

O-821-18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3253380
BY RICHARD SIGNS LTD
TO REGISTER THE FOLLOWING AS A TRADE MARK**

WORKINGWALL

IN CLASSES 16, 19 AND 40

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 411036
BY LOGOVISUAL LTD**

Background and pleadings

1. On 30 August 2017 Richard Signs Ltd (“the applicant”) applied to register the mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 15 September 2017. The applicant seeks to register its marks for the following goods and services:

Class 16: *Magnetic boards, drywipe boards, magnetic drywipe boards and magnetic noticeboards; attachments for magnetic boards, drywipe boards, magnetic drywipe boards and magnetic noticeboards; stationery and office requisites, all for use with the aforesaid goods.*

Class 19: *Wall tiles and coverings; magnetic wall tiles and coverings.*

Class 40: *Custom manufacture of wall tiles, magnetic boards, drywipe boards, magnetic drywipe boards and magnetic noticeboards; custom manufacture of stationery and office furniture for use with magnetic boards, drywipe boards, magnetic drywipe boards or magnetic noticeboards; custom manufacture of attachments and fittings for wall tiles, magnetic boards, drywipe boards, magnetic drywipe boards or magnetic noticeboards.*

2. The application was opposed by Logovisual Ltd (“the opponent”). The grounds of opposition are under Sections 3(1)(b), 3(1)(c) and 3(1)(d) of the Trade Marks Act 1994 (“the Act”) and under Section 5(2)(b). These are in summary:

a) under Sections 3(1)(b), (c) and (d) of the Act the opponent contends that the mark consists of the word WORKINGWALL and that the term is commonly used in the trade. Consequently, such application offends against:

(i) Section 3(1)(b) in that the mark is devoid of distinctive character;

- (ii) Section 3(1)(c) in that the mark is commonly used in trade for goods in classes 16 and 19 and, as such, “it should be free for all third parties to use and serves in trade to designate the kind of goods in question and their intended purpose. The services in class 40 are complementary and the word WORKINGWALL would similarly [...] serve as a designation of the kind of services in question and intended purpose [of] the services”;
 - (iii) Section 3(1)(d) in that the sign is common to the trade and should be precluded from registration.
- b) under Section 5(2)(b) that the applicant’s mark is similar to the opponent’s earlier trade mark EUTM 13474093 and has been applied for in relation to goods and services which are identical or similar to those within the specification of the opponent’s trade mark. Details of the opponent’s trade mark are set below:

Mark: ThinkingWall

Filing date: 19 November 2014

Registration date: 20 April 2015

The opponent relies on all goods for which the earlier mark is registered, namely:

Class 16: *Whiteboards; whiteboard systems; coloured magnetic shapes for use with whiteboards; coloured shapes for use with whiteboards; drawing instruments for whiteboards; parts and fittings for the aforesaid goods.*

3. The applicant has filed a counterstatement denying the grounds of opposition.
4. The opponent is represented by Mathys & Squire LLP; the applicant is represented by Wilson Gunn.

5. Only the opponent filed evidence. A hearing took place before me on 28 November 2018 at which the opponent was represented by Andrew Lomas of Counsel, instructed by Mathys & Squire LLP, and the applicant by Tim Rose of Wilson Gunn.

The evidence

6. The opponent's evidence consists of a witness statement by Gary Johnston of Mathys & Squire LLP, who are the opponent's legal representatives. The witness statement is dated 12 June 2018 and is accompanied by 3 exhibits. Mr Johnston says that having conducted some research, he has determined that the terms WORKINGWALL and WORKING WALL first came to prominence in the education sector and primarily in children's classrooms as an aid to teach various subjects. According to Mr Johnston, the terms have subsequently been adopted in commerce to describe white boards and dry wipe boards which are used in many businesses and board rooms globally. The following exhibits are attached:

- Exhibit 1: consists of Internet print-outs which show use of the word WORKING WALL in primary education. The term is clearly used to indicate a display. The exhibit includes the following:
 - i) an online article from the website educationworks.org.uk. It is headed "WORKING WALLS FOR MATHS AND LITERACY" and contains the following text: "While spending time with schools, I am delighted to see so many brilliant Working Walls in use. They are innovative and interactive - take a look at few examples". The examples include working walls relating to various subjects, e.g. KS1 Maths Working Wall, Reception Maths Working Wall, etc; these are described as displays of teacher and children's work;
 - ii) an online article from the website jmbeducation.com. It is headed "WORKING WALL. Take your Working Wall beyond the classroom..." and

talks about Working Walls as one of JMB Education's products. It contains the following text: "Working Wall from JMB Education is a unique tool that allows teachers to easily and quickly create feature-rich resource banks for any topic imaginable [...]" and "Unlikely traditional wall display, working walls are interactive and can be used to record, visualise and assist learning [...]"

