

o/898/22

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF INTERNATIONAL REGISTRATION NOS.
WO0000001546145 AND WO0000001544381

BY STO SE & CO. KGAA

TO REGISTER THE TRADE MARKS:

StoPanel

IN CLASSES 6, 17 AND 19

AND

StoPanel Technology

IN CLASSES 6, 17, 19 AND 37

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NOS. 423232 AND 423308

BY CUPA STONE S.L.U.

BACKGROUND AND PLEADINGS

1. International trade mark 1544381 (“the First IR”) consists of the word **StoPanel** shown on the cover page of this decision. The holder is Sto SE & Co. KGaA. The First IR is registered with effect from 27 April 2020. With effect from 27 April 2020, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The goods in which holder seeks protection for the First IR are contained in the Annex to this decision.

2. International trade mark 1544381 (“the Second IR”) consists of the words **StoPanel Technology** shown on the cover page of this decision. The holder is Sto SE & Co. KGaA. The Second IR also is registered with effect from 27 April 2020. With effect from 27 April 2020, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The goods and services in which holder seeks protection for the Second IR are contained in the Annex to this decision.

3. The request to protect the First IR was published on 13 November 2020. The request to protect the Second IR was published on 20 November 2020.

4. On 15 February 2021, and 22 February 2021, CUPA STONE S.L.U. (“the opponent”) opposed the protection of both IR’s in the UK based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following trade marks:



European Union trade mark no.005895792¹

¹ Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/2020 for further information.

Filing date 11 May 2007; registration date 10 April 2008.

(“The First Earlier Mark”)

Stonepanel Sky

European Union trade mark no.008365744

Filing date 16 June 2009; registration date 10 February 2010.

(“The Second Earlier Mark”)

The logo for Stonepanel cupa features the word "stonepanel" in a bold, orange, lowercase sans-serif font. Below it, the word "cupa" is written in a grey, lowercase, italicized sans-serif font.

European Union trade mark no.006011571

Filing date 18 June 2007; registration date 29 May 2008.

(“The Third Earlier Mark”)

5. For the opposition against the First IR, the opponent only relies upon class 19 for all of the above marks. For the opposition against the Second IR, the opponent relies upon both class 19 and 37 for all of the above marks. All of the specifications for the opponent’s earlier marks are contained in the Annex to this decision.

6. I note that the opposition against the First IR is directed against all of the holder’s goods in classes 6 and 19, and in relation to all the goods other than “extruded plastics [semi-finished products]; extruded plastic in the form of bars, blocks, pellets, rods, sheets and tubes for use in manufacturing; double profiles and expansion profiles of plastic” in class 17.

7. I note that the opposition against the Second IR is directed against all of the holder’s goods in classes 6 and 19, and in relation to all the goods other than “adhesive tapes including double-sided adhesive tapes, other than stationary and not for medical or

household purposes; adhesive masking tapes” in class 17, and in relation to all services in class 37.

8. The opponent claims that there is a likelihood of confusion because the of identity and similarity of the goods and services and because of the similarity of the marks.

9. The holder filed a counterstatement denying the claims made.

10. The opponent is represented by Kilburn & Strode LLP and the holder is represented by Mewburn Ellis LLP. The opponent filed two sets of evidence in chief and submissions. The holder filed one set of evidence in chief and submissions. The holder’s evidence consists of the witness statement of Ranier Hüttenberger dated 23 May 2022. Mr Hüttenberger is the Executive Board Spokesperson at STO Management SE, a position which he has held since June 2015. Mr Hüttenberger’s statement was accompanied by 4 exhibits (RH1-RH4). Neither party requested a hearing, but both parties filed submissions in lieu. Whilst I do not propose to summarise it here, I have taken all of the evidence and the parties’ submissions into consideration in reaching my decision and will refer to it where necessary below.

11. 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

12. The opponent’s evidence consists of the first witness statement of Nora Fowler dated 3 February 2022. Ms Fowler is a Trade Mark Attorney with Kilburn & Strode who is the opponent’s representative in this matter. Ms Fowler’s statement was accompanied by 4 exhibits (NF1-NF4).

13. The opponent’s evidence also consists of the second witness statement of Nora Fowler dated 7 February 2022. Ms Fowler’s statement was accompanied by 8 exhibits

(NXF1-NXF8). However, I note that some of the exhibits provide the same information which is contained in exhibits NF1-NF4.

14. Ms Fowler provides the following turnover figures for the goods sold under the “Stonepanel” mark, in the last five years, in the UK, in **exhibits NF4** and **NXF4**:

2021	2020	2019	2018	2017
507.783,00 €	443.634,00 €	180.166,00 €	778.647,00 €	150.000,00€

15. The following marketing and advertising figures have also been provided “in relation to the marks”, in the last 5 years, in the UK:

2021	2020	2019	2018	2017
9.440,00 €	3.450,00 €	3.460,00 €	4.725,00 €	1.450,00 €

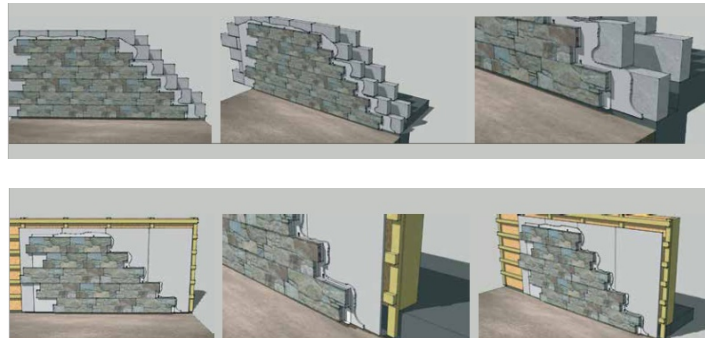
16. I note that Ms Fowler has provided 7 catalogues/pricelists, dated between 2016 and 2021, containing information on the opponent’s class 19 goods in both **exhibit NF1** and **NXF1**.

