

O/0046/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF UK TRADE MARK APPLICATION NOS. 4064427 AND
4064419

BY BROGAN GROUP HOLDINGS LTD
TO REGISTER THE FOLLOWING TRADE MARKS:

CAS COMMON TOWER

CAS

IN CLASSES 6, 7, 19, 37 AND 42

IN THE MATTER OF OPPOSITIONS THERETO UNDER NOS. 450305 AND 450307

BY METABOWERKE GMBH

BACKGROUND & PLEADINGS

1. Brogan Group Holdings Ltd (“the applicant”) applied to register the following trade marks in the UK:

CAS COMMON TOWER

UKTM no. 4064427

Filing Date: 17 June 2024

(“the first application”)

CAS

UKTM no. 4064419

Filing Date: 27 June 2024

(“the second application”)

(together “the applications”)

2. The applicant seeks protection in respect of both of its applications for the goods and services set out in Annex 1 of this decision.
3. On 21 October 2024, the applications were opposed by Metabowerke GmbH (“the opponent”). Opposition number 450307 (i.e., the opposition relating to the first application) is brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), and opposition number 450305 (i.e., the opposition relating to the second application) is brought under section 5(1) and 5(2)(a) of the Act.¹
4. For both of the oppositions, the opponent relies upon the trade mark number UK00917890746 for the word CAS (“the earlier mark”), which was filed on 23 April 2018 and entered onto the register on 9 July 2019. For both oppositions, the opponent relies upon all of the goods for which the earlier mark is registered, namely:

¹ The oppositions were originally also brought under sections 5(3) and 5(4)(a) of the Act, but the opponent confirmed by way on an email dated 9 April 2025 that it wished to withdraw these grounds.

Class 7: Electric power tools and parts therefor, included in class 7; Hand held power tools; Battery-operated and battery-powered hand tools; Electrical tools for lawns and gardening; Tool chests and tool boxes configured for the aforesaid goods.

Class 9: Devices for storing electricity; Accumulator batteries; Chargers; Batteries; Batteries for hand held power tools.

Class 11: Electric lamps; Hand-held lights.

5. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

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

6. The mark identified in paragraph 4 qualifies as an earlier trade mark under the above provisions. As the earlier mark had not completed its registration process more than five years before the relevant date, it is not subject to proof of use requirements. Consequently, the opponent may rely on all of the goods and services highlighted in paragraph 4 of this decision for the purposes of both oppositions.
7. The opponent submits that its earlier trademark is “highly similar” to the first application, and that its earlier trademark is “identical” to the second application. The opponent also submits that the applications are registered in respect of identical and similar goods to those for which the earlier mark is protected. As a consequence, the opponent submits that there exists a likelihood of confusion on the part of the relevant public, and that the applications should be refused in their entirety.

8. The applicant filed counterstatements denying the claims made against it. The applicant therefore requests that the oppositions be dismissed in their entirety, and that an award of costs be made in its favour. The proceedings were consolidated on 8 January 2025 pursuant to rule 62(1)(g) of the Trade Marks Rules 2008.
9. The opponent is represented by Barker Brettell LLP. The applicant is represented by Legalvision Law UK Ltd. In this case, neither party filed evidence. No hearing was requested, and only the opponent filed written submissions in lieu of a hearing. This decision is therefore taken following a careful consideration of the papers that have been filed by the parties, which will not be summarised but will be referred to as and where appropriate during this decision.
10. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

DECISION

11. As outlined above, the opponent's opposition number 450305 is based upon section 5(1) and 5(2)(a) of the Act, and the opponent's opposition number 450307 is based upon section 5(2)(b) of the Act. The relevant sections of the Act are as follows:

Section 5(1):

“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.”

Section 5(2)(a):

“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”.

5(2)(b):

“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”.

12. Section 5A of the Act stipulates that where “grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”
13. The following principles relevant to the assessments under sections 5(2)(a) and (b) are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*,² *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (“Canon”),³ *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.*,⁴ *Marca Mode CV v Adidas AG & Adidas Benelux BV*,⁵ *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (“OHIM”),⁶ *Medion AG v.*

² Case C-251/95

³ Case C-39/97

⁴ Case C-342/97

⁵ Case C425/98

⁶ Case C-3/03

Thomson Multimedia Sales Germany & Austria GmbH,⁷ *Shaker di L. Laudato & C. Sas v OHIM*⁸ and *Bimbo SA v OHIM*⁹:

- 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 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;

⁷ Case C-120/04

⁸ Case C-334/05P

⁹ Case C-591/12P

- g. a lesser degree of similarity between the goods or services may be offset by a greater 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 services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of trade marks

14. 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 *Bimbo SA v OHIM*,¹⁰ 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

¹⁰ Case C-591/12P

and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

15. It would be wrong, therefore, to dissect the trade marks artificially, 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.

16. The respective trade marks are shown below:

Earlier mark	Applications
CAS	CAS COMMON TOWER (first application)
	CAS (second application)

Comparison of Earlier Mark with Second Application:

17. It is a pre-requisite of both section 5(1) and 5(2)(a) of the Act that the trade marks at issue are identical. Plainly, in this case, it is clear that the earlier mark and the second application are identical.

Comparison of Earlier Mark with First Application:

18. The earlier mark and the first application are self-evidently not identical. However, as outlined above, the opponent’s opposition to the registration of the first application is being pursued under section 5(2)(b), which only requires the marks in issue to be “similar”.

19. The earlier mark consists of the letters CAS. There are no other elements to contribute to the overall impression, which resides in those letters.

