

O/0511/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3698184

BY

FIRST FENCE LTD

TO REGISTER THE TRADE MARK (SERIES OF TWO)

EnviroMesh

Enviro Mesh

IN CLASSES 6 AND 19

AND OPPOSITION THERETO UNDER NUMBER 431517

BY

ENVIROMESH GROUP LIMITED

Background and Pleadings

1. On 21 September 2021, First Fence Ltd (“The Applicant”) applied to register in the UK the trade mark (series of two) numbered 3698184 EnviroMesh/Enviro Mesh for goods in classes 6 and 19, as set out in full later in my decision.

2. On 2 March 2022, Enviromesh Group Limited (“the Opponent”) issued proceedings, opposing the application under sections 5(1), 5(2)(a) and (b), 5(3), 5(4)(a) and 3(6)¹ of the Trade Marks Act 1994 (“the Act”).

3. For the purposes of its opposition under sections 5(1), 5(2)(a), 5(2)(b) and 5(3) it relies on the following trade marks:

(i) UKTM 3458172 (“Mark 172”)

ENVIROMESH

Filed on 15 January 2020 and registered on 7 August 2020 for goods and services in classes 6, 19, 37 and 42.

(ii) UKTM 2440565 (“Mark 565”)

ENVIROMESH

Filed on 5 December 2006 and registered on 28 September 2007 for goods in class 6.

(iii) UKTM 905970405 (“Mark 405”)

ENVIROMESH

Filed on 5 June 2007 and registered on 8 May 2008 for goods in class 6.

4. Under section 5(1) it is claimed that the contested mark is visually, phonetically and conceptually identical to the earlier marks and the applied for goods are identical to

¹ Whilst the Opponent relied on this ground throughout the proceedings, a week before the final hearing on the on the matter it applied for leave to withdraw this ground which was duly granted. The ground under section 3(6) shall therefore play no further part in my decision other than in relation to the issue of costs to which I shall return later.

those goods as relied upon in classes 6 and 19 such that that the registration shall be refused.

5. Under section 5(2)(a) and (b) its primary position is that the marks are identical or if determined not to be identical then similar, and the goods are either identical or similar such that there exists a likelihood of confusion between the respective marks.

6. Under section 5(3) it is claimed that each of the earlier marks has been used in relation to the goods and services of its registration, generating significant reputation and goodwill in the UK. Any use therefore of an identical/similar mark would result in the relevant public believing that there was an economic link between the two entities and the resultant diversion of trade would cause economic detriment to the Opponent. The Applicant is seeking to take unfair advantage of and free ride on the Opponent's reputation, goodwill and market share. Further, the Applicant may bring goods on the market below the exceptionally high standards of the Opponent, damaging the Opponent's reputation causing economic loss. It would further erode and dilute the distinctive character and repute of the Opponent's mark.

7. Under section 5(4)(a) the Opponent relies on its unregistered sign ENVIROMESH said to have been used throughout the UK since 2006 for *Gabions*. It claims that it has generated significant goodwill in relation to gabions and use by the Applicant of an identical/similar mark would constitute an actionable passing off claim, amounting to a misrepresentation as to the origin of the goods which would lead consumers to believe that the goods offered by the Applicant are those of the Opponent leading to the Opponent suffering damage.

8. The Applicant filed a defence and counterstatement denying each claim and all of the grounds of opposition, requesting that the Opponent provide strict proof of its reputation and goodwill in respect of each of its marks.

9. The trade marks upon which the Opponent relies, all qualify as earlier marks pursuant to section 6 of the Act. Whilst some of those marks were subject to the proof of use requirements under section 6A of the Act, the Applicant did not put the Opponent to proof of use. Consequently the Opponent may rely on each of its earlier marks and the full extent of its registrations without having to demonstrate the use it has made of them.

10. In these proceedings the Opponent is represented by Bryers LLP. The Applicant is represented by Patent Outsourcing Limited. Both parties filed evidence during the evidence rounds. A hearing was requested which took place before me, via video link, on 5 April 2023. Ms Amanda Michaels (counsel), of Hogarth Chambers, instructed by Bryers LLP appeared for the Opponent. The Applicant was represented by Ms Ashton Chantrielle (counsel), of 8 New Square chambers instructed by Patent Outsourcing Limited. Both parties filed skeleton arguments prior to the hearing.

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

Preliminary Issues

12. A week or so before the final hearing the Opponent sought leave to withdraw its ground of opposition under section 3(6), which was subsequently granted subject to any request for a claim of costs by the Applicant. Other than when assessing the costs award, the section 3(6) claim shall play no further part in my decision.

