

O/891/22

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3578685

BY HEADLAM GROUP PLC

AND

OPPOSITION THERETO

UNDER NO. 426769

BY KREAFIN GROUP S.A.

Background and pleadings

1. This is an opposition against trade mark application number 3578685, which has a filing date of 13 January 2021 (“the relevant date”). The application was filed by Headlam Group Plc (“the applicant”) for the series of two trade marks shown below:



2. The application was published in respect of the following goods:

Class 19: Non-metallic building materials; materials for covering floors, walls and stairs; flooring (non-metallic); wooden flooring; ceramic tiles; laminated and engineered wood flooring; LVT flooring; damp proof membranes; membranes for use with floors; parts and fittings for the aforesaid goods.

Class 27: Carpets; rugs; mats; matting; linoleum; floor coverings; vinyl floor coverings and tiles; floor tiles; protective floor coverings; underlay; rug grippers (underlay); artificial grass; parts and fittings for the aforesaid goods.

3. The application is opposed by Kreafin Group S.A. (“the opponent”) under s. 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against all of the goods in the application.

4. The opponent relies upon its comparable trade mark (EU) number 916119737 for the words “RCF RIGID CORE FLOORING”. The trade mark has a filing date of 1 December 2016 and was entered in the register on 29 March 2017 in respect of “floor coverings and artificial ground coverings; wall and ceiling coverings” in class 27.

5. The opponent asserts that the respective goods are identical or highly similar and that the marks are similar, leading to a likelihood of confusion, including the likelihood of association.

6. The applicant filed a counterstatement denying the claims. It says that the marks are not similar and put the opponent to proof of identity or similarity between the goods. It argues that there is no likelihood of confusion.

7. Both sides filed evidence. Written submissions were also filed by both parties during the evidence rounds. Neither party requested a hearing; only the applicant filed written submissions in lieu. This decision is taken following a careful reading of all of the papers.

8. The opponent is represented by KOB NV. The applicant is represented by ip21 Limited.

EU Law

9. Although the UK has left the EU, s. 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 EU trade mark law.

Proof of use

10. The earlier mark had not completed its registration process more than five years before the relevant date. Accordingly, the proof of use provisions at s. 6A of the Act do not apply. The opponent may rely upon all of the goods it has identified without demonstrating that it has used the mark.

Case management

11. A case management conference was held before me on 25 April 2022 regarding an application by the applicant for an extension of time. I allowed the extension up to the date of the CMC but refused a longer extension. I gave my reasons in a letter to the parties of the same date and I adopt those reasons here.

Evidence

12. The opponent's evidence is provided by Emmelie Devos, a Chartered Trade Mark Attorney at KOB NV, the opponent's professional representatives. Ms Devos's statement has one exhibit, which is a report of an internet search conducted on the specialised IP search engine FOVEA IP on 22 June 2022. The search was of all worldwide trade mark registers for trade marks containing the elements "Rigid Core".

13. The applicant's evidence consists of the witness statement of Jaqueline Tolson (and exhibits JT1 to JT11). Ms Tolson is a Chartered Trade Mark Attorney for ip21 Ltd, the applicant's professional representatives. Ms Tolson's witness statement is dated 22 April 2022. Her evidence goes to the descriptiveness and use in the trade of "Rigid Core".

14. Neither witness was cross-examined. I will return to the evidence to the extent I consider necessary later in this decision.

Decision

Section 5(2)(b)

15. Section 5(2)(b) of the Act is 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".

16. Section 5A of the Act is also relevant and reads:

"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".

17. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, EU:C:1997:528, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, EU:C:1998:442, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, EU:C:1999:323, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, EU:C:2000:339, *Matratzen Concord GmbH v OHIM*, Case C-3/03, EU:C:2004:233, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, EU:C:2005:594, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P, EU:C:2007:333, and *Bimbo SA v OHIM*, Case C-591/12P, EU:C:2016:591:

(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

18. The goods to be compared are:

Earlier mark's goods	Contested marks' goods
<u>Class 27</u> : Floor coverings and artificial ground coverings; wall and ceiling coverings	<u>Class 19</u> : Non-metallic building materials; materials for covering floors, walls and stairs; flooring (non-metallic); wooden flooring; ceramic tiles; laminated and engineered wood flooring; LVT flooring; damp proof membranes; membranes for use with floors; parts and fittings for the aforesaid goods. <u>Class 27</u> : Carpets; rugs; mats; matting; linoleum; floor coverings; vinyl floor

	coverings and tiles; floor tiles; protective floor coverings; underlay; rug grippers (underlay); artificial grass; parts and fittings for the aforesaid goods.
--	--

19. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“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”.

20. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, T-325/06, EU:T:2009:428, the General Court (“GC”) stated that “complementary” means:

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

21. In *Gérard Meric v Office for Harmonisation in the Internal Market*, T- 133/05, EU:T:2006:247, the GC held that, where goods or services in the specification of the contested mark are included within a more general category designated by the goods/services of the earlier mark, or vice versa, such goods and services can be considered identical.

Class 19

Non-metallic building materials; materials for covering floors and stairs; flooring (non-metallic); LVT flooring

22. The above terms are or include Luxury Vinyl Tile (LVT) flooring. The term “floor coverings” in the earlier mark’s specification includes goods such as linoleum and vinyl floor tiles.

23. The difference between flooring products in class 19 and those in class 27 is that the goods in class 19 are used to construct floors, whilst those in class 27 are used to cover existing floors. However, the purpose of the LVT (i.e. luxury vinyl tile) flooring is identical to that of the earlier goods because both provide a finished floor surface. Both parties’ goods include tiles which have vinyl as the uppermost surface, potentially with identical patterns/effects, but there may be a difference in, for example, the flexibility, strength or composition of the product (e.g. the laminated structure of the LVT products which includes a rigid core). The user, who will be the same for both parties’ goods, is likely to view the goods as alternatives to one another: there is no reason to believe that a laminate or LVT floor would not be chosen instead of a vinyl tile floor, though there will be considerations like difference in cost and durability. The goods are not complementary but they are all likely to be available through the same specialist flooring providers, though I acknowledge that there may be distinct sections in showrooms. The goods are highly similar.

Wooden flooring; laminated and engineered wood flooring

24. These goods also have the same purpose as the earlier “floor coverings”. However, there is a difference in nature, since the opponent’s goods do not include wooden flooring. The users are the same and there remains a competitive choice to be made between the respective products. They are not complementary but they may reach the market through the same channels of trade. They are similar to a reasonably high degree.

Non-metallic building materials; materials for covering floors and stairs; flooring (non-metallic); ceramic tiles

25. Ceramic tiles (also covered by the wider terms above) may be used to tile a floor and have the same purpose as the opponent’s floor coverings. The goods themselves may both be tiles, in the sense that they are flat shapes which may be placed against one another to form a surface. However, they bear no resemblance in their materials

and their method of application only coincides because both may be secured with adhesive (of different types); tiles will require grout whereas the earlier goods do not. Users are the same. The consumer may well choose to install a ceramic tile floor rather than vinyl or carpet tiles. There is no complementarity. Flooring suppliers routinely offer carpets and other floor coverings proper to class 27 in the same place as laminate or LVT flooring but that is not the case for ceramic tiles, nor, in my experience, would a more specialised outlet such as a tile shop or a kitchen/bathroom supplier which provides tiles also offer floor coverings like carpets. I accept that large DIY chains may sell both goods. However, even where that is the case, the products are likely to be in distinct sections. These goods are similar to a fairly low (i.e. between low and medium) degree.

Materials for covering walls

26. These contested class 19 goods would include products such as cladding for walls and wall panels. They also include ceramic wall tiles. These materials will be the visible surface of the wall and may be used inside as well as out. The goods therefore coincide in purpose with the earlier mark's "wall coverings". Their nature is different. There may be some competition but they are not complementary. It is unlikely that these goods will reach the market through the same channels: even where they are available in the same stores, they will be in discrete areas. There is a fairly low degree of similarity.

