

O/0458/26

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK00003850779
IN THE NAME OF FIXA YAPI KIMYASALLARI SANAYI VE
TICARET LIMITED SIRKETI FOR THE TRADE MARK:

Monofloor

IN CLASS 19

AND

AN APPLICATION FOR A DECLARATION OF
INVALIDITY UNDER NO. 506369 BY
MONOFLOOR TECHNOLOGY LIMITED

BACKGROUND AND PLEADINGS

1. FIXA YAPI KIMYASALLARI SANAYI VE TICARET LIMITED SIRKETI (“the Proprietor”) is the registered proprietor of the trade mark shown on the cover page of this decision (“the contested mark”). The contested mark was filed on 18 November 2022 and registration was granted on 17 February 2023. The contested mark stands registered for the following goods:

Class 19: *Floors, floorings and floor tiles, not of metal; non-metal floors; ceramic floor tiles; clay floor tiles; parquet flooring; rubber flooring; floor panels of plastic; tile floorings, not of metal; floating floor boards, not of metal.*

2. On 31 July 2023, Monofloor Technology Limited (“the Applicant”) applied to invalidate the contested mark. The application was brought under section 47 of the Trade Marks Act 1994 (“the Act”) and is reliant upon sections 5(2)(a), 5(3) and 5(4)(a) of the Act. Under the section 5(2)(a) and 5(3) grounds, the Applicant relies on the following trade mark:

Trade mark number UK00911419661¹ (“the earlier mark”)

Representation: MONOFLOOR

Filing date: 12 December 2012

Registration date: 11 September 2013

Specification relied upon:

Class 37: *Construction services; installation of flooring; maintenance, repair and renovation of flooring; construction project management services; advisory services in relation to the installation, maintenance, repair and renovation of flooring; provision of*

¹ The opponent’s mark is a comparable mark based on an earlier EUTM. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs. These comparable marks enjoy the same filing and registration dates as their European counterparts.

information in relation to the installation, maintenance, repair and renovation of flooring.

Class 41: *Education and training services in relation to the design, installation, maintenance, repair and renovation of flooring.*

Class 42: *Surveying services; engineering services; engineering project management services; technical assessments relating to the design of flooring; advisory services in relation to the design of flooring; provision of information in relation to the design of flooring; technical supervisory services in relation to the design, installation, maintenance, repair and renovation of flooring.*

3. Given its filing date and registration, the above mark qualifies as an earlier mark under section 6(1)(a) of the Act. It is, however, subject to the use provisions set out at section 47(2B) of the Act, a point I will discuss further below.
4. Under the section 5(2)(a) ground, the Applicant claims that the marks are identical and that the goods and services at issue are similar. As a result, it is claimed that there exists a likelihood of confusion between the marks, including a risk of association.
5. Turning to the section 5(3) ground, the Applicant claims that the identity between the marks, in combination with the reputation enjoyed by the earlier mark is such that the relevant public would strongly link the marks. Further, it is claimed that use of the contested mark would be without due cause and would take unfair advantage of and be detrimental to the distinctive character and/or the reputation of the earlier mark.
6. Lastly, under the section 5(4)(a) ground, the Applicant relies on the unregistered sign 'MONOFLOOR', which is claimed to have been used throughout the UK since 21 March 1994 in respect of "flooring consultancy, design, testing, installation, maintenance and repair services". It is claimed that the Applicant has generated a

protectable level of goodwill in the UK due to the use of its sign. As such, the Applicant's position is that use of the contested mark would misrepresent to the consumer that the Proprietor's goods originated from, or were licensed by, the Applicant. As a result of this deception, the Applicant claims that it will suffer damage to its goodwill as well as a potential loss of sales.

7. The Proprietor filed a defence and counterstatement denying the entirety of the Applicant's claims. It also requested that the Applicant provide proof of use for the mark relied upon.
8. During the evidence rounds, both parties filed evidence in chief. A hearing took place before me on 11 December 2024. The Applicant was represented by Mr Daniel Ramos of Osborne Clarke LLP, who has represented the Applicant throughout these proceedings. The Proprietor elected not to attend the hearing, nor file written submissions in lieu of the same, but I note that it has been represented throughout these proceedings by Beck Greener LLP.