20. The first application is a word only mark consisting of the letters/words “CAS Common Tower”. Just as with the earlier mark, there are no other elements in the first application which contribute to its overall impression, so the overall impression lies in the words “CAS COMMON TOWER” themselves. Having said that, I note the opponent’s submissions that a Common Tower is “a temporary tower structure, tied to the face of a building which can accommodate construction hoists and staircases”. Whilst I have no evidence before me that this is the meaning the average consumer would attribute to “Common Tower”, I note that the applicant’s goods include building frameworks, platforms and scaffolding, and the applicant’s services include building and construction services. In the absence of evidence and relying on the ordinary meaning of the words “common” and “tower” as a commonly used tower structure, I do accept that the words “Common Tower” are suggestive of the type of goods sold by the applicant, or that are used in the delivery of the applicant’s services. Consequently, I find that the words “Common Tower” play a lesser role in the overall impression of the first application, with the word “CAS” playing a greater role.

Visual Comparison

21. Visually, these marks share the same letters at the start (“CAS”) and, for the reasons outlined above, I have determined this to play the greater role in the overall impression of the first application. The first application also contains two additional words “Common Tower”, which are not present in the earlier mark and are therefore points of visual difference. However, I am conscious that the General Court in *El Corte Inglés, SA v OHIM* noted that the beginning of marks tend to have more visual impact than the ends.¹¹ Weighing up these factors, I find the marks to be visually similar to a medium degree.

¹¹ Cases T-183/02 and T-184/02

Aural Comparison

22. As outlined above, the marks share the same letters (“CAS”), which is the only element in the earlier mark, and the first element in the first application. The first application also contains the words “Common Tower”, and I am of the view that all of these letters/words in both marks would be pronounced. Whilst I appreciate that there are phonetic differences between the marks, I once again note my finding that “CAS” plays the dominant role in both marks, and that the beginning of marks (i.e., the word “CAS”) tend to have more aural impact.¹² Consequently, I consider the marks to be aurally similar to a medium degree.

Conceptual Comparison

23. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU, including *Ruiz Picasso v OHIM*.¹³ The assessment must, therefore, be made from the point of view of the average consumer.

24. I am also conscious of the findings of the GC in *Usinor SA v OHIM*,¹⁴ that “as regards the conceptual comparison, it must be noted that while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Lloyd Schuhfabrik Meyer*, paragraph 25), he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him”.

25. In this instance, both marks contain the same first element “CAS”, which appears to be an invented word or an acronym with no identifiable conceptual meaning to the average consumer, and no submissions have been made by the parties that would suggest otherwise.

¹² Cases T-183/02 and T-184/02

¹³ [2006] ECR I-643; [2006] E.T.M.R

¹⁴ Case T-189/05

26. The first application also contains the additional words “Common Tower”, which I have found would be understood by the average consumer to mean a commonly used tower structure. The first application therefore has a conceptual meaning which is absent from the earlier mark. Given this point of conceptual difference (albeit not a particularly distinctive one), I find these marks to be conceptually dissimilar.

Comparison of Goods and Services

27. The competing goods and services are listed in Annex 1 of this decision. It is noted that the opponent has submitted that the applicant’s goods and services are either identical or similar to all of its goods. In the interest of brevity, whilst I have given due consideration to all of the opponent’s submissions, given the significant number of goods and services contained in the parties’ specifications, I have only outlined what I consider to be the opponent’s best case for the purposes of my comparison of the goods and services. Of course, identity or similarity only needs to be established between the applicant’s goods and services and some of the opponent’s goods. If identity or similarity cannot be established on the opponent’s best case, then there can be no basis for a finding of similarity or identity between the remaining goods and services in issue.

28. It should be noted that section 60A of the Act provides that goods are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification¹⁵, or dissimilar on the ground that they appear in different classes under the Nice Classification.”

29. In *Canon*,¹⁶ the Court of Justice of the European Union (“CJEU”) stated (at paragraph 23) that, when making the comparison, “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”.

¹⁵ “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957.

¹⁶ Case C-39/97

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

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

31. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case¹⁷, for assessing similarity were:

- a. The uses of the respective goods or services;
- b. The users of the respective goods or services;
- c. The physical nature of the goods or services;
- 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 in the same or different sectors.

¹⁷ [1996] R.P.C. 281

32. In *Gérard Meric v OHIM*, the General Court confirmed that even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa)¹⁸:

“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 fur Lernsysteme v OHIM- Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

33. As per the case of *Separode*,¹⁹ I bear in mind that it is permissible to group the goods together, for the purpose of comparison.

Class 6

Building frameworks, buildings and structures of metal; Building components of metal for the construction of structures; Metal materials for building and construction; Metal platform staging, ramps, staircases, ladders, beams, work platforms, formwork, access platforms, boards, canopies, cladding, frameworks, and towers for use with scaffolding; Metal platform staging, ramps, staircases, ladders, beams, work platforms, formwork, access platforms, boards, canopies, cladding, frameworks, and towers for use in building and construction; Metal scaffolding and scaffolding apparatus; Structural building elements of metal; Structural steelwork.

34. All of the above referenced goods can be summarised as building materials, frameworks, structures or platforms, or their individual components, and I compare them with the opponent’s class 7 “Electric power tools and parts”, “Hand held power tools” and “Battery-operated and battery-powered hand tools”. The opponent submits that the compared goods are similar on the basis that they overlap in purpose. Specifically, the opponent submits that they “all relate to goods and services for construction, metalworking and renovation (and trades)” and the

¹⁸ Case T-133/05

¹⁹ BL O/399/10

purpose of all of these goods is to “create products, buildings and structures, and their constituent parts”. I do agree that there is a general overlap in purpose between the compared goods as they are all used in building and construction work. However, the specific purpose of the goods will differ. I also agree with the opponent that there is an overlap in the user of these goods (namely, building and construction businesses) and in trade channels given that they can all be hired or purchased from building merchants.