Damp proof membranes; membranes for use with floors

27. The earlier mark includes the term "floor coverings". This would include protective floor coverings, such as plastic sheeting used with carpet, to protect the surface beneath. The purpose of these goods is not the same as the contested membranes, which will be used underneath the flooring surface rather than on top of it. However, they both provide a barrier, the earlier goods preventing penetration of solids or liquids from above and the contested goods preventing moisture rising from below. They will be similar in nature, both potentially being thin sheets of plastic. They cannot be used in place of one another and there is, therefore, no competition. It is likely that they will coincide in trade channels, as sheet plastics suppliers are likely to produce, or retailers

of such goods will supply, both. They are not complementary. They are similar to a medium degree.

Parts and fittings for the aforesaid goods

28. The opponent claims that these goods are complementary to the earlier goods. There is no evidence on the point. Parts and fittings for the various goods contained in the contested trade mark's specification would, it seems to me, include goods such as door bars, profiles and trims to hide expansion gaps. They will be made of different materials and their nature will be different from the earlier goods. I accept, however, that it is possible that a door bar/threshold strip may be designed to blend with, for example, laminate or tiled flooring but accommodate a carpeted floor on the other side. It seems to me that there may be a complementary relationship, though not of the highest order given that the primary purpose is use with the class 19 goods. There may be an overlap in channels of trade, as the respective goods may both be sold by flooring retailers, though they are likely to be in a distinct section of such stores. They are similar to a fairly low degree.

Class 27

Carpets; rugs; mats; matting; linoleum; floor coverings; vinyl floor coverings and tiles; floor tiles; protective floor coverings; underlay; rug grippers (underlay); artificial grass

29. These goods are all encompassed by the term "floor coverings and artificial ground coverings" in the earlier trade mark's specification. They are identical on the principle outlined in *Meric*.

30. Parts and fittings for the aforesaid goods

31. These goods are both intended to be used with the floor coverings covered by the earlier mark and the average consumer is likely to consider them the products of the same manufacturer. It is a reasonably strong complementary relationship. Additionally, they will share channels of trade. These goods are similar to a medium degree.

The average consumer and the nature of the purchasing act

32. The average consumer is a legal construct deemed to be reasonably well informed and reasonably circumspect: *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) at [60]. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik*.

33. The average consumer for the goods will be a member of the general public or a tradesperson/business consumer. When selecting the goods, attention will be paid to select the correct colour or print and to the suitability of the goods for their intended use. For the general public, the goods are relatively infrequent purchases; they may be more routine purchases for business owners/those in the trade but such users are likely to be buying the goods in greater quantities and, therefore, at greater expense. The level of attention for both groups of consumer will be reasonably high.

34. The selection of the goods is likely to be mainly a visual process, with the goods chosen after inspection in retail premises, websites and from catalogues, both physical and online. I do not discount that there may also be an oral element to the purchase, since the goods at issue may be discussed in-store with assistants or recommended orally.

Distinctive character of the earlier trade mark

35. In *Lloyd Schuhfabrik*, 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)".

36. The applicant has filed evidence regarding the alleged descriptiveness of the term "Rigid Core". The exhibits to Ms Tolson's statement are as follows:

JT1: This is the first page of undated internet search results for the term "rigid core". Of the ten website results returned, nine refer to "Rigid Core Vinyl Flooring", "Rigid Core Flooring", "Rigid Core Vinyl Plank Flooring", "Rigid Core Vinyl", "SPC Rigid Core LVT Flooring" or "Rigid Core". The last of these is from www.karndean.com and is under the heading "Benefits of Rigid Core | Easy Fit Flooring". An explanation is visible in an extract from www.msisurfaces.com which is part of a blog from 2019. It says, "An improvement on traditional vinyl, rigid core is an engineered product with a rigid core construction for added stability, and because it's a solid plank, it has less flexibility than regular vinyl". There are various "related search" suggestions, which are variations on rigid core vinyl/flooring.