13. In her skeleton argument filed before the hearing, Ms Chantrielle confirmed that the Applicant's position had changed. Although it maintained its defence to each claim, various concessions were made namely:

1. that the respective marks are identical. The remaining issue is solely as to whether the respective goods and services are identical, similar or otherwise and whether under section 5(2)(a) or (b) there exists a likelihood of confusion.
2. it is accepted that the earlier marks enjoy an enhanced level of distinctive character in respect of *gabions*.
3. it is accepted that the earlier marks enjoy a reputation in the UK in respect of *gabions*.
4. in relation to the Opponent's section 5(4)(a) claim, it is accepted that the Opponent is the owner of goodwill in the UK and that the ENVIROMESH mark enjoys a reputation in the UK in respect of *gabions*.

14. In light of these concessions, Ms Michaels accepted that the Opponent's claim under section 5(2)(b) would not place it in any better position than its grounds of opposition under section 5(1) and 5(2)(a), given that the issue between the parties now appears to have been narrowed to assessing the identity/similarity or otherwise of the goods/services. I shall therefore focus my assessment initially on the grounds of opposition brought under sections 5(1) and 5(2)(a). Furthermore at the hearing Ms Michaels confirmed that the Opponent was only pursuing a claim to an enhanced degree of distinctiveness, goodwill and reputation in relation to *gabions*. I shall bear this in mind when assessing the grounds of opposition and in particular those brought under sections 5(3) and 5(4)(a).

Evidence

15. The Opponent's evidence in chief is in the form of the following witness statements:

- (a) The witness statement of Neil Holmes dated 28 August 2022 accompanied by twenty one exhibits marked NH01-NH21.
- (b) The witness statement of Ian Thomas dated 25 August 2022 accompanied by one exhibit marked IT01.
- (c) The witness statement of Kevin Hancock dated 25 August 2022.
- (d) The witness statement of Phillip Cross dated 22 August 2022 accompanied by two exhibits marked PC01-PC02.
- (e) The witness statement of Richard Allen dated 24 August 2022.
- (f) The witness statement of Tim Scrivens dated 22 August 2022.
- (g) The witness statement of Tom Malham dated 22 August 2022 accompanied by three exhibits TM01-TM03.

16. The Applicant's evidence consists of the following witness statements:

- (a) The witness statement of William Ferguson dated 28 October 2022.
- (b) The witness statement of Steve Davis dated 28 October 2022.
- (c) The witness statement of Thomas Watson dated 28 October 2022.
- (d) The witness statement of Daren Loader dated 28 October 2022.

(e) The witness statement of Jack Sherwood dated 28 October 2022.

(f) The witness statement of Adam Hannay dated 26 October 2022.

(g) The witness statement of Vinesh Kotecha dated 28 October 2022.

17. The Opponent's evidence in reply consists of a further witness statement of Neil Holmes dated 21 December 2022 accompanied by further exhibits marked NH01–NH21, and a witness statement of John Marlen-Summers dated 11 December 2022 accompanied by three exhibits marked JMS01-JMS03.

18. Both parties' evidence is voluminous. In the main the Opponent's evidence consists of statements to support its bad faith claim (which it is no longer pursuing), evidence relating to the identity/similarity or otherwise of the goods and services at issue, and evidence to demonstrate the reputation, goodwill and enhanced distinctive character it holds. The Applicant's evidence was filed to counter these claims and to demonstrate the differences between the respective goods and services. A number of witnesses (from both parties) provide evidence as to their knowledge of the industry and the differences between the respective goods/services. It is said that in so far as they give opinion evidence it is not relied on. Given the Applicant's concessions it is unnecessary for me to summarise the evidence at this stage, however, I shall return to consider it later in my decision when assessing the Opponent's claim to an enhanced degree of distinctive character and to determine the extent of the reputation held and where necessary any evidence regarding the similarity or otherwise of the goods/services at issue. Suffice to say I have taken all the evidence into account during my deliberations and shall refer to the salient points where appropriate later in my decision.

Decision

Section 5(1)

19. Section 5(1) of the Act states as follows:

“A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

Identity of the marks

20. For a claim under sections 5(1) to succeed it is a prerequisite that the marks are identical. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“CJEU”) held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

21. Even without the Applicant’s concession, I would have found the respective marks to be identical. The verbal elements of the marks are identical and the difference in casing and the addition/omission of a space between the elements Enviro and Mesh in my view are so insignificant that they are likely to be overlooked by the average consumer. Furthermore, it is well established that a word mark protects the word itself, irrespective of the way in which it is presented on the Register, for example notional use of a word mark covers use in different fonts and typefaces.² In light of the caselaw, I do not find that the space or casing alters the distinctive character of the mark. The marks are identical, visually, phonetically and conceptually.

Comparison of the goods³

22. When conducting a goods comparison, all relevant factors should be considered as per the judgment of the CJEU in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* Case C-39/97, where the court stated at paragraph 23 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.”

² Mr Iain Purvis KC sitting as the Appointed Person in BL O/281/14 *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, at [21]

³ Whilst the Opponent also relied on its services, as the basis of its opposition, it is the goods comparison which provides it with its best case. I shall therefore focus on the comparison as between the goods initially, only returning to the Opponent services if it becomes necessary to do so.

23. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

- (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.

24. 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."

25. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM - Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or Applicant relies on those goods as listed in paragraph where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

26. The respective goods are as follows:

Applicant’s goods ⁴	Opponent’s goods
<p>Class 6</p> <p>Wire fences; Wire fencing; Metallic fences; Metal fencing; Metal wire fencing; Metal wire fences; Fencing wire (Metal-); Fences of metal; Metal fencing panels; Metal fence panels; Metal fence posts; Fencing posts (Metal-); Metal fence stays; Metal fencing stays; Metal chainlink fencing; Metal chain link fences; Fencing materials of metal; Fences, fencing, fence panels, fencing pins, fencing rolls, stock fencing, badger fencing, horse fencing, rabbit netting, self-raking fencing, palisade fencing, fencing components, temporary fencing, building site fencing, temporary fencing panels, safety attachments for fencing, fencing made of common metal coated with plastics</p>	<p>Mark 565</p> <p>Class 6</p> <p>Gabions, gabion mattresses; rock netting (wire mesh); modular building blocks of wire mesh; articles of metal for use in civil engineering works, construction, groundworks and landscaping.</p> <p>Mark 405</p> <p>Class 6</p> <p>Gabions, gabion mattresses; rock netting; modular building blocks of wire mesh; articles of metal for use in civil engineering works, construction, groundworks and landscaping.</p> <p>Mark 172</p>

⁴ As amended on 31 October 2022

<p>materials; fencing materials of metal; metal fencing posts; fence panels of metal; galvanised fencing; fence links of metal; components of metal for modular fencing; parts and fitting for all the aforesaid goods.</p>	<p>Class 6 Metallic materials and articles for use in building, construction, mass gravity and reinforced earth retaining structures, groundworks, earthworks, landscaping, civil engineering works, embankments, reinforcing and retaining structures; parts and fittings for all the aforesaid goods.</p>
<p>Class 19 Plastic fences; Non-metallic fences; Temporary fencing, building site fencing, temporary fencing panels.</p>	<p>Mark 172 Class 19 Non-metallic materials and articles for use in building, construction, mass gravity and reinforced earth retaining structures, groundworks, earthworks, landscaping, civil engineering works, embankments, reinforcing and retaining structures; materials and articles of wood or plastics for use in building, construction, mass gravity and reinforced earth retaining structures, groundworks, earthworks, landscaping, civil engineering works, embankments, reinforcing and retaining structures; recycled materials and articles of wood, plastic or concrete for use in building, construction, mass gravity and reinforced earth retaining structures, groundworks, earthworks, landscaping, civil engineering works, embankments, reinforcing and retaining structures; non-metallic reinforcing materials and</p>

	<p>articles for use in building, construction, mass gravity and reinforced earth retaining structures, groundworks, earthworks, landscaping, civil engineering works, embankments, reinforcing and retaining structures; gabions, not of metal; parts and fittings for all the aforesaid goods.</p>
	<p>Mark 172</p> <p>Class 37</p> <p>[Various building and construction etc services]</p> <p>Class 42</p> <p>[Various design services related to building and construction]</p>

27. The issue between the parties appears to be solely related to the identity/similarity or otherwise of the goods at issue given that the identity of the marks has been accepted. In this regard the Opponent submitted that:⁵

“15. The Applicant’s goods in Class 6 are now limited to metal fences of various kinds. All such goods are a sub-set of the Class 6 goods in the Opponent’s 3458172 specification, as they are all designed or likely to be used in building, construction, landscaping, or civil engineering works. They are also identical to the metal goods for use in civil engineering works, construction and landscaping in the two other earlier marks. On the *Meric* principle, the Applicant’s goods are all subsumed in and part of the Opponent’s wider specification. Hence, the parties’ Class 6 goods are identical.

⁵ Ms Michaels’ skeleton argument dated 3 April 2023

16. Similarly, the Applicant's goods in Class 19 are plastic or non-metallic fences of various kinds (i.e. including wooden fences) and expressly including temporary fencing. All such goods are a sub-set of the Class 19 goods in the Opponent's 3458172 specification as they are designed or likely to be used in building, construction, landscaping, or civil engineering works. The parties' Class 19 goods are also identical."

28. Furthermore, it is argued that the Opponent's evidence clearly establishes that the goods are identical with examples being produced of metal and non-metallic fencing being used in landscaping of public and private spaces (including gardens);⁶ fencing for sale by different retailers for landscaping projects;⁷ temporary fencing used during building and construction,⁸ and metal and non-metallic fencing used as part of civil engineering projects.⁹

29. The Applicant's view is that none of the earlier marks' goods refer to or include any type of fencing. In this regard Ms Chantrielle submits that:¹⁰

"14..... All of the goods which are covered by the Earlier Marks are building materials and articles that are used *in* construction, civil engineering, building works etc. This would include things like beams of metal for formwork systems, metal reinforcement materials for buildings, articles of metal for roofing; metal screeds; wire mesh for reinforcing concrete etc. By way of example, the Explanatory Note to the WIPO's Nice Classification Guide for class 06 refers to "*metal building materials*" as, for example, "*materials for railway tracks, pipes and tubes of metal*".