EVIDENCE AND SUBMISSIONS

9. The Applicant's evidence came in the form of two witness statements. The first is that of Andrew Leonard Keen dated 12 January 2024 and its corresponding 35 exhibits (labelled Exhibits ALK1 to ALK35). Mr Keen is the former Chief Services Officer at RCR Industrial Flooring SLU ("RCR Spain"), which is a company that, along with the Applicant, sits within the RCR group of companies that operates in the industrial flooring sector. Mr Keen confirms that he was employed by the RCR group since January 2010 but retired on 1 January 2024. However, he is retained by RCR Spain on a consultancy basis. Prior to his retirement, Mr Keen confirms that he had overall responsibility for the Applicant's business strategies, sales and growth, as well as its day to day business, including the MONOFLOOR brand in the UK.

10. The Applicant's second statement came in the form of the witness statement of Christopher Martin Henderson dated 16 January 2024. Mr Henderson is the Chairman of the Association of Concrete Industrial Flooring Contractors ("ACIFC"), a position he has held since July 2022. His statement was filed in order to attest to the knowledge surrounding MONOFLOOR and the Applicant in the UK.
11. The Proprietor's evidence came in the form of the witness statement of Ali Murat Ekin dated 4 June 2024. Ali Murat Ekin is the founder and general manager of the Proprietor, a position they have held since 2001. This evidence was provided in order to explain the difference in the goods and services at issue as well as to refute the existence of a reputation in the earlier mark.
12. I do not intend to summarise the parties' evidence in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

Preliminary issue

13. At the hearing, Mr Ramos made submissions that the witness statement filed on behalf of the Proprietor by Ali Murat Ekin consisted solely of submissions as opposed to evidence of fact. At the conclusion of the hearing, I confirmed that I would give consideration to this point and decide what weight to place on it. Having had the chance to consider this issue further, I agree with Mr Ramos that the evidence of Ali Murat Ekin constitutes submissions and not evidence of fact. I say this because all Ali Murat Ekin seeks to do is raise points with the Applicant's evidence and make arguments as to the distinct fields of activity that the parties operate in. I will, therefore, give it no evidential weight and simply treat the witness statement as written submissions.

DECISION

Relevance of EU law

14. 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.

Section 47

15. Sections 5(2), 5(3) and 5(4)(a) of the Act all have application in invalidation proceedings by virtue of section 47(2) of the Act, which states as follows:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D)-(2DA) [Repealed]

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) [...]

(4) [...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

16. As the earlier mark is a comparable mark, paragraph 9 of part 1, Schedule 2A of the Act is relevant. It reads:

“9.— (1) Section 47 applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the period of five years referred to in sections 47(2A)(a) and 47(2B) (the "five-year period") has expired before IP completion day —

(a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 47 to the United Kingdom include the European Union.

(3) Where IP completion day falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 47 to the United Kingdom include the European Union.”

Proof of use

17. The earlier mark was registered for the five years before (1) the date of the application for invalidation and (2) the filing date of the contested mark. This means that it is open to the use provisions. Further, as I have confirmed above, the Proprietor has requested that the Applicant provide proof of use for the earlier

mark. In accordance with section 47(2B) of the Act, there are two relevant periods for proof of use in invalidation proceedings, being 19 November 2017 to 18 November 2022 (“the first relevant period”) and 1 August 2018 to 31 July 2023 (“the second relevant period”). Given the significant overlap across these periods, I see no issue in assessing them together. Lastly, for the avoidance of doubt, the relevant territory for genuine use prior to 31 December 2020 (“IP Completion Day”) is the EU at large but, thereafter, it is the UK only.

18. In respect of genuine use, I remind myself that section 100 of the Act is also relevant. It reads:

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

Relevant case law

19. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v*

Centrotherm Clean Solutions GmbH & Co KG [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional

items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the

proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

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

20. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”² because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

21. Before proceeding to the evidence of use, there are two points I wish to discuss. The first issue relates to the Proprietor’s evidence which states that, “[a]s is clear from that evidence, the Applicant for Cancellation provides design, testing and consultancy services related to industrial flooring.” While the Proprietor goes on to refute the existence of a reputation, there does not appear to be any indication that it denies that there is any genuine use. Further, I consider that the above comments could reasonably be taken as a concession as to genuine use for the Applicant’s design and consultancy services that relate to flooring. That being said, the services relied upon are wider than the services covered by the comments of the Proprietor. Further, I am of the view that I can deal with the issue of genuine use relatively briefly so I will proceed to consider it in the ordinary way. The second issue relates to the comment of Mr Ramos in his skeleton argument wherein he sets out that the Applicant’s evidence sufficiently proves use for the following services:³

² *Jumpman* BL O/222/16.