35. Having said that, I do not consider the goods to be complementary, as I can see no basis for finding that the opponent’s goods are important or indispensable to the applicant’s above referenced goods. I also would not consider that responsibility for the applicant’s above referenced goods derives from the same undertaking as that of the opponent’s goods, nor have I been provided with any evidence to support such a finding.²⁰ These goods also self-evidently differ in nature and method of use, and I can see no basis for finding that there is any competition between these compared goods given that you would not purchase one in the place of the other.
36. Overall, I find the opponent’s “Electric power tools and parts”, “Hand held power tools” and “Battery-operated and battery-powered hand tools” to be similar to a low degree to the applicant’s above referenced class 6 goods.

Class 7

Machine and power-operated tools; Mechanical tools.

37. As discussed above, the opponent’s specification contains “Electric power tools and parts therefor, included in class 7”, “Hand held power tools”, “Battery-operated and battery-powered hand tools” and “Electrical tools for lawns and gardening”, and the opponent submits that these goods are identical to the applicant’s above referenced goods. I consider that all of these goods are types of “Machine and

²⁰ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

power-operated tools” and “Mechanical tools”. Consequently, I agree that these compared goods are identical in line with the principle established in *Meric*.

Construction [...] machine tools:

38. The opponent submits that the applicant’s above referenced “construction...machine tools” are identical to its “Electric power tools and parts therefor, included in class 7”, “Hand held power tools” and “Battery-operated and battery-powered hand tools”. I do consider the term “Construction... machine tools” to be broad enough to include the opponent’s above referenced tools. Consequently, I find these goods to be identical in line with the principle established in *Meric*.

Lifting, elevating, handling and hoisting [...] tools [...]

39. The opponent also submits that the applicant’s “lifting, elevating, handling and hoisting [...] tools” are identical to its “Electric power tools and parts therefor, included in class 7”. I note that the standard definition of “electric power tools” is a tool powered by electricity,²¹ which is an extremely broad term. I do therefore consider that “lifting, elevating, handling and hoisting [...] tools” would fall within that extremely broad term. Consequently, I do find these goods to be identical under the principle established in *Meric*.

40. However, if I am wrong in that determination, I would have found these goods to be similar to at least a medium degree on the basis that they overlap in user (tradespeople/building and construction businesses) and general use/purpose (being tools for building and construction works), albeit their specific use will differ. I also consider there to be an overlap in trade channels on the basis that these goods will all be available to purchase from building merchants and may be produced by the same businesses. There will also be an overlap in nature as all of these terms are (or include) types of tools. Having said that, without any evidence to the contrary, I can see no basis for a finding that users may opt to

²¹ www.collinsdictionary.com/dictionary/english/power-tool

utilise the applicant's above referenced goods over the opponent's goods or vice versa. I can therefore see no basis for finding these goods to be competitive. I also do not consider these goods to be important or indispensable from one another.²² Consequently, I do not consider these goods to be complementary.

Lifting, elevating, handling and hoisting apparatus, equipment, [...] and instruments.

41. I compare the above referenced goods to the opponent's "Electric power tools and parts therefor, included in class 7". For the same reasons outlined in paragraph 40 above, I consider that these goods overlap in trade channels, user (being tradespeople/building and construction businesses) and general use/purpose (being items used for building and construction works), albeit I acknowledge that their specific use will differ. Having said that, without any evidence to the contrary, I can see no basis for finding these goods to be competitive (I do not consider that users would opt to utilise the applicant's above referenced goods over the opponent's goods or vice versa), or complementary (I do not consider these goods to be important or indispensable from one another).²³
42. Overall, I therefore find the opponent's electric power tools and parts therefor, included in class 7" to be similar to a medium degree to the applicant's above referenced goods.

Building machinery; Construction machines [...]

43. All of the above goods are types of building/construction machinery. The opponent submits that the above referenced goods are similar to the opponent's "Electric power tools and parts therefor" on the basis that the above referenced goods "are now more likely to be electric rather than diesel powered and the purpose is to enable assembly and construction" resulting in them both satisfying "the same needs". The opponent further submits that these goods are complementary, that

²² *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

²³ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

they target the same consumers, and are produced and distributed by the same undertakings.

44. In support of its claim of similarity, the opponent relies upon the EUIPO Board of Appeal's decision *INDASA - Industria de Abrasivos vs AUTO Millennium Investment GROUP*,²⁴ which found similarity between "cranes [lifting and hoisting apparatus] and "Machine Tools", and *Sky plc vs HM*,²⁵ which found similarity between "lifting platforms" and "Machine tools". As a preliminary point, whilst I note the contents and findings of those decisions, it should be noted that previous decisions of this Tribunal or the EUIPO are not binding authority on subsequent hearing officer decisions. I do, however, agree that there is an overlap in user between the applicant's above referenced machinery and the opponent's "Electric power tools and parts" (being building and constructions businesses). I do accept that there is an overlap in trade channels, as these goods would all be available to purchase/hire from building merchants. There is also a general overlap in use/purpose given that these goods are all utilised for building/construction, albeit their specific purpose in relation to the building/construction work varies. In that regard, I can see no basis for finding that you would purchase the opponent's "Electric power tools and parts" in place of the applicant's above referenced machinery/parts, or vice versa, and I have not been provided with any evidence to support an alternative finding.
45. These goods undoubtedly differ in nature (with the opponent's compared goods being a tool and the applicant's compared goods being machinery), and I can see no basis for a finding of complementarity between the goods, nor have I been provided with any evidence to substantiate such a finding. Overall, I consider the opponent's "electric power tools and parts" to be similar to a low degree to the applicant's above referenced goods.