15. Fencing on the other hand, whether general or more specialised, does not fall within that category. It is a barrier placed on the land to mark a boundary. Although it can be used whilst construction is carried out or as part of a building project, it is not used *in* construction. Constructing the specification so as to do so would be too liberal and contrary to the clear guidance given by the Courts."

⁶ Mr Holmes statement exhibits NH5, 13, 15-18; Mr Cross exhibit PC1; Mr Malham exhibit TM1-2.

⁷ Mr Holmes Exhibit NH21.

⁸ Mr Holmes statement exhibits NH15, 18 and 20.

⁹ Mr Holmes statement NH5-6, 13, 15, 17-18, 20; Mr Cross PC1; Mr Malham TM1-2.

¹⁰ Skeleton argument dated 3 April 2023.

30. At the hearing Mr Chantrielle submitted that the meaning and interpretation of the words “for use in” in the Opponent’s specifications “*Metallic materials and articles /articles of metal for use in civil engineering works, construction, groundworks and landscaping*”¹¹ was key to the assessment of identity/similarity of the goods. She stated that the construction of these words extends to materials that are physically used within construction, as opposed to use on a construction site or as part of a construction project. Accepting that these words do not act as a limitation, it nevertheless was argued by Ms Chantrielle that these types of materials refer to those that are used within building, construction and landscaping and are more akin to metal screens, wire meshing that are used in concrete or metallic goods incorporated or used as part of a construction project. To find identity/similarity between the respective specifications would allow too broad an interpretation of the Opponent’s goods. Whilst Ms Chantrielle accepted that “fencing can be used during construction projects as part of either temporary fencing on a construction site or more permanently as part of that project”, she argued that it cannot be said that these are materials used within a building or construction or landscaping.

31. In reality it was said that the Opponent’s evidence only goes to the issue of complementarity and interconnectivity as between the goods, with Ms Chantrielle arguing that the respective goods differ in nature, purpose and methods of use and cannot be said to be provided or produced by the same companies through the same distribution channels. When considering the different type of fencing applied for by the Applicant it was further submitted that the differences are even starker when assessing for example *stock fencing, badger fencing, horse fencing and rabbit netting*, which are all “a specialised subsection of fencing in a specialised area in its own category as opposed to more general fencing”.

32. In so far as the meaning of the words ‘for use in’ Ms Michaels argues that the interpretation of these words would cover both use within a construction and use in conjunction with a construction project but also in landscaping and civil engineering projects. It is submitted that the distinction trying to be drawn by Ms Chantrielle does not hold up to scrutiny. Fencing goods are used in all kinds of construction or civil engineering work or in the landscaping that results from them. Furthermore she did

¹¹ And the equivalent wording in relation to “non-metallic materials and articles ...” in class 19.

not accept that animal fencing was a specialist type of fencing.

33. Dealing firstly with the construction of the words 'for use in', I do not accept Ms Chantrielle's narrow interpretation. The caselaw is quite clear that the meaning of words should be construed widely and there is no justification for straining the language unnaturally so as to produce a narrow meaning.¹² More importantly the words are to be considered from the perspective of what the average consumer would understand them to mean. In my view the words "for use in" would be understood to include both 'physically within' and 'in the field of' rather than solely restricted to actually being integral within the goods themselves. Also I do not accept that animal fencing gives rise to any particular area of specialism such that different considerations should be applied to these goods. As I outlined at the hearing my view of the use of animal fencing as opposed to general fencing comes down to the size of the holes or the distance between the rods, as opposed to any other kind of specialism. I shall bear these matters in mind when comparing the goods under consideration.

Class 6

Wire fences; Wire fencing; Metallic fences; Metal fencing; Metal wire fencing; Metal wire fences; Fencing wire (Metal-); Fences of metal; Metal fencing panels; Metal fence panels; Metal fence posts; Fencing posts (Metal-); Metal fence stays; Metal fencing stays; Metal chainlink fencing; Metal chain link fences; Fencing materials of metal; Fences, fencing, fence panels, fencing pins, fencing rolls, stock fencing, badger fencing, horse fencing, rabbit netting, self-raking fencing, palisade fencing, fencing components, temporary fencing, building site fencing, temporary fencing panels, safety attachments for fencing, fencing made of common metal coated with plastics materials; fencing materials of metal; metal fencing posts; fence panels of metal; galvanised fencing; fence links of metal; components of metal for modular fencing.