- iii) an online article from the website tes.com headed "Literacy Working Wall Resources". It contains the following text "These resources I made for our working wall in Literacy (upper KS2) [...]". The article is shown as created in May 2011 and updated in January 2015;
- iv) an online article from the website naht.org.uk. It is headed "Working walls vs traditional displays" and contains the following text "In primary setting, working walls have seen a growth in popularity over recent years. The key question, as school leaders, is what role should working walls play in our school, and should they replace or complement the more traditional displays?" and "What's a working wall and what's its role in a primary classroom? As its name denotes, it's a working document and by its very nature, it's ever changing. The purpose of a working wall is to support the children in their current learning [...]. The most effective working walls should contain the following: a unit title; learning objective [...]; immersive examples [...]; key vocabulary and images as appropriate; examples of the learning outcome/end goal; key questions [...]; examples of the teacher's work [...]; examples of children's work [...]"
- v) a print-out from the website tinkl.co.uk which shows KS2 English Working Wall display pack available as a resource pack;

7. According to Mr Johnston, the terms WORKINGWALL and WORKING WALL have subsequently been adopted in commerce to describe white boards and dry wipe boards and are descriptive of these goods (and associated goods and services).

- Exhibit 2 is said to comprise examples of use of WORKINGWALL and WORKING WALL in a descriptive manner. It includes:
 - i) a print-out from the website unityav.com. It relates to a UK retailer as it shows a UK telephone contact. The goods are identified as mobile working walls & screens;
 - ii) a print-out from the website ourboards.co.uk. It shows a number of “WORKING WALL Packs” available for sale. The products are described as magnetic wipeable boards and are meant to be used in conjunction with equipment, e.g. magnetic notes, pockets and icons;
 - iii) a print-out from the website presentationmedia.co.uk. The products on offer include “WORKING WALLS” which are described as “mobile freestanding whiteboard surfaces”;

The pages are undated, save for the printing date of 1 February 2018.

- Exhibit 3 are Internet print-outs from various UK retailers, including eBay and WHSmith, showing a number of items all of which are described as white boards and dry wipe boards.

8. I shall return to Exhibit 2 in more detail later in this decision.

Decision

9. The opposition is based upon Sections 3(1)(b), (c) and (d) of the Act. These provide:

“3(1) The following shall not be registered –

(a) ...

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

10. It must be borne in mind that these grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of Section 3(1)(c), but still be objectionable under Section 3(1)(d) and/or 3(1)(b) of the Act. In *SAT.1 Satelliten Fernsehen GmbH v OHIM*, Case C-329/02 P, the Court of Justice of the European Union (CJEU) stated that:

“25. Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground

for refusal in question (Joined Cases C-456/01 P and C 457/01 P Henkel v OHIM [2004] ECR I-0000, paragraphs 45 and 46).”

11. There is no evidence before me of any use of the applied for mark and accordingly I have only the *prima facie* case to consider. The date at which the applied for mark must be assessed is the date of the application for registration, that is, 30 August 2017.

12. I will address the grounds of opposition in the same order as they were referred to by the parties at the hearing. I shall therefore start with Section 3(1)(c).

The Section 3(1)(c)

13. Section 3(1)(c) prevents the registration of marks “which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services”.

14. The case law under Section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or

services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18, paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

15. Mr Lomas argued, on behalf of the opponent, that the term WORKING WALL is descriptive of the characteristics of the goods and services in respect of which registration is sought. In particular, he claimed that the contested goods and services in class 16, 19 and 40 “are aimed at creating a wall [...] to facilitate working, i.e. a working wall”. He also referred to the public interest that descriptive signs should be kept free for use by others; in this connection, he submitted that allowing the applicant’s mark to proceed to registration would permit it to bring infringement proceedings against other traders using the words WORKING WALL in a descriptive manner.