²⁴ case R 2020/2022

²⁵ opposition No B 2271479

Aerial platforms for use with cranes and hoists; Attachments for cranes; Cranes; Hoists; Lifting, elevating, handling and hoisting [...] platforms; Tower cranes;.

46. The opponent submits that the above referenced goods are similar to the opponent's "Electric power tools and parts therefor" for the same reasons outlined in paragraph 43 above.
47. The above reference goods clearly differ in nature to the opponent's "electrical power tools and parts". There is a superficial overlap in purpose and user (being for use in construction by the same users). However, the compared goods have specific (and different) uses in the construction process. Their method of use therefore undoubtedly differs, and I can see no basis for finding that you would use the applicant's goods in place of the opponent's compared goods, or vice versa, nor can I see any basis for finding the goods to be important or indispensable from one another. These goods are therefore not complementary.
48. I also consider the applicant's above referenced goods to be quite specialised goods, and without evidence to the contrary, I can see no basis for finding that you can hire or purchase these specialised goods from a general building merchant. In the absence of evidence, I am not prepared to find an overlap in trade channels.
49. Whilst the generic overlap in purpose and user is noted, I do not consider this to be sufficient to reach a finding of similarity, and I am conscious of the judgment of Iain Purvis KC in *Unicorn Studio Inc v Veronese* in which he stipulated that "any finding of similarity in the end requires the exercise of common sense and requires the hearing officer to stand back and consider the overall question" rather than by engaging "in a box-ticking exercise, asking how many of the factors identified in *TREAT* or in *Canon* could be said to have been satisfied".²⁶ Consequently, I consider the opponent's "electric power tools and parts" to be dissimilar to the applicant's above referenced goods.

²⁶ [2024] EWHC 1098 (Ch) - paragraph 24

Class 19

Building frameworks, buildings and structures not of metal; Building components for the construction of structures, not of metal; Materials for building and construction, not of metal; Platform staging, ramps, staircases, ladders, beams, work platforms, formwork, access platforms, boards, canopies, cladding, frameworks, and towers for use with scaffolding, not of metal; Platform staging, ramps, staircases, ladders, beams, work platforms, formwork, access platforms, boards, canopies, cladding, frameworks, and towers for use in building and construction, not of metal; Scaffolding and scaffolding apparatus, not of metal; Structural building elements not of metal; Structural timber, support joists and other elements for use in building and construction, not of metal.

50. It is noted that the above referenced goods are non-metal versions of the applicant's class 6 goods referenced in paragraphs 34 to 36 above, and I, once again, compare them with the opponent's class 7 "Electric power tools and parts", "Hand held power tools" and "Battery-operated and battery-powered hand tools". For the same reasons outlined in paragraphs 34 to 36 above, I consider that the applicant's class 19 goods overlap in user and trade channels. I also accept that there is an overlap in general (but not specific) purpose between these goods. However, for the same reason outlined in paragraphs 34 to 36 above, I do not consider these goods to be complementary or competitive. These goods also, once again, clearly differ in nature.

51. Overall, I therefore find the opponent's electric power tools and parts, hand held power tools, battery-operated and battery-powered hand tools to be similar to a low degree to the applicant's above referenced class 6 goods.

Class 37

Building and construction services; Building construction, demolition, maintenance and repair; Construction; Development of land [construction]; General building contractor services; Hiring, rental and leasing of construction equipment, apparatus and machinery; Installation, cleaning, servicing, renovation, maintenance, repair, and construction of fixtures and fittings for [...] residential premises; Masonry; Plumbing

installation, maintenance, and repair; Property development services [construction]; Refurbishment, renovation and restoration of buildings; Site preparation [construction]; information, consultancy and advice in relation to the foregoing.

52. The opponent submits that the applicant's above referenced services are similar to the opponent's class 7, 9 and 11 goods on the basis that they all "relate to construction, metal working and renovations (and trades)", the "end users are the same", and "the goods and services are complementary". The opponent also submits that the applicant's above referenced services are "distributed through the same or similar channels" as "many companies specialise in assembly and construction products and construction services", and "end customers may think that the responsibility for the production of the goods and services lies with the same undertaking".
53. As discussed above, for the purpose of brevity I will only be comparing the applicant's above referenced services with the opponent's "Electric power tools and parts", "Hand held power tools" and "Battery-operated and battery-powered hand tools" as they represent the opponent's best case. In comparing goods with services there is, of course, a difference between the nature of a good and the nature of a service, which also affects the method of use comparison. In this instance, the nature of the opponent's aforementioned goods and the services offered by the applicant clearly differ, as does their method of use.
54. Goods and services can also be complementary, share channels of trade or be in competition with one another, and this point was established by the General Court ("GC") in *Oakley, Inc v OHIM*,²⁷.
55. In this instance, however, I do not agree that there is an overlap in trade channels because, whilst I accept that the opponent's goods may be used in the course of delivering the applicant's class 42 services, the applicant's services would be provided by contractors, and I do not consider that the opponent's class 7, 9 or 11 goods would also be purchased from those same contractors, nor have I been

²⁷ Case T-116/06, at paragraphs 46-57

provided with any evidence by the parties that would support an alternative finding. Instead, I consider that the opponent's goods would, as discussed above, be purchased from building merchants or other retailers who, without evidence being provided by the parties to the contrary, I do not consider would also provide the applicant's class 37 services. Having said that, I do accept that there is an overlap in general purpose between the applicant's class 37 services and the opponent's class 7 "Electric power tools and parts", "Hand held power tools" and "Battery-operated and battery-powered hand tools" because they are used for building/construction purposes, albeit the specific purpose differs. I also consider these goods and services to overlap in user (being members of the public), and that there is a level of competition between these goods and the applicant's class 37 services on the basis that consumers may opt to purchase the tools to carry out building and construction work themselves or utilise the applicant's class 37 services (i.e., getting a professional to carry out the work on their behalf).