34. The Applicant's goods as set out above, can all be described generally as metal/wire fencing of various kinds and parts and fittings thereof. Since the Applicant referred me to the Nice Classification Guide I remind myself that the list of goods within class 6 is broad ranging and includes "*Common metals and their alloys, ores; metal materials for building and construction....*" The explanatory note sets out a number of

¹² *You View* as before.

goods particular to this class including “*mainly unwrought and partly wrought common metals, including ores, as well as certain goods made of common metals*”. In particular it includes “*metal building materials, for example, materials of metal for railway tracks, pipes and tubes of metal and transportable buildings or structures of metal for example prefabricated houses, swimming pools cages for wild animals skating rinks*”. Furthermore, the EUIPO’s TMclass¹³ shows the terms metal fencing and wire fencing as listed in class 6 and contrary to Ms Chantrielle’s submissions are therefore properly attributed to this class.¹⁴

35. Comparing the aforementioned applied for goods to the Opponent’s “articles of metal for use in civil engineering works, construction, and landscaping” (marks 565 and 405) and “Metallic materials and articles for use in building, construction,...landscaping, civil engineering works...” (mark 172), the Opponent’s terms are construed sufficiently widely, so as to encompass all of the Applicant’s metallic fencing goods in the same class, all being a sub category of the Opponent’s registered class 6 goods. They are therefore, identical on the principles as outlined in *Meric*.

...parts and fitting for all the aforesaid goods

36. In so far as the parts and fittings, since I have established that the aforementioned goods of the application are identical to the Opponent’s goods, it follows that the parts and fittings would also be identical to the Opponent’s *Metallic materials and articles for use in building, construction, landscaping, civil engineering works; parts and fittings for all the aforesaid goods* in its 172 mark and also be encompassed within the Opponent’s broad terms *articles of metal for use in civil engineering works, construction, and landscaping* included in its 565 and 405 marks. They are identical in accordance with *Meric*.

¹³ Which is the EUIPO’s search tool for classification of goods and services for trademark protection purposes.

¹⁴

<https://euipo.europa.eu/ec2/search/find;jsessionid=27EAF5C0BD70A9A54AA7007149C837B6?language=en&ext=fencing&niceClass=&size=25&page=1&harmonised=true&searchMode=WORDSPREFIX&sortBy=relevance>

Class 19

Plastic fences; Non-metallic fences; Temporary fencing, building site fencing, temporary fencing panels.

37. I consider that these terms being non-metallic fencing of various kinds would similarly be encompassed within the Opponent's "*non-metallic materials and articles for use in building, construction, ...landscaping, civil engineering works.; materials and articles of wood or plastics for use in building, construction, ...landscaping, civil engineering works*" in the same class (mark 172) irrespective of whether it is intended for temporary or permanent use. For the same reasons as before, I consider that the respective goods are identical in accordance with the principles in *Meric*.

Comparison with Gabions

38. Given that the Opponent has advanced a claim to an enhanced degree of distinctive character, a reputation and goodwill in relation to *gabions* (which is accepted) I shall also undertake a comparison between the applied for goods and the Opponent's *gabions*, as this will be relevant for reasons that will become apparent later in my decision.

39. It is useful to note my understanding of the goods at issue stemming from the evidence filed by the parties, dictionary definitions and my own knowledge of the terms. A fence is a barrier erected to confine or exclude people or animals or to define boundaries between two areas; its purpose is to separate one area from another or to act as an enclosure or a barrier to prevent access.¹⁵ I consider that it is supplied in panels or in rolls normally affixed to posts supplied in a variety of materials to include timber, soil, stone and metal. Irrespective of the material used a fence can be a temporary or permanent fixture. A gabion is defined as a wire/metal structure or barrier usually in the form of a cage, basket, box or container, which is filled with rocks, concrete and soil for use in civil engineering, road building and landscaping, often as

¹⁵ A fence is a barrier between two areas of land, made of wood or wire supported by posts: www.collinsdictionary.com/dictionary/english/fence; a barrier intended to prevent escape or intrusion or to mark a boundary such a barrier made of posts and wire or boards: www.merriam-webster.com/dictionary/fence

a measure to prevent erosion.¹⁶ The Opponent's evidence also demonstrates that it can be used as an alternative to fencing and borders in private landscaping projects.

40. Whilst the final form of the goods may differ, in that a metallic/wire fence is normally a vertical structure supplied in panels or in rolls, whereas and a gabion is a cage like structure, from the evidence filed it appears that they are derived from the same semi-finished component i.e. wire or metallic mesh, and therefore overlap in nature. I also consider that their end purpose would be the same both being used as a barrier. The Opponent argues that the channels of trade would overlap as would the way they reach the market. I agree. The wire mesh/ metallic chain mail is likely to be received from the manufacturer semi-finished and then shaped by the producer into a range of dimensions, shapes, sizes and forms either to stock measurements or custom built to the customers' exact specifications. Whilst I accept that a gabion and a fence can be used in combination, I do not think that this gives rise to a complementary relationship between them in accordance with the caselaw. As Ms Emma Himsworth stated,¹⁷ "the question of whether goods are 'complementary' is to be distinguished from use in combination, where goods are merely used together, whether for choice or convenience." Similarly, I do not agree that they are truly in competition, although I accept that a consumer may choose to purchase a gabion to act as a border between two areas as opposed to a traditional fence for example. Taking these factors into account I consider that the applied for goods in class 6 are similar to a high degree to the Opponent's gabions. Consumers of both metallic fences and gabions would believe that the goods are capable of being provided for by the same or related commercial undertaking. The same reasoning would generally apply to the parts and fixtures of the aforementioned goods which I consider are similar to a medium to high degree to gabions.

