

BL o/0923/23

TRADE MARKS ACT 1994
CONSOLIDATED PROCEEDINGS

IN THE MATTER OF

TRADE MARK APPLICATION NOS: 3761090, 3761083, 3761097 AND 3761073

BY THE MCAVOY GROUP LIMITED

TO REGISTER THREE SERIES OF TRADE MARKS:

Series mark 1: **SMARTCARE**

Series mark 2: **SMART CARE**

Series mark 1: **SMARTCLASS**

Series mark 2: **SMART CLASS**

Series mark 1: **SMARTBUSINESS**

Series mark 2: **SMART BUSINESS**

AND TO REGISTER THE TRADE MARK:

SMARTSPACE

ALL IN CLASSES 6, 19, 37, 39, 42 AND 43

-AND-

THE OPPOSITIONS THERETO UNDER NOS.

434374, 434379, 435253 AND 435255

BY SMART OFFICES LIMITED

Background and pleadings

1. These proceedings concern four UK trade mark applications by The McAvoy Group Limited (“**the Applicant**”). Details of the applications are set out below:

The ‘090’ application	
Representation of the marks:	Series mark 1: SMARTCARE Series mark 2: SMART CARE
Trade mark application No.:	3761090
Type of mark:	Word mark
Filing date:	2 March 2022
Date of publication in the Trade Marks Journal:	18 March 2022

The ‘083’ application	
Representation of the marks:	Series mark 1: SMARTCLASS Series mark 2: SMART CLASS
Trade mark application No.:	3761083
Type of mark:	Word mark
Filing date:	2 March 2022
Date of publication in the Trade Marks Journal:	18 March 2022

The ‘097’ application	
Representation of the marks:	Series mark 1: SMARTBUSINESS Series mark 2: SMART BUSINESS
Trade mark application No.:	3761097
Type of mark:	Word mark
Filing date:	2 March 2022
Date of publication in the Trade Marks Journal:	27 May 2022

The '073' application	
Representation of the mark:	SMARTSPACE
Trade mark application No.:	3761073
Type of mark:	Word mark
Filing date:	2 March 2022
Date of publication in the Trade Marks Journal:	27 May 2022

2. The above applications are all in respect of goods and services in Classes 6, 19, 37, 39, 42 and 43 and the specifications for all four applications are identical to each other. The applied-for goods and services are set out in their entirety at my paragraph 19, they include, inter alia:

Class 6

Common metals and their alloys; metal building materials; transportable buildings of metal; portable mobile metal office buildings; prefabricated building components [metal].

Class 19

Non-metallic building materials; non-metallic transportable buildings; prefabricated building elements (Non-metallic -) for on site assembly; prefabricated non-metallic constructions.

Class 37

Building construction; building services; repair and installation services of non-metallic transportable buildings, prefabricated building components (Non-metallic -), prefabricated non-metal buildings; erection of prefabricated buildings and structures.

Class 39

Transport; packaging and storage of goods; Rental of containers for warehousing and storage; rental of portable storage containers; rental of storage containers;

rental of storage facilities; rental of storage space; rental of storage units; storage containers (Rental of -); storage units (Rental of -).

Class 42

Architectural design services; Professional engineering management.

Class 43

Rental of portable buildings; temporary accommodation; rental of accommodation [temporary]; rental of buildings and temporary office space.

3. Smart Offices Limited (“**the Opponent**”) opposed the ‘090’ and ‘083’ applications on 20 June 2022 (opposition numbers 434374 and 434379 respectively); and the ‘097’ and ‘073’ applications on the 25 July 2022 (opposition numbers 435253 and 435255 respectively), under section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”).¹ The oppositions are directed at all the applied-for goods and services.

4. The oppositions are based on the Opponent’s earlier UK trade mark shown below,² which is registered in respect of goods and services in Classes 6, 19, 35, 37, 40 and 42:³

Representation of the mark:	SMART
Trade mark registration No.:	3290668
Type of mark:	Word mark
Filing date:	16 February 2018
Registration date:	10 July 2020

5. For the purposes of the oppositions, the Opponent relies on all the goods and services for which its earlier mark is registered, these are as follows:

¹ The Opponent had additionally pleaded sections 5(3) and 5(4)(a) of the Act as grounds for its oppositions. However, these pleadings were subsequently struck out as the Opponent chose not to file evidence in support of those grounds. The oppositions therefore proceeded under section 5(2)(b) only.

² The Opponent’s mark is an earlier trade mark in accordance with section 6 of the Act. As it had not been registered for a period of more than five years at the filing dates of the applications, it is not subject to the use requirements under section 6A of the Act.

³ The Opponent had originally relied on two additional earlier rights, both of which had been registered for a period of more than five years at the filing dates of the applications. As such, the Applicant put the Opponent to proof of use of those registrations. The Opponent subsequently chose not to file evidence to prove use, therefore those earlier registrations were struck out because the use conditions under section 6A of the Act could not be met.

Class 6

Re-locatable buildings of metal; transportable metallic buildings; prefabricated metal buildings; all of the aforesaid being transportable garden offices.

Class 19

Garden office buildings, office buildings, studios, summer houses; all of the aforesaid being transportable garden offices.

Class 35

Retail services in relation to floor coverings; retail services in relation to wall coverings; retail services in relation to furnishings; retail services in relation to construction equipment; retail services in relation to furniture; retail services in relation to transportable garden office buildings; wholesale services in relation to floor coverings; wholesale services in relation to wall coverings; wholesale services in relation to furnishings; wholesale services in relation to furniture; wholesale services in relation to transportable garden offices; advisory, consultancy and information services in relation to the aforesaid services, all being related to transportable garden offices.

