tables; street furniture (of timber and metal), including, benches, seats and tables; parts, components, fixtures and fittings for any or all the aforesaid goods.*

71) The applicant's evidence includes 1) various examples of trade mark registrations which include the mark ELEMENTS which cover the classes in question, and 2) examples of use of the mark ELEMENTS or ELEMENT by third parties in relation to seating and outdoor furniture. The evidence is aimed at demonstrating that the mark ELEMENT/ELEMENTS is used and registered and therefore consumers are accustomed to distinguishing between marks containing the word ELEMENT or ELEMENTS.

72) Each of the arguments set out above are dismissed. With regard to point one, apart from the fact that some of the marks are registered for the sort of goods which the opponent has chosen not to oppose in the applicant's specification, there is no way of knowing whether the marks are in use in the UK. It is well established that mere state of the register evidence does not assist a defence against a claim that there is a likelihood of confusion (see, for example, *Zero Industry Srl v OHIM*, Case T-400/06).

73) With regard to the various marketplace use of ELEMENT/ELEMENTS, these have no bearing on these proceedings since I must make a notional assessment on whether there is a likelihood of confusion between the application and the earlier mark. Further, it is noted that some of the evidence of use is use made of the mark by the opponent. Many other articles appear to be outside of the UK and are therefore not relevant.

74) During the hearing Mr Jones argued that if the average consumer was sat on a bench with the trade mark 'ELEMENTS' on it and the bench next to him had the mark 'NATURAL ELEMENTS' on it then the consumer of those goods would be confused into believing that there is a connection between them. This is not the likelihood of confusion assessment that I must make. Consumers rarely have the



opportunity to see the marks side by side and instead must rely upon its imperfect recollection.

75) In my view, even allowing for imperfect recollection, the differences between the marks as wholes, when combined with the difference between the respective services, are sufficient to avoid a likelihood of direct confusion.

76) I have more difficulty in ruling out the likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*,<sup>6</sup> Mr Iain Purvis Q.C. as the Appointed Person noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

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<sup>6</sup> Case BL-O/375/10

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

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

78) I have found that ELEMENTS has greater trade mark significance than NATURAL in the overall impression of the mark. I find that the later mark has simply added a part to the earlier mark which one would expect to find in a sub-brand or brand extension which places it within example Mr Purvis’ example (b) above. This results in there being a likelihood of indirect confusion.

79) I consider the likelihood of indirect confusion to exist in respect of all the goods which have been found to be similar to varying degrees. The opposition succeeds against the goods which have been found to be similar to varying degrees, these are:

*Class 6: Street furniture (predominantly of metal); metal street furniture, or street furniture made predominantly of metal, such as of aluminium and/or steel; street furniture made of metal; steel and/or cast iron street furniture; parts, components, fixtures and fittings for any or all the aforesaid goods.*

*Class 20: Street furniture (non-metallic); street furniture (predominantly of non-metal, including of timber and metal); street furniture made of timber and metal; street furniture (non-metallic or predominantly non-metallic, including of*

*timber and metal); Street furniture, including, benches, seats and tables; street furniture, including, benches, seats and tables; street furniture (of timber and metal), including, benches, seats and tables; parts, components, fixtures and fittings for any or all the aforesaid goods.*

### **DECISION - Section 5(3)**

80) Since the opposition based on section 5(2)(b) of the Act has not succeeded in its entirety I must also consider the opponent's section 5(3) claim against the remaining goods. These are:

*Class 6: Metallic building materials; transportable buildings of metal; metal bollards; metal furniture fittings; canopies (structures) of metal; walkways; shelters; canopies [structures] of metal; storage shelters of metal; cycle storage products/racks of metal; metal bins; metal litter bins; metal hoardings; post caps, being caps of metal for posts; metal gratings;, including, bins, litter bins, planters, telephone boxes, booths, kiosks, advertising pillars, advertising columns, banner columns, stands for motorcycles/bicycles, parking installations for bicycles and motorcycles, vehicle racks, bollards, shelters, bus shelters, signs, signage, fingerposts, notice boards, railings, fencing, balustrades, guardrails, handrails, posts, gates, barriers, gratings, grilles, tree support frames, manhole covers, display panels, display boards, gazebos; parts, components, fixtures and fittings for any or all the aforesaid goods.*