56. Without any evidence to the contrary, whilst I accept that the opponent's goods will be used in the course of delivering the applicant's above referenced services, I can see no basis for a finding of complementarity as I do not consider that the end user would believe that the responsibility for the compared goods and services lies with the same undertaking. Overall, however, I do consider the applicant's class 37 services to be similar to a low degree to the opponent's "Electric power tools and parts", "Hand held power tools" and "Battery-operated and battery-powered hand tools".

Commercial construction; Consultancy relating to residential and building construction; Construction management and construction project management; Erection, construction, installation, maintenance and repair of pre-fabricated buildings, aerial platforms, formwork, platform staging, ramps, staircases, ladders, beams, work platforms, access platforms, boards, canopies, cladding, frameworks, and towers for use in building and construction; Erection, construction, installation, maintenance and repair of scaffolding; Fireproofing during construction; Hiring, rental and leasing of scaffolding; Installation, cleaning, servicing, renovation, maintenance, repair, and construction of fixtures and fittings for commercial [...] premises; Installation, cleaning, servicing, renovation, maintenance, and repair of construction units and sites;

Scaffolding; Supervision of civil engineering and construction projects; information, consultancy and advice in relation to the foregoing.

57. I, once again, compare the applicant's above referenced services with the opponent's "Electric power tools and parts", "Hand held power tools" and "Battery-operated and battery-powered hand tools. For the same reasons outlined in paragraphs 53 to 55 above, the nature and trade channels for these goods and services differs, as does their method of use.
58. Without evidence to suggest otherwise, I can also see no basis for finding these goods and services to be complementary or competitive, as I do not consider that the end user would believe that the responsibility for the compared goods and services lies with the same undertaking, nor do I see any basis for finding that you would purchase the goods in place of the services (or vice versa) because I consider these services to be specialised in nature or they relate to commercial properties, and they are not therefore something that you would attempt as a "do it yourself" job/task.
59. Whilst I do accept that these goods and services overlap in general purpose at a superficial level (on the basis that they are used for building/construction purposes), their specific purpose differs. There is also a very general overlap in user between these goods and service. However, I do not consider this superficial overlap in general purpose and user to be sufficient to reach a finding of similarity, and I am, once again, conscious of the judgment of Iain Purvis KC in *Unicorn Studio Inc v Veronese* referenced in paragraph 49 above. I therefore find the opponent's goods to be dissimilar to the applicant above referenced services.

Class 42

Engineering:

60. The opponent submits that the applicant's engineering services are similar to its goods. However, once again, in the interest of brevity, I will compare the applicant's above referenced services with the opponent's "Electric power tools

and parts”, “Hand held power tools” and “Battery-operated and battery-powered hand tools”.

61. For the same reasons outlined in paragraphs 53 to 55 above, I consider these goods and services to differ in trade channels, nature and method of use. Having said that, I consider “engineering” to be a more specialised field than general building work. Consequently, I do not consider engineering to be something that users can take on as a “do it yourself” project, and I can see no basis for finding these goods and services to be competitive.

62. Whilst I appreciate that engineering services will involve an element of building/construction works, for the same reason outlined in paragraph 56 above, I do not accept that there is complementarity between these goods and services. Whilst I do, once again, accept that there is a very general overlap in user between the opponent’s compared goods and the applicant’s engineering services (because, for example, the general public might buy tools and also might hire the services of a structural engineer to assist with a building project), and that there is a superficial overlap in general purpose (but not specific purpose), I do not find this to be a sufficient basis for a finding of similarity for the same reasons outlined in paragraph 49 above. Consequently, I find the opponent’s “Electric power tools and parts”, “Hand held power tools” and “Battery-operated and battery-powered hand tools” to be dissimilar to the applicant’s “Engineering” services.

Construction design; Design and research services; Engineering design; Environmental assessments, monitoring research, testing and consultancy services; Planning, design and research of buildings and structures; Planning, design and research of building and construction apparatus, equipment and machinery; Planning, design and research of products; Planning, design and research of building interiors, exteriors and structures; Planning, design and research of pre-fabricated buildings, aerial platforms, formwork, platform staging, ramps, staircases, ladders, beams, work platforms, access platforms, boards, canopies, cladding, frameworks, and towers; information, consultancy and advice in relation to the foregoing.

63. The opponent, once again, submits that the applicant's above referenced goods are similar to all of its class 7, 9 and 11 goods. However, in the interest of brevity, I will only be comparing the applicant's above referenced services with the opponent's "Electric power tools and parts", "Hand held power tools" and "Battery-operated and battery-powered hand tools.
64. Once again, this is a comparison of goods against services, and they therefore undoubtedly differ in nature and method of use. For the same reasons outlined in paragraph 55 above, I do not consider there to be an overlap in trade channels between the compared goods and services.
65. I also consider the above referenced services to be more specialised than general building and construction work. The primary purpose of the above referenced services is to design, plan, research or assess in advance of the building or constructions works being undertaken, and this differs to that of the opponent's goods, which, as discussed previously, are for building and construction works. Given these differences in purpose, I can see no basis for finding that any of the opponent's goods are competitive or complementary to the applicant's above referenced services.
66. Whilst I accept that there is a general overlap in users of the opponent's goods and the applicant's above referenced services, I do not consider this to be sufficient to reach a finding of similarity, and I am, once again, conscious of the judgment of Iain Purvis KC in *Unicorn Studio Inc v Veronese* referenced in paragraph 49 above.²⁸ I therefore find the opponent's goods to be dissimilar to the applicant's above referenced services.
67. As discussed above, it is a prerequisite of section 5(1) that the marks in issue and the goods and services against which they are protected/for which they are registered must be identical for an opposition under that ground to be successful. Accordingly, the opponent's opposition number 450305 (i.e., its opposition relating

²⁸ [2024] EWHC 1098 (Ch) - paragraph 24

to the second application) succeeds under section 5(1) in respect of the goods in issue which I have found to be identical, namely:

Class 7 Construction... machine tools; Lifting, elevating, handling and hoisting tools; Machine and power-operated tools; Mechanical tools.