Class 37

Building services; carpentry services; building construction and repair; building and construction of interlocking socketed chassis and frameworks for buildings, prefabricated buildings, garden office buildings, office buildings, studios, summer houses and/or residential accommodation units; supervision of building construction and repair; supervision of building work; custom construction of buildings; residential and commercial building construction; on site project management relating to the construction of buildings; building conversion work and new build work; general building contractor services; erection of prefabricated buildings; assembly of prefabricated houses; construction works for prefabricated houses; assembling (installation) of building framework; building inspection (in the course of building construction); drilling of wells; maintenance and repair of buildings, parts and fittings for buildings and utilities of buildings; property

development (construction); land development services for housing and commercial use; residential property development; commercial property development; wiring of buildings for telecommunication transmission; supervision of the engineering of buildings; services for the painting and decorating of buildings; services for the redecoration of buildings; damp-proofing (building); application of protective coatings to building exteriors; application of protective coatings to building surfaces; application of rendering to buildings; application of protective paint to buildings; sealing of buildings during construction; building sealing; proofing of buildings against pest and vermin access; prevention of dust ingress to buildings; prevention and correction of building subsidence; cleaning services; interior and exterior cleaning of buildings; insulating of buildings; insulation construction; detection of leaks within buildings; detection of draughts in buildings; installation of interior partitions for buildings; installation of fittings for buildings; specialist building restoration; refurbishment of buildings; repair and maintenance of building scaffolds, working and building platforms; dismantling of buildings; demolition of buildings; installation of electric appliances, alarms, burglar alarms, fire alarms, fire detection systems, safes and security systems; installation of bedrooms, kitchens, kitchen equipment, bathrooms and bathroom equipment; installation of access control systems; installation of flood warning systems; installation, changing, replacement and repair of locks; installation of apparatus for heating, lighting, air conditioning, central heating; installation of electronic and computerised systems for monitoring energy efficiency and usage; installation of environmental engineering systems; installation of pipework systems, sewers, drains, pipes and washroom apparatus; installation of lifts and elevators; computer hardware and telecommunication apparatus installation, maintenance and repair; computer installation services; preparation of a site for the installation of computer equipment; advisory, consultancy and information services in relation to the aforesaid services, all being services relating to transportable garden offices.

Class 40

Custom manufacture and assembly services; custom manufacture and assembly of building frameworks and chassis; custom manufacture and assembly of prefabricated building components; custom manufacture and assembly of buildings, prefabricated buildings, garden office buildings, office buildings, studios, summer

houses and/or residential accommodation units; damp-proofing to existing buildings; rot prevention treatment of buildings; fire-proofing to existing buildings; cabinet-making (custom manufacture); custom manufacture of furniture; joinery (custom manufacture); building fabrication and finishing services; advisory, consultancy and information services in relation to the aforesaid services, all services relating to transportable garden offices.

Class 42

Architecture services; architecture design services; computer aided design services related to architecture; preparation of architectural plans; drawing up of house plans; drafting of construction plans for recreational premises; urban design; urban planning; town planning; space planning (design) of interiors; services for the planning (design) of houses; design of controlled environmental buildings; room planning; preparation of reports relating to real estate planning; planning (design) of buildings; planning of building estates; engineering; interior design; engineering drawings; design of buildings and of components used in building and construction; surveying; land surveying; building surveying; road surveying; surveying of defective structures; analysis of the structural behaviour of buildings; quantity surveying; inspection of buildings; engineering surveying; quality control of completed buildings; technical project studies; project studies; technical testing; technical advice relating to energy consumption; recording data relating to energy consumption in buildings; environmental testing; environmental conservation; environmental surveys; environmental consultancy services; environmental hazard assessment; compilation of environmental information; measuring the environment within buildings; computer aided design for manufacturing operations; computer aided part and mould design services; design of manufacturing methods; computer assisted engineering design services; computer-aided engineering design and drawing services; computer aided graphic design; consumer product design; design services; custom design services; industrial design; advisory, consultancy and information services in relation to the aforesaid services, all being services relating to transportable garden offices.

6. In each instance, the Opponent argues that the respective goods and services are identical or similar and that the marks are similar, giving rise to a likelihood of

confusion. The Opponent submits that the respective marks are highly similar on account of the Opponent's mark being *"fully contained within the opposed mark[s]"* and that *"the identical portion is at the start of the opposed mark[s] and so will have significant impact and resonance with consumers."* Additionally, in relation to the '097' and the '073' applications, the Opponent submits that the *"remaining component[s]"* namely 'BUSINESS' and 'SPACE' respectively, are *"arguably descriptive and non-distinctive and so the comparison will focus primarily on the identical 'SMART' component."*

7. The Applicant filed counterstatements to the oppositions denying the claims made. It submits in each instance that *"when the respective trade marks are compared in their entirety, as they must be, the differences are sufficient so as to avoid any likelihood of confusion."* With regard to the comparison of the respective goods and services, the Applicant denies *"that any of the goods and/or services of the Applicant are identical or similar to any of the services in Classes 35, 40 or 42"* and it denies *"that any of the goods for which registration is sought are identical or similar but in the event that identity or similarity is found, the interdependency principle applies."*

8. Neither party filed evidence, nor submissions during the evidence rounds. No hearing was requested and only the Applicant filed submissions in lieu of a hearing. I therefore make this decision following a careful consideration of the papers.

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

DECISION

Legislation and Case Law

10. Sections 5(2)(b) and 5A of the Act are as follows:

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

[...]

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

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

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

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

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when

- all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
 - (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
 - (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
 - (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
 - (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
 - (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
 - (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of good and services

12. In *Gérard Meric v Office for Harmonisation in the Internal Market*,⁴ (“**Meric**”), the General Court held to the effect that goods and services can be considered as identical when the goods and services designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa.

⁴ Case T- 133/05

13. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

- (a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification
- (b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.”

14. When considering whether goods and services are similar, all the relevant factors relating to the goods and services should be taken into account. Those factors include, inter alia: the physical nature of the goods or acts of service; their intended purpose; their method of use / uses; who the users of the goods and services are; the trade channels through which the goods or services reach the market; in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and whether they are in competition with each other (taking into account how those in trade classify goods and services, for instance whether market research companies put them in the same or different sectors); or whether they are complementary to each other.⁵

15. Complementary means *“there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”*.⁶ I note that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity,⁷ and that complementarity can be clearly distinguished from ‘use in combination’ – the latter being where goods/services are merely used together, whether by choice or convenience (e.g. bread and butter; or wine and wine glasses⁸), this means that they are not essential for each other.

