

O/0670/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004064459

BY BROGAN GROUP HOLDINGS LTD

TO REGISTER THE TRADE MARK:

BROGAN MASTCLIMBER

IN CLASSES 6, 7, 19, 37, 41 AND 42

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 449988

BY BRAND ENERGY HOLDINGS B.V.

BACKGROUND AND PLEADINGS

1. On 27 June 2024, Brogan Group Holdings Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 5 July 2024. The applicant seeks registration for the goods and services contained in Annex 1 to this decision.

2. The application was opposed in full by Brand Energy Holdings B.V. (“the opponent”) on 4 October 2024 based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. Under section 5(2)(b), the opponent relies upon the following trade marks:

MASTCLIMBERS

Comparable UK trade mark (EU) registration no. UK00905726617¹

Filing date 19 February 2007.

Registration date 11 December 2007.

(“the First Earlier Mark”)

MASTCLIMBERS

BY BRAND SAFWAY

UK registration no. UK00003809114

Filing date 13 July 2022.

Registration date 4 November 2022.

(“the Second Earlier Mark”)

¹ Following the end of the transition period of the UK’s withdrawal from the EU, all EU trade marks (“EUTM”) registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A ‘comparable trade mark (EU)’ retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

4. Under section 5(2)(b), the opponent relies upon all of the First and Second Earlier Mark's goods and services, contained in Annex 2 to this decision. The opponent also claims that there is a likelihood of confusion because the goods and services are either identical or very highly similar and the marks are similar.

5. Under section 5(3), the opponent only relies upon its First Earlier Mark, and all of its goods and services contained in Annex 2 to this decision. The opponent claims that it has a "significant reputation, throughout the UK, in relation to the supply of scaffold and access solutions for the construction industry", and that use of the applicant's similar mark would "lead to an undue association with the opponent", making them believe that the "commercial source of the goods and services is the same entity or an economically linked undertaking". The opponent also claims that use of the applicant's mark on similar or identical goods and services would create, without due cause "an immediate link to the substantial reputation that the opponent's **MASTCLIMBERS** brand enjoys" and that this will enable the applicant to ride on its coat tails, benefitting from the power of attraction the earlier mark carries, without any independent investment or marketing effort. The opponent also submits that this would be detrimental to its reputation and will "diminish its power of attraction to the relevant public by way of tarnishment", and that it would "lead to a risk of dilution of the distinctive character" of the opponent's mark.

6. Under section 5(4)(a), the opponent relies upon its **MASTCLIMBERS** sign which it claims to have used throughout the UK since 1996 for "scaffolding of metal", "pulleys", "access and work platforms", "elevators", "elevating apparatus", "hoists", "scaffolding", "rental of construction equipment", "hiring of access and work platforms" and "handling of building materials". The opponent claims that use of the applicant's mark would be contrary to the law of passing off.

7. The applicant filed a counterstatement denying the claims made, subjecting the First Earlier Mark to proof of use.

8. The opponent is represented by Stevens Hewlett & Perkins and the applicant is represented by LEGALVISION LAW UK LTD. The opponent filed evidence in chief. Neither party requested a hearing, nor filed submissions in lieu. I make this decision

having taken full account of all the papers and evidence, and I will refer to them where necessary below.

RELEVANCE OF EU LAW

9. 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.

EVIDENCE

10. The opponent's evidence consists of the witness statement of Blair Carswell dated 14 March 2025. Mr Carswell is the "Finance Director Europe Commercial Part of Brand Energy & Infrastructure Services UK, Ltd", a subsidiary of the opponent. This is a position which Mr Carswell has held since August 2023, and his statement is accompanied by 5 exhibits (CB1-CB5).

11. Whilst I do not propose to summarise it here, I have taken all of the opponent's evidence and the parties' submissions into consideration in reaching my decision and will refer to them where necessary below.

DECISION

Section 5(2)(b)

12. Section 5(2)(b) reads as follows:

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

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

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

13. The opponent’s marks qualify as earlier marks in accordance with section 6(1)(a) of the Act as their filing dates are earlier than the filing date of the applicant’s mark. As the opponent’s First Earlier Mark completed its registration process more than five years before the filing date of the mark in issue, it is subject to proof of use pursuant to section 6A of the Act. The opponent’s Second Earlier Mark completed its registration process less than five years before the filing date of the applicant’s mark. Accordingly, the use provisions at section 6A of the Act do not apply. The opponent may rely on all of the goods and services it has identified without demonstrating that it has used its Second Earlier Mark.

Proof of use

14. I will begin by assessing whether there has been genuine use of the First Earlier Mark. The relevant statutory provisions are as follows:

15. Section 6A of the Act states:

“(1) This section applies where

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

(b) there is an earlier trade mark of a kind falling within section 6(1)(a),
(aa) or (ba) in relation to which the conditions set out in section 5(1),
(2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed
before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

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

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (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.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the

purposes of this section as if it were registered only in respect of those goods or services.”

16. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the First Earlier Mark is the five years ending on the filing date of the applicant’s mark, i.e. 28 June 2019 to 27 June 2024. By virtue of paragraph 7 of Part 1, Schedule 2A of the Act, use within the EU is relevant for the entirety of the relevant period which falls prior to IP Completion Day (31 December 2020). After that date, only use in the UK will be relevant.

17. 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 Bundervsvereinigung 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 Marken 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].”

Evidence of use

18. At paragraph 2 of his witness statement, Mr Carswell states that Brand Energy & Infrastructure Services UK, Ltd (hereafter “BEIS”) has “over 100 years of experience providing superior temporary access solutions for the construction industry”. I have been provided with the company history of BEIS exhibited in **BC1**. I note that this exhibit contains an undated screenshot from the website www.beis.com/uk/history, which contains a historical timeline of the company from 1905 to 2025 detailing that “MASTCLIMBERS” was officially founded in the UK in 1996 and acquired in 2004. However, these are the only two references on the timeline to “MASTCLIMBERS”.

19. At paragraph 3 of his witness statement, Mr Carswell states BEIS “prides itself on the quality of the goods and services [it] provide[s]”, and that it has been a member of

the IPAF (the International Powered Access Federation) for over 25 years. **Exhibit BC2** contains a screenshot from the IPAF website which confirms that the undertaking “promotes the safe and effective use of powered access equipment worldwide”. **Exhibit BC3** contains a screenshot from its member’s directory which confirms that BEIS is a IPAF member, and that BEIS is also based in Surrey UK.

