

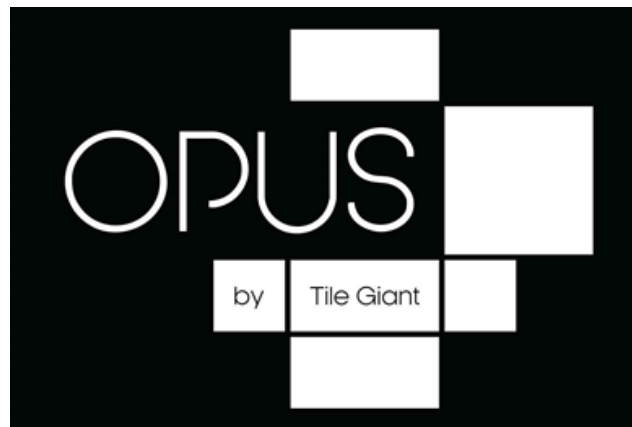
O/892/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3609154

**IN THE NAME OF THE
MOSAIC TILE CO. LTD**

**TO REGISTER THE FOLLOWING TRADE
MARK:**



IN CLASS 19

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 427391
BY KARNDEAN INTERNATIONAL LIMITED**

Background and pleadings

1. On 12 March 2021, The Mosaic Tile Co. Ltd ('the applicant') applied to register the trade mark shown on the cover page of this decision. It was accepted and published in the Trade Marks Journal on 9 July 2021 in respect of the following goods:

Class 19: Wall and floor tiles; handmade floor and wall tiles; porcelain, ceramic, stone or mosaic tiles; marble, granite, tumbled marble, travertine marble, limestone, natural stones, terracotta, glass, Jerusalem stone, slate; building products in the nature of slate, slate tiles, quartzite.

2. On 8 October 2021, Karndean International Limited ("the opponent") filed a notice of opposition against the application. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 ("the Act") and is directed against all the applied for goods.

3. The opponent relies upon the following trade marks:

Earlier Mark	Registration no.	Registration date	Services relied upon
OPUS	UK 2543777 "The first earlier mark"	16 July 2010	Class 27: Floor coverings
OPUS	UK 909000688 "The second earlier mark"	16 February 2011	Class 27: Floor coverings

4. In its notice of opposition, the opponent contends that the competing trade marks are highly similar and that the respective goods are either identical or similar, giving rise to a likelihood of confusion.

5. By virtue of their earlier filing dates, the opponent's trade marks are earlier marks, in accordance with section 6 of the Act. Both marks had completed their registration processes more than five years before this date and are therefore subject to the proof of use provisions contained in section 6A of the Act.

6. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use in respect of both of its earlier marks.

7. The opponent is represented by Marks & Clerk LLP whereas the applicant is represented by Bailey Walsh & Co LLP. Whilst the opponent filed evidence, the applicant did not. Neither party requested a hearing however the opponent did file written submissions in lieu. I now make this decision after careful consideration of the papers before me.

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

EVIDENCE

9. The opponent's evidence was filed in the form of a witness statement dated 10 May 2022 from the company's Director of Global Marketing, Megan Haywood and accompanying 20 exhibits. Whilst I do not intend to summarise the evidence here, I have read all of the evidence and will return to it to the extent I consider necessary in the course of this decision.

DECISION

Proof of use

10. The applicant has requested proof of use in these proceedings in respect of the opponent's earlier marks. I will begin by assessing whether and to what extent the evidence supports the opponent's statement that it has made genuine use of the mark in relation to the good relied upon. In accordance with section 6A(1A) of the Act, the relevant period for this purpose is the five years ending on the filing date of the contested application: 13 March 2016 to 12 March 2021.

Relevant statutory provision:

Section 6A:

“(1) This section applies where -

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

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

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

(3) The use conditions are met if -

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

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

(4) For these purposes -

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

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

(5)- (5A) [Repealed]

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

11. As the second earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the “five-year period”) has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

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

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

12. Section 100 is also relevant, which reads:

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

13. Consequently, the onus is upon the opponent to prove that genuine use of the registered trade marks was made within the relevant territory in the relevant period, and in respect of the goods as registered.