⁵ See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.*, [1996] R.P.C. 281 – the “*Treat*” case

⁶ *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82

⁷ *Kurt Hesse v OHIM*, Case C-50/15 P

⁸ As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited*, BL O/255/13 - *“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”*

16. When interpreting the terms in a specification I bear in mind:

- (1) that it is “*necessary to focus on the core of what is described [... and that] trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise*”, although “*where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods [and services] in question*”;⁹
- (2) where “*the words chosen may be vague or could refer to goods or services in numerous classes [of the Nice classification system], the class may be used as an aid to interpret what the words mean with the overall objective of legal certainty of the specification of goods and services*”;¹⁰
- (3) the following applicable principles of interpretation:

“(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”¹¹

17. For the purposes of making a comparison, the goods and services can be grouped together where the same reasoning applies.¹²

⁹ *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12

¹⁰ *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)*, [2018] EWHC 3608 (Ch), paragraph 94

¹¹ See *Sky v Skykick* [2020] EWHC 990 (Ch), paragraph 56 (wherein Lord Justice Arnold, in the course of his judgment, set out a summary of the correct approach to interpreting broad and/or vague terms)

¹² *Separode Trade Mark* BL O/399/10, paragraph 5

18. I have included in the table below only the Opponent's goods and services that represent its best case:

Opponent's goods and services	Applied-for goods and services
<p><u>Class 6</u></p> <p>Re-locatable buildings of metal; transportable metallic buildings; prefabricated metal buildings; all of the aforesaid being transportable garden offices.</p>	<p><u>Class 6</u></p> <p>Common metals and their alloys; metal building materials; transportable buildings of metal; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; portable buildings of metal; portable buildings made principally of metal; modular portable buildings of metal; portable mobile metal office buildings; prefabricated building components [metal]; prefabricated building elements [metal]; prefabricated elements of metal for building; prefabricated houses [kits of metal]; prefabricated houses of metal; prefabricated metal buildings; prefabricated metal constructions; metal prefabricated elements for building; modular prefabricated steel framing; shelters made of prefabricated metal insulated materials; relocatable buildings (Metal -).</p>
<p><u>Class 19</u></p> <p>Garden office buildings, office buildings, studios, summer houses; all of the aforesaid being transportable garden offices.</p>	<p><u>Class 19</u></p> <p>Non-metallic building materials; non-metallic transportable buildings; portable buildings (Non-metallic -); portable buildings (Non-metallic -) incorporating kitchen facilities; portable buildings (Non-metallic -) incorporating toilet facilities; portable buildings made of non-metallic materials; non-metallic portable buildings; portable non-metal buildings; prefabricated building components (Non-metallic -);</p>

	<p>prefabricated building elements (Non-metallic -); prefabricated building elements (Non-metallic -) for on site assembly; prefabricated elements (Non-metallic -) for building; prefabricated houses (Non-metallic -); prefabricated houses [kits]; prefabricated houses [kits], not of metal; prefabricated non-metal buildings; prefabricated non-metallic constructions; prefabricated, non-metal storage shed; modular units (Non-metallic -) for constructing prefabricated buildings; non-metallic prefabricated buildings; relocatable buildings (Non-metallic -).</p>
<p><u>Class 37</u></p> <p>Building services; building construction and repair; building and construction of interlocking socketed chassis and frameworks for buildings, prefabricated buildings, garden office buildings, office buildings, studios, summer houses and/or residential accommodation units; supervision of building construction and repair; supervision of building work; custom construction of buildings; residential and commercial building construction; on site project management relating to the construction of buildings; erection of prefabricated buildings; assembly of prefabricated houses; construction works for prefabricated houses; assembling (installation) of building framework; maintenance and repair of buildings, parts and fittings for buildings and utilities of buildings; supervision of the engineering of buildings; installation of fittings for buildings; installation of bedrooms, kitchens, kitchen equipment, bathrooms and bathroom equipment;</p>	<p><u>Class 37</u></p> <p>Building construction; building services; construction management for the building, construction and engineering industries; repair and installation services of non-metallic building materials, non-metallic transportable buildings, portable buildings (Non-metallic -), portable buildings (Non-metallic -) incorporating kitchen facilities, portable buildings (Non-metallic -) incorporating toilet facilities, portable buildings made of non-metallic materials, non-metallic portable buildings, portable non-metal buildings, prefabricated building components (Non-metallic -), prefabricated building elements (Non-metallic -), prefabricated building elements (Non-metallic -) for on site assembly, prefabricated elements (Non-metallic -) for building, prefabricated houses (Non-metallic -), prefabricated houses [kits], prefabricated houses [kits], not of metal, prefabricated non-metal buildings, prefabricated non-metallic</p>

<p>installation of pipework systems, sewers, drains, pipes and washroom apparatus; advisory, consultancy and information services in relation to the aforesaid services, all being services relating to transportable garden offices.</p>	<p>constructions, prefabricated, non-metal storage shed, modular units (Non-metallic -) for constructing prefabricated buildings, non-metallic prefabricated buildings, relocatable buildings (Non-metallic -), construction of buildings and other structures; assembly of prefabricated houses; erection of prefabricated buildings and structures.</p>
	<p><u>Class 39</u></p> <p>Transport; packaging and storage of goods; Rental of containers for warehousing and storage; rental of portable storage containers; rental of storage containers; rental of storage facilities; rental of storage space; rental of storage units; storage containers (Rental of -); storage units (Rental of -).</p>
<p><u>Class 42</u></p> <p>Architecture services; architecture design services; preparation of architectural plans; design of controlled environmental buildings; engineering; engineering drawings; engineering surveying; environmental testing; environmental conservation; environmental surveys; environmental consultancy services; environmental hazard assessment; compilation of environmental information; measuring the environment within buildings; computer assisted engineering design services; computer-aided engineering design and drawing services; advisory, consultancy and information services in relation to the aforesaid services, all being services relating to transportable garden offices.</p>	<p><u>Class 42</u></p> <p>Architectural design; architectural design services; architectural services for the design of buildings; architectural services for the design of commercial buildings; architectural services for the design of industrial buildings; architectural services for the design of office buildings; architectural services for the design of office facilities; architectural services for the design of retail premises; consultancy in the field of architectural design; preparation of architectural design; professional services relating to architectural design; advisory, analytical and information services relating to architectural, engineering and environmental matters; Professional engineering management.</p>

	<p><u>Class 43</u></p> <p>Rental of portable buildings; temporary accommodation; rental of accommodation [temporary]; rental of buildings and temporary office space.</p>
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19. Before I proceed with the comparison, I note that in general terms, Class 6 goods in the Nice Classification system include, inter alia, ‘metal materials for building and construction’ and ‘transportable buildings of metal’; and Class 19 goods include ‘materials, not of metal, for building and construction’ and ‘transportable buildings, not of metal’.¹³

20. Whilst these goods are separated for classification purposes in accordance with the base materials of which they are made, they are nonetheless similar. This is because the purpose, nature, use and user would overlap. The goods may also share the same trade channels and also be in competition with each other. For example, roofing material could be made out of corrugated metal sheets, or they could also be made out of ‘non-metal’ materials such as corrugated plastic sheets or slate tiles.