68. The opponent's opposition number 450305 fails under section 5(1) in respect of the remaining goods and services that I have not found to be identical. However, I will proceed to consider whether there is a likelihood of confusion or association on the part of the average consumer in respect of the goods and services in issue which I have deemed to be similar, and therefore whether the opposition succeeds in respect of those goods and services under section 5(2)(a) of the Act.

69. Further, as some degree of similarity between the goods and services is required for a successful claim under section 5(2)(a) and 5(2)(b) of the Act, both of the opponent's oppositions must fail in respect of those goods and services that I have found to be dissimilar,²⁹ namely:

Class 7 Aerial platforms for use with cranes and hoists; Attachments for cranes; Cranes; Hoists; Lifting, elevating, handling and hoisting platforms; Tower cranes.

Class 37 Commercial construction; Consultancy relating to residential and building construction; Construction management and construction project management; Erection, construction, installation, maintenance and repair of pre-fabricated buildings, aerial platforms, formwork, platform staging, ramps, staircases, ladders, beams, work platforms, access platforms, boards, canopies, cladding, frameworks, and towers for use in building and construction; Erection, construction, installation, maintenance and repair of scaffolding; Fireproofing during construction; Hiring, rental

²⁹ *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA

and leasing of scaffolding; Installation, cleaning, servicing, renovation, maintenance, repair, and construction of fixtures and fittings for commercial premises; Installation, cleaning, servicing, renovation, maintenance, and repair of construction units and sites; Scaffolding; Supervision of civil engineering and construction projects.

Class 42 Construction design; Design and research services; Engineering; Engineering design; Environmental assessments, monitoring research, testing and consultancy services; Planning, design and research of buildings and structures; Planning, design and research of building and construction apparatus, equipment and machinery; Planning, design and research of products; Planning, design and research of building interiors, exteriors and structures; Planning, design and research of pre-fabricated buildings, aerial platforms, formwork, platform staging, ramps, staircases, ladders, beams, work platforms, access platforms, boards, canopies, cladding, frameworks, and towers; information, consultancy and advice in relation to the foregoing.

Average consumer and the purchasing act

70. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. 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 and services in question (see *Lloyd Schuhfabrik Meyer*³⁰).

³⁰ Case C-342/97

71. 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*,³¹ Birss J. held:

“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.”

72. The opponent submits that the parties’ goods and services are directed at the public at large. However, due to the broad range of goods and services in issue, I consider that there will be a variety of average consumers, specifically the general public, tradespeople and business users.
73. The cost and the frequency of purchase of the goods and services in issue is likely to vary considerably. The goods range from lower price tools, which may be purchased more frequently by the average consumers (particularly tradespeople), to much larger machinery, which will be considerably more expensive and is likely to be purchased as a one-off item. In any event, in respect of all of the goods, all of the average consumers are likely to consider factors such as price, suitability, customer reviews and the reputation of the provider during the purchasing process. For the lower price goods, I consider that a medium level of attention is likely to be paid by both types of consumers. However, for the more expensive goods, a high level of attention is likely to be paid by the average consumer.
74. The price and frequency of use of the services in issue will also vary considerably, but even the smallest building/construction jobs will inevitably be relatively expensive. All types of average consumers will consider the price of the services and suitability of the service provider, but they will inevitably place a considerable amount of weight on previous customers reviews and the reputation of the service

³¹ [2014] EWHC 439 (Ch)

provider during the purchasing process. For all types of identified average consumer of the services in issue, I consider that a high level of attention will be paid during the purchasing process.

75. The goods and services are likely to be purchased from bricks and mortar premises such as show rooms, from online websites operated by traders or from advertisements (such as flyers, posters or online adverts). Visual considerations are likely to dominate the selection process. However, word-of-mouth recommendations may also play a part, particularly in relation to the services in issue. Consequently, I do not therefore discount that there will be an aural component to the selection process.

Distinctive character of the earlier trade mark

76. In *Lloyd Schuhfabrik Meyer* 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 C108/97 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).”

77. Whilst the distinctiveness of a mark may be enhanced as a result of it having been used in the market, in this instance the opponent has filed no evidence of use. Consequently, I have only the inherent position to consider.
78. The opponent submits that the earlier mark is “clearly distinctive” for the goods for which it is protected. Distinctiveness is a scale along which marks of various types sit. A mark which is allusive of the goods/services will have less distinctive character than one that is not; dictionary words will also be less distinctive than words which are entirely fanciful. However, all will turn on the particular facts. For example, there are “invented” words which are really just composites of two allusive words and only distinctive as a result, and dictionary words which are more or less common than others.
79. In this instance, as discussed previously, I consider the word CAS to be an invented word or an acronym which does not appear to be descriptive or allusive of the opponent’s goods. I therefore consider the earlier mark to have a medium level of distinctive character.