Relevant case law

14. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The Court of Justice of the European Union (“CJEU”) has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co*

KG [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to

encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

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

Use of the marks

15. In her witness statement, Ms. Haywood explains that Karndean International Limited (KIL) was incorporated on 9 February 1982 and forms part of the wider group of companies being Designflooring International Limited, Designflooring (International) South Limited and Karndean Limited, all UK-registered companies, along with Designflooring GmbH, registered in Germany¹. She states that KIL’s core activities lie in the distribution of flooring products with the products being manufactured externally on their behalf.

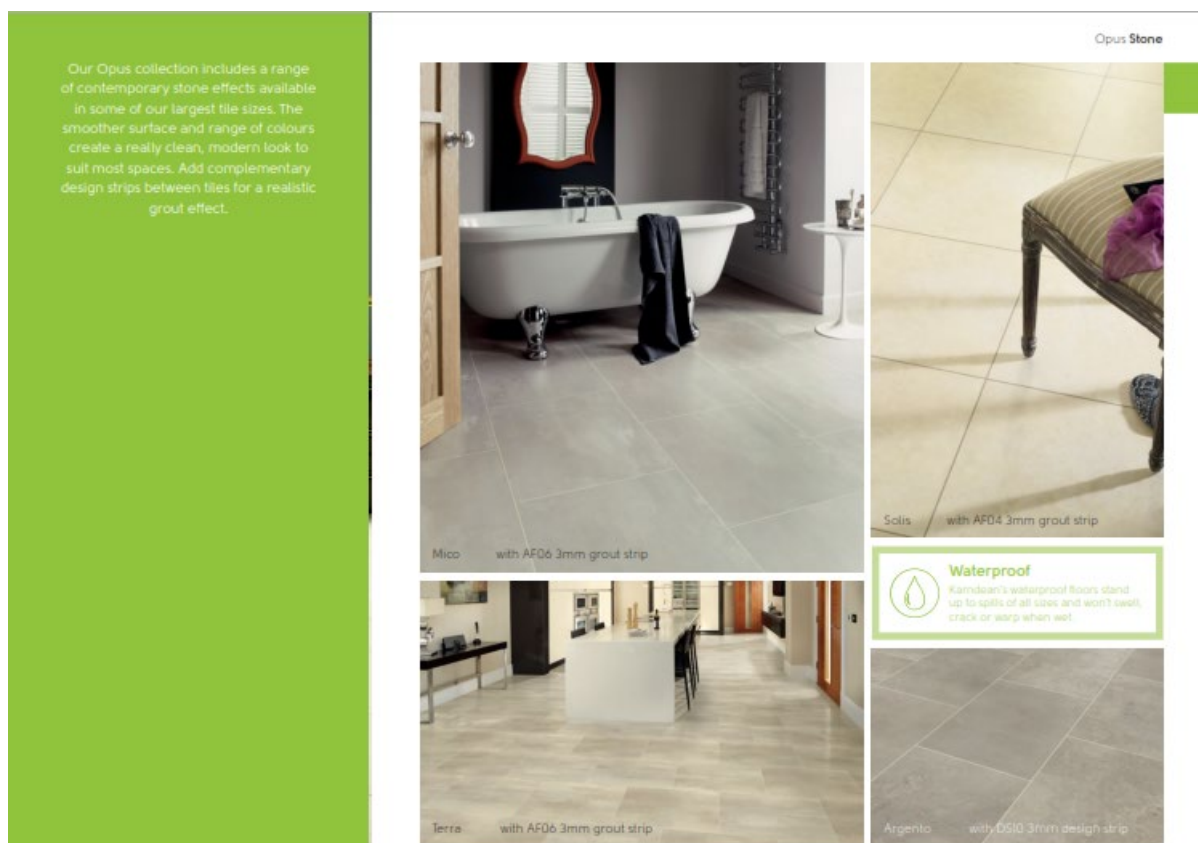
16. Ms. Haywood continues that the OPUS range was introduced in July 2010, to provide larger format stone and wood effect floors in contemporary colours and designs. The Opus stone tiles replicate natural stone or ceramic flooring, with the exception of two metallic effect designs.²