20. At paragraph 5 of his witness statement, Mr Carswell has provided the following turnover figures for BEIS “relating to MASTCLIMBERS goods and services since 2019”:

Year	Total Revenue (GBP000s)
FY19 (27 June to 31 December)	2,648
FY20	4,586
FY21	5,450
FY22	4,285
FY23	4,590
FY24 (1 January to 27 June)	1,995
Total	23,555

21. At paragraph 6 of his witness statement, Mr Carswell has provided a table showing the “top five customers of MASTCLIMBER goods and services, and the figures relate to the period 2019 to 2024”:

Customer	Value (GBP000s)
John Graham Construction Ltd	2,134
Bowmer & Kirkland Ltd	1,937
City Building (Glasgow) LLP	1,441
Waters	1,002
Robertson	918

22. Mr Carswell states that BEIS is a part of the BrandSafway group, and **exhibit BC4** contains an undated screenshot showing where the BrandSafway group businesses are located. I note that the screenshot shows 1 location point in the UK, as well as locations across the globe, including the EU and US, as well as India, and Saudi Arabia. I have also been provided with a brochure exhibited in **BC5** which Mr Carswell states details BEIS’ MASTCLIMBER goods and services. I note the following from this exhibit:

- a) The brochure is titled “MASTCLIMBERS™ BY BRANDSAFWAY”.
- b) MASTCLIMBERS is described as a mast climbing work platform and a vertical access solution, with its platforms levels which can be quickly and safely adjusted to the desired elevation for any temporary works. It is compared to, and said to be more effective than, scaffolding. The mast climbing platforms are shown as follows:



- c) The brochure confirms that “MASTCLIMBERS™ by BrandSafway operations” is based out of Manchester and Glasgow and that they have “the whole of the United Kingdom covered for vertical mechanical access solutions”.
- d) The brochure also has a page dedicated to “MASTCLIMBERS fleet services” which is described as a “mechanical access service”. The brochure states that “hiring us to provide safe vertical access to your construction project is a safe, sensible move – not only to make use of the scale and quality of the MASTCLIMBERS™ by BrandSafway operation and its inherent safety, but for a seamless integration with other services within the business”.
- e) Page 2 of the brochure states that “MASTCLIMBERS™ vertical access solutions in the UK are backed by the might of one of the leading global access providers, BrandSafway”.
- f) The last page of the brochure dates it as being from 2023.

23. I note that Mr Carswell does not provide any information as to exactly when the brochure was created and began to be distributed in 2023. I also have no information as to how many brochures were printed and distributed as a whole.

Assessment of genuine use

24. As far as the form of the mark is concerned, I am satisfied that the MASTCLIMBERS mark has been used as registered on the brochure evidence. I will now consider whether the evidence shows that the First Earlier Mark has been genuinely used.

25. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.² As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.

26. The opponent’s above evidence clearly contains a number of deficiencies. I have not been provided with any invoice evidence showing the sale of BEIS’ goods and services during the relevant period. This is plainly information which should have been available and relatively easy to provide. Whilst I have been provided with BEIS’ top five clients, I am only able to determine the geographical location of City Building (Glasgow) LLP as being based in Glasgow by virtue of its name. In regard to the remaining four clients, I do not have any evidence or submissions from the opponent as to where they are based. However, the brochure evidence clearly establishes that MASTCLIMBERS has bases in both Manchester and Glasgow, covering the “whole of the United Kingdom [...] for vertical mechanical access solutions” and that the MASTCLIMBERS brand is backed by “one of the world’s leading global access providers, BrandSafway”. Therefore, I find that whilst BrandSafway (which owns

² *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

MASTCLIMBERS) is a global brand, which is supported by the map evidence above showing that it has locations across the globe, BEIS itself is based in the UK and provides its goods and services across the whole of the UK. I have no other evidence to confirm that MASTCLIMBERS operates outside of the UK, and on this basis, I find that it is reasonable to infer that the turnover figures provided are likely to pertain to sales of its goods and services only in the UK, and that the list of clients provided by Mr Carswell are also all likely to be based in the UK. However, without any further information in regard to 4 of BEIS' top clients, such as specifically where they are located, I am unable to determine the geographical spread of the mark across the UK.

27. I have not been provided with any advertising figures, and the only advertising material provided is the brochure from 2023. Therefore, the advertising evidence only pertains to one year (albeit I do not know when the brochure was created and distributed, and whether this continued into 2024). I also have not been provided with any information as to how many brochures were printed and distributed to consumers in the UK in 2023. Nevertheless, I bear in mind that the brochure evidence confirms that BEIS offers mast climbing platform goods and hiring services which provide mast climbing platform goods across the UK. I have also been provided with significant sales figures in regard to such goods and services, which from 27 June 2019 to 27 June 2024 generated £23,555,000 in turnover, and I have found that these notable sales will all pertain to the UK. Therefore, taking the above into account, I am satisfied that the opponent has shown genuine use of the First Earlier Mark within the relevant period.³

Fair Specification

28. I must now consider whether, or the extent to which, the evidence shows use of the goods and services relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

³ As highlighted by paragraph 1 of Mr Carswell' witness statement, BEIS is a subsidiary of the opponent, and by virtue, its use is consented to by a parent company. Therefore, BEIS' evidence of use shows use of the earlier mark by the parent company, being the opponent, and I note that the applicant has not challenged the validity of this.

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

29. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors*, [2017] EWCA Civ 1834, Kitchin LJ (as he then was) set out the approach to be followed when considering partial revocation of a trade mark. The same approach is relevant when framing a fair specification. He said:

“244. As I described in *Maier v Asos*, the approach to be adopted is relatively straightforward (although I readily acknowledge that it may on occasion be difficult to apply) and it is in my view consistent with the earlier decisions of the Court of Appeal to which I referred at paragraph [63]. On reflection, I think it can be expressed more clearly as follows.

245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. [...] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered.”

30. This approach was approved by the Supreme Court in *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, subject to the proviso that it must be seen in light of more recent guidance by the CJEU that that the essential criterion to apply for the purposes of identifying a coherent subcategory of goods or services capable of being viewed independently is their purpose and intended use (for example, *Ferrari SpA v DU* (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106, at paragraphs 36-53).

31. As per the brochure evidence, I have found that BEIS offers mast climbing platform goods and hiring services which provide mast climbing platform goods. I therefore find that the opponent has shown use of its “access and work platforms” in class 6 and “hiring of access and work platforms” in class 37. In regard to the remaining goods and services listed in Annex 2, I find the opponent has shown no use of such goods and services. I therefore find that a fair specification for the First Earlier Mark is:

Class 6 Access and work platforms.

Section 5(2)(b) - case law

32. 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;⁴

(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.

Comparison of goods and services

33. The parties' competing goods and services are as follows:

Opponent's goods and services	Applicant's goods and services
The First Earlier Mark <u>Class 6</u> Access and work platforms. <u>Class 37</u> Hiring of access and work platforms.	<u>Class 6</u> 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

⁴ That being the interdependency principle.

The Second Earlier Mark <u>Class 6</u> Scaffolding of metal; access platforms [scaffolding] of metal; work platforms [structures]. <u>Class 7</u> Elevators; elevating apparatus; hoists; pulleys. <u>Class 37</u> Scaffolding; rental of construction equipment; hiring of access and work platforms; installation of construction equipment.	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. <u>Class 7</u> 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. <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
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	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. <u>Class 37</u> Building and construction services; Building construction, demolition, maintenance and repair; Commercial 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
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	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; Site preparation [construction]; Supervision of civil engineering and construction projects; information, consultancy and advice in relation to the foregoing. <u>Class 41</u> Arranging, conducting, managing, organising, producing and providing educational events, seminars, workshops, courses and conferences; Arranging and conducting of in-person educational forums and interviews; Creation of educational content; Education and training services; Education and training services in relation to building and construction; Education and training services in
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	relation to the 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; Electronic publication; Electronic publication in the field of building and construction; Provision of training and online information in the field of building and construction; Publication of multimedia material online; Training in the design, development, operation and understanding of building and construction units, sites, apparatus and projects; information, consultancy and advice in relation to the foregoing. <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,
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	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.
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34. When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

35. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

36. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court (“GC”) stated that:

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

37. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

38. 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 OHIM*, Case T-325/06, the GC 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 the responsibility for those goods lies with the same undertaking.”