JT2: This consists of a print from a website identified during a search on Microsoft Bing for answers to the question "what is rigid core flooring?". It is the website of an American company and is dated 2022 (the copyright dates are 2015-2022). It describes developments in the "Luxury Vinyl Tile (LVT)" market and there is a subsection devoted to "What is Rigid Core LVT?". The use of "rigid core" is descriptive. The company has produced products with a rigid core since 2017 and it is said that there are many rigid core options in the marketplace.

JT3: This is an extract from www.extrusionpanel.com with a copyright date of 2022. It shows the cross section of “Rigid Core Luxury Vinyl Tile Flooring”, with a “rigid core” layer identified.

JT4: This is a print from the website of Kardean Design Flooring titled “What is rigid core”. It says that “rigid core is a click locking floating floor”. There are multiple references to the company’s “rigid core” products. The term is used to describe the qualities of the flooring (i.e. its construction). The copyright date is 2022. Although the web address is not provided, there is a reference to “flats” as well as apartments, there appears to be a reference to listed buildings and there is a modern slavery statement. These suggest that it is a UK website.

JT5: This consists of prints from the John Lewis website dated 2022 which show “Karndean Van Gogh Rigid Core Luxury Vinyl Tile Flooring” for sale in pounds sterling. It reproduces the description of the product as a click locking floating floor from the Karndean website.

JT6: This is a print from www.toolstation.com offering “Maximus Provectus Rigid Core Flooring” for sale in pounds sterling. “Rigid Core Flooring” is abbreviated in the description to “RCF”. There are copyright dates of both 2021 and 2022; it is not clear when the product was first available.

JT7: This is a print, dated December 2019, from www.msisurfaces.com. It appears to be a North American website, since the company is MS International, Inc, prices are in dollars and American spelling (e.g. “labor”, “color”) is used. The article is titled “What is rigid core luxury vinyl flooring?”. It says that “Rigid core is click-type plank vinyl flooring” and the same description is visible as at JT1. This exhibit expands on that description.

JT8: This consists of prints from www.ukflooringdirect.co.uk titled “Everything you need to know about rigid core”. There is a copyright date of 2022. The article begins by posing the question “what is rigid core vinyl” and says that “SPC rigid core vinyl flooring [...] is a type of luxury vinyl tile (LVT) that’s set apart from other vinyl flooring types thanks to its uniquely resilient core layer [...]”. There are a number of references to “rigid core flooring”/ “rigid core vinyl”,

all of which are descriptive of the type of flooring; one of the questions answered in the article is “what is the difference between rigid core and other vinyl?”. I also note a reference to the flooring’s “limestone rigid core” and a cross section diagram which identifies the “rigid core”.

JT9: This exhibit includes further prints from www.ukflooringdirect.co.uk with a copyright date of 2022. It is said to show an example of rigid core flooring on sale but I cannot see that rigid core flooring is identified anywhere in the exhibit.

JT10: This is an extract from www.whatisvinyl.com of an article titled “Is Rigid Core Luxury Vinyl Flooring Good? (Pros & Cons)”. The copyright date is 2022. The article describes rigid core flooring in much the same terms as above. It appears to be for a North American audience, referencing in prices in dollars and using US spellings.

JT11: This is a list of results from the UK register of trade marks containing the term “rigid core” in class 27. The list of results is, without evidence of how or if these marks are used in the market, of no assistance whatsoever.

37. The applicant’s evidence shows that there is a type of luxury vinyl tile which has a rigid core. Further, there is some indication that the term “rigid core” is the chosen term in the marketplace to refer to that particular type of tile. Most of the evidence is dated from after the relevant date and/or is from US websites and is therefore of limited assistance in showing how “rigid core” was perceived at the relevant date by the UK average consumer.