17. It is further explained that these flooring products are sold to customers via wholesale routes with the KIL website acting as a “shop window” displaying images and information about various products including the OPUS range. These wholesalers include retailers based locally and throughout the UK in areas such as Manchester, Oxford, Bristol and Norwich³. Several invoices sent to wholesalers dated within the relevant period have been provided within Exhibit MH7. Although the invoices do not display the “OPUS” mark, I have examined the product descriptions on the invoices and am satisfied that they correspond to OPUS sub-brand designs such as ‘Mico’, ‘Terra’ and ‘Argento’ from the OPUS stone range as shown below in Exhibit MH4:

¹ Paragraph 4 of the Witness Statement of Megan Haywood

² Paragraph 6 of the Witness Statement of Megan Haywood

³ Paragraph 19 of the Witness Statement of Megan Haywood



18. Turnover figures from within the UK have also been provided from the years 2010 to 2021. The turnover figures for the OPUS range have also been provided and are as follows:

Year	UK Turnover	UK Opus Turnover	%
2010	£33,658,832	Not available	n/a
2011	£34,619,918	Not available	n/a
2012	£36,120,180	Not available	n/a
2013	£40,561,385	£4,492,934	11.08
2014	£47,757,679	£5,405,633	11.32
2015	£54,340,473	£5,950,801	10.95
2016	£63,329,453	£6,478,216	10.23
2017	£70,550,743	£7,531,649	10.68
2018	£69,740,280	£7,356,480	10.55
2019	£74,768,310	£7,977,708	10.67
2020	£72,729,062	£6,776,880	9.32
2021	TBC	£7,317,787	TBC

19. Whilst it has already been outlined that KIL sell their goods to wholesalers rather than directly to the consumer, their website displays the OPUS range to domestic and commercial consumers. Figures have been provided displaying web visitors for all OPUS product listing and product detail pages and are shown below:

Web visitors		
All Opus product listing and product detail pages		
	UK	Global
2017	37,577	63,736
2018	35,327	61,003
2019	41,548	65,827
2020	57,449	95,116
2021	58,530	99,100
	230,431	384,782

20. It is also stated that brochures are either downloaded or paper copies are distributed throughout the UK all including the OPUS range. Details of the brochures downloaded and distributed throughout the UK are as follows:

Brochure downloads		Printed brochures distributed	
UK			
2013	1,461	2011	52,920
2014	5,265	2012	183,020
2015	4,235	2013	185,577
2016	4,974	2014	194,953
2017	3,905	2015	203,578
2018	5,003	2016	235,693
2019	6,634	2017	218,789
2020	11,105	2018	304,833
2021	10,775	2019	157,224
		2020	113,483
Total	53,357	2021	120,835

Use for the goods as registered

21. It is clear from the opponent's evidence above that it has made use of the mark OPUS within the relevant period and within the relevant territory. The opponent's mark is registered for the term '*floor coverings*' in class 27 however I note that the evidence

shown displays use of the mark in relation to vinyl floor tiles which are fitted to form permanent flooring as explained on the opponent's website provided at Exhibit MH5 as below:



22. Images from the brochure in Exhibit MH4 also display what appears to be permanent flooring as shown previously in paragraph 17 and below:

Opus Wood



23. Exhibit MH8 provides pages from the websites of various stockists providing further information about the flooring provided. By way of example, a sample from www.crawleycarpetwarehouse.co.uk from Exhibit MH8 is shown below:

Karndean Opus Luxury Vinyl Tile Flooring

Opus is one of the six collections of **Karndean** Luxury Vinyl Flooring we have at Crawley Carpet Warehouse. Karndean has a Global reputation for superb quality and innovative designs in its flooring. Each of the 6 collections are ideal for any room for any home or business. The Opus collection comes in 2 ranges, Opus inspired by wood and Opus inspired by stone. The floors themselves are easy to look after and easy to maintain. You can create something special from any of the Karndean Luxury Vinyl Flooring collections and if you require customisable features that is covered to so you can create imaginative floors that are stunning to look at yet easy to look after. Karndean gives you so many styles, finishes and formats to choose from, everyone can find something to suitable for them. To get an idea of the ranges and flexible styles have a look at the galleries for each of the Karndean ranges to help you transform, not just your floor, but your home.