The parties' pleadings

39. The opponent has only provided submissions in regard to the similarity and identity of the parties' the goods and services in its Statement of Grounds accompanying its Form TM7. On this point, I bear in mind that it is for the opponent to adequately plead its case when filing its Form TM7, which claims the following:

"The goods and services the subject of the Application are either identical or at the very least highly similar to the goods and services protected by the Earlier Marks.

Further, the nature and intended purpose of the goods and services, the subject of the Application, are complementary to the goods and services the subject of the Opponent's Earlier Marks. Moreover, the trade channels for the respective goods and services are the same."

40. The opponent has not provided any submissions in lieu to provide any further detail elaborating upon its very sparse submissions. For the sake of completeness, I bear in mind that in the applicant's Form TM8, they state the following:

"The applicant denies the opponent's ground of opposition raised under section 5(2)(b) of the Trade Marks Act 1994 "the Act"). Specifically, the applicant denies that the opponent's MASTCLIMBERS marks are similar to the applicant's BROGAN MASTCLIMBER mark. The forefront element of the applicant's mark (BROGAN) is highly distinctive, is the only memorable aspect of the applicant's mark, and does not feature in the opponent's marks at all. The only word in common between each party's marks (MASTCLIMBER) is highly descriptive of the goods and services in question, given it is a generic description for a construction platform and is in common use in the construction industry. The applicant will substantiate these claims during the evidence stages. On the above bases, the applicant also denies the opponent's claims that there exists a likelihood of confusion on the part of the public." **(my emphasis)**

41. The need for pleadings to be fully particularised was emphasised by Professor Phillip Johnson, sitting as the Appointed Person, in *SkyClub* Trade Mark, BL O/044/21, paragraphs 23-28. I find that the first sentence of the applicant's statement is clearly a blanket denial. To deny the ground of opposition under section 5(2)(b), the applicant is denying both that the parties' marks are similar, and that its mark is to be **registered for goods or services identical with or similar** to those for which the earlier trade mark is protected. On this basis, whilst the applicant has not made any specific submissions in regard to the goods and services, I find that the blanket denial shows that they disagree with the opponent's submissions that the goods and services are identical or very highly similar.

42. I also note that the applicant's specification is quite lengthy and technical. On this basis, I remind myself of paragraph 28 of the appeal to the Appointed Person in *SMARTX* BL O/0911/24 which states that:

"... it is for the Opponent to put forward the combinations of goods on which it relies for similarity (or identity). If it fails to identify a particular combination, it cannot expect the Hearing Officer to do the job for it. The approach for which Mr Wood contends would place an intolerable burden on Hearing Officers in cases of this nature in which there will be thousands of potential combinations of goods which could be relied on, and for each combination a slightly different argument for similarity could be made. Furthermore, such an approach would be unfair on the Applicant for the mark, since they will have had no opportunity to address points on similarity taken by the Hearing Officer if those points are not first raised by the Opponent."

43. Consequently, I will proceed on the basis that I will only consider the most obvious terms to compare, otherwise, the parties' goods and services will be found to be dissimilar.

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.

44. I find that the applicant's above goods fall within the broader categories of "access and work platforms" in the opponent's First Earlier Mark's specification and "scaffolding of metal", "access platforms [scaffolding] of metal" and "work platforms [structures]" in the opponent's Second Earlier Mark's specification. The goods are identical on the principle outlined in *Meriç*.

Class 7

Hoists.

45. The above term appears identically in in applicant's specification and the Second Earlier Mark's specification.

Building machinery; Construction machines and machine tools; Machine and power-operated tools; Mechanical tools.

46. The opponent's "elevators", "elevating apparatus" and "hoists" in its Second Earlier Mark's specification all fall within the applicant's above broader categories. The goods are identical on the principle outlined in *Meriç*.

Lifting, elevating, handling and hoisting apparatus, equipment, tools, platforms and instruments.

47. The opponent's "hoists" in its Second Earlier Mark's specification falls within the applicant's above broader category. The goods are identical on the principle outlined in *Meriç*. The applicant's above goods also fall within the broader category of

“elevating apparatus” in the Second Earlier Mark’s specification. The goods are identical on the principle outlined in *Meric*.

Cranes; Tower cranes.

48. The applicant’s above goods fall within the broader category of “elevating apparatus” in the Second Earlier Mark’s specification. The goods are identical on the principle outlined in *Meric*.

Aerial platforms for use with cranes and hoists; Attachments for cranes.

49. The applicant’s above goods are types of attachments that can be used on the opponent’s “elevating apparatus” contained in its Second Earlier Mark’s specification. On this basis, I find that the goods will likely overlap in trade channels, and are complementary. However, they do not overlap in method of use and nature. All of the goods are generally used for construction purposes, and will therefore overlap in user. On this basis, I find that the parties’ goods are similar to a medium degree.

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. I note that all of the applicant’s above goods are all types of scaffolding and platforms which are not made of metal. These goods therefore differ in nature to the opponent’s class 6 “access and work platforms” in its First Earlier Mark’s specification,

and its “scaffolding of metal”, “access platforms [scaffolding] of metal” and “work platforms [structures]” in its Second Earlier Mark’s specification. However, all of the goods will overlap in method of use and purpose. I also find that it is likely the goods will overlap in trade channels, all being provided by scaffolding and work platform specialists in the field of construction. The goods are not complementary but they may be in competition (with the user choosing a metal structure over a non-metal structure and vice versa). Therefore, taking the above into account, I find that the goods are similar to between a medium and high degree.

Class 37

Scaffolding.

51. The above term appears identically in applicant’s specification and the Second Earlier Mark’s specification.

Erection, construction, installation, maintenance and repair of scaffolding.

52. I find that the applicant’s above term falls within the broader category of “scaffolding” contained in the opponent’s Second Earlier Mark’s specification. The services are identical on the principle outlined in *Meric*.

Hiring, rental and leasing of construction equipment, apparatus and machinery; Hiring, rental and leasing of scaffolding.

53. The opponent’s “rental of construction equipment” and “hiring of access and work platforms” falls within the applicant’s above broader categories. The services are identical on the principle outlined in *Meric*.

Information, consultancy and advice in relation to the foregoing.

54. In paragraphs 51 to 53 above, I have found that the applicant’s services and the opponent’s “scaffolding” and “rental of construction equipment” services to overlap in trade channels. I therefore consider that with regard to the applicant’s above

information, advice and consultancy services, there may also be an overlap in user and trade channels, with the same undertaking also providing information and advice in relation to these services. For example, a consumer may go to an undertaking for information, advice and consultancy in relation to scaffolding, and by virtue end up purchasing their scaffolding services as well. However, the services do not overlap in nature, method of use or purpose. I also do not consider that the goods and services are in competition or complementary. Consequently, I find that the parties' services are similar, but only to a low degree.