16. Mr Rose, on behalf of the applicant, submitted that:

- as no absolute grounds objections were initially raised upon examination, the opponent’s claims that the mark does not meet the requirements of Section 3 will need to be supported by cogent evidence in order to depart from the examiner’s report;
- the mark consists of one word, i.e. WORKINGWALL (conjoined) as opposed to two separate words, i.e. WORKING WALL. The evidence only refers to use of WORKING WALL as two separate words;
- whilst acknowledging that the term WORKING WALL is used in relation to an educational tool used in primary education, Mr Rose argued that WORKING WALL denotes “the display of a complete piece of work” and “a permanent or semi-permanent instalment within a classroom” as opposed to the products for which registration is sought, i.e. dry wipe boards, which are visual aids for

temporary explanations and thought processes and are not, by their very nature, tools used in relation to the display of completed or ongoing pieces of work. He also said that there is a difference between the goods for which registration is sought, which are tools, and the term WORKING WALL, which is indicative of a concept and/or methodology. In Mr Rose's words "the WORKINGWALL mark alludes to a wall which works for the user, rather than a display of work";

- the three examples of independent use of WORKING WALL are insufficient to support the opponent's claims that the mark is descriptive, non-distinctive or generic. In any event, the examples provided are (possibly) trade mark use;
- none of the examples provided at Exhibit 3 shows use of the term WORKING WALL to describe the goods for which registration is sought.

17. In response to Mr Rose's submissions, Mr Lomas clarified that Exhibit 1 was aimed at providing a history of the term WORKING WALL and explain i) the concept behind it and ii) how the term has come to be used, more widely, as a description of the category of goods in respect of which registration is sought.

18. As regard the meaning of the term WORKINGWALL, it is reasonably clear from the evidence (and Mr Rose accepted) that the term (as two separate words) is used within the primary education sector to indicate a wall display intended to be used as an educational tool. Even if the applied for goods in class 16 might be used in a classroom in a way that involves creating a working wall, that is not sufficient to conclude that 'WORKINGWALL' may serve to designate the intended use of the goods. Such use of the goods constitutes, at most, one of many possible areas of use, but not a technical function. Nor can the word 'WORKINGWALL' be said to serve to designate any other essential characteristic of these goods.

19. That having been said, Exhibit 2 shows at least three instances of use by other UK businesses of the term "WORKING WALL" as a description of the goods for which

registration is sought. A firm called Unity advertises its dry-wipe boards under the descriptions “Take the wall with you...mobile working walls & screens”, “the Unity AV working wall is ideal for use in an open plan office” and “The Glass working wall - Minimalist and modern dry-wipe writing surface for contemporary classroom, meeting room or office. Manufactured from 6.0mm toughened safety glass in a range of colours, the surface of the glass carries a life time guarantee and a magnetic surface can be added as an optional extra [...]”. Similarly, a business called OurBoard uses the term “working wall” in relation to its dry-wipe boards, both on its own and within the phrases “OurBoard working wall” and “Working Wall Pack” and a company called Presentation Media describes its goods as “WORKING WALL” with the words “Mobile Freestanding Whiteboard Surfaces” and “NEW” underneath it.

20. Further, some of the material filed by the opponent show the goods being marketed specifically for use in a classroom. For example, the printouts from ourboards.co.uk, state:

“The OurBoard working wall works in conjunction with OurBoard table top boards. A wide range of subject mats can be purchased for the table top OurBoards making learning fun and interactive. Children can work in small groups or with a learning partner and their work can be simply displayed to the whole class.”

21. The same printouts show a “Working Wall Video”. A copy of that video was not available; however, the page seems to promote a “Classroom Working Wall application”. In addition, the description of Unity’s “Glass working wall” refers to the product being suitable for use in, *inter alia*, a “contemporary classroom” and the printout from Presentation Media refers to the business offering bespoke solutions for schools and colleges.

22. This evidence was challenged by Mr Rose only to the extent that the uses shown are “possible” use of WORKING WALL as a trade mark¹.

¹ Mr Rose also argued that use by only three independent traders is insufficient to establish that the mark is generic under Section 3(1)(d), however, given my findings (see below) I do not need to deal with that specific submission.