38. However, it is, in my view, obvious that where a product is apt to have an inflexible core the term “rigid core” is likely to be perceived as descriptive. The immediate question is how distinctive the earlier mark is for the goods in its specification.¹ It is not clear to me why the goods in class 27 would have a rigid core, or why the average consumer would perceive the words “rigid core” as describing a characteristic of the earlier mark’s goods. The identical or similar goods in the earlier specification are, for example, carpets, underlay, mats and rugs, artificial turf and vinyl floor coverings. The

¹ It is not open to me to find the mark as a whole non-distinctive (*Formula One Licensing BV v OHIM*, Case C-196/11P), though

last of these includes vinyl tiles but for application to pre-constructed flooring, not the type of vinyl tile proper to class 19 (e.g. LVT). The applicant has not identified any goods in class 27 which would ordinarily be considered to have a rigid core. I conclude that the words “RIGID CORE” are, in relation to the relevant goods in the earlier specification, inherently distinctive. The words themselves are ordinary English words, put together in the usual way with the word “FLOORING” to create a phrase where “rigid core” describes the qualities of the flooring.

39. There is no evidence that “RCF” is a recognised abbreviation of “RIGID CORE FLOORING”. Consequently, while some consumers may perceive it as the initials of the words “RIGID CORE FLOORING”, some consumers will not. However, even in the latter case, three letters unconnected with the goods are distinctive only to a medium degree. The word “FLOORING” is obviously descriptive of the earlier flooring goods, though not of the wall coverings. With all of the above in mind, when taken as a whole the trade mark “RCF RIGID CORE FLOORING” has a medium degree of distinctive character for all of the goods at issue.

Comparison of trade marks

40. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel* (particularly paragraph 23). *Sabel* also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, 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”.

41. It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take into account the distinctive and dominant components of the marks.

Due weight must be given to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

42. The marks to be compared are:

Earlier mark	Contested marks
RCF RIGID CORE FLOORING	

43. Both contested marks consist of the words “Rigid Core” on a rectangular grey background. The “o” is a pear shape and in a contrasting colour: in the first mark, the letters are white with the “o” in blue; in the second mark, the writing is in black with the “o” in white. There is a very thin underline in the same colour as the “o” running under the words. The words “Rigid Core” are the largest single element and have the most visual impact. The grey background and thin underline will be perceived as decorative and play a very weak role. The weight afforded to the pear-shaped “o” will depend on the extent to which the words “Rigid Core” are perceived as distinctive: where the words are seen as descriptive, the stylisation of the letter will play a greater role, though it will still be secondary to the words. It seems to me that “Rigid Core” will be seen as descriptive or non-distinctive for the goods in class 19, particularly those such as laminated, engineered wood and LVT flooring, since they may have a layered structure and, therefore, a rigid core. However, in relation to the remaining goods, including the parts and fittings, I also think it is unlikely that the words “Rigid Core” will be seen as distinctive. The average consumer is, on the contrary, likely to assume either that “Rigid Core” is an attribute of the goods, such as that they are particularly strong or durable, or that they are intended to be used with goods for which a “rigid

core” is a characteristic. I have already indicated why I consider “rigid core” distinctive for the goods in class 27.

44. The earlier mark consists of the words “RCF RIGID CORE FLOORING”. The use of capital letters rather than title or lower case is not a material factor, as the mark could also be used in these other formats. The average consumer will read “RIGID CORE FLOORING” as a phrase, in which “RIGID CORE” qualifies the word “FLOORING”. It may be that “RCF” is seen as unconnected initials or that it is perceived as the first letters of the following words but in either case it will be seen as a separate element from the complete words. Although the letters “RCF” are at the start of the mark, the relative length of the words “RIGID CORE FLOORING”, given that the phrase as a whole is distinctive of the goods, is likely to result in the complete words having slightly more impact in the overall impression.