Building and construction services; Building construction, demolition, maintenance and repair; Commercial 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; Fireproofing during construction; General building contractor services; 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; Site preparation [construction]; Supervision of civil engineering and construction projects; information, consultancy and advice in relation to the foregoing.

55. All of the applicant's above services can generally be described as construction services, which encompasses services provided in connection with the construction, repair and alteration of properties. Whilst I note that the opponent's "hiring of access and work platforms" and "scaffolding" services are also used in the field of construction, they enable the construction workers to do their work safely and effectively. Therefore, the opponent's services are likely to be provided by work platform and scaffolding specialists, and the applicant's services would be provided by construction undertakings. I therefore find that the services will not overlap in user, as builders and construction workers would use the opponent's services, and the general

public would use the applicant's construction services. The services are clearly neither in competition nor are they complementary in the way described by the case law cited above. I therefore find them to be dissimilar.

Class 41

Arranging, conducting, managing, organising, producing and providing educational events, seminars, workshops, courses and conferences; Arranging and conducting of in-person educational forums and interviews; Creation of educational content; Education and training services; Education and training services in relation to building and construction; Education and training services in relation to the 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; Provision of training and online information in the field of building and construction; Training in the design, development, operation and understanding of building and construction units, sites, apparatus and projects; information, consultancy and advice in relation to the foregoing.

56. The applicant's above services include and encompass education and training specifically in relation to building and construction. Whilst the opponent's "scaffolding" services in its Second Earlier Marks' specification, and "hiring of access and work platforms" in its First Earlier Marks specification can be generally be described as being in the field of construction, I do not consider that the parties' services are similar. This is on the basis that they clearly differ in nature, method of use and purpose (as the applicant's services are for training and teaching whereas the opponent's services facilitate the construction, repair and alteration of properties). Without any evidence before me, I do not consider that there would be an overlap in trade channels as educational undertakings would provide the applicant's services, and the opponent's services would be provided by work platform and scaffolding specialists. The services are neither in competition nor complementary. Whilst there may be an overlap in user, this is not enough on its own to find similarity. Therefore, I consider that the parties' services are dissimilar.

Electronic publication; Electronic publication in the field of building and construction; Publication of multimedia material online; information, consultancy and advice in relation to the foregoing.

57. Whilst the applicant's above services include and cover electronic publications and multimedia in the field of building and construction, I still do not consider that these services are similar to the opponent's class 37 work platform and scaffolding services. This is on the basis that they clearly differ in nature, method of use and purpose (as the applicant's services are the publication of multimedia materials whereas the opponent's services facilitate the construction, repair and alteration of properties). Without any evidence before me, I do not consider that there would be an overlap in trade channels as publishers would likely provide the applicant's services, and the opponent's services would be provided by work platform and scaffolding specialists. The services are neither in competition nor complementary. Whilst there may be an overlap in user, this is not enough on its own to find similarity. Consequently, I consider that the parties' services are dissimilar.

Class 42

Construction design; Design and research services; Engineering; Engineering design; Planning, design and research of buildings and structures; 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.

58. The applicant's above services can all be generally described as construction design services, and these will be provided by architects and engineers who will create and design buildings, in order for them to be constructed. Without any evidence before me, I do not consider there to be an overlap in trade channels between the applicant's services and the opponent's "hiring of access and work platforms" and "scaffolding" services. As noted above, I consider that the opponent's services would be provided by work platform and scaffolding specialists, whereas the applicant's services would

likely be provided by construction companies which offer design, engineering, project management, and construction services as part of a single package. Therefore, the services do not overlap in user, as builders and construction workers would use the opponent's services, and the general public would use the applicant's construction services. The services clearly do not overlap in nature and method of use, nor do they overlap in purpose as the applicant's services are design based whereas the opponent's services facilitate the construction of a building. The services are neither in competition nor complementary. I find that the parties' services are dissimilar.

Planning, design and research of building and construction apparatus, equipment and machinery; Planning, design and research of products; information, consultancy and advice in relation to the foregoing.

59. The applicant's above services concern the research and development of construction equipment rather than the construction of buildings themselves. On this basis, and without any evidence before me, I do not consider that these services overlap in nature, method of use or purpose with the opponent's class 37 "scaffolding" and "installation of construction equipment" services. I do not consider that the services are in competition nor complementary. If there was an overlap in trade channels and user, I do not consider that this is sufficient to find similarity especially when considering that none of the other *Treat* criteria apply. On this basis, I find that the parties' services are dissimilar.

Environmental assessments, monitoring research, testing and consultancy services; information, consultancy and advice in relation to the foregoing.

40. Without any evidence before me, I do not consider that the applicant's above services are similar to the opponent's class 37 services. I find that specialist environmental undertakings will conduct environmental assessments and provide information and advice in relation to this specialist subject. The opponent's services would be provided by work platform and scaffolding specialists. The services clearly do not overlap in nature, method of use or purpose. The services are neither in competition nor complementary. If there is an overlap in user, this is not enough on its own to establish similarity. I therefore find the parties' services are dissimilar.

41. It is a prerequisite of section 5(2)(b) that the goods and services be identical or at least similar. The opposition will, therefore, fail in respect of the services that I have found to be dissimilar.⁵ The opposition under section 5(2)(b) fails for the following:

Class 37 Building and construction services; Building construction, demolition, maintenance and repair; Commercial 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; 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; Site preparation [construction]; Supervision of civil engineering and construction projects; Information, consultancy and advice in relation to the foregoing.

Class 41 Arranging, conducting, managing, organising, producing and providing educational events, seminars, workshops, courses and conferences; Arranging and conducting of in-person educational forums and interviews; Creation of educational content; Education and training services; Education and training services in relation to building and construction; Education and training services in relation to the erection, construction, installation, maintenance and repair of pre-fabricated buildings, aerial platforms, formwork, platform staging, ramps,

⁵ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

staircases, ladders, beams, work platforms, access platforms, boards, canopies, cladding, frameworks, and towers; Electronic publication; Electronic publication in the field of building and construction; Provision of training and online information in the field of building and construction; Publication of multimedia material online; Training in the design, development, operation and understanding of building and construction units, sites, apparatus and 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.

The average consumer and the nature of the purchasing act

42. 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: *Lloyd Schuhfabrik Meyer*, Case C-342/97. 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.

43. The average consumer for the goods and services will be professionals who work in the building or construction industry and the general public. The cost of purchase is likely to vary. The frequency of the purchase is also likely to vary, although it is unlikely to be particularly regular. I bear in mind that the average consumer will take various factors into consideration such as the material of the goods, durability, quality, cost, reputational standing of the provider, health and safety certifications, and the suitability of the goods and services for their specific needs. I therefore find that between a medium and high degree of attention will be paid during the purchasing process.

44. The goods are likely to be purchased via a website or signage on a physical premises of construction specialists. The services are likely to be purchased on the physical premises (or via the website) of work platform and scaffolding specialists. The goods and services may also be purchased following the perusal of advertisements. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase through advice sought from a sales assistant, or via recommendations given through word-of-mouth.