41. In so far as the Applicant's class 19 fencing goods that are non-metallic, from the evidence filed I am not aware that a gabion could be constructed in anything other than metal wire/mesh and therefore the material used to produce the goods differ. However, the purpose, trade channels, uses and users would overlap. On this basis I consider that they are similar to a medium degree.

¹⁶ Para 7 Mr Holmes first witness statement; para 6 Mr Ferguson's witness statement.

¹⁷ sitting as the Appointed Person in *Everest Dairies Limited v Everest Food Products Private Limited*, [23] O/0107/23

Section 5(1) conclusion

42. Setting aside my assessment regarding the similarity between the applied for goods and the Opponent's gabions for the time being, in light of my earlier findings as to identity of the marks, and as I have concluded at paragraphs 34 to 37 that the goods at issue are identical, the opposition under section 5(1) succeeds in its entirety.

43. For completeness in case I am wrong as to the identity of the goods at issue, I shall consider the other grounds of opposition.

Section 5(2)(a)

44. Section 5(2)(a) of the Act states as follows:

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services 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”.

Identity of the marks

45. It is accepted that the marks are identical.

Goods

46. I found that the goods in classes 6 and 19 are identical. If I am wrong then they are similar to a high degree, overlapping in nature, purpose, trade channels, users and uses. I also found that the goods for which the opponent has a reputation, namely gabions, were similar to a high degree to the applied for wire/metallic fences in class 6 and similar to a medium degree to the applied for goods in class 19. I found that the parts and fittings of the respective goods were similar to a medium to high degree.

Average consumer and the purchasing process

47. When considering the opposing marks the average consumer is deemed reasonably informed and reasonably observant and circumspect. For the purposes of

assessing the likelihood of confusion the average consumer's level of attention is likely to vary according to the category of goods/services in question.¹⁸

48. 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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

49. The parties accept that in so far as the average consumer it includes both the member of the general public who is doing construction projects at home or wherever but also includes professional developers, business users. The Applicant argued that the level of attention would be high regardless of whether a professional or someone looking for a fence for their home, because regardless of what kind of fencing was required a consumer would wish to ensure that the correct product is purchased, ensuring that it is the right material, size, length, and has the right aesthetic qualities and functionalities. It was argued by Ms Chantrielle that the goods are “not something that can just be purchased in a rush.”

50. Ms Michaels argues that “the average consumer of both parties’ goods will range from a member of the general public to businesses, small or large. Many of the goods/services will be purchased with an average degree of care.”

51. I do not consider that overall the level of attention is such that a high level of attention would be undertaken as argued by Ms Chantrielle. Some consideration will be taken in purchasing goods of the right size, material and quality but this can be said for all manner of goods not necessarily limited to those in the construction or building trade. Whilst I accept that some building construction goods may require a higher level of attention, I consider that for those goods under consideration, overall, an

¹⁸ *Lloyd Schuhfabrik Meyer*, case c- 342/97.

average level will be undertaken for the purchase of the fences and gabions no higher or lower than the norm for such goods. I find that the selection process of the goods will be predominantly a visual one but not discounting aural considerations following word of mouth recommendations and enquiries with sales staff.

Distinctiveness of the earlier marks

52. The case of *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 sets out the legal position to determine the distinctive character of a mark. In this case 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).”

53. Registered trade marks possess varying degrees of inherent distinctive character, some being suggestive or allusive of a characteristic of the goods and services on offer, to those with high inherent distinctive character such as invented words which have no allusive qualities. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion.

54. It was accepted by the parties that the earlier marks were inherently distinctive to an average degree. I agree. Furthermore it was accepted that the earlier marks have achieved an enhanced degree of distinctive character for *gabions*.

55. The evidence which demonstrates the extent of the enhanced distinctiveness enjoyed by the earlier marks comes from Mr Holmes' witness statement. Mr Holmes is the Opponent's director a position he has held since 2006. He states that the Opponent is the second largest supplier of gabions in the UK, with annual turnover ranging between approx. £5 million at its lowest and £7.7 million at its highest over the period 2017 to 2022. Mr Holmes states that the Opponent has built up its reputation by word of mouth and recommendations and as such has little need to continually advertise or market itself in conventional advertising. He provides details of the company's annual advertising spend amounting to approx. £13,000 in 2013 and £21,000 in 2022 and £30,000 at its highest in 2015. Mr Holmes states that the Opponent advertises predominantly via Google adwords and its website, the latter generating between 36,472 and 74,087 per annum website traffic between 2019 and 2022. The company also produces a brochure to promote its goods/services in printed form which is also available to download. A total of 11,500 brochures in printed form have been purchased for distribution in 15 years of business, sent to contractors and customers.