21. Prefabricated buildings made of metal and prefabricated buildings not of metal are both fundamentally prefabricated buildings – their purpose, nature, use and user would overlap; they would also share the same trade channels and could be in competition with each other.

22. I shall approach the comparison of the parties’ respective Class 6 and Class 19 goods with the above in mind.

23. Absent any submissions from the parties to assist me, I proceed with my comparison on the basis of my understanding of what a ‘prefabricated building’ is. I am aware that ‘prefabrication’ in reference to a building or structure is defined as the process where a building is constructed using standardised modular sections; such sections being manufactured in an offsite facility and then transported to the site where the building is to be located, where those prefabricated sections are then assembled to complete the building structure; or in certain circumstances, depending on the

¹³ These terms are included in the class headings of the Nice Classification system.

building size, the sections are assembled offsite and the entire building is then transported to the final site for installation.

Class 6 and Class 19

24. The Opponent's Class 6 specification consists entirely of the following goods, which are subject to a limitation (the limitation is underlined for ease of reference):

“Re-locatable buildings of metal; transportable metallic buildings; prefabricated metal buildings; all of the aforesaid being transportable garden offices.”

25. Bearing in mind the limitation, I consider that the following goods in the Applicant's Class 6 specification are **identical** on the principle outlined in *Meric*, to the Opponent's Class 6 goods:

“Transportable buildings of metal; portable buildings of metal; portable buildings made principally of metal; modular portable buildings of metal; portable mobile metal office buildings; prefabricated metal buildings; prefabricated metal constructions; shelters made of prefabricated metal insulated materials; relocatable buildings (Metal -).”

26. The Opponent's Class 19 specification consists entirely of the following goods, which are subject to a limitation (the limitation is underlined for ease of reference):

“Garden office buildings, office buildings, studios, summer houses; all of the aforesaid being transportable garden offices.”

27. The mere fact that the Opponent's goods are 'transportable' implies that they come in kits for easy assembly on site or are pre-assembled. Keeping in mind the limitation, I consider that the following goods in the Applicant's Class 19 specification are **identical** on the principle outlined in *Meric*, to the Opponent's Class 19 goods:

“Non-metallic transportable buildings; portable buildings (Non-metallic -); portable buildings (Non-metallic -) incorporating kitchen facilities; portable buildings (Non-metallic -) incorporating toilet facilities; portable buildings made of non-metallic materials; non-metallic portable buildings; portable non-metal buildings;

prefabricated non-metal buildings; prefabricated non-metallic constructions; non-metallic prefabricated buildings; relocatable buildings (Non-metallic -)."

28. The following goods in the Applicant's Class 19 specification are similar to the Opponent's Class 19 specification:

"Prefabricated houses (Non-metallic -); prefabricated houses [kits]; prefabricated houses [kits], not of metal; prefabricated, non-metal storage shed."

- (1) Whilst the Opponent's goods are limited to garden offices, this does not preclude a finding of similarity since the respective goods overlap in nature as they are both prefabricated buildings/ structures; they may also overlap in user since the consumer purchasing a prefabricated house for example, may also purchase a prefabricated office to go in their garden.
- (2) The goods may also be perceived by the average consumer as likely to share the same trade channels on the basis that the same undertakings that sell prefabricated garden offices are also likely to sell prefabricated houses and prefabricated storage sheds. I assess the degree of **similarity as medium**.
- (3) **In addition, or in the alternative**, the Applicant's goods are **similar** to the Opponent's Class 6 goods to a **medium** degree, bearing in mind that, the fact that the goods are made of metal on the one hand, and not of metal on the other, is not a significant point of difference as I have already stated.

29. Applying the same reasoning as in my paragraph 28 above, the following goods in the Applicant's Class 6 specification, namely:

"Prefabricated houses [kits of metal]; prefabricated houses of metal."

are **similar** to a **medium** degree to the Opponent's Class 6 *"prefabricated metal buildings; all of the aforesaid being transportable garden offices"*.

30. I now turn to consider the Applicant's 'prefabricated building elements' contained in its Class 6 and Class 19 specifications:

(1) It is my understanding that the prefabricated elements are just pieces of the jigsaw that make up the final building. I therefore cannot see how a dissimilarity can logically be found between a pre-assembled, prefabricated structure itself, and the prefabricated elements that are pieced together to make the final structure. With that in mind:

(a) the following goods in the Applicant's Class 6 specification are **similar** to the Opponent's Class 6 goods to a **high** degree:

"Prefabricated building components [metal]; prefabricated building elements [metal]; prefabricated elements of metal for building; metal prefabricated elements for building; modular prefabricated steel framing."

(b) the following goods in the Applicant's Class 19 specification are similar to (i) the Opponent's Class 6 and goods to a **medium degree**; and (ii) similar to the Opponent's Class 19 goods to at least a **medium degree**:

"Prefabricated building components (Non-metallic -); prefabricated building elements (Non-metallic -); prefabricated building elements (Non-metallic -) for on site assembly; prefabricated elements (Non-metallic -) for building; modular units (Non-metallic -) for constructing prefabricated buildings."

(2) This is because the respective goods detailed above, overlap in purpose and nature and share the same method of use; they would also have the same user. There will also be an overlap in trade channels as the same undertakings may sell the respective goods. The goods are also complementary to each other because one is indispensable or important for the use of the other to the extent that the average consumer of the goods would think that they originate from the same undertaking.