45. The contested marks share with the earlier mark the words “Rigid Core”. However, the earlier mark also includes the element “RCF” and the word “FLOORING”, which have no counterpart in the contested marks. Although the words “RIGID CORE” are in the centre of the earlier mark, they are the first part of the second element. This means that they are not ‘lost’ in the centre of the mark. The contested marks have a figurative aspect, the most significant part of which is the pear-shaped letter “o”. There is overall some visual similarity as well as difference. The marks are visually similar to a medium degree.

46. Turning to the aural comparison, some average consumers may verbalise the earlier mark in full; others may, particularly if “RCF” is perceived as initials of the other words, only pronounce the words “RIGID CORE FLOORING”. In the former scenario, of eight syllables in the earlier mark, only three (RIGID CORE) are shared with the contested mark. There are no other elements in the contested mark which will be verbalised. The marks in this scenario are aurally similar to a fairly low degree. Where only the words “RIGID CORE FLOORING” are pronounced, the marks are aurally similar to a medium degree.

47. Conceptually, there is similarity because both marks refer to the concept of a “rigid core”. “RCF” does not introduce a separate meaning; “FLOORING” is descriptive. I have considered whether the pear-shaped “o” will carry a concept, in particular

whether it will indicate water or that the goods are waterproof/water-resistant. Even where the figurative “o” is blue, I do not think that there is a clear concept conveyed by this element. It would, in my view, require too many steps for the average consumer to perceive the droplet as water and then take the additional leap to conclude that this means the goods are waterproof. At most, the droplet is suggestive of something liquid but without a specific concept attached to it. Overall, the marks have a high degree of conceptual similarity.

Likelihood of confusion

48. In determining whether there is a likelihood of confusion, all of the above factors need to be borne in mind. They must be considered globally (*Sabel*), from the perspective of the average consumer. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik*). The factors considered above have a degree of interdependency (*Canon*): for example, a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa.

49. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *LA Sugar Limited v Back Beat Inc.*, BL O/375/10, where Iain Purvis Q.C., sitting as the Appointed Person, explained that:

“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”.

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

51. As far as class 19 is concerned, whilst the earlier mark has a medium degree of distinctive character for the goods for which it is registered, the words “rigid core” are, for the contested goods, descriptive or non-distinctive. For the goods in class 19, the words alone will not be given trade mark significance. It therefore appears to me that the impact of the conceptual similarity arising from the words “RIGID CORE” on the likelihood of confusion is lessened. That being the case, despite the level of similarity between the marks, including the high degree of conceptual similarity, I do not consider that there is a likelihood of confusion, whether direct or indirect, for the goods in class 19, because the common element “rigid core” will not be perceived as indicating the commercial origin of the goods when the applicant uses its trade mark for these goods. The average consumer is likely to attribute the use of these words to coincidence rather than believe that they signify an economic connection between the companies using the marks. There is no likelihood of confusion for the goods in class 19.

52. Turning to class 27, the goods are identical or similar to a medium degree. The earlier mark is averagely distinctive and the marks are visually similar to a medium degree. The position most favourable to the applicant is that there is a fairly low degree of aural similarity but the impact of this must be weighed against a purchasing process that is largely visual. The marks are conceptually similar to a high degree. Weighing all of the competing factors, I think it unlikely that there will be direct confusion. Although not especially distinctive, if at all, there are elements in the earlier mark which are not replicated in the contested marks, whilst the contested marks themselves have a presentational element which is not negligible. However, the position is different for

indirect confusion. My view is that the differences are insufficient to avoid indirect confusion. When the medium distinctive character of the earlier mark is taken into account, the consumer will be led to believe that these are variant marks used by the same or connected undertakings: the differences are not significant enough to indicate a different trade origin. The opposition succeeds against class 27.

Conclusion

53. The opposition has failed against the goods in class 19, for which the application will proceed to registration. The opposition has succeeded against all of the goods in class 27, in respect of which the application will be refused.

Costs

54. Both parties have had a measure of success. I direct that they bear their own costs.

Dated this 14th day of October 2022

Heather Harrison

For the Registrar

The Comptroller-General