56. I accept that the market for gabions is a relatively specialised and not particularly widespread market and as such the turnover figures, promotional activities and advertising spend demonstrate that by the use made of its mark the Opponent has enhanced the distinctiveness of its mark from an average degree to a high degree.

Likelihood of confusion

57. When considering whether there is a likelihood of confusion between the marks I must consider whether there is direct confusion, where one mark is mistaken for the other or whether there is indirect confusion; where the consumer recognises that the marks are not the same but, nevertheless, puts the similarities between the marks and the respective goods down to the same or related source.

58. A number of factors must also be borne in mind when undertaking the assessment of confusion. 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/services and vice versa. It is also necessary for me to keep in mind a global assessment of all relevant factors when undertaking the comparison and that the purpose of a trade mark is to distinguish the goods and services of one undertaking from another. In doing so, I must consider 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 that he has retained in his mind.

59. I remind myself that the respective marks are identical and the goods are similar ranging between a medium to high degree, if I am wrong as to them being identical. I found that the average consumer is both a professional and a member of the general public paying an average degree of attention in the purchasing process predominantly via visual means but not discounting aural considerations. I found the earlier marks to be inherently distinctive to an average degree which had been enhanced to a high degree for gabions.

60. Even if I had found that the level of attention paid by consumers was high as argued by Ms Chantrille this does not assist the Applicant given the identity of the marks and the similarity between the goods at its lowest to a medium degree. Given the identical use of the same mark, combined with the earlier mark being inherently distinctive to an average degree for highly similar goods, there is insufficient distance between the goods, for consumers to believe that the providers are different entities. It is my view that there is a likelihood of the marks being mistakenly recalled or misremembered one for the other leading to a likelihood of direct confusion. When factoring in the enhanced distinctive character held by the Opponent for gabions, even if the contested goods are similar to a lesser degree when compared to gabions, this would further lead in my view to the marks being directly confused one for the other and the belief that the goods are provided by the same or related entities.

62. This conclusion would mean that the opposition based on section 5(2)(a) also succeeds. Given these findings it is unnecessary for me to go on to consider the ground of opposition under section 5(2)(b) and I decline to do so.

Section 5(3)

63. Section 5(3) of the Act states:

“A trade mark which-

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

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

64. I bear in mind the relevant case law set out in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. The conditions of section 5(3) are cumulative. Firstly, the Opponent must show that the earlier marks are similar to the Applicant’s mark. Secondly, the Opponent must show that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the later mark. Fourthly, assuming that the first three conditions are met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) for the goods to be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks. For the purposes of section 5(3) the relevant date for the assessment is 21 September 2021.

Similarity between the marks

65. In relation to the similarity between the marks I found and it was accepted that the marks are identical; this first condition is therefore satisfied.

Reputation

66. 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.”

67. In assessing whether the first earlier mark has a reputation to a significant number of consumers, I must assess the evidence in terms of the extent it demonstrates “the market share held by the trademark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertaking in promoting it.”¹⁹

68. I note that the assessment of whether the Opponent has a reputation for the goods claimed is a different test to the one undertaken for an enhanced level of distinctive character and that proving reputation is not a particularly onerous task.²⁰ I have summarised the Opponent's evidence at paragraph 55 in relation to its claim to enhanced distinctiveness, which in light of my findings will apply equally to the assessment of whether it holds a reputation. The Applicant has also conceded that the Opponent has a reputation for *gabions*. I have no hesitation in finding that the evidence supports the Opponent's claim to a reasonably strong reputation in the UK for such goods.

¹⁹ *General Motors* para 28

²⁰ *Enterprise Holdings Inc. v Europcar Group UK Ltd* [2015] EWHC 17 (Ch), Arnold J.

Link

69. Having found a reputation I must now go on to consider whether this reputation would give rise to the necessary mental link being made between the respective trade marks. The factors to be taken into account to establish as to whether a link would be made, are those as set out in *Intel*.²¹ Taking each of the factors in turn.

The degree of similarity between the conflicting marks

I have already found and it is accepted that the marks are identical.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services and the relevant section of the public.

The Applicant's goods in classes 6 and 19, are those relating to metallic and non-metallic fencing. I have already found that the Applicant's goods are similar ranging between a medium to high degree.

The relevant public for the goods under consideration, is both the general member of the public and the business user, who are deemed to be reasonably informed and reasonably observant and circumspect.

The strength of the earlier marks' reputation

I have found that based upon the evidence filed, the Opponent has a reasonably strong reputation for *gabions*.

The degree of the earlier marks' distinctive character, whether inherent or acquired through use

I found that the earlier mark is inherently distinctive to an average degree and by virtue of the evidence filed, I found that the Opponent has enhanced the degree of distinctiveness further to a high degree for *gabions*.