31. I consider the Applicant's Class 6 "*common metals and their alloys*" to be **dissimilar** to the Opponent's Class 6 goods for the following reasons:

- (1) A distinction can be drawn between the prefabricated components/ sections that are pieced together to construct a 'prefabricated building' made of metal on the one hand, and the metal itself. Notwithstanding the Opponent's goods are fabricated from metal, the raw materials used in the fabrication cannot be similar to the finished product because the respective goods differ in purpose and nature and they have different uses.
- (2) They would differ in user because the consumer wishing to purchase a prefabricated structure made of metal is not going to buy only metal in its stead. It therefore follows that the goods are not in competition with each other. The goods would also unlikely share the same trade channels.
- (3) Although metal is indispensable for the manufacture of a prefabricated metal building, the respective goods are not complementary since the average consumer would not believe that the origin of those respective goods lies with the same undertaking.

32. I also consider:

- (1) the following goods in the Applicant's Class 6 specification, namely:

"metal building materials; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal"

and

- (2) the Applicant's Class 19 "*non-metallic building materials*",

to be **dissimilar** to the Opponent's Class 6 and 19 goods. Whilst the Applicant's goods may be items used in the construction and in the fittings of a prefabricated building, their intended purpose and nature are not the same as the Opponent's goods. They

have different uses and they would not be in competition with each other. In this regard I note that the General Court has stated that:¹⁴

“The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

Class 37

33. The Opponent’s Class 37 services contain the following term: *“advisory, consultancy and information services in relation to the aforesaid services, all being services relating to transportable garden offices.”* I note that there is a comma, as opposed to a semicolon, separating the *“advisory, consultancy and information services in relation to the aforesaid services”* and the limitation *“all being services relating to transportable garden offices”*. The significance of this is that the limitation applies only to the *“advisory, consultancy and information services in relation to the aforesaid services”*. As this is how the specification has been registered, for the sake of legal certainty, I proceed on the basis that the limitation of *“all being services relating to transportable garden offices”* does not apply to the entirety of the Opponent’s Class 37 specification.

34. The terms *“building construction;¹⁵ building services; assembly of prefabricated houses”* appear in both parties’ specifications and are therefore **identical**.

35. *“Erection of prefabricated buildings and structures”* in the Applicant’s specification is self-evidently **identical** to the Opponent’s *“erection of prefabricated buildings”*.

36. The Applicant’s ‘repair and installation services’, namely (my underlining for clarity):

“repair and installation services of non-metallic building materials, non-metallic transportable buildings, portable buildings (Non-metallic -), portable buildings (Non-metallic -) incorporating kitchen facilities, portable buildings (Non-metallic -) incorporating toilet facilities, portable buildings made of non-metallic materials,

¹⁴ See *Les Éditions Albert René v OHIM*, Case T-336/03, paragraph 61.

¹⁵ *“Building construction and repair”* being the full term for which the earlier mark is registered.

non-metallic portable buildings, portable non-metal buildings, prefabricated building components (Non-metallic -), prefabricated building elements (Non-metallic -), prefabricated building elements (Non-metallic -) for on site assembly, prefabricated elements (Non-metallic -) for building, prefabricated houses (Non-metallic -), prefabricated houses [kits], prefabricated houses [kits], not of metal, prefabricated non-metal buildings, prefabricated non-metallic constructions, prefabricated, non-metal storage shed, modular units (Non-metallic -) for constructing prefabricated buildings, non-metallic prefabricated buildings, relocatable buildings (Non-metallic -), construction of buildings and other structures.”

are **identical** on the principles outlined in *Meric* to the Opponent’s:

“building repair;¹⁶ maintenance and repair of buildings;¹⁷ building and construction of interlocking socketed chassis and frameworks for buildings, prefabricated buildings, garden office buildings, office buildings, studios, summer houses and/or residential accommodation units; custom construction of buildings; residential and commercial building construction; erection of prefabricated buildings; assembly of prefabricated houses; construction works for prefabricated houses; assembling (installation) of building framework; installation of fittings for buildings; installation of kitchens, kitchen equipment, bathrooms and bathroom equipment;¹⁸ installation of pipework systems, sewers, drains, pipes and washroom apparatus.”

37. The Applicant’s “*construction management for the building, construction and engineering industries*” is **identical** on the principles outlined in *Meric* to the Opponent’s:

“on site project management relating to the construction of buildings; supervision of building construction and repair; supervision of building work; supervision of the engineering of buildings.”

¹⁶ The full registered term being “building construction and repair”.

¹⁷ The full registered term being “maintenance and repair of buildings, parts and fittings for buildings and utilities of buildings”.

¹⁸ The full registered term being “installation of bedrooms, kitchens, kitchen equipment, bathrooms and bathroom equipment”.

38. Returning to my earlier point (in my paragraph 33), even had I found that the limitation of “*all being services relating to transportable garden offices*” applied to the entirety of the Opponent’s Class 37 services, this would not have affected my findings since the identical terms would still be identical under the principles outlined in *Meric*; and, had I found that terms were similar (as opposed to identical), any similarity between the terms would not have been materially affected.

Class 39

39. The Opponent’s Class 39 includes services that can be characterised as rental of storage containers and rental of storage facilities / space; packaging of goods and storage of goods. I agree with the Applicant’s submissions, that its Class 39 services are **dissimilar** to the Opponent’s goods and services; this is because I do not consider there to be any overlap in purpose, nature or use, neither do I find any competition between them, nor do I consider they would share the same trade channels. I also do not consider them to be complementary.

40. The Applicant’s Class 39 specification also includes the broad term “*transport*”. This service is **dissimilar** to the Opponent’s goods and services because there is no overlap in purpose, nature or use, neither do I find any competition between them, nor do I consider they would share the same trade channels. This leaves me to consider whether there would be any complementarity, this is because the principle of complementarity can result in a finding of similarity in circumstances where the nature and purpose of the goods and services are very different, e.g. *chicken* has been found to have some degree of complementarity, and therefore some degree of similarity to *transport services for chickens*.¹⁹ However, a finding of ‘no similarity’ may legitimately be made despite the existence of ‘a degree of complementarity’ if that complementarity is not sufficiently pronounced for it to be accepted that, from the consumer’s point of view, the goods/ services are similar; and there is no rule that ‘complementarity’ always and necessarily equals ‘similarity’.²⁰

¹⁹ *Sanco SA v OHIM*, Case T-249/11 (in particular paragraph 61).