³ See paragraph 30 of Mr Ramos’s skeleton argument.

Class 37

Construction services; construction project management services relating to the installation, maintenance, repair and renovation of flooring; Consultancy services relating to the installation, maintenance, repair and renovation of flooring.

Class 41

Education and training; Education and training services relating to the design, installation, maintenance, repair and renovation of flooring.

Class 42

Surveying, engineering and advisory services; Surveying services relating to flooring; Engineering services relating to flooring; Engineering project management services relating to flooring; Consultancy services relating to the design, installation, maintenance, repair and renovation of flooring; Technical assessment and supervisory services relating to the design of flooring; and Advisory and information services in relation to the design, installation, maintenance, repair and renovation of flooring.

22. While noted, this submission goes beyond the specification at issue. For the most part, the services listed above are in line with the specification relied upon. However, the earlier mark does not include the terms “education and training” or “surveying, engineering and advisory services”. As a result, I will take Mr Ramos’s submissions on board but in the event that I find use, I will determine the terms upon which the Applicant is permitted to rely based on the specification before me.

Evidence of use

23. As set out above, the evidence of Mr Keen is accompanied by 35 exhibits. For reasons that will become obvious below, I see no real merit in discussing each and

every one of these exhibits. Instead, I will simply focus on what I consider to be the most salient points.

24. The evidence sets out that the Applicant introduced the MONOFLOOR brand into the UK in March 1994. The Applicant was then acquired by RCR group on 19 September 2013. After that point, the RCR group re-branded all of its own engineering and flooring consultancy companies under the MONOFLOOR name.

25. In respect of the Applicant's website, it is confirmed that this has been in operation since at least 2002. A screenshot of how the website appeared at this time, taken from the internet archive facility, the Wayback Machine, is provided in evidence.⁴ Further screenshots are provided from various points throughout the relevant periods.⁵ While this is the Applicant's global website, it is confirmed by Mr Keen that the website acts as its global marketing tool and is aimed at UK and EU customers. While on the topic of the website, the Applicant has provided a range of additional screenshots that outlines the various services it offers. These include industrial flooring design services, construction support services for industrial flooring, testing and reporting services in relation to industrial flooring, issue resolution services for damaged and defective industrial flooring, training and sharing best practice services and its maintenance and repair services for industrial flooring.⁶

26. In respect of the Applicant's turnover, this is provided for the years 2018 to 2022. It is not broken down in any way but Mr Keen confirms that it is the revenue accrued from the Applicant selling its MONOFLOOR services. These figures are as follows:

Year	Approx. UK Turnover (£)
2018	378,000

⁴ ALK2.

⁵ ALK3.

⁶ See ALK4 to ALK9, respectively.

2019	407,000
2020	446,000
2021	508,000
2022	834,000
Total	2,573,000

27. In support of the turnover figures and to assist in illustrating the type of services provided, the Applicant has provided a range of what Mr Keen refers to as UK invoices that cover the years 2019 to 2023.⁷ Despite Mr Keen's reference to the UK, there are a limited number of EU invoices provided. While the EU invoices prior to IP Completion Day are relevant here, the ones from thereafter are not. I do not intend to calculate the totality of the invoices but I note that, in his skeleton argument filed prior to the hearing, Mr Ramos provided a calculation for these invoices in that they stand at £510,876.76. While I see no reason to question the accuracy of this figure, there is no confirmation that it excludes the invoices provided after the conclusion of the relevant periods.⁸ In any event, the invoices merely support the turnover figures provided above so I do not consider that this is a particular issue here.

28. Having considered the invoices, it is noted that they cover the provision of proposal reviews, development of quality plans, pre-construction site visits and meetings, on-site quality audits (both part time and full time), inspection of completed works and reporting on completed works. Each invoice includes the words 'Monofloor UK' within the item column as well as the following branding in the top right hand corner:



⁷ ALK13 to ALK17.

⁸ The calculation is confirmed as excluding EU invoices from after IP Completion but it is noted that AK17 includes a number of invoices from after 31 July 2023.

29. Remaining on the topic of the invoices, it is noted at the hearing that Mr Ramos sought to argue that they represented repeat custom. Save for the general location of the customer, the customer details in the invoices are redacted. Therefore, it is not possible for me to determine whether, for example, the repeat invoices to addresses in Buckinghamshire were to the same customers or not. As a result, I do not consider that the repeat custom argument is supportable.