Karndean Luxury Vinyl floors have becoming an ever increasing flooring choice for its range of looks and formats. As Karndean was original designed for the commercial flooring because of how hard wearing they are. Not long after, Karndean brought out ranges specifically to target flooring for homes and residential properties which offered a classic and stylishly unique look with the added features of looking and feeling just like real wood or stone/ceramics.

Karndean LVT comes with a lifetime guarantee for the floor when fitted by an approved Karndean fitter. The beauty of this is that if you sell your property at a later date, the Karndean guarantee can be signed over to the new owner. The ease of maintenance and replacement is a real winner for Karndean Luxury Vinyl Tiles, as all you have to do is give us a call and we will come out heat up the damaged tile and lay in a new one, the work involved is so minimal and time effective compared to other flooring that you will never know that there was a damaged tile in there. The design ideas you can have are endless from straight lay to diagonal lay to boards with design strips, you can truly give your home that traditional yet modern look while still being warm under foot unlike Laminates, Real Wood and Ceramics.

Karndean flooring is a great alternative to any hardwood/ceramic flooring, Hygienic-low maintenance-durable and affordable, a Luxury Vinyl Floor will not harbour dirt and will not need sanding. Along with the plus side to Karndean Luxury Vinyl Flooring is the stripper and polisher which you only need to do once a year (which is optional) but it will keep your flooring looking brand new for many years to come.

If you would like advice on purchasing Karndean Opus Luxury Vinyl Flooring see our [LVT buy guide](#) and our [LVT care guide](#) for how to care for your new floor.

24. A further example from Exhibit MH8 provides information from www.surefitcarpets.co.uk stating that the OPUS range is comprised of stone and wood vinyl floor tiles. I also note their description states "...you can find a floor that will last decades", indicating that the goods sold under the OPUS mark are intended to form permanent flooring:

The Karndean Opus Flooring collection is comprised of a stunning range of both stone and wood vinyl flooring tiles. Surefit Carpets are proud to supply Karndean flooring. Karndean are one of the world's leading manufacturers of luxury vinyl that looks as classy, beautiful and modern as real wood or stone, but is much cheaper and easier to maintain.

The Opus range is extremely versatile with flooring options to suit any environment from bedrooms to bathrooms. There is a range of choices in variations of colour and texture so you can get the exact look you want without compromise.

Wood Range

The Opus collection's excellence lies in its contemporary design. It is sleek and stylish so that whatever room in which you place your flooring, it'll look fantastic. In the range of colours and tints, you can find the one that perfectly compliments your decor and furniture.



As there are many simplistic designs, you can choose a floor that will withstand years of changing wallpaper, furniture and decorations. It's particularly useful if you have children whose tastes constantly change and rooms are being redecorated every few years. With the Karndean opal collection, you can find a floor that will last decades. Simplistic and contemporary, it will go with anything your kids want in their bedrooms!

For example, the Pallida floor tiles are a simple pale colour with a dynamic range of very light brown tones. The grain is intricate to create a beautiful natural appearance that looks like real hardwood. Its simplicity makes it fantastic not just for any room, but for the changing styles of a family home through the decades.

The grain and texture of the opal range make the wooden floors extremely attractive and beautiful. They're also completely waterproof so are the perfect choice for busy homes.

25. Within its written submissions, the opponent states:

“63. In view of the foregoing, the Opponent submits that the Registration has clearly been used in the manner in which it is registered, in relation to floor coverings, being primarily a range of wood-look, stone-look and abstract designs of floor covering, including decorative borders and strips, and also strips intended to resemble grout, allowing the presentation of a floor which looks to be made of tiles when in fact it is not.”

26. I consider that the products being provided by the opponent include flooring, particularly vinyl flooring. To my mind, the ordinary and natural meaning of the term *floor coverings* will include top layer coverings to be laid upon an existing floor. It is my view that this will include goods such as rugs, mats, carpets and roll out products, and not the vinyl flooring namely the vinyl tiles and planks that fit together to create a solid floor structure that appear to be offered by the opponent.