Comparison of the trade marks

45. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

47. I bear in mind that the opponent is relying upon 2 earlier marks, and therefore, I shall need to conduct a marks comparison for both. I shall start by comparing the opponent's First Earlier Mark and the applicant's mark.

The First Earlier Mark and the applicant's mark

Opponent's First Earlier Mark	Applicant's trade mark
MASTCLIMBERS	BROGAN MASTCLIMBER

48. The First Earlier Mark consists of the word “MASTCLIMBERS”. There are no other elements to contribute to the overall impression which lies in the word itself.

49. The applicant's mark consists of the words “BROGAN MASTCLIMBER”. As I will come to discuss in the conceptual comparison, I find that the word “MASTCLIMBER” is allusive of the applicant's goods and services, and therefore, the word “BROGAN” at the beginning of the mark, plays a greater role in the overall impression.

50. Visually, the opponent's “MASTCLIMBERS” mark is the plural version of the word “MASTCLIMBER” which appears at the end of the applicant's mark. This acts as a visual point of similarity. However, the applicant's mark begins with the word “BROGAN”, a position to which the average consumer usually pays more attention.⁶ This acts as visual points of difference. I therefore find that the parties' marks are visually similar to at least a medium degree.

51. Aurally, the word “MASTCLIMBERS” in the opponent's mark will likely be pronounced as MAST-CLIMB-ERS. The word “BROGAN” at the beginning of the applicant's mark will likely be pronounced as BRO-GAN, and the word “MASTCLIMBER” at the end of the mark will likely be pronounced as MAST-CLIMB-ER. Therefore, on the basis that the parties' marks overlap in the pronunciation of the words MASTCLIMBERS and MASTCLIMBER (the only aural difference between these elements being the letter “S” at the end of the opponent's word) I find that as a whole, the marks are aurally similar, to at least a medium degree.

⁶ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

52. Conceptually, I note that neither party has not provided any evidence or submissions as to the meaning of the words MASTCLIMBERS and MASTCLIMBER. However, I note that both words are composed of two ordinary dictionary words, that being “MAST” and “CLIMBER(S)”. I remind myself that the average consumer will break down the parties marks’ into verbal elements which suggest a concrete meaning or which resemble words known to them.⁷ I therefore find that the ordinary dictionary words “MAST” and “CLIMBER(S)” will be recognised and seen by the average consumer within both of the parties’ marks.

53. The opponent submits that the word MASTCLIMBERS/MASTCLIMBER dominates in each of the respective marks.⁸ The applicant submits that the common element between the parties’ marks, that being MASTCLIMBER, “is highly descriptive of the goods and services in question”. However, the applicant does not provide any further reasoning or supporting evidence as to why the word MASTCLIMBER is descriptive. I bear in mind that in *LIGHT VITAMIN* (word mark) BL O/1174/25, Mr Thomas Mitcheson KC sitting as the Appointed Person stated that the assessment of a conceptual meaning should take place with reference to the parties’ goods and services where there is a potential link between the conceptual meaning of the mark and the goods and services to which it is affixed. In this instance, I find that the average consumer, being both professionals and the general public, will recognise the ordinary dictionary words “mast” and “climber”/“climbers” in the parties’ marks, and are therefore likely to understand the words “MASTCLIMBERS” and “MASTCLIMBER” to mean a person or people who climb masts (a mast being a tall vertical pole used as structural support). I bear in mind that this meaning is not descriptive of the parties’ goods and services. However, I find that it is allusive of the parties’ goods and services, which would include the erection of platforms and scaffolding, consisting of tall vertical poles used for structural support for buildings.

54. In its counterstatement, the applicant states that the word “BROGAN” “is highly distinctive” and “is the only memorable aspect of the applicant’s mark, and does not feature in the opponent’s marks at all”. The opponent does not provide any

⁷ *Usinor SA v OHIM*, Case T-189/05

⁸ Paragraph 5 of the opponent’s statement of grounds.

submissions as to the meaning conveyed by the word “BROGAN” in the applicant’s mark. However, I consider that a significant proportion of average consumers will likely see the word “BROGAN” as an invented term which evokes no conceptual meaning. I also find it likely that a significant proportion of consumers may see the word “BROGAN” being an unusual forename or surname, and therefore, this element will indicate that “BROGAN” (being a person or family) owns “MASTCLIMBER”. However, regardless of whether the average consumer will see the word “BROGAN” denoting an unusual name or being an invented word, I find that both meanings are neither allusive nor descriptive of the applicant’s goods and services.

55. Taking the above into account, the parties’ marks clearly share the allusive words “MASTCLIMBERS” and “MASTCLIMBER”, the only difference between these words being the letter “S” at the end of the First Earlier Mark (making it the plural version of MASTCLIMBER). I therefore find that these elements create a conceptual point of similarity between the marks.

The Second Earlier Mark and the applicant’s mark

Opponent’s Second Earlier Mark	Applicant’s trade mark
MASTCLIMBERS BY BRAND > <u>SAFWAY</u>	BROGAN MASTCLIMBER

56. The opponent’s mark consists of the word “MASTCLIMBERS”, with the “MAST” element presented in a thick black capitalised typeface, and the “CLIMBERS” element presented in a thick red capitalised typeface. This word as a whole is presented at the top of the mark in a larger typeface, and underneath is the wording “BY BRAND > SAFWAY”, all presented in a smaller grey capitalised typeface. Whilst the opponent submits that an “upside down division sign” separates the “BY BRAND” and “SAFWAY” elements, I do not consider that the average consumer will recognise this element as such. They are more likely to see the wording separated and underlined

by a decorative abstract shape. For reasons I shall come to discuss in the conceptual comparison, I find that the word “MASTCLIMBERS” is allusive of the opponent’s goods and services, and therefore will play an equal role with the wording “BY BRAND SAFWAY” in the overall impression of the mark. However, the stylisation of the opponent’s mark will play a lesser role.

57. The applicant’s mark consists of the words “BROGAN MASTCLIMBER”. As I will come to discuss in the conceptual comparison, I find that the word “MASTCLIMBER” is allusive of the applicant’s goods and services, and therefore, the word “BROGAN” at the beginning of the mark, plays a greater role in the overall impression.

58. Visually, the word “MASTCLIMBER” at the end of the applicant’s mark appears in a plural form at the beginning of the opponent’s mark (“MASTCLIMBERS”). This acts as a visual point of similarity. However, the opponent’s mark ends with the wording “BY BRAND SAFWAY”, which is presented in a capitalised black, grey and red typeface, and the applicant’s mark begins with the word “BROGAN”, a position to which the average consumer usually pays more attention.⁹ These all act as visual points of difference. I therefore find that the parties’ marks are visually similar to between a low and medium degree.