30. The evidence proceeds to discuss a range of quotes given to potential UK customers in 2022 and 2023.⁹ These appear to discuss services in line with those provided by the invoices I have discussed above. In any event, there is nothing before me to confirm whether these quotes turned into actual business for the Applicant and, even if they did, there is no confirmation as to when the work took place and given the proximity of these quotes to the conclusion of the relevant periods, it is reasonable to suggest that the services may have been provided after that.

31. In respect of press coverage and promotion, the Applicant has provided an article title '21st Century Floors' from the Concrete Society's September 2020 issue of 'Concrete Magazine'.¹⁰ The article discusses the Applicant's expertise in the industrial flooring consultancy business, stating that the Applicant has provided specialist floor consultancy and quality auditing in respect of more than 1.5 million square meters of warehouse floors. It is noted that the article itself was written by an employee of the Applicant but I still consider it suitable as an attempt to promote the earlier mark. In addition, Mr Keen has provided an extract from 'The Concrete Society's Good Concrete Guide 10' which, in an extract dated 27 February 2020, features an advert of the Applicant's maintenance and repair services for industrial flooring.¹¹ Additional evidence in respect of the press coverage/promotion point is

⁹ ALK18 to ALK20.

¹⁰ ALK29.

¹¹ ALK30.

provided but I do not consider that it is of any real assistance here. For example, one article makes no reference to MONOFLOOR at all but, instead, contains advertisements for RCR¹² and another is simply a press release regarding the appointment of Tom Hancock (an ex-managing director of the Applicant) as chairman of the ACIFC association.¹³ In short, I do not consider that each of these demonstrate attempts to create or preserve a market share for the relevant services by the Applicant.

32. In terms of its own marketing, Mr Keen explains why he has not divulged any evidence in respect of the Applicant's marketing spend. He confirms that the Applicant does not typically seek to generate business through advertising and marketing and, as such, its marketing spend is relatively minor. Any marketing efforts it does undertake are either to support a technical article that is relevant to its sector or indirect advertising by way of attendance at trade exhibitions.

33. Lastly, the evidence addresses the use of MONOFLOOR on flooring products. While noted, this is not relevant to these proceedings as the Applicant seeks to rely on services relating to flooring only.

Form of the mark

34. As demonstrated at paragraph 28 above, the Applicant has used its mark in a figurative manner on its invoices. This version of the mark is also shown on the Applicant's website, its quotes and in adverts. I appreciate that such evidence also includes use of MONOFLOOR in a word only format meaning that it is, clearly, evidence upon which the Applicant may rely. However, for the sake of completeness, I will briefly assess whether use of the mark in this way is acceptable. As per the case of *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, use of a mark generally encompasses both its independent use and its

¹² ALK27.

¹³ ALK31.

use as part of another mark taken as a whole or in conjunction with that other mark. Further, so long as the mark continues to be perceived as an indicator of origin for the services at issue, it is use of the mark as registered. In the present case, MONOFLOOR appears in a standard, white font and sits on a blue diamond shaped device. The word MONOFLOOR is partially reflected on the surface of the blue diamond device. In my view, use of MONOFLOOR in this way is as part of a composite mark and it clearly remains the primary indicator of origin within this version of the mark. As such, I am satisfied that it is use of the earlier mark as registered. Alternatively, if this is incorrect then I find that the way the mark is used does not alter its distinctive character so, in accordance with section 47(2C)(a) of the Act, it is an acceptable variant of the earlier mark.

Assessment of the evidence

35. As discussed above, the Applicant's turnover in the UK for 2018 to 2022 sits at approximately £2.5 million. It is noted that the second relevant period started on 1 August 2018 meaning that some of the figures for 2018 are likely to have fallen prior to then, making them irrelevant for the present assessment. A similar point applies to the first relevant period in that it concluded on 18 November 2022 meaning that some of the turnover for that year fell after that date. These are points I must bear in mind and while I have no way to determine how much turnover came prior to the second relevant period or how much came after the first relevant period, I do not consider that it impacts on my assessment to any material degree. I say this on the basis that, even bearing this point in mind, the level of use, whilst not significant, clearly demonstrates a genuine attempt to create or preserve a market share for the services offered by the Applicant under the MONOFLOOR branding. While I have no evidence before me as to the size of the market within which the Applicant operates, I remind myself that use need not be quantitatively significant in order for it to be deemed genuine.

36. Outside of the turnover and invoices provided, I do not consider that the Applicant's evidence is particularly compelling insofar as it relates to the present assessment. That being said, I do accept that there are instances of press coverage and advertising in respect of the MONOFLOOR brand that, whilst limited, support what I have said above about there being a genuine attempt to create or preserve a market share.