²⁰ See *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, paragraph 22, in which the Appointed Person quoted: *Assembled Investments (Proprietary) Ltd v. OHIM*, T105/05, paragraphs 30 to 35 (which was upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*, C-398/07P, paragraphs 34, 35).

41. In this instance, I am not comparing for example, 'prefabricated buildings' with 'transport services for prefabricated buildings', therefore, whilst the Opponent's services could in theory relate to the transport of prefabricated buildings (this is because the services are extremely broad in their scope and are not limited to any specific industry, nor to any specific category of goods), this would be allowing a liberal interpretation of the Applicant's term, and the unnatural straining of the core meaning of 'transport services', which is incorrect. To make such a finding would in effect mean that any category of goods, capable of being transported, would be similar to 'transport services' at large. This, in my opinion would lead to legal uncertainty.

42. In conclusion, I find that there is no sufficient basis for a finding of similarity between the Applicant's 'transport' services and the Opponent's goods and services based on complementarity alone. If there were any degree of complementarity (on the basis that the Applicant's transport services at large could be for the transport of prefabricated buildings), it would not be sufficiently pronounced for a finding of similarity.

43. The Applicant's Class 39 services are **dissimilar** to the Opponent's goods and services.

Class 42

44. The Opponent's Class 42 services contain the term "*advisory, consultancy and information services in relation to the aforesaid services, all being services relating to transportable garden offices.*" The issue is the same as with the Opponent's Class 37 specification. For the same reasons I have already set out above, this shall not have any material effect on the comparison of the parties' specifications.²¹

45. "*Architecture services; architecture design services*" in the Opponent's specification are:

(1) self-evidently **identical** to the Applicant's "*architectural design; architectural design services*"; and

²¹ See my paragraphs 33 and 38.

(2) **identical** on the principles outlined in *Meric* to the following services in the Applicant's Class 42 specification:

“architectural services for the design of buildings; architectural services for the design of commercial buildings; architectural services for the design of industrial buildings; architectural services for the design of office buildings; architectural services for the design of office facilities; architectural services for the design of retail premises; preparation of architectural design; professional services relating to architectural design.”

46. “*Consultancy in the field of architectural design*” in the Applicant's specification is **identical** on the principle outlined in *Meric*, to the Opponent's “*architecture design services; advisory, consultancy and information services in relation to the aforesaid services, all being services relating to transportable garden offices.*”

47. “*Advisory, analytical and information services relating to architectural, engineering and environmental matters*” (my underlining for clarity) in the Applicant's specification is **identical** on the principle outlined in *Meric* to the following services in Opponent's Class 42 specification:

(1) “*Architecture services; architecture design services; preparation of architectural plans; advisory, consultancy and information services in relation to the aforesaid services, all being services relating to transportable garden offices.*”

(2) “*Engineering; engineering drawings; engineering surveying; computer assisted engineering design services; computer-aided engineering design and drawing services; advisory, consultancy and information services in relation to the aforesaid services, all being services relating to transportable garden offices.*”

(3) “*Design of controlled environmental buildings; environmental testing; environmental conservation; environmental surveys; environmental consultancy services; environmental hazard assessment; compilation of environmental information; measuring the environment within buildings; advisory, consultancy and information services in relation to the aforesaid services, all being services relating to transportable garden offices.*”

48. “Professional engineering management” in the Applicant’s specification is **identical** on the principles outlined in *Meric* to the Opponent’s “engineering”.

Class 43

49. The Applicant’s Class 43 services are as follows:

“Rental of portable buildings; temporary accommodation; rental of accommodation [temporary]; rental of buildings and temporary office space.”

50. As a Class heading can serve as an aid to interpretation, at this point I pause to note the wording of the Class 43 heading of the Nice Classification system and the accompanying ‘Explanatory Note’, namely:²²

Class 43 heading:

Services for providing food and drink; temporary accommodation.

Explanatory Note:

Class 43 includes mainly services provided in relation to the preparation of food and drink for consumption, as well as services for providing temporary accommodation.

This Class includes, inter alia:

- *temporary accommodation reservations, for example, hotel reservations;*
- *rental of meeting rooms, tents and transportable buildings.*

This Class does not include, inter alia:

- *rental services for real estate, such as houses or flats, for residential use (Class 36).*

51. In the absence of submissions or evidence from the parties, it is my understanding that the ordinary and core meaning of the term ‘temporary accommodation’ (within the context of Class 43) refers to the service of providing non-residential accommodation

²² See the ‘Nice Classification’, a copy of which is available on the ‘World Intellectual Property Organisation’ website.

such as hotel accommodation, and temporary office accommodation, as well as the rental of transportable buildings (not being residential buildings); however it does not include rental services for real estate i.e. buildings/ property, for residential use.

52. The Applicant's Class 43 services are therefore fundamentally different to any of the services for which the earlier mark is registered.

53. The Opponent's Classes 6 and 19 consist of 'transportable garden offices'. A transportable garden office is a portable building that is a form of office accommodation. Whilst I recognise that the business of manufacturing and selling those goods is different to the enterprise of renting buildings and the services of providing temporary accommodation, and therefore the respective goods and services do not have the same nature and method of use, I nonetheless consider there to be a **low degree of similarity** between the respective goods and services.

54. This is because there is likely to be a degree of competition between them, in the sense that a consumer may choose a rental service above purchasing the actual building itself as they may only require the building for a fixed or temporary period of time. I also do not reject the existence of a complementarity between the goods and services on the sole ground that they differ in nature and method of use. Rather, I find that the average consumer is likely to believe that the responsibility for the production and sale of those goods, and the provision of those services lies with the same undertaking, since from their point of view, they may think that the manufacturer of the building also rents out the buildings. Therefore there is a sufficiently pronounced degree of complementarity between them for a finding of similarity.

Conclusion on the comparison of the goods and services

55. For the most part, I have found instances of identity between the respective goods and services, I have also found some to be similar (to varying degrees) and others to be dissimilar.

56. The Applicant's goods and services which I have found to be dissimilar to the Opponent's goods and services are as follows:

Class 6

Common metals and their alloys; metal building materials; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal.

Class 19

Non-metallic building materials.

Class 39

Transport; packaging and storage of goods; Rental of containers for warehousing and storage; rental of portable storage containers; rental of storage containers; rental of storage facilities; rental of storage space; rental of storage units; storage containers (Rental of -); storage units (Rental of -).