59. Aurally, the words “BY” and “BRAND” in the opponent’s mark will be given their ordinary dictionary pronunciation. The word “MASTCLIMBERS” in the opponent’s mark will likely be pronounced as MAST-CLIMB-ERS and the word “SAFWAY” at the end of the mark will likely be pronounced as SAF-WAY. The decorative element in the opponent’s mark will not be articulated. The word “BROGAN” at the beginning of the applicant’s mark will likely be pronounced as BRO-GAN, and the word “MASTCLIMBER” at the end of the mark will likely be pronounced as MAST-CLIMB-ER. Therefore, on the basis that the marks overlap in the pronunciation of the words MASTCLIMBERS and MASTCLIMBER (the only aural difference between these elements being the letter “S” at the end of the opponent’s word) I find that as a whole, the opponent’s and applicant’s marks are aurally similar, but only to between a low and medium degree.

⁹ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

60. Conceptually, as highlighted above, the words MASTCLIMBERS and MASTCLIMBER are composed of two ordinary dictionary words, that being “MAST” and “CLIMBER(S)”, which will be recognised and seen by the average consumer within both of the parties’ marks. This is particularly highlighted within the opponent’s Second Earlier Mark where the word “MAST” is presented in a bold black typeface and the word “CLIMBER” is presented in a thin red typeface (differentiating and separating the 2 words).

61. As noted above, as a whole, the average consumer is likely to understand the words “MASTCLIMBERS” and “MASTCLIMBER” to mean a person or people who climb masts (a mast being a tall vertical pole used as structural support). I bear in mind that this meaning is not descriptive of the parties’ goods and services. However, I find that it is allusive of the parties’ goods and services, which would include the erection of platforms and scaffolding, consisting of tall vertical poles used for structural support for buildings.

62. I consider that a significant proportion of average consumers will likely see the word “BROGAN” as an invented term which evokes no conceptual meaning. I also find it likely that a significant proportion of consumers may see the word “BROGAN” being an unusual forename or surname, and therefore, this element will indicate that “BROGAN” (being a person or family) owns “MASTCLIMBER”. However, regardless of whether the average consumer will see the word “BROGAN” denoting an unusual name or being an invented word, I find that both meanings are neither allusive nor descriptive of the applicant’s goods and services.

63. The “BY BRAND SAFWAY” element at the end of the opponent’s mark will evoke to the consumer that “MASTCLIMBER” is owned by the brand “SAFWAY”. The decorative element and stylisation of the opponent’s mark will not evoke any meaning to the average consumer. Therefore, on the basis that the words “MASTCLIMBERS” and “MASTCLIMBER” in the parties’ marks is allusive of the parties’ goods and services, and that the only difference between these elements is that it is the plural version within the opponent’s mark, I find that these elements create a conceptual point of similarity between the marks.

Distinctive character of the earlier trade mark

64. 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 C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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 promotion of 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).”

65. 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 services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

66. I will begin by assessing the inherent distinctive character of the opponent's First and Second Earlier Marks.

67. The average consumers for the opponent's goods and services will recognise the ordinary dictionary words "mast" and "climbers" in "MASTCLIMBERS", and will therefore understand it to mean people who climb masts. Whilst this is not directly descriptive of the opponent's goods and services, I find that it is allusive of them, as it these goods and services include scaffolding equipment, work platforms and the rental of construction equipment and work platforms, all of which consists of vertical poles which are used for the structural support of buildings (i.e. masts).

68. Therefore, as a whole, I find that the First Earlier Mark is inherently distinctive to between a low and medium degree.

69. The "BY BRAND SAFWAY" element at the end of the Second Earlier Mark will evoke to the consumer that "MASTCLIMBER" is owned by the brand "SAFWAY". The decorative element and stylisation of the opponent's mark will not evoke any meaning. I therefore find that as a whole, the opponent's mark is inherently distinctive to no more than a medium degree.

70. I will now assess whether the evidence filed by the opponent is sufficient to demonstrate enhanced distinctiveness. The relevant market for assessing this is the UK market.

71. I have summarised the evidence filed by the opponent in paragraphs 18 to 23 above. I have also noted that it encounters significant deficiencies. For example, I have not been provided with any advertising expenditure and I have only been provided with one piece of advertising evidence, that being the 2023 brochure. Mr Carswell has not provided any information as to when the 2023 brochure was created and distributed. I also do not have any information before me as to how many brochures were printed and distributed, or if the brochure continued to be distributed into and throughout 2024. I am therefore unable to determine how many UK consumers were exposed to BEIS' advertising. Furthermore, I have not been provided with any invoice evidence, or evidence in regard to the units of goods sold and services provided. This evidence would have allowed me to determine the price of the goods and services sold to consumers, as well as the geographical spread of BEIS' customers across the UK. Moreover, the opponent has not provided any evidence of its market share. I find that

the goods and services are likely to be very expensive, and therefore, based on the turnover provided, I find that it would only amount to a small proportion of the construction market (which I consider to be a large sector). Therefore, taking all of the above into account, I do not consider the evidence sufficient to establish enhanced distinctiveness.

Likelihood of confusion

72. 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. Nevertheless, the 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, as listed in paragraph 36 above.

The First Earlier Mark and the applicant's mark

73. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually and aurally similar to at least a medium degree.
- I have found the allusive “MASTCLIMBERS” and “MASTCLIMBER” elements create a conceptual point of similarity between the parties’ marks.
- I have found the First Earlier Mark to be inherently distinctive to between a low and medium degree.
- I have identified the average consumer of the goods and services to be professionals who work in the building or construction industry and the general

public, who will select the goods and services primarily by visual means, although I do not discount an aural component.

- I have concluded that between a medium and high degree of attention will be paid during the purchasing process.
- I have found the parties' goods and services to range from being identical to similar to a low degree.

74. Taking all of the above into account, bearing in mind the interdependency principle and the principle of imperfect recollection, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other. I do not consider that the average consumer for the parties' goods and services, paying between a medium and high degree of attention during the purchasing process, would overlook the word "BROGAN" at the beginning of the applicant's mark. This is especially the case as the "BROGAN" element plays an equal role in the overall impression, and is placed at the beginning of the mark, a position which tends to make more of an impact than its ends. I therefore do not consider there to be a likelihood of direct confusion.

75. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C. sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10:

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

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

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

76. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

77. As highlighted above, Mr Purvis Q.C. in *L.A. Sugar Limited* sets out that there are three main categories of indirect confusion, and that indirect confusion 'tends' to fall in one of them. I note that the opponent has not stated specifically what category this case would fall within or suggested any alternative way in which indirect confusion might arise between the parties' marks. However, for the sake of completeness, I will go through each category.

78. As noted above, I found that the “MASTCLIMBER”/“MASTCLIMBERS” elements in the parties’ marks will evoke the meaning of a person or people who climb masts. I have found that this meaning is allusive of the parties’ goods and services, which would include the erection and hire of scaffolding and work platforms, consisting of tall vertical poles used for structural support for buildings. On this basis, the shared common element is not 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. Therefore, category (a) is not satisfied.

79. Category (b) from *L.A. Sugar* is where the later mark simply adds a non-distinctive element to the earlier mark. For this category to be satisfied, the opponent’s mark as a whole would need to be reproduced, with an addition of a non-distinctive element. However, the word “BROGAN” which appears at the beginning of the applicant’s mark is not a non-distinctive element. This element will be recognised as an invented word or an unusual forename/surname, neither of which convey meanings which are descriptive or allusive of the parties’ goods and services. I have also found that this word plays an equal role in the overall impression of the applicant’s mark. Therefore, this category is also not satisfied.