37. Taking all of the evidence into account, I am satisfied that the Applicant has genuinely used the earlier mark during both of the relevant periods. That being said, I consider that this finding is only applicable to the following services relied upon:

Class 37: *Construction project management services in relation to the installation, maintenance, repair and renovation of flooring; advisory services in relation to the installation, maintenance, repair and renovation of flooring; provision of information in relation to the installation, maintenance, repair and renovation of flooring.*

Class 42: *Surveying services in relation to the installation, maintenance, repair and renovation of flooring; engineering services in relation to the installation, maintenance, repair and renovation of flooring; engineering project management services in relation to the installation, maintenance, repair and renovation of flooring; technical assessments relating to the design of flooring; advisory services in relation to the design of flooring; provision of information in relation to the design of flooring; technical supervisory services in relation to the design, installation, maintenance, repair and renovation of flooring.*

38. In short, I accept that the Applicant has used its mark in respect of services that specifically relate to the installation, maintenance, repair and renovation of flooring.

However, the evidence does not appear to suggest that the Applicant conducts the installations of the floors itself. Further, while there is some attempt to refer to educational and training services within the evidence, this comes via a range of screenshots from the Applicant's website. In short, the provision of education or training is not borne out in the evidence and it is noted that the invoices make no reference to the provision of education or training. In determining what services are provided, I am guided by the invoices because, as I have set out above, the turnover is not broken down in any way. In my view, if there were specific examples of use upon which the Applicant wished to rely on in respect of these services, it was for the Applicant to direct me to it. Therefore, I am unable to determine how much, if any, of the turnover can be attributed to the educational/training services. As a result, I consider that the evidence in respect of the class 41 services of the relied upon specification is insufficiently solid and, as such, I am not willing to conclude that there is genuine use for the same.

Section 5(2)(a)

Statutory provisions

39. Section 5(2)(a) of the Act reads as follows:

“(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, or

(b) [...]

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

40. Section 5A of the Act states as follows:

“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.”

Relevant case law

41. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a 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; and

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

Identity of the marks

42. It is a prerequisite of section 5(2)(a) of the Act that the marks at issue be identical.

The marks at issue are word only marks for the word 'MONOFLOOR', albeit the contested mark is presented in title case whereas the earlier mark is presented in upper case. The Proprietor argued that the marks at issue are not identical because of their different uses of case. This argument is noted but entirely misguided on the basis that word only marks are protected for use of the word contained within them, regardless of their use of case. Plainly, the marks at issue are identical and I will proceed as such.

Comparison of goods and services

43. The Proprietor's goods can be found at paragraph 1 above whereas the Applicant's services can be found at paragraph 37 above.

44. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, the court stated at paragraph 23 that:

"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."

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

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

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

46. 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.”

47. In its evidence, the Proprietor made reference to the fact that its own goods will be sold directly to fitters, mainly from DIY stores and are likely to be used in residential buildings. On the contrary, the Proprietor states that the Applicant’s services relate to industrial construction projects with customers being major corporations such as Amazon and Costco, amongst others. As such, the Proprietor argues that there

are distinct channels of trade and that there is sufficient distance between the goods and services. I appreciate that the parties may operate in this manner. However, the present assessment must be based, in fact, on the concept of 'notional and fair use' which involves carrying out the comparison of the goods and services based on the specifications before me, not the goods and services effectively provided by the parties.¹⁴ Given that the Proprietor's goods are not limited to exclude them from industrial application, the Proprietor's arguments have no impact here and I will say no more about them.

48. At the hearing, Mr Ramos went through the services in each class of the Applicant's specification and offered submissions as to why they were similar to the Proprietor's goods. These submissions are noted but I see no merit in going through each of the Applicant's different class of services. Instead, I can deal with the present assessment by simply selecting what I consider to be the closest comparator to the Proprietor's goods. In my view, that is the term "*construction project management services in relation to the installation, maintenance, repair and renovation of flooring*".

49. The Proprietor's goods consist solely of flooring products, be that the broad terms of "*floors, floorings and floor tiles, not of metal*" and "*non-metal floors*" or terms that are limited to their materials or design, namely "*ceramic floor tiles*", "*clay floor tiles*", "*parquet flooring*", "*rubber flooring*", "*floor panels of plastic*", "*tile floorings, not of metal*" and "*floating floor boards, not of metal*". At the hearing, Mr Ramos made reference to another decision of this Tribunal (being BL O/491/20) wherein a Hearing Officer found similarity between "*flooring, not of metal*" and "*installation, maintenance and related services relating to flooring*". Firstly, this is not a comparison that is relevant here as these services covered are not in the Applicant's specification. Secondly, I am not bound by findings of other Hearing Officers. As such, the decision referred to by Mr Ramos has no persuasive value.