23. I am unable to accept Mr Rose's submission. The identifiers of trade origin are, in the examples provided, Unity (AV), OurBoard and Presentation Media. The traders in question are clearly using the term "working wall" as the name of the product or in their descriptions, not as a brand name, i.e. to indicate trade origin. I am satisfied from the context in which the references occurred that they were in circumstances where it was considered to be usage of descriptive expressions.

24. In BL-O-017-17, Mr Daniel Alexander QC, sitting as the Appointed Person, dismissed an appeal against the Hearing Officer's decision whereby he rejected an opposition to the registration of the sign TALK FOR WRITING in relation to, inter alia, educational services. The attack was based on the claim that the term was descriptive of a methodology. Mr Alexander QC reached its conclusion with some hesitation. He stated:

"69. The position in the present case is that there was therefore evidence in favour and against the proposition that TALK FOR WRITING was a descriptive term – or more strictly, it appears to have been used in both senses in different contexts. Cases of this kind present real difficulties of evaluation, since marks of this kind generally fall on a spectrum of distinctiveness to descriptiveness/genericness. A tribunal has to make a binary decision as to whether they are, in essence, sufficiently descriptive or generic, or may be used as such, for registration to be prevented, often on incomplete evidence as to the understanding of real consumers of the meaning of the term. Where a hearing officer has considered the evidence as a whole and has placed a mark on the "brand" side of an imperfectly defined line on the distinctiveness/descriptiveness spectrum, this tribunal is unlikely to be in a better position than the hearing officer to make a reevaluation, especially where the primary position of the opponent to the mark is (in effect) that terms of this general kind are capable of being brands.

70. A well-known illustration of the difficulties of evaluation comes from the litigation over the mark BACH FLOWER REMEDIES (see the first instance decision *Healing Herbs Limited v. Bach Flower Remedies Limited* [1998] EWHC

Patents 318). In that case, as here, there was evidence from the trade and members of the public, which presented a mixed picture: some regarded the mark as descriptive of a kind of product, others regarded the mark as denoting a specific trade origin. In that case, there was considerably more evidence than here including surveys (themselves equivocal) and many more witnesses, including experts. Cross-examination revealed that the witnesses were sometimes under a mis-apprehension which was not evident from their written statements or changed their view after questioning.

71. There was extensive reference in the judgment of the High Court to the case law on the caution required before conferring proprietary rights in respect of the name of new products, including the well-known observations of Viscount Maugham in *The Shredded Wheat Co. Ltd -v- Kellogg Co. of Great Britain Ltd* (1940) 57 RPC 137.

72. Neuberger J, as he then was, ultimately concluded that the relevant marks fell foul of s.3(1) in various respects and said:

“There is no doubt that the evidence provides support for the applicant’s basic proposition that “Bach Flower Remedies” is and has been used to mean, and understood to mean, flower remedies prepared in accordance with the recipes of Dr Bach. However, it is also clear that there is evidence to support the respondent’s contention that the expression is both used to mean, and understood to mean, flower remedies from a particular source, namely the Bach Centre. Given that “Bach” is what is sometimes called a “fancy name” and that the evidence of some members of the public, practitioners and shopkeepers, and some of the printed material show that “Bach Flower Remedies” does operate, and did operate in 1979, as a badge of origin, there is no doubt that the respondent has made out a real case for maintaining the first mark.”

73. Despite there being some evidence to show that some members of the trade and public regarded the term as operating as a badge of origin, Neuberger J found that the mark was invalid being registered contrary to sections 3(1)(c) and (d) of the Act and that is one source of my doubts in this case.

74. There are, however, material factual differences here from that case and I mention it only to illustrate the nature of the issues that arise and the difficulties the hearing officer had in making a decision on the basis of much more limited and untested material. There was less evidence (on both sides) than in that case and the factual background was different. The evidence that was provided was not challenged or subject to the kind of expert criticism that the evidence of the proprietor faced in the *BACH FLOWER REMEDIES* case. That case was a full High Court trial conducted at what appears to be considerable expense, not a determination by the Registrar. Even in that case, the High Court reached its conclusion with some hesitation, since there was evidence supporting both sides of the argument. That well illustrates the point that these are kinds of cases where fine decisions have to be made but on the basis of evidence that rarely presents an unequivocal picture.