Likelihood Of Confusion

80. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, whilst indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods/services down to the responsible undertakings being the same or related.
81. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind (see *Sabel*³²). The first is the interdependency principle i.e., a

³² C-251/95, para 22

lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa (see *Canon*³³). It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods/services, and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

82. Save for those identified in paragraph 69 above, I have found all of the applicant's goods to be identical or similar to between a low or at least a medium degree to the opponent's goods. I have also found some of the applicant's class 37 services to be similar to a low degree to the opponent's goods.
83. I have found the second application to be identical to the earlier mark, and the first application and the earlier mark to be visually and aurally similar to a medium degree, and conceptually dissimilar.
84. Further, I have found the earlier mark to have a medium level of distinctive character and have identified that the average consumer of the goods and services in issue would be members of the general public, tradespeople or business users who will pay a medium to high level of attention during the purchasing process. I have also determined that the purchasing process for all of the goods/services in issue would be primarily visual in nature, although I do not discount aural considerations.
85. Weighing up all of the above, whilst also noting the principle of imperfect recollection, and that consumers rarely have the opportunity to compare marks side by side, I am satisfied that there are sufficient differences between the first application and the earlier mark to prevent a likelihood of direct confusion on the part of the average consumers. Whilst I note my finding that both of these marks overlap in their dominant element (the word "CAS"), I do not consider that the

³³ C-39/97, para 17

words “Common Tower” will be overlooked by the average consumers, despite my finding that they are suggestive of the goods and services in the applicant’s specification, particularly because they form the majority of the letters/words in the first application. I am also conscious of my finding that the average consumer will pay either a medium or high level of attention during the purchasing process and, consequently, I consider that any identity/similarity between the goods and services in issue will be offset by the lower level of similarity between the first application and the earlier mark.

86. Having said that, I do find that there is a likelihood of direct confusion between the second application and the earlier mark in respect of all of the goods and services that I have found to be similar. This is because I consider that the general public would become confused upon seeing identical marks used in relation to similar goods and services (all of which relate to building and construction). For the avoidance of doubt, I also consider this to be the case in respect of the goods and services which I have only found to be similar to a low or medium degree, as I consider this lesser degree of similarity between these goods and services will be offset by the identity between the second application and the earlier mark.
87. Given my finding that the second application is identical to the earlier mark, I do not consider there to be any basis for a finding of indirect confusion between these marks. However, I will now go on to consider whether there is a likelihood of indirect confusion between the first application and the earlier mark, which I have not found to be identical.
88. Indirect confusion was described in the following terms by Iain Purvis QC (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:³⁴

“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

³⁴ BL O/375/10

simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised 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).

(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)."

89. As outlined above, I consider the common element of the first application and the earlier mark (being the word "CAS") to have a medium level of distinctive character. I also note my finding that the "Common Tower" element of the first application is suggestive of the applicant's goods. I do therefore consider that there is a likelihood that upon seeing the "CAS" element of the first application, the average consumer would view "CAS Common Tower" to be an entirely logical sub-brand of the "CAS" brand (i.e., of the earlier mark), perhaps believing that CAS is

the undertaking's mark relating to its general building and constructions goods and services, and CAS COMMON TOWER is the undertaking's mark for its more specialised scaffolding/staging goods and services. Consequently, I do consider that there is likely to be indirect confusion between the first application and the earlier mark. For the avoidance of doubt, I consider this to be the case even in respect of the goods and services which I have only found to be similar to a low or medium degree, and I am fortified in that finding on the basis that the goods and services that I have found to be similar to a low degree are those goods and services which I do consider would naturally fall within this sub-brand, being the scaffolding/staging goods.

CONCLUSION

90. For the reasons outlined above, Opposition numbers 450305 and 450307 succeed in respect of all the goods and services that I have found to be identical or similar. Therefore, the first application and second application are, subject to any successful appeal of my decision, refused registration for the following:

Class 6

Building frameworks, buildings and structures of metal; Building components of metal for the construction of structures; Metal materials for building and construction; Metal platform staging, ramps, staircases, ladders, beams, work platforms, formwork, access platforms, boards, canopies, cladding, frameworks, and towers for use with scaffolding; Metal platform staging, ramps, staircases, ladders, beams, work platforms, formwork, access platforms, boards, canopies, cladding, frameworks, and towers for use in building and construction; Metal scaffolding and scaffolding apparatus; Structural building elements of metal; Structural steelwork.

Class 7

Building machinery; Construction machines and machine tools; Lifting, elevating, handling and hoisting apparatus, equipment, tools and instruments; Machine and power-operated tools; Mechanical tools;

Class 19

Building frameworks, buildings and structures not of metal; Building components for the construction of structures, not of metal; Materials for building and construction, not of metal; Platform staging, ramps, staircases, ladders, beams, work platforms, formwork, access platforms, boards, canopies, cladding, frameworks, and towers for use with scaffolding, not of metal; Platform staging, ramps, staircases, ladders, beams, work platforms, formwork, access platforms, boards, canopies, cladding, frameworks, and towers for use in building and construction, not of metal; Scaffolding and scaffolding apparatus, not of metal; Structural building elements not of metal; Structural timber, support joists and other elements for use in building and construction, not of metal.

Class 37

Building and construction services; Building construction, demolition, maintenance and repair; Construction; Development of land [construction]; General building contractor services; Hiring, rental and leasing of construction equipment, apparatus and machinery; Installation, cleaning, servicing, renovation, maintenance, repair, and construction of fixtures and fittings for residential premises; Masonry; Plumbing installation, maintenance, and repair; Property development services [construction]; Refurbishment, renovation and restoration of buildings; Site preparation [construction]; information, consultancy and advice in relation to the foregoing.

91. That being said, both the first application and second application may proceed to registration (again, subject to any successful appeal of my decision) for the following goods and services, which I have found to be dissimilar:

Class 7

Aerial platforms for use with cranes and hoists; Attachments for cranes; Cranes; Hoists; Lifting, elevating, handling and hoisting platforms; Tower cranes.