57. Since some similarity between the goods is required for the purposes of a section 5(2)(b) claim, the opposition must fail in respect of the dissimilar goods identified above.²³ I therefore proceed to consider a likelihood of confusion only in relation to the goods and services that are identical or similar.

The average consumer and the nature of the purchasing act

58. Trade mark questions, including the likelihood of confusion, must be viewed through the eyes of the average consumer of the goods and services in question. 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.²⁴

²³ See *Waterford Wedgwood plc v OHIM* – C-398/07 P (case of the Court of Justice of the European Union – 'CJEU'); and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49.

²⁴ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97.

59. The goods and services appear to be aimed at the general public and professionals such as builders. Due to the nature of the goods and the specialist nature of the services, the degree of attention that such average consumers would pay when selecting those goods and services, will be medium to high.

60. The goods and services are likely to be selected mainly visually, through catalogues, websites etc., but oral recommendations and orders may also play some part in the process. The way the respective marks look is therefore of primary importance, but the way they sound must also be taken into account.

Distinctive character of the earlier trade mark

61. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to 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. 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.²⁵

62. The issue of a trade mark's protection is intimately tied to the scope of the protection to which it is entitled. If a mark has an inherently high level of distinctiveness, the greater the likelihood of confusion may be, although it is the distinctive character of a component that is similar between the marks that is particularly relevant.²⁶

63. The Opponent has filed no evidence to show how the earlier mark has been used, therefore I have only the inherent position to consider.

64. There are no submissions before me from either party with regard to the distinctiveness of the word 'SMART'. The word 'SMART' is an ordinary dictionary word that has several laudatory meanings, for example, it can be used as an adjective in reference to a person to mean that they are clever, or well-kept/ neat in their appearance; or that something is stylish; or it is a term that can refer to a device that

²⁵ Ibid., paragraphs 22 – 23.

²⁶ *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, paragraphs 38 and 39.

is controlled by a computer, so that it appears to act in an intelligent way. In my view there is no clear suggestion that the earlier trade mark is descriptive of the goods and services for which it is protected, however, it could potentially be mildly allusive of the characteristics of the goods and some of the services in the sense that, for example, the transportable prefabricated buildings, and the services themselves are 'smart' i.e. intelligent solutions; or that the buildings are 'smart' in the sense that they are stylish and/or they use computer automation to control things such as lighting, heating etc, security systems etc.

65. In my view, the earlier mark has a low degree of inherent distinctive character.

Comparison of marks

66. It is clear from *Sabel BV v. Puma AG*,²⁷ that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union ('CJEU') stated in *Bimbo SA v OHIM*,²⁸ 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."

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

²⁷ Case C-251/95, paragraph 23.

²⁸ Case C-591/12P, paragraph 34.

68. The respective trade marks are shown below:

Earlier trade mark	Contested trade marks
SMART	<p><u>'090' application</u></p> <p>Series mark 1: SMARTCARE</p> <p>Series mark 2: SMART CARE</p> <p><u>'083' application</u></p> <p>Series mark 1: SMARTCLASS</p> <p>Series mark 2: SMART CLASS</p> <p><u>'097' application</u></p> <p>Series mark 1: SMARTBUSINESS</p> <p>Series mark 2: SMART BUSINESS</p> <p><u>'073' application</u></p> <p style="text-align: center;">SMARTSPACE</p>

69. Before I proceed with comparing the marks, I note the findings of the CJEU in *L'Oréal SA v OHIM*.²⁹ In that case, the CJEU considered the comparison between an earlier mark for the word 'FLEX' and a later mark for the words 'FLEXI AIR', both for hair-care products. The CJEU held that even where an earlier trade mark is deemed to have a weak distinctive character, that does not preclude a finding of a likelihood of confusion per se. In reaching this conclusion, the court stated (my underlining):

"31. [...] the assessment of the similarity of the signs in question must concentrate on the perception of the relevant public, irrespective of the extent of the protection enjoyed by the earlier mark.

32. [...] the extent of the distinctiveness of an element of a complex mark will be a guiding factor in determining whether such distinctiveness will dominate the overall impression conveyed by that mark, irrespective of the assessment of the similarity of the two signs. The fact that such an element is only of weak distinctive character does not automatically mean that it cannot be the dominant element of

²⁹ Case C-235/05 P

a complex mark. If the other elements of the mark are of even weaker distinctive character, the common element will, notwithstanding its weak distinctive character, none the less dominate the global impression conveyed by the mark applied for.

[...]

42. It follows that the distinctive character of the earlier mark cannot have the significance which the applicant argues it should be given in the comparison of the signs in question, as it is not a factor which influences the perception which the consumer has of the similarity of the signs.

[...]

“45. The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

Overall impression

70. The earlier mark comprises solely of the word ‘SMART’, therefore the overall impression of the earlier mark is dominated by that word.

71. In the case of the ‘073’ application and ‘Mark 1’ in each of the three series marks, the word ‘SMART’, at the beginning of the marks, is joined with a word that is not particularly distinctive per se and could be seen by the average consumer as being allusive in the context of some of the goods and services for which registration is

sought. For example: 'CARE' suggests that the prefabricated buildings (and associated construction services and rental services) could be for a care home/ residential care home; 'CLASS' suggests that they could relate to classrooms for schools; 'BUSINESS' suggests that they could relate to offices; and 'SPACE' that they add extra space by way of an annex to a home/ existing structure.

72. The only difference between 'Mark 1' and 'Mark 2' of the three series marks is that there is a space between the first word 'SMART' and the word that follows. The overall impression of all the contested marks lies in the juxtaposition of 'SMART' with an allusive/ suggestive word.

73. I have already found that the word 'SMART' has a low degree of inherent distinctive character, however, I consider the additional words added to 'SMART' in the contested marks are less distinctive than that element, and accordingly have less relative weight. As such, the overall impression of the contested marks is dominated by the word 'SMART'. In reaching this conclusion, I have also taken into account the perception of the average consumer, and the general rule of thumb that the first parts of a mark normally carry a greater significance.³⁰

Visual comparison

74. In terms of a visual comparison, 'SMART' forms the first five letters of the '073' application and 'Mark 1' in each of the three series marks – that sequence of letters is therefore identical to the earlier mark. The word 'SMART' is the first word in 'Mark 2' of the three series marks – the first words of these marks are therefore identical to the earlier mark. The earlier mark is therefore reproduced in its entirety in all of the contested marks.