Conclusion on s.3(1)(c)

75. In my judgment, on the materials presented to the hearing officer in this case, there was, albeit marginally, sufficient basis for the conclusion that he reached. This is, however, a situation in which it is not possible to be confident that this tribunal would have decided it the same way, had it been evaluating the matter *de novo* or indeed that were such an issue to be revisited, for example in the context of infringement proceedings, there would be the same result.”

And

“84. Stepping back from the detail of the case and the criticisms made of the hearing officer’s decision, this seems to me a case in which the overall justice of the situation is best served by giving this trade mark and the hearing officer’s decision concerning it the benefit of the distinctiveness doubt on this opposition while inviting subsequent tribunals, should it come to be asserted, to engage in more intensive scrutiny of the question of descriptiveness including possibly section 11 of the Act, in the event that particular uses of the term TALK FOR WRITING or similar terms are challenged. Nothing in this decision should be taken as warranting a “complete monopoly” (in the appellant’s words) in respect of all uses of TALK FOR WRITING in the educational field which was a key objection advanced by the appellant.”

25. Footnote 1 at paragraph 79, the AP made the following comments:

“[I]t may be useful to cite the statement by Mr Justice Parker in *In re Gramophone Company’s Application* [1910] 2 Ch. 423 at page 437 since he was a master in this branch of law: "For the purpose of putting a mark on the register, distinctiveness is the all-important point, and in my opinion, if a word which has once been the name of the article ought ever to be registered as a trade mark for that article, it can only be when the word has lost, or practically lost, its original meaning. As long as the word can appropriately be used in a description of the articles or class of articles in respect of which a trade mark is proposed to be registered, so long, in my opinion, ought the registration of that word for those articles or that class of article to be refused."”. See also *British Sugar* [1996] RPC 281 (“A manufacturer may coin a new word for a new product and be able to show massive use by him and him alone of that word for the product. Nonetheless the word is apt to be the name of the product and not a trade mark. Examples from old well-known cases of this sort of thing abound. The *Shredded Wheat* saga is a good example: [in] the Canadian case.... (1938) 55 RPC 125... Lord Russell said at 145: "A word or words to be really distinctive of a person’s goods must generally speaking be incapable of application to the goods of anyone else." It is precisely because a common

laudatory word is naturally capable of application to the goods of any trader that one must be careful before concluding that merely its use however substantial has displaced its common meaning and has come to denote the mark of a particular trader.”.)”

26. Whilst the evidence is far from overwhelming, it shows that the term WORKING WALL is suitable for descriptive use in the marketing of dry-wipe boards and whiteboards, with two traders expressly marketing goods described as “working wall(s)” as being apt for use in classrooms².

27. To the extent that the evidence is from after the relevant date, i.e. 30 August 2017, it serves to confirm that it was reasonably foreseeable that WORKING WALL was apt for use in a descriptive fashion.

28. I therefore come to the conclusion that WORKING WALL is descriptive for use in relation to *magnetic boards, drywipe boards, magnetic drywipe boards and magnetic noticeboards* and there is a need to keep the mark free for use by others. As such, the mark offends against Section 3(1)(c) in respect of these goods.

29. In *Fourneaux De France Trade Mark*, Case BL-O/240/02, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“Having listened with care to the arguments that have been addressed to me on this appeal, I have come to the conclusion that cooker hoods and extractors are closely connected items of commerce, and that they are both so closely connected with cookers that it would be unrealistic to treat the words FOURNEAUX DE FRANCE as descriptive of the character of the latter but not the former. The expression “cookers from France” is descriptive at a high level of generality. That

² See Exhibit 2 page 19 which displays the text: “The Glass working wall – Minimalist and modern dry-wipe writing surface for contemporary classroom” and page 21 which displays the text “Keep lesson preparation to a minimum, your OurBoard working wall is a simple and efficient use of a teacher’s time”. Further, at page 23 there is a reference to the company offering bespoke solutions for schools and colleges.

makes it suitable, in my view, for descriptive use in the marketing of units of equipment of the kind found in modern cooker installations including not only grilling and roasting units, but also hood and extractor units”.