¹⁴ *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06 at [66] and *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at [22].

50. At the hearing, Mr Ramos argued that these goods and services overlap in trade channels and referred to Mr Keen's evidence in support of this point. This evidence shows an example of flooring products offered by the undertaking ROCLAND (which is a part of the RCR group) being listed alongside the Applicant's services.¹⁵ In addition, there is reference to an undertaking called CoGri Group that promotes its services and goods alongside each other.¹⁶ This evidence is noted but covers just two examples, one of which being the Applicant's own use. As such, I am not convinced that this evidence carries any significant weight. That being said, I do not consider that evidence in respect of this point is something that is necessarily required. This is because I consider it to be common in the trade for undertakings that provide flooring goods to also provide project management services in respect of the same. As such, I am willing to conclude that these goods and services overlap in trade channels.

51. Another factor discussed at the hearing was a claim that there would be an overlap in user between these goods and services. I agree. In short, someone looking to have construction project management services in respect of flooring is clearly going to be the user of the Proprietor's flooring products.

52. In addition to the above, Mr Ramos also argued that there was a degree of complementarity and competition between these goods and services. I accept that there is a degree of complementarity in the present case on the basis that, clearly, flooring is going to be important to the Applicant's services and I consider that the relationship between these goods and services is such that consumers will believe that they originate from the same undertaking in accordance with the case of *Boston* (cited above). As for the issue of competition, Mr Ramos argued that the public can buy flooring products themselves or they can seek a tradesman who might source those flooring product to install them. While I accept that this may

¹⁵ ALK32 and ALK33.

¹⁶ ALK34 and ALK35.

apply where the actual installation of flooring is involved, this is not the case here. As a result, I see no merit in this argument.

53. Taking all of the above into account, I find that the overlaps in trade channels and user, together with the degree of complementarity between the goods and services render them similar to between a low and medium degree.

The average consumer and the nature of the purchasing act

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

55. In *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

(a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average

consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

56. In his skeleton argument, Mr Ramos made arguments in respect of the average consumer for the Proprietor's class 19 goods only. While noted, the present assessment must take into account all of the goods and services at issue, including those of the Applicant. That being said, I do agree with Mr Ramos's position in that the consumer of the goods at issue will be members of the general public and members of the trade who will purchase the goods from physical and online retailers. The selection process for these goods will, therefore, be primarily visual (though I do not discount an aural component). As for the level of attention, Mr Ramos argues that members of the trade will pay a medium degree of attention but that members of the public will pay a lower degree. While I agree with the former submission, I disagree with the latter. I say this because whilst flooring goods may be cheap, the consumer will still consider the materials used, style, sustainability, durability and installation methods/ease of installation. Such factors, in my view, point to a medium degree of attention being paid.

57. In respect of the services at issue, these will be selected by business users looking for project management to oversee the installation of large flooring installations. Those consumers will select the services directly from the provider (be that online or in their physical premises after seeing the services on lists or pamphlets) and after having discussions with sales assistants. As such, the selection process will be both visual and aural. In terms of the level of attention paid, I consider that this will be relatively high due to the likely size of the project to be undertaken. Further, the selection will be important to the operation of that business as it will directly impact on the quality and operational ability of their warehouses or factories, for example.

Distinctive character of the earlier mark

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

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section

of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

59. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of marks can be enhanced through use, and I note that the Applicant has filed evidence of use. I will, therefore, consider whether the Applicant’s evidence is sufficient to give rise to a finding that the distinctiveness of the earlier mark has been enhanced through use. Before doing so, I will consider the inherent position.

60. The earlier mark is a word only mark consisting solely of the word ‘MONOFLOOR’. Despite being presented as a singular word, I consider that consumers will break this down into two elements, being the combining form ‘MONO’ and the ordinary word ‘FLOOR’. I say this because ‘MONO’ only exists in combination with other words to form a new word with its own meaning. I appreciate that I have no evidence on this point but, in reaching this finding, I refer to popular English language words such as monopoly, monochrome, monologue, monotone. The ‘mono’ aspect of these words indicates something in the singular, i.e. *monotone* means a singular tone or *monochrome* means a singular colour, for example. As a result, when viewed as a whole, I find that ‘MONOFLOOR’ will be understood as a reference to *a singular floor*. I do not consider this to be outright descriptive of the services relied upon by the Applicant, but it is highly allusive in that it clearly indicates that the Applicant’s services relate to flooring. In my view, its inherent distinctiveness sits at a low degree.