80. Lastly, category (c) is where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension. In this case, both marks overlap in the “MASTCLIMBER” element, the only difference being that this word is plural in the opponent’s Second Earlier Mark; “MASTCLIMBERS”. I have found this element to be allusive of the parties’ goods and services. The parties’ marks also differ in the word “BROGAN” which is placed at the beginning of the applicant’s mark. The word “BROGAN” is neither allusive nor descriptive of the parties’ goods and services, as it will be seen as an unusual name or an invented word, and it plays an equal role in the overall impression of the mark. I therefore do not consider that the applicant’s “BROGAN MASTCLIMBER” mark is an obvious or logical brand extension of the opponent’s “MASTCLIMBERS” brand. I have also given thought to the *Medion*¹⁰ principle and whether it can apply to the present case. On this point, I remind myself of the comments of Arnold J (as he then was) at

¹⁰ *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04

paragraph 20 in the case of *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch) wherein he set out that the *Medion* principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. However, as noted above, the “MASTCLIMBER” and “MASTCLIMBERS” elements in the parties’ marks is allusive of the parties’ goods and services. On this basis, the word “MASTCLIMBER” cannot have distinctive significance independent of the applicant’s mark as a whole. Again, I find that the third category is not satisfied.

81. I bear in mind that the examples above set out by Mr Purvis Q.C. are not exhaustive. However, I do not consider that there are any other logical examples of how the applicant’s mark could be indirectly confused with the opponent’s First Earlier Mark and the opponent has not suggested any. I consider that having noticed that the trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. As highlighted above, the marks are not natural variants or brand extensions of each other. Even if the First Earlier Mark is brought to mind by the applicant’s mark, this is mere association, not confusion: see *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81. I consider there is no likelihood of indirect confusion.

The Second Earlier Mark and the applicant’s mark

82. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually and aurally similar to between a low and medium degree.
- I have found the allusive “MASTCLIMBERS” and “MASTCLIMBER” elements create a conceptual point of similarity between the parties’ marks.
- I have found the Second Earlier Mark to be inherently distinctive to no more than a medium degree.
- I have identified the average consumer of the goods and services to be professionals who work in the building or construction industry and the general

public, who will select the goods and services primarily by visual means, although I do not discount an aural component.

- I have concluded that between a medium and high degree of attention will be paid during the purchasing process.
- I have found the parties' goods and services to range from being identical to similar to a low degree.

83. Taking all of the above into account, bearing in mind the interdependency principle and the principle of imperfect recollection, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other. I do not consider that the average consumer for the parties' goods and services, paying between a medium and high degree of attention during the purchasing process, would overlook the word "BROGAN" at the beginning of the applicant's mark, a position which tends to make more of an impact than its ends. I also do not consider that the average consumer for the goods and services would overlook the wording "BY BRAND SAFWAY" at the end of the opponent's Second Earlier Mark. This is especially the case as the "BROGAN" and "BY BRAND SAFWAY" elements play an equal role in the overall impression of the parties' marks, and these elements clearly create visual, aural and conceptual points of difference. I therefore do not consider there to be a likelihood of direct confusion.

84. In regard to a likelihood of indirect confusion, as noted above, I found that the "MASTCLIMBER"/"MASTCLIMBERS" elements in the parties' marks will evoke the meaning of a person or people who climb masts. I have found that this meaning is allusive of the parties' goods and services, which would include the erection of scaffolding and work platforms, consisting of tall vertical poles used for structural support for buildings. I therefore find that, again, the common element is not so strikingly distinctive that the average consumer would assume that no-one else, but the brand owner, would be using it. Therefore, category (a) is not satisfied.

85. The opponent's "MASTCLIMBERS BY BRAND SAFWAY" mark has not been reproduced as a whole in the applicant's mark, with an addition of a non-distinctive element. Therefore, category (b) is not also satisfied.

86. I also find that changing the words “BY BRAND SAFWAY” which appear at the end of the opponent’s mark, to “BROGAN” which is placed at the beginning of the applicant’s mark, is not an obvious or logical brand extension, or a logical sub-brand of one another. As noted above, the elements “BY BRAND SAFWAY” and “BROGAN” play an equal role in the overall impression of the parties’ marks. For those consumers who would see the word “BROGAN” in the applicant’s mark as being an invented word, there is no conceptual connection to the wording “BY BRAND SAFWAY” in the opponent’s mark which indicates that “MASTCLIMBERS” is a brand owned by “SAFWAY”. For those consumers who see the word “BROGAN” as being an unusual forename or surname, whilst this name indicates that “MASTCLIMBER” is owned by “BROGAN”, without any indication that the brand “SAFWAY” and the invented word or the unusual name “BROGAN”, are interlinked or related, I find that the applicant’s mark is a step too-far removed from being an obvious or logical brand extension, or a logical sub-brand of the opponent’s mark. Moreover, I do not consider that the *Medion* principle applies in this case, as the word “MASTCLIMBERS” is allusive and therefore cannot have distinctive significance independent of the Second Earlier Mark and the applicant’s as a whole. Therefore, I do not consider that category (c) is satisfied.

87. I bear in mind that the examples above set out by Mr Purvis Q.C. are not exhaustive. However, I do not consider that there are any other logical examples of how the applicant’s mark could be indirectly confused with the opponent’s Second Earlier Mark and the opponent has not suggested any. I consider that having noticed that the trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. As highlighted above, the marks are not natural variants or brand extensions of each other. Even if the Second Earlier Mark is brought to mind by the applicant’s mark, this is mere association, not confusion: see *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81.

88. Taking all of the above into account, I consider there is no likelihood of indirect confusion.

89. The opposition under section 5(2)(b) fails.

Section 5(3)

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

“5(3) A trade mark which –

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

91. Section 5(3A) of the Act states:

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

92. 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* and Case C-323/09, *Marks and Spencer v Interflora* and 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 Saloman*, paragraph 29 and *Intel*, paragraph 63.

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

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

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77 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 proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

93. The conditions of section 5(3) are cumulative. Firstly, the First Earlier Mark and applicant's mark must be identical or similar, and I have discussed their level of similarity in paragraphs 50 to 55 above. Secondly, the opponent must show that its First Earlier Mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must have established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the opponent's First Earlier Mark being brought to mind by the later mark. Fourthly, assuming that the first, second and third conditions have been met, section 5(3) requires that one or more types of damage claimed 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. The relevant date for the assessment under section 5(3) is the date of application of the applicant's mark i.e. 27 June 2024.

Reputation

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

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

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

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

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

95. In determining whether the opponent has demonstrated a reputation for the goods in issue, it is necessary for me to consider whether its mark will be known by a significant part of the public concerned with the goods and services. In reaching this decision, I must take all of the evidence into account including "the market share held by the trade mark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertakings in promoting it."