30. Further, applying the principle of *Fourneaux De France Trade Mark* set out above, I consider *attachments for magnetic boards, drywipe boards, magnetic drywipe boards and magnetic noticeboards; stationery and office requisites, all for use with the aforesaid goods* in class 16 and *custom manufacture of magnetic boards, drywipe boards, magnetic drywipe boards and magnetic noticeboards; custom manufacture of stationery and office furniture for use with magnetic boards, drywipe boards, magnetic drywipe boards or magnetic noticeboards; custom manufacture of attachments and fittings for magnetic boards, drywipe boards, magnetic drywipe boards or magnetic noticeboards* in Class 40 to be so closely connected that the objection extends to such goods and services.

31. I also extend the same conclusions to the remaining *wall tiles and coverings; magnetic wall tiles and coverings* in class 19 and related *custom manufacture of wall tiles; custom manufacture of attachments and fittings for wall tiles* in class 40. Whilst the term WORKING WALL is not a truly apt way of describing the goods and there is nothing to suggest that WORKING WALL has any application in describing the goods, it was accepted by Mr Rose at the hearing that the functionality of wall tiles and magnetic wall tiles also include the ability of writing on them (and so the goods provide a whiteboard functionality to their consumers). Consequently, one can easily envisage consumers being able to purchase wall tiles they can write on and built walls tiles provided to function as WORKING WALLS. **The ground of opposition based upon Section 3(1)(c) succeeds in relation to all of the applied for goods and services, namely:**

Class 16: *Magnetic boards, drywipe boards, magnetic drywipe boards and magnetic noticeboards; attachments for magnetic boards, drywipe boards, magnetic drywipe boards and magnetic noticeboards; stationery and office requisites, all for use with the aforesaid goods.*

Class 19: *Wall tiles and coverings; magnetic wall tiles and coverings.*

Class 40: *Custom manufacture of wall tiles, magnetic boards, drywipe boards, magnetic drywipe boards and magnetic noticeboards; custom manufacture of stationery and office furniture for use with magnetic boards, drywipe boards, magnetic drywipe boards or magnetic noticeboards; custom manufacture of attachments and fittings for wall tiles, magnetic boards, drywipe boards, magnetic drywipe boards or magnetic noticeboards.*

Section 3(1)(b)

32. Section 3(1)(b) prevents the registration of marks which are devoid of distinctive character.

33. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and Section 3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C 456/01 P and C 457/01 P *Henkel v OHIM* [2004] ECR I 5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of

which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C 304/06 P *Eurohypo v OHIM* [2008] ECR I 3297, paragraph 66; and Case C 398/08 P *Audi v OHIM* [2010] ECR I 0000, paragraph 33).

32. It is settled case law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three dimensional marks and slogans (see, to that effect, respectively, Case C 447/02 P *KWS Saat v OHIM* [2004] ECR I 10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C 473/01 P and C 474/01 P *Proctor & Gamble v OHIM* [2004] ECR I 5173, paragraph 36; Case C 64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I 10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

34. The opponent has put its Section 3(1)(b) objection in the following terms:

"The mark applied for WORKING WALL is devoid of any distinctive character quite simply because the term is commonly used in the trade and should be free for all

third parties to use in conjunction with the sale of products in classes 16 and 19 and complementary services in class 40.”

35. In *Postkantoor*³ it was held that:

“86. In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive.”

36. Accordingly, my findings that the mark is descriptive in relation to the goods and services for which registration is sought for the purposes of Section 3(1)(c), also means that is necessarily devoid of distinctive character with regard to the same goods or services for the purposes of Section 3(1)(b). **The opposition under Section 3(1)(b) also succeeds.**

The sections 3(1)(d)

37. Section 3(1)(d) prevents the registration of marks “which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade”.

38. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court (GC) summarised the case law of the CJEU under the equivalent of Section 3(1)(d) of the Act, as follows:

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark

³ Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (POSTKANTOOR) [2004] ETMR 57

is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (*BSS*, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40).”