²¹ *Intel Corporation Inc v CPM United Kingdom Ltd* - [2009] RPC 15 (CJEU).

Whether there is a likelihood of confusion

I found a likelihood of confusion under section 5(2)(a) as a result of the similarity between the goods and identity between the marks.

70. A link means that the earlier marks will be brought to mind by the later mark. One of the considerations in deciding whether a link will be made between the marks is whether there is a likelihood of confusion. If there is a likelihood of confusion, there must be a link, because confusion means that there must be more than a bringing to mind. I concluded, under section 5(1) that there was identity and in case I was wrong that under section 5(2)(a), there is a likelihood of confusion which would equally apply to the goods for which the marks have a reputation namely gabions. On this basis I have no hesitation in finding that due to the identity of the marks and the similarity between the goods the relevant public will believe that the marks are used by the same undertaking or will believe that there is an economic connection between the undertakings leading to a link being made.

Damage

71. It was conceded by the parties that if I found a link then this would inevitably lead to damage being caused, which I do. The Opponent's claim that the Applicant would gain an unfair advantage is made out even if this was not intentional. Given the identity between the marks this will create a familiarity with consumers when confronted with the later mark such that there is an increased chance of consumers buying the later mark's products because of their perceived link to the Opponent. In my view this would take unfair advantage of the earlier marks' reputation and gain a foothold in the industry quickly, without having to make an equivalent investment or marketing effort themselves. The economic behaviour of customers would change leading to a commercial advantage being gained by the Applicant.

72. Since I have found damage resulting from an unfair advantage being gained by the Applicant this is sufficient for the opposition based upon section 5(3) to succeed and I need not therefore consider whether any of the other heads of damage has arisen.

73. The opposition based upon section 5(3) succeeds in its entirety

Section 5(4)(a)

74. Section 5(4)(a) of the Act states as follows:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

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

aa)...

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

75. Subsection (4A) of section 5 of the Act states:

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

76. Whilst the Opponent also relies on a claim under section 5(4)(a), on a question of proportionality, its position is not improved beyond that which I have already found under sections 5(1), 5(2)(a) and 5(3).

77. However, dealing with the claim briefly, in order for the Opponent to succeed under this ground it must demonstrate goodwill, misrepresentation and damage. Since goodwill is territorial, and no prior use has been claimed by the Applicant, the Opponent must establish that it had the requisite goodwill with UK consumers as at the relevant date namely 21 September 2021. Goodwill arises out of trading activities which must be considered in the context of its revenue figures. The Applicant has conceded that the Opponent has achieved goodwill and in light of the evidence filed and the nature of the goods in question the evidence produced demonstrates that the Opponent has established a protectable goodwill for gabions as at the relevant date.

78. I note that the test for misrepresentation requires a substantial number of members of the public to be deceived and that this test differs to the one undertaken for a

likelihood of confusion where it necessitates that the average consumer is confused. However, in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. had previously cast doubt on whether in reality the difference between the two legal tests would produce different outcomes. In light of my assessment regarding the identity between the marks and the similarity of the goods, I believe this to be the case here. The Opponent's gabions and the Applicant's fencing are all goods within the same field of activity such that I am satisfied that a substantial number of the Opponent's customers or potential customers would be misled into purchasing the Applicant's goods in the mistaken belief that they are the goods of the Opponent or those of an undertaking economically linked to the Opponent.²² Having found goodwill and misrepresentation it follows that damage would arise leading to a reasonably foreseeable diversion of sales from the Opponent to the Applicant, resulting in the Opponent suffering financial loss.²³

Overall conclusion

79. The opposition has succeeded in its entirety under sections 5(1), 5(2)(a), 5(3) and 5(4)(a). Subject to any successful appeal the application shall be refused.

Costs

80. The Opponent has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. I note, however, that the Opponent only withdrew its section 3(6) ground a week or so before the final hearing. Furthermore, it wasn't until the Applicant filed Ms Chantrielle's skeleton argument that it conceded identity as between the marks, the Opponent's claim to an enhanced degree of distinctive character, reputation and goodwill for gabions. On this basis I consider that the costs that I would have awarded each party for the changes in their respective positions cancel each other out. Taking these matters into account in the overall assessment, I award costs on the following basis:

Preparing an opposition and

£400

²² *Harrods Limited v Harrodian School Limited* [1996] RPC 697.

²³ *Bocacina Limited v Boca Cafés Limited, Dercio De Souza Junior, Malgorzata De Souza* [2013] EWHC 8090 (IPEC)

statement of grounds:

Preparing evidence and considering

the Applicant's evidence: £600

Preparing for and attending a hearing including
drafting skeleton arguments: £1,000

Official fee: £200

Total £2,200

81. I order First Fence Ltd to pay Enviromesh Group Limited the sum of £2,200 as a contribution towards its costs. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 1 day of June 2023

Leisa Davies

For the Registrar