75. The visual differences lie in the words 'CARE'; 'CLASS'; 'BUSINESS'; and 'SPACE', which are not present in the earlier mark. I assess the visual similarity overall as medium; this is because, notwithstanding the visual identity in the word 'SMART', the additional words making up the contested marks cannot be ignored in an overall comparison; equally a sign consisting of two words (or two conjoined words) may still be visually similar to a sign consisting of a single word.

³⁰ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, paragraph 81.

Aural comparison

76. 'SMART' is an ordinary dictionary word and will be pronounced in the ordinary way. As such, 'SMART' will be pronounced identically in all marks. Although I note that the '073' application and 'Mark 1' in each of the three series marks comprises two words that are conjoined, there is a natural break between them, such that each mark, when spoken, is likely to be heard as two separate words. There is no suggestion from the Applicant that its conjoined marks would be pronounced in any other way and the Opponent has not made submissions on this point either.

77. The words that follow 'SMART' in the contested marks are ordinary dictionary words and will be pronounced in the ordinary way. These additional words are not present in the earlier mark and therefore they represent a point of difference. I assess the aural similarity as medium, owing to the identity of the word 'SMART' that begins each mark.

Conceptual comparison

78. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.³¹ I have already set out my interpretation of the words making up the respective marks and, as they are ordinary dictionary words, I consider the average consumer will perceive them as such, thus the concept derived from the marks relates to the ordinary and natural meaning of those words.

79. The concept of 'SMART' is common to the earlier mark and the contested marks. I therefore assess the overall conceptual similarity as medium.

Conclusions on likelihood of confusion

80. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law, taking into account all factors relevant to the circumstances of the case.³² I must also bear in mind the principle of interdependency i.e. that *"a global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between*

³¹ This is highlighted in numerous judgments of the General Court and the CJEU including *Ruiz Picasso v OHIM* [2006] E.C.R. I-643; [2006] E.T.M.R. 29.

³² *Sabel BV v Puma AG*, Case C-251/95.

[the] goods or services. Accordingly 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.³³

81. Making an assessment as to the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. This includes taking into account the fact that the average consumer rarely has an opportunity to make direct comparisons between the trade marks and must instead rely on the imperfect picture of them that they have kept in mind.³⁴ The global assessment therefore is supposed to emulate what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.³⁵ The relative weight of the factors is not laid down by law but is a matter of judgement for the tribunal on the particular facts of each case.³⁶

82. Confusion can be direct, which is a simple matter of the consumer mistaking one mark for another; or indirect. Indirect confusion is where the consumer does not simply mistake the later mark for the earlier mark, but instead they believe that the goods or services bearing the later mark come from the same undertaking or from an economically linked undertaking,³⁷ this is because they share common elements with the earlier mark that lead the consumer to conclude that it is another brand (or brand extension) of the owner of the earlier mark.³⁸

83. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of the following three categories,³⁹ (although this list is not intended to be an exhaustive definition⁴⁰):

- (1) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but

³³ *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 17

³⁴ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, Case C-342/97, paragraph 27

³⁵ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81

³⁶ See paragraph 33 of the Appointed Person's decision in Case No. O/049/17, (*Rochester Trade Mark*).

³⁷ *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, paragraph 10.

³⁸ See *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, paragraphs 16 to 17 wherein Mr Iain Purvis QC, sitting as the Appointed Person, dealt with the distinction between direct and indirect confusion.

³⁹ *Ibid.*, paragraph 17.

⁴⁰ *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, paragraph 12.

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).

(2) 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.).

(3) 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).

84. I have found that the goods and services are for the most part identical and will be selected by the average consumer, who may be a member of the general public as well as a business user, via a visual and aural selection process, with a medium to high degree of care and attention.

85. The earlier mark has a low degree of inherent distinctive character (although I have already noted that that does not preclude a finding of confusion per se). The respective marks are visually, aurally and conceptually similar to a medium degree overall; and 'SMART' (which forms the first part of all the contested marks) is visually, aurally and conceptually identical to the earlier mark; the word 'SMART' also dominates the overall impression of the contested marks.

86. I find that the average consumer is not likely to directly confuse the earlier mark for the others owing to the differences between them; however, because of the common element 'SMART', there is a real risk that they are likely to believe that the goods and services, come from the same undertaking or from an economically linked undertaking. This is because all the contested marks follow the same pattern i.e. 'SMART' forms the first part of the marks and it is followed with a suggestive word of the kind which one would expect to find in a sub-brand; and the change introduced by that second element appears entirely logical and consistent with a brand extension.

87. Taking all the relevant factors into account, I find that the average consumer will be indirectly confused in respect of all the contested marks for all the goods and

services that are still in play, even where the degree of similarity between those goods and services is only low.

OUTCOME

88. The oppositions under section 5(2)(b) of the Act are partially successful. Subject to any appeal, the contested trade mark applications (numbers 3761090, 3761083, 3761097 and 3761073) shall proceed to registration only in respect of the following goods and services contained in Classes 6, 19 and 39 of the applications:

Class 6

Common metals and their alloys; metal building materials; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal.

Class 19

Non-metallic building materials.

Class 39

Transport; packaging and storage of goods; Rental of containers for warehousing and storage; rental of portable storage containers; rental of storage containers; rental of storage facilities; rental of storage space; rental of storage units; storage containers (Rental of -); storage units (Rental of -).

COSTS

89. The Opponent has been partially successful and is entitled to a contribution towards its costs. In the circumstances, I award the Opponent the sum of £400 as a contribution towards the cost of the proceedings (for the official fees for the filing of four notices of opposition – at £100 each).⁴¹

⁴¹ Although the official fee paid by the Opponent for each opposition filing was £200, the section 5(3) and 5(4)(a) grounds were subsequently struck out. It is therefore only appropriate to award the Opponent the sum of £100 in respect of each of the oppositions (£100 being the official fee for an opposition brought solely under section 5(2)(b) of the Act) totalling £400.

90. I therefore order The McAvoy Group Limited to pay Smart Offices Limited the sum of **£400**. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 28th day of September 2023

Daniela Ferrari

Daniela Ferrari
For the Registrar