39. See also: *Merz & Krell GmbH & Co* [2002] ETMR 21 (CJEU) and *Stash Trade Mark* – BL O/281/04 (AP)

40. The evidence is dated after the relevant date. As such the opponent had failed to prove at the relevant date that WORKINGWALL contravened Section 3(1)(d) as consisting exclusively of a sign or indication which had become customary in the current language or in trade practices for the goods and services concerned. **The opposition under Section 3(1)(d) fails.**

41. The claims based on Section 3(1)(b) and (c) have been successful in their entirety. If I am wrong in deciding the Section 3 objection as I have done, I will go on to consider the objection based on Section 5(2)(b).

Section 5(2)(b)

42. Section 5(2)(b) of the Act states:

“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”.

43. An earlier trade mark is defined in Section 6 of the Act, which states:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration

earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

44. The opponent’s mark is an earlier trade mark within the meaning of Section 6(1) of the Act. As this earlier trade mark had not been registered for more than five years at the date the application was published, it is not subject to the proof of use provisions contained in section 6A of the Act. As a consequence, the opponent is entitled to rely upon it without having to demonstrate genuine use.

Section 5(2)(b) case law

45. The following principles 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 goods and services

46. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment 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”.

47. In *Gérard Meric v OHIM*, Case T- 133/05, the GC stated:

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

48. The goods and services to be compared are:

Applied for goods and services	Opponent's goods
Class 16: <i>Magnetic boards, drywipe boards, magnetic drywipe boards and magnetic noticeboards; attachments for magnetic boards, drywipe boards, magnetic drywipe boards and magnetic noticeboards; stationery and office</i>	Class 16: <i>Whiteboards; whiteboard systems; coloured magnetic shapes for use with whiteboards; coloured shapes for use with whiteboards; drawing instruments for whiteboards; parts and fittings for the aforesaid goods.</i>

<p><i>requisites, all for use with the aforesaid goods.</i></p> <p>Class 19: <i>Wall tiles and coverings; magnetic wall tiles and coverings.</i></p> <p>Class 40: <i>Custom manufacture of wall tiles, magnetic boards, drywipe boards, magnetic drywipe boards and magnetic noticeboards; custom manufacture of stationery and office furniture for use with magnetic boards, drywipe boards, magnetic drywipe boards or magnetic noticeboards; custom manufacture of attachments and fittings for wall tiles, magnetic boards, drywipe boards, magnetic drywipe boards or magnetic noticeboards.</i></p>	
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49. At the hearing Mr Rose accepted Mr Lomas' submission that all of the applied for goods and services are similar to the opponent's goods. In particular, he accepted that 1) the parties' goods in class 16 are identical and 2) (as I have mentioned earlier) the applied for goods in class 19 are similar to the opponent's goods in class 16 because the functionality of *wall tiles* and *magnetic wall tiles* also include the ability of writing on them (and so the goods provide a whiteboard functionality to their consumers). I proceed on that basis.

The average consumer and the nature of the purchasing act

50. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods and services at issue; I must then determine the manner in which these goods and services will be selected in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading)*

Limited, U Wear Limited, J Fox Limited, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

51. The average consumer of the parties’ goods and services are schools, businesses and member of the general public. The goods and services are likely to be selected primarily by visual means from advertisements on paper and on-line and from catalogues and brochures. However, word of mouth recommendations and orders will also play a part in the selection process, so aural similarity is also material. The goods are not every day consumables but pieces of equipment; that said they are neither particularly expensive nor particularly technical and will be selected, in my view, with an average degree of attention.

Comparison of marks

52. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, 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.”

53. It would be wrong therefore artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features, (which are not negligible) and therefore contribute to the overall impressions created by them. The marks to be compared are:

Applied for mark	Earlier mark
WORKINGWALL	ThinkingWall

54. The applied for mark consists of the word WORKINGWALL in block capital letters. Although the mark is presented as one word, it will be understood by the average consumer as the two very well-known English language words i.e. WORKING and WALL conjoined. The earlier mark consists of the word ThinkingWall written in lower case with the T and the W capitalised. Here again, although the mark is presented as one word, I have no doubt that the average consumer will see the two words, Thinking and Wall, separately. In both cases, the overall impression the trade marks convey and their distinctiveness lie in the totality, rather than in the individual words of which they are made up. For the avoidance of doubt I should say that whilst I have found that the applied for mark is devoid of distinctive character for the purpose of Section 3(1)(b), here I am considering the opponent’s alternative claim under Section 5(2)(b), for the purpose of which I am proceeding on the basis that the applied for mark has some degree of distinctive character.