All of classes 11 and 19

*Class 20: Planters, bollards, bins, litter bins, telephone boxes, booths, kiosks, advertising pillars, advertising columns, banner columns, vehicle racks, stands and racks for motorcycles/bicycles, signs, signage, finger posts, notice boards, railings, fencing, balustrades, guardrails, handrails, posts, gates, barriers, gratings, grilles, tree support frames, manhole covers, shelters, bus shelters, display panels, display boards, gazebos, and parking installations, notice boards, bulletin boards, planters, bins, litter bins, signs, signage, display boards, display panels; notice boards, bulletin boards, planters, bins,*

*litter bins, signs, signage, display boards, display panels, including such made of (or predominantly made of) timber or a combination of metal and timber; notice boards, bulletin boards, planters, bins, litter bins, signs, signage, display boards, display panels; parts, components, fixtures and fittings for any or all the aforesaid goods.*

## **The law**

81) Section 5(3) of the Act states:

“(3) A trade mark which-

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

## **General principles**

82) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

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

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

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

83) The relevant date at which reputation must be proven is the date of the application, namely 23 December 2016.

## **Reputation**

84) In *General Motors*, Case C-375/97, the CJEU held that:

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

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

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

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

85) In my view, the opponent has not shown that ELEMENTS was known to a significant part of the relevant public at the relevant date. I am aware that in *Enterprise Holdings Inc. v Europcar Group UK Ltd*,<sup>7</sup> Arnold J. stated that proving a reputation "*is not a particularly onerous requirement.*" However, the evidence before Arnold J. in that case showed that the claimant was in fact the market leading car hire company in the UK with a 30% share of the UK market. It was in that context that the judge said that proving a reputation "*is not a particularly onerous requirement.*" He had no reason to turn his mind to situations where the claimant had only a small and/or unquantified share of the relevant market in the UK.

86) No evidence relating to market share has been filed and I consider it reasonable to infer from the sales figures (ranging from £35k per annum in 2013 up to £90k per annum in 2017) that they are not sufficient to demonstrate that the earlier mark is known by a significant part of the public concerned. For these reasons I find that the earlier mark has not shown that it has the requisite reputation and the section 5(3) claim falls at the first hurdle.

### **Section 5(3) outcome**

87) The section 5(3) of the Act fails and is rejected.

### **DECISION – Section 5(4)(a)**

88) I shall now consider the section 5(4)(a) claim which are against the goods which the sections 5(2)(b) and 5(3) claims have failed.

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<sup>7</sup> [2015] EWHC 17 (Ch)

89) Section 5(4)(a) of the Act states:

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

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

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

90) The requirements to succeed in a passing off action are well established and are summarised in Halsbury’s Laws of England 4th Ed. as being that:

- i) the claimant’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- ii) there is a misrepresentation by the defendant (whether or not intentional) which is likely to deceive the public into believing that the defendant’s goods or services are those of the claimant;
- and iii) the claimant has suffered or is likely to suffer damage as a result of the erroneous belief created by the defendant’s misrepresentation.

91) There is one possible difference between the position under trade mark law and the position under passing off law. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchen L.J. concluded:

“... if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”



92) Although this was an infringement case, the principles apply equally under 5(2): see *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch). In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a substantial number” of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal’s later judgment in *Comic Enterprises*, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

93) The opponent’s section 5(4)(a) claim is based on the goodwill arising from its business operating under the sign NATURAL ELEMENTS for sales of outdoor furniture, benches and seats in the UK. Even accepting that the evidence establishes the necessary goodwill I do not consider that it would offer the opponent any greater success than it has already achieved under section 5(2)(b). Consequently, the goodwill the opponent has for the aforementioned goods would not result in a misrepresentation sufficient to invoke section 5(4)(a) in relation to any of the goods for which I found that there is no likelihood of confusion under section 5(2)(b). Therefore, I do not propose to give any further consideration to this ground particularly since there was no further justification for the opponent’s position to be better at the hearing.