61. I turn now to consider the issue of an enhanced degree of distinctive character. I have summarised the evidence of Mr Keen at paragraphs 23 to 33 above. That same evidence is relevant here. In addition to this evidence, the Applicant provided the witness statement of Mr Henderson. At the hearing, Mr Ramos sought to rely on this evidence in support of a claim that the Applicant enjoys a reputation in the UK. Whilst reputation and enhanced distinctiveness are different, the factors relevant to both are the same. I will, therefore, discuss this evidence here. While it is appreciated that Mr Henderson makes several claims about how the Applicant and the MONOFLOOR brand is known to the ACIFC, I do not consider the evidence to be particularly compelling. I acknowledge that ACIFC is an association that represents the views of the concrete industrial flooring industry to the government. However, I am not convinced that its impression of the MONOFLOOR brand can be said to equate to a level of knowledge of the same across the relevant public in the UK. In addition, Mr Henderson states that the ACIFC believes that others in the flooring industry will know of the Applicant as a market leading provider of its services. This is noted but I do not consider it to be a claim that Mr Henderson is open to make and, further, it is not supported by any documentary evidence. In any event, knowledge of others within the industry does not equate to an understanding across the relevant public. As a result, I do not consider that Mr Henderson's evidence is of any assistance to the Applicant.

62. At the hearing, Mr Ramos drew my attention to the fact that the former managing director of the Applicant, Mr Hancock, was appointed as Chairman of the ACIFC in 2020.¹⁷ It was argued that the reason he was chosen was because of his experience and reputation at the Applicant and the associated reputation of MONOFLOOR itself. Firstly, I do not consider that this claim is borne out in evidence as there is nothing to suggest what ACIFC's selection process was for selecting Mr Hancock. Secondly, and as I have discussed above, I am not concerned with the views or understanding of ACIFC as it does not equate to a

¹⁷ I have discussed evidence on this point at paragraph 29 above.

level of knowledge across the relevant public. Therefore, I do not consider that this point supports the Applicant in any way.

63. The totality of the level of use by the Applicant of its mark prior to 31 July 2023 (being the relevant date for the present assessment) was that its services accrued a turnover of approximately £2.5 million from 2018 onwards. I accept that this was sufficient to find genuine use but I remind myself that the requirement for a finding of an enhanced distinctive character is considerably more onerous than that of genuine use. I say this on the basis that use need not be quantitatively significant in order for it to be genuine, whereas distinctive character is a measure of how strongly the mark identifies the goods/services of a single undertaking. It follows that a finding of an enhanced degree of distinctive character requires use at such a level that is capable of pointing to the fact that a proportion of consumers would identify the goods/services as originating from a particular undertaking. Therefore, it does not follow that just because I found use there must also be an enhanced degree of distinctive character. Under the present assessment, I remind myself that the Applicant has not provided any evidence as to the size or nature of the market in which it operates and while that may not have been a hurdle to a finding of genuine use, it is an issue here because it prevents me from being able to assess the impact of the level of use in the context of the relevant market. For example, if the market is a small one, a lower turnover might suffice but, on the contrary, if it is a large market then a higher turnover is required. The issue here is that while the market appears to be specialised, I have nothing pointing towards its size and, as such, I am unable to assess the use in the context of the actual market. In addition, the supporting evidence is far from compelling as there is very little by way of press coverage or advertising efforts. As a result, I find that the earlier mark does not benefit from any enhanced distinctiveness and, instead, the inherent position applies.

Likelihood of confusion

64. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while 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 and services down to the responsible undertakings being the same or related. 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. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and 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 they have retained in their mind.

65. The marks at issue are identical. I have found the goods and services to be similar to between a low and medium degree. The average consumer base is formed of members of the general public and members of the trade who will select the goods via primarily visual means (though not discounting an aural component) and business users who will select the services via both visual and aural means. The members of the trade and the public will select the goods whilst paying a medium degree of attention whereas the business user will pay a relatively high degree of attention. Lastly, in respect of distinctiveness, I have found the earlier mark to be inherently distinctive to a low degree.