Class 37

Commercial construction; Consultancy relating to residential and building construction; Construction management and construction project management;

Erection, construction, installation, maintenance and repair of pre-fabricated buildings, aerial platforms, formwork, platform staging, ramps, staircases, ladders, beams, work platforms, access platforms, boards, canopies, cladding, frameworks, and towers for use in building and construction; Erection, construction, installation, maintenance and repair of scaffolding; Fireproofing during construction; Hiring, rental and leasing of scaffolding; Installation, cleaning, servicing, renovation, maintenance, repair, and construction of fixtures and fittings for commercial premises; Installation, cleaning, servicing, renovation, maintenance, and repair of construction units and sites; Scaffolding; Supervision of civil engineering and construction projects; information, consultancy and advice in relation to the foregoing.

Class 42

Construction design; Design and research services; Engineering; Engineering design; Environmental assessments, monitoring research, testing and consultancy services; Planning, design and research of buildings and structures; Planning, design and research of building and construction apparatus, equipment and machinery; Planning, design and research of products; Planning, design and research of building interiors, exteriors and structures; Planning, design and research of pre-fabricated buildings, aerial platforms, formwork, platform staging, ramps, staircases, ladders, beams, work platforms, access platforms, boards, canopies, cladding, frameworks, and towers; information, consultancy and advice in relation to the foregoing.

COSTS

92. As I do consider that the opponent has achieved the greater degree of success overall it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Note 1/2023, albeit my award will have regard to the fact that the opponent did not achieve outright success in its oppositions. In the circumstances, I award the opponent the sum of £800 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee (x2):	£200
Preparing notices of opposition & considering the other side's statements:	£400
Preparing submissions-in-lieu of a hearing:	£200
<u>Total:</u>	<u>£800</u>

93. I therefore order Brogan Group Holdings Ltd to pay Metabowerke GmbH the sum of £800. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 23rd day of January 2026

B Hartland
For the Registrar

Annex 1

The opponent's goods	The applicant's goods and services
	<p><u>Class 6</u></p> <p>Building frameworks, buildings and structures of metal; Building components of metal for the construction of structures; Metal materials for building and construction; Metal platform staging, ramps, staircases, ladders, beams, work platforms, formwork, access platforms, boards, canopies, cladding, frameworks, and towers for use with scaffolding; Metal platform staging, ramps, staircases, ladders, beams, work platforms, formwork, access platforms, boards, canopies, cladding, frameworks, and towers for use in building and construction; Metal scaffolding and scaffolding apparatus; Structural building elements of metal; Structural steelwork.</p>
<p><u>Class 7</u></p> <p>Electric power tools and parts therefor, included in class 7; Hand held power tools; Battery-operated and battery-powered hand tools; Electrical tools for lawns and gardening; Tool chests and tool boxes configured for the aforesaid goods.</p>	<p><u>Class 7</u></p> <p>Aerial platforms for use with cranes and hoists; Attachments for cranes; Building machinery; Construction machines and machine tools; Cranes; Hoists; Lifting, elevating, handling and hoisting apparatus, equipment, tools, platforms and instruments; Machine and power-operated tools; Mechanical tools; Tower cranes.</p>

<p><u>Class 9</u> Devices for storing electricity; Accumulator batteries; Chargers; Batteries; Batteries for hand held power tools.</p>	
<p><u>Class 11</u> Electric lamps; Hand-held lights.</p>	
	<p><u>Class 19</u> Building frameworks, buildings and structures not of metal; Building components for the construction of structures, not of metal; Materials for building and construction, not of metal; Platform staging, ramps, staircases, ladders, beams, work platforms, formwork, access platforms, boards, canopies, cladding, frameworks, and towers for use with scaffolding, not of metal; Platform staging, ramps, staircases, ladders, beams, work platforms, formwork, access platforms, boards, canopies, cladding, frameworks, and towers for use in building and construction, not of metal; Scaffolding and scaffolding apparatus, not of metal; Structural building elements not of metal; Structural timber, support joists and other elements for use in building and construction, not of metal.</p>
	<p><u>Class 37</u> Building and construction services; Building construction, demolition, maintenance and repair; Commercial</p>

	<p>construction; Consultancy relating to residential and building construction; Construction; Construction management and construction project management; Development of land [construction]; Erection, construction, installation, maintenance and repair of pre-fabricated buildings, aerial platforms, formwork, platform staging, ramps, staircases, ladders, beams, work platforms, access platforms, boards, canopies, cladding, frameworks, and towers for use in building and construction; Erection, construction, installation, maintenance and repair of scaffolding; Fireproofing during construction; General building contractor services; Hiring, rental and leasing of construction equipment, apparatus and machinery; Hiring, rental and leasing of scaffolding; Installation, cleaning, servicing, renovation, maintenance, repair, and construction of fixtures and fittings for commercial and residential premises; Installation, cleaning, servicing, renovation, maintenance, and repair of construction units and sites; Masonry; Plumbing installation, maintenance, and repair; Property development services [construction]; Refurbishment, renovation and restoration of buildings; Scaffolding;</p>
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	<p>Site preparation [construction]; Supervision of civil engineering and construction projects; information, consultancy and advice in relation to the foregoing.</p>
	<p><u>Class 42</u> Construction design; Design and research services; Engineering; Engineering design; Environmental assessments, monitoring research, testing and consultancy services; Planning, design and research of buildings and structures; Planning, design and research of building and construction apparatus, equipment and machinery; Planning, design and research of products; Planning, design and research of building interiors, exteriors and structures; Planning, design and research of pre-fabricated buildings, aerial platforms, formwork, platform staging, ramps, staircases, ladders, beams, work platforms, access platforms, boards, canopies, cladding, frameworks, and towers; information, consultancy and advice in relation to the foregoing.</p>