96. Earlier in my decision, I found that the distinctive character of the opponent's First Earlier Mark had not been enhanced through use. I recognise that reputation is not the same as enhanced distinctive character, but the same factors are to be taken into account in both assessments.¹¹

97. As noted above, I have not been provided with any advertising expenditure, and the singular example of advertising, being the 2023 brochure, is not accompanied with any further information such as when the brochure was created and distributed, and how many were distributed to UK consumers. I am therefore unable to determine how many UK consumers were exposed to BEIS' advertising before the relevant date.

¹¹ *O2 Worldwide Limited v CX02.COM (UK) Limited*, BL O/393/19, paragraph 39

Furthermore, I have not been provided with any invoice evidence showing the sale of BEIS' goods and services, and I do not have any evidence in regard to the units of goods sold and services provided. Without the invoice evidence, or further submissions from the opponent, I am unable to determine the geographical spread of BEIS' customers across the UK.¹² Nor am I able to determine the price of BEIS' goods and services, albeit I consider it is reasonable to infer that they are likely to be relatively expensive. The opponent has not provided any evidence of its market share, and therefore based on the turnover alone,¹³ I find that it would only amount to a small proportion of the construction market (which I consider to be a large sector). Therefore, the evidence is, for the reasons set out above, insufficient to establish a reputation in the UK. On this basis, without having found a reputation, the opposition based upon section 5(3) fails.

Section 5(4)(a)

98. 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”.

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

¹² As noted above, I am only able to determine that one of the top five customers is based in Glasgow.

¹³ As I have not been provided with the invoice evidence, or evidence such as the price of BIES' goods and services.

“(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.”

100. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

Relevant date

101. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of s.5(4)(a) of the Act and stated as follows:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows: ‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before

the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.”

102. As the applicant has filed no evidence of use of its mark, I have only the prima facie relevant date to consider i.e. 27 June 2024.

Goodwill

103. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in customers. It is the one thing which distinguishes an old-established business from a new business at its first start.”

104. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application* (OVAX) (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; 54 evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

105. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

106. Goodwill arises as a result of trading activities, and I have been provided with BEIS' sales figures from 27 June 2019 to 27 June 2024 which amounted to £23,555,000. To support this, I have been provided with a brochure from 2023, which shows that BEIS' provides mast climbing platform goods and hiring services which provide climbing platform goods to construction companies. I bear in mind that the brochure is the only advertising evidence provided,¹⁴ and that it is unclear when it was produced and distributed, and how many were seen by UK consumers. Nevertheless, as per the brochure evidence, which confirms that MASTCLIMBERS has bases in both Manchester and Glasgow, covering the “whole of the United Kingdom [...] for vertical mechanical access solutions”, I am able to infer that the list of BEIS' top 5 clients are all based in the UK.¹⁵ The brochure also establishes that the MASTCLIMBERS brand

¹⁴ I also note that I have not been provided with any advertising expenditure.

¹⁵ With City Building (Glasgow) LLP most likely based in Glasgow.

is backed by “one of the world’s leading global access providers, BrandSafway”. All of the above is supported by the following extracts from the back of the 2023 brochure, which states that:

The copyright in these materials (or instructions for assembly and use) belongs to Brand Energy and Infrastructure Services UK, Ltd. (Brand Industrial Services, Inc., known as BrandSafway). All the trademarks named in these materials (or instructions for assembly and use) are the property of Brand Energy and Infrastructure Services UK, Ltd., unless marked as third-party rights or identifiable as such in another way.

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107. I bear in mind that there is no reference to the opponent, that being Brand Energy Holdings B.V., in the above extract, or anywhere else within the evidence. The website evidence exhibited in **BC1** and **BC4** are screenshots from BEIS’ website (www.beis.com) and **exhibits BC2** and **BC3** again refer to BEIS being an IPAF member. The only reference to the opponent within Mr Carswell’s evidence, is in paragraph 1, which confirms that BEIS is a subsidiary of the opponent.

108. The evidence therefore shows that use of the MASTCLIMBERS sign was by BEIS and not by the opponent. On this basis, any goodwill generated would be vested in the company BEIS. Therefore, taking all of the above into account, I find that the section 5(4)(a) case fails as I have not been provided with any evidence proving the existence of any protectable level of goodwill in the opponent and its MASTCLIMBERS sign at the relevant date.

109. However, I shall nonetheless proceed as if the evidence filed does show a small level of protectable level of goodwill in the opponent (which would have been the opponent’s best case based on the limited evidence filed), and its MASTCLIMBERS sign at the relevant date. However, that being said, I find that this ground would not put the opponent in any stronger position than its section 5(2)(b) case.

110. I recognise that the test for misrepresentation is different from that for likelihood of confusion in that it entails “deception of a substantial number of members of the public” rather than “confusion of the average consumer”. However, as recognised by Lewison L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that to be the case here.

111. Under section 5(4)(a), the opponent relies upon its MASTCLIMBERS sign, which mirrors the opponent’s First Earlier Mark that it relies upon under section 5(2)(b). The evidence that the opponent relies upon for section 5(4)(a) is also the same evidence as summarised in paragraphs 18 to 23 above.

112. Therefore, even proceeding on the basis that the opponent had a small level of protectable goodwill, and that the sign relied upon was distinctive of that goodwill (which represents the opponent’s best case), I consider that the differences between the opponent’s sign and the applicant’s mark are sufficient to avoid a substantial number of the opponent’s customers and potential customers purchasing the applicant’s goods and services in the mistaken belief that they are provided by the opponent’s business. As I have found there is no misrepresentation, there can be no damage.

113. The opposition under section 5(4)(a) is unsuccessful.

CONCLUSION

114. The opposition is unsuccessful, and the application may proceed to registration.

COSTS

115. 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. In the circumstances, I award the applicant the sum of **£250** as a contribution towards the costs of the proceedings, in which they only had to consider the opponent’s Notice of opposition and prepared a counterstatement.

116. I therefore order Brand Energy Holdings B.V. to pay Brogan Group Holdings Ltd the sum of £250. This sum is to 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 29th day of July 2026

L FAYTER

For the Registrar

ANNEX 1

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

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.

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; Commercial 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; Site preparation [construction]; Supervision of civil engineering and construction projects; information, consultancy and advice in relation to the foregoing.

Class 41

Arranging, conducting, managing, organising, producing and providing educational events, seminars, workshops, courses and conferences; Arranging and conducting of in-person educational forums and interviews; Creation of educational content; Education and training services; Education and training services in relation to building and construction; Education and training services in relation to the 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; Electronic publication; Electronic publication in the field of building and construction; Provision of training and online information in the field of building and construction; Publication of multimedia material online; Training in the design, development, operation and understanding of building and construction units, sites, apparatus and 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.

ANNEX 2

The First Earlier Mark

Class 6

Scaffolding of metal; pulleys; access and work platforms.

Class 7

Elevators; elevating apparatus; hoists.

Class 37

Scaffolding; rental of construction equipment; hiring of access and work platforms; handling of building materials.

The Second Earlier Mark

Class 6

Scaffolding of metal; access platforms [scaffolding] of metal; work platforms [structures].

Class 7

Elevators; elevating apparatus; hoists; pulleys.

Class 37

Scaffolding; rental of construction equipment; hiring of access and work platforms; installation of construction equipment.