94) The section 5(4)(a) ground fails.

## **OVERALL OUTCOME**

95) The opposition succeeds and the application shall therefore be refused for:

*Class 6: Street furniture (predominantly of metal); metal street furniture, or street furniture made predominantly of metal, such as of aluminium and/or*

*steel; street furniture made of metal; steel and/or cast iron street furniture; parts, components, fixtures and fittings for any or all the aforesaid goods.*

*Class 20: Street furniture (non-metallic); street furniture (predominantly of non-metal, including of timber and metal); street furniture made of timber and metal; street furniture (non-metallic or predominantly non-metallic, including of timber and metal); Street furniture, including, benches, seats and tables; street furniture, including, benches, seats and tables; street furniture (of timber and metal), including, benches, seats and tables; parts, components, fixtures and fittings for any or all the aforesaid goods.*

96) The opposition fails and the application may therefore proceed to registration for:

*Class 6: Metallic building materials; transportable buildings of metal; metal bollards; metal furniture fittings; canopies (structures) of metal; walkways; shelters; canopies [structures] of metal; storage shelters of metal; cycle storage products/racks of metal; metal bins; metal litter bins; metal hoardings; post caps, being caps of metal for posts; metal gratings; bins, litter bins, planters, telephone boxes, booths, kiosks, advertising pillars, advertising columns, banner columns, stands for motorcycles/bicycles, parking installations for bicycles and motorcycles, vehicle racks, bollards, shelters, bus shelters, signs, signage, fingerposts, notice boards, railings, fencing, balustrades, guardrails, handrails, posts, gates, barriers, gratings, grilles, tree support frames, manhole covers, display panels, display boards, gazebos; parts, components, fixtures and fittings for any or all the aforesaid goods.*

All of classes 11 and 19

*Class 20: Planters, bollards, bins, litter bins, telephone boxes, booths, kiosks, advertising pillars, advertising columns, banner columns, vehicle racks, stands and racks for motorcycles/bicycles, signs, signage, finger posts, notice boards, railings, fencing, balustrades, guardrails, handrails, posts, gates, barriers, gratings, grilles, tree support frames, manhole covers, shelters, bus shelters, display panels, display boards, gazebos, and parking installations,*

*notice boards, bulletin boards, planters, bins, litter bins, signs, signage, display boards, display panels; notice boards, bulletin boards, planters, bins, litter bins, signs, signage, display boards, display panels, including such made of (or predominantly made of) timber or a combination of metal and timber; notice boards, bulletin boards, planters, bins, litter bins, signs, signage, display boards, display panels; parts, components, fixtures and fittings for any or all the aforesaid goods.*

## **COSTS**

97) Neither part made a request for a costs award above the normal published scale. However, Mr Jones did request costs at the higher end of the scale. The reasons for this are twofold. Firstly, prior to the opposition being filed it contacted the applicant requesting that they withdraw the application in order to avoid the opposition being filed. No response was received. I do not consider this warrants a higher contribution in costs. Indeed, the relative success of the applicant is a reason by itself for the applicant not making any contribution, let alone an increased contribution.

98) Secondly, Mr Jones argued that the evidence filed by the applicant did not address any of the issues to be decided. I am of the view that the applicant's evidence was filed to support its argument that a) there are many registrations including the word ELEMENTS coexisting on the register and, b) common marketplace usage of the term ELEMENTS. Whilst these arguments have not been persuasive, the applicant is nevertheless entitled to make such arguments and I do not agree that it should be penalised for doing so.

99) In the circumstances, since both parties both enjoy a measure of success I do not consider it necessary for both parties to bear its own costs.

**Dated this 20th day of June 2018**

**Mark King**

**For the Registrar,**

**The Comptroller-General**