66. Taking all of the above factors into account, I am satisfied that the average consumer would mistake the marks at issue for one another, even despite the low degree of distinctive character possessed by the earlier mark. In respect of this

point, I remind myself that, as per *L'Oréal SA v OHIM*, Case C-235/05 P, a weak distinctive character does not preclude a likelihood of confusion and, in the present case, the marks at issue are identical. In short, there is nothing to allow the consumer to be able to distinguish the marks from one another so I fail to see any scenario in which consumers would not be directly confused, regardless of the level of attention paid when selecting the goods or services. Consequently, I am satisfied that there will be a likelihood of direct confusion between the marks at issue.

Section 5(2)(a) outcome

67. The section 5(2)(a) ground of opposition has succeeded in full. For the sake of completeness, I will proceed to consider the remaining grounds.

Section 5(3)

Statutory provisions

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

“5(3) A trade mark which –

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 repute of the earlier trade mark.”

Relevant case law

69. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L'Oreal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora*, Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

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

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

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

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

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

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

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

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

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

70. The conditions of section 5(3) are cumulative. Firstly, the Applicant must show that the marks are similar. Secondly, the Applicant must show that its mark has achieved a level of knowledge/reputation amongst a significant part of the public throughout the relevant territory. Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the contested mark. Finally, assuming the first three conditions have been 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) that the goods and services 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.

71. Before proceeding to consider a reputation, I remind myself the issue of proof of use is as relevant to section 5(3) as it is to section 5(2) and given that the Proprietor requested proof of use for the earlier mark, the findings in respect of that point are equally applicable here. As such, the present ground is limited to a reliance upon the services set out at paragraph 37 above.

Reputation

72. In considering the issue of a reputation, I remind myself that I have assessed the Applicant's evidence of use at paragraphs 23 to 33 above. I do not intend to repeat this evidence in full here but note that while it was sufficient to find genuine use, it was not sufficient to result in the earlier mark enjoying an enhanced degree of distinctive character. The latter point is relevant here because while I appreciate that the test for reputation differs from that for enhanced distinctiveness, it is common in proceedings before the Tribunal that, when all factors are equal, the outcomes of these assessments mirror one another. In the present case, the relevant date is the same, so are the marks and the services relied upon. Therefore, following the same reasons given at paragraphs 61 to 63 above, I find

that the Applicant has failed to prove that its mark enjoyed a reputation in the relevant territory as at the relevant date.

Section 5(3) outcome

73. The section 5(3) ground of the application is dismissed.

Section 5(4)(a)

Statutory provisions

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. I am of the view that I can deal with the present ground relatively briefly. I say this because whilst the evidence was insufficient to find a reputation, the bar for proving a protectable level of goodwill is lower. On this point, I remind myself that even a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its goodwill and reputation may be small.¹⁸ In the present case, I accept that the Applicant’s use is sufficient to prove that it enjoys a protectable level of goodwill in “flooring consultancy, design, testing, maintenance and repair services”.¹⁹

77. Further, I accept that the goodwill would be associated with the sign relied upon. Under the 5(2)(a) ground, I found there to be a likelihood of confusion between the parties’ marks and in respect of all of the Proprietor’s goods. In assessing the present ground, I remind myself of the case of *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, wherein Kitchin LJ set out that it was doubtful whether the difference between the legal tests for likelihood of confusion and misrepresentation will (all other factors being equal) produce different outcomes. As the Applicant’s sign is identical to the mark it relied upon under the 5(2)(a) ground, I am of the view that this principle applies here. As such, I am satisfied that a finding of misrepresentation (and subsequently, damage) follows the outcome of the 5(2)(a) ground in respect of the application against the contested mark.

Section 5(4)(a) outcome

78. The section 5(4)(a) ground of the application succeeds in full.

¹⁸ See, for example, the case of *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590.

¹⁹ While installation services were included under the section 5(4)(a) ground, the evidence does not speak to the provision of such services.

CONCLUSION

79. The application has succeeded in full and the contested mark is hereby declared invalid and, in accordance with section 47(6) of the Act, it is deemed never to have been made.

COSTS

80. The Applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. I award the following:

Preparing an application for invalidity and considering the counterstatement	£300
Preparing evidence and considering the other side's evidence	£600
Preparing for and attending a hearing	£800
Official fees	£200
Total	£1900

I therefore order FIXA YAPI KIMYASALLARI SANAYI VE TICARET LIMITED SIRKETI to pay Monofloor Technology Limited the sum of £1900. This 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 final determination of the appeal proceedings.

Dated this 29th day of May 2026

MRS E FISHER
For the Registrar