55. Visually and aurally the marks coincide in the 8-letter sequence KINGWALL/kingWall. Whilst the marks differ in their beginnings, i.e. 'WOR' and 'Thin', they present the same ends and structure, namely the word WALL/Wall conjoined with the gerund of a verb, i.e. WORKING and Thinking, that qualifies it. In my view the marks are visually and aurally similar to a medium to high degree.

56. Conceptually, whilst 'working' and 'thinking' are not the same thing, when the words are used the context of the marks at issue in combination with the other (identical) verbal element, i.e. 'wall', and are applied to the goods (and services) at issue, they will be perceived by the public as alluding to the concept of a wall (or a screen) used to facilitate working and thinking respectively. The evocative connotation that each combination carries, means that the marks transmit very similar concepts and are conceptually similar to a medium to high degree.

Distinctive character of earlier mark

57. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*²⁶, the CJEU stated that:

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been

registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

58. The opponent has filed no evidence of use, so I have only the inherent position to consider. The earlier mark consists of the word ‘ThinkingWall’. Whilst the mark as a whole has allusive connotations when used in relation to the registered goods, e.g. whiteboards that provide walls (or screens) to write down thoughts and ideas, it is not directly descriptive. In my view, it has a below average (but not as low as ‘low’) degree of distinctive character.

Likelihood of confusion

59. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

60. There are two types of relevant confusion to consider: direct confusion (where one mark is mistaken for the other) and indirect confusion (where the respective similarities lead the consumer to believe that the respective goods and services come from the same or a related trade source). This distinction was summed up by Mr 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.”

61. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

62. Earlier in my decision I found that some of the goods and services are identical and others are similar. The marks are visually, aurally and conceptually similar to a medium to high degree and the earlier mark is distinctive to a below average degree (but not low). The goods will be selected visually and aurally with an average degree of attention, which means that the principle of imperfect recollection comes into full play. Moreover, the fact that the goods and services in question are not purchased or provided on a regular basis increases the possibility that the relevant public might be misled by its imprecise recollection of the marks⁴. Although the distinctive character of the earlier mark must be taken into account when assessing the likelihood of confusion, it is only one factor among others involved in that assessment.

⁴ Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II'4301, paragraph 76

63. Having considered all of the relevant factors, my conclusion is that in relation to identical goods, namely *magnetic boards, drywipe boards, magnetic drywipe boards and magnetic noticeboards; attachments for magnetic boards, drywipe boards, magnetic drywipe boards and magnetic noticeboards; stationery and office requisites, all for use with the aforesaid goods* in class 16 there is a likelihood of direct confusion. The purchase of the goods in question could follow an oral recommendation to that effect and the consumer, confronted with the two signs as spoken, could easily, because of his/her imperfect recollection, confuse the product covered by the recommended trade mark and those covered by the other mark at issue.

64. As regards the remaining *wall tiles and coverings; magnetic wall tiles and coverings* (in class 19) and *custom manufacture of wall tiles, magnetic boards, drywipe boards, magnetic drywipe boards and magnetic noticeboards; custom manufacture of stationery and office furniture for use with magnetic boards, drywipe boards, magnetic drywipe boards or magnetic noticeboards; custom manufacture of attachments and fittings for wall tiles, magnetic boards, drywipe boards, magnetic drywipe boards or magnetic noticeboards* (in class 40), which the applicant accepted are, at least, similar, I find that there is a likelihood of indirect confusion arising out of the consumer misremembering the marks whilst appreciating the differences between the respective goods and services.

Conclusion

65. The opposition under Section 5(2)(b) succeeds in its entirety. Subject to appeal, the application will be refused.

Costs

66. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Tribunal Practice Notice (TPN) 2/2016. Using that TPN as a guide, I award costs to the opponent on the following basis:

Official fees:	£200
Preparing a statement and considering the other side's statement:	£200
Filing evidence:	£500
Attending a hearing:	£700
Total:	£1,600

67. I order Richard Signs Ltd to pay Logovisual Ltd the sum of £1,600 as a contribution towards its costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 20th day of December 2018

T Perks

**Teresa Perks
For the Registrar
The Comptroller – General**