27. However, in case I am wrong and the term ‘floor coverings’ may be interpreted more broadly, I consider for completeness its possible broader meaning of a product that covers the floor, but at the same time keeping in mind that the term falls within class 27. It is clear that the class within which a term is categorised is an administrative decision and does not dictate, for example, whether goods may be found to be similar to goods in other classes. However, in *Altecnic Ltd’s Trade Mark Application*⁴ the Court of Appeal decided that “*the Registrar is entitled to treat the Class number in the application as relevant to the interpretation of the scope of the application, for example, in the case of an ambiguity in the list of the specification of goods.*”

28. Further, in addition, in *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)*, [2018] EWHC 3608 (Ch), the late Mr Justice Carr considered whether it was appropriate to take the class(es) in which the trade mark was registered into account in revocation or invalidation proceedings when deciding whether a description covered the goods/services shown in the evidence. After considering the judgments of the High Court in the Omega 1 [2010] EWHC 1211 (Ch) and Omega 2 cases [2012] EWHC 3440 (Ch), the judge stated that in his (provisional) view, the class number should be taken into account where the meaning of the disputed term is not otherwise sufficiently clear and precise. In particular the judge stated that where “*the words chosen may be vague or could refer to goods or services in numerous classes [of the Nice classification system], the class may be used as an aid to interpret what the words mean with the overall objective of legal certainty of the specification of goods and services.*”

⁴ *Altecnic Ltd’s Trade Mark Application* [2002] RPC 34 (COA)

29. Whilst the comments made by the late Mr Justice Carr above concerned invalidation and revocation proceedings, I find I may apply these same principles to these opposition proceedings. If the term “*floor coverings*” is to be interpreted broadly to mean quite literally anything that may cover a floor, it will be capable of referring to goods in a number of classes, including class 6, class 19 and class 27. I therefore consider it appropriate in these circumstances, to use the class number as a guide to construe the meaning of the description “*floor coverings*” in class 27, and determine if, in this instance, the use of the mark in relation to the goods as shown in the evidence is use in relation to the goods as registered.

30. I note that vinyl flooring itself, in addition to vinyl floor coverings for forming a floor are proper to class 19 rather than 27, along with other goods such as wooden flooring, laminate flooring, ceramic floor tiles for covering floors, bamboo flooring and rubber flooring for example. However, vinyl floor coverings for existing floors are included within class 27, alongside goods such as floor mats and floor tiles of carpet. The question therefore is whether the opponent’s goods shown in the evidence constitute vinyl flooring for forming a floor within class 19, or vinyl flooring for covering existing floors, which may fall under *floor coverings* in class 27 as registered.

31. I note firstly that the goods themselves are described consistently in the evidence as ‘vinyl flooring’ on the third-party websites and reviews provided. The longevity of the tiles and the method in which they are fitted are also outlined in brochures⁵ and on websites⁶ indicating that the flooring offered by the opponent is for the purpose of forming a permanent floor. I therefore consider that the goods are vinyl tiles or planks that fit together to form a solid floor structure. With full consideration of the evidence provided, it is my view the goods that are shown are proper to class 19 under the term *vinyl flooring*. I consider that *vinyl floor coverings for existing floors*, which may well fall within the scope of the *floor coverings* in class 27 as registered by the opponent, will comprise roll out products for sticking over flooring, rather than the more structured products offered by the opponent.

⁵ See Exhibit MH4

⁶ See exhibit MH8

32. This reaffirms my initial position that whilst use of the mark has been evidenced, it is not use of the mark in respect of the goods as registered. Consequently, the evidence of use provided showing vinyl flooring is of no assistance to the opponent and I therefore consider the evidence provided to be insufficient to allow me to find that there has been genuine use in relation to any of the goods on which the opponent relies.

33. Consequently, in the absence of any evidence from the opponent to demonstrate use of *floor coverings* in class 27, the earlier marks cannot be relied upon in these proceedings and on that basis, the opposition under Section 5(2)(b) fails.

Conclusion

34. The opposition by Karndean International Limited has failed. Subject to any successful appeal, the application by The Mosaic Tile Co. Ltd may proceed to registration.

COSTS

35. The applicant has been successful in this case and is therefore entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice ('TPN') 2 of 2016. Using that TPN as a guide, I award costs to the applicant on the following basis:

Preparing a statement and considering the other side's statement:	£200
Considering the other side's evidence:	£200
Total:	£400

36. I therefore order Karndean International Limited to pay the sum of £400 to The Mosaic Tile Co. Ltd. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 14th day of October 2022

Catrin Williams

For the Registrar