17. The first brochure in **exhibit NF1** is a Taylor Maxwell 2017 brochure. As highlighted in **exhibit NXF6**, Taylor Maxwell is a UK distributor for the opponent. I note that throughout the brochure, the opponent has used the following mark (variant 1), including on the front page, and on the right top hand corner of the brochure pages:



18. The brochure describes ‘STONEPANEL’ as “an innovative cladding system for walls and facades, suitable for both internal and external application”. Cladding is defined as a covering that is fixed to the outside of a building to protect it against bad

weather or to make it look more attractive.² I note that this correlates to the following images provided in the opponent's brochure:



19. The first brochure also explains that the individual panels are “made of natural stone including quartzite, gneiss, limestone, sandstone or slate joined to a cement base that is reinforced with a light metal or fibre glass mesh at the base”. Stonepanel cladding “is the only natural stone pre-assembled product on the market that is backed by BBA certification and offers installation advantages over traditionally built natural stone”. I also note that the opponent's goods are made into Z shaped panels to avoid visible joints and to make the placement simpler. The brochure also lists the different shapes of the individual panels which are provided by the opponent such as the ‘double end large’, ‘radial curve long’, ‘window reveal corner small’ and ‘short faced end’.

20. The brochure also references the opponent's “STONEPANEL SKY” which “allows you to install to greater highs” using a “patented built-in mechanical anchoring system allowing cladding of higher areas with adhesive fix alone”.

21. The second and seventh catalogues are by the opponent (CUPA). These catalogues are dated 2020 and 2018. I note that another variant (variant 2) of the opponent's First Earlier Mark is used throughout, and in combination with its First Earlier Mark, for example:

² <https://www.collinsdictionary.com/dictionary/english/cladding>

STONE PANEL
MULTICOLOR THIN SET SLATE

Red and brown thin set slate. It is an original composition for contemporary and modern interiors.

Applications
Interior and exterior cladding
Incorporated mechanical anchor for installation on surfaces higher than two meters.

Standard measure
60 x 20 x 3-4.5 cm

Options
Massive corners and special pieces upon demand

Reference
2000045837



STONE PANEL
by CUPA GROUP

STONEPANEL™ is the most efficient, safe, aesthetic and the highest quality constructive solution that can be used for any type of natural stone wall cladding.

✦ MORE EFFICIENT

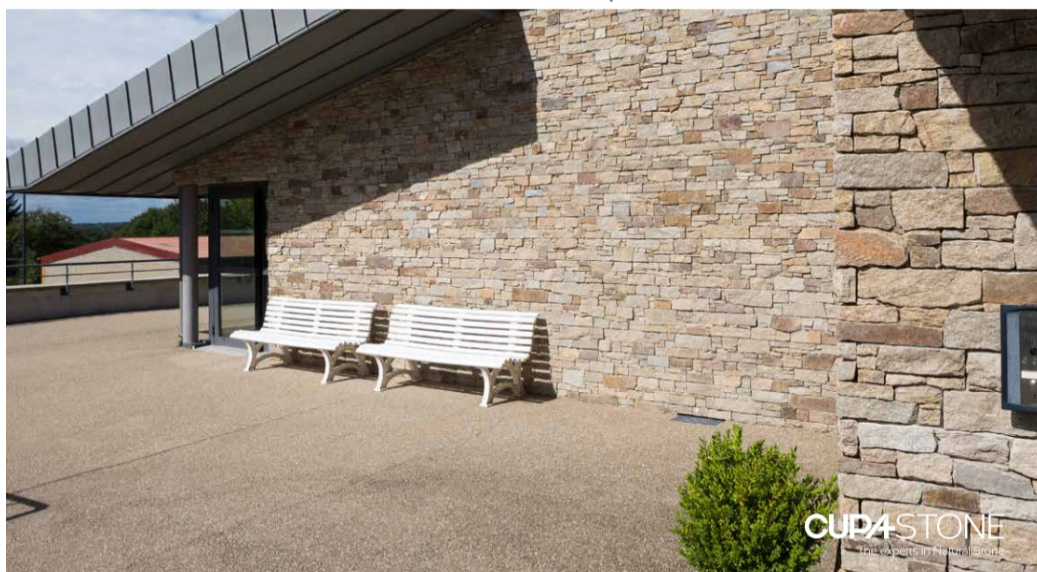
- Simple and quick installation: **10 times faster** than traditional masonry (placing rate average 15 m²/day)
- More profitable: virtually non-existent product waste. Natural Stone products are more durable than other cladding materials.
- STONEPANEL™ installation requires no skilled labor or machinery.



22. They highlight the same information as above. The panels are “composed by natural stone pieces, mounted on a cement base and reinforced with lightweight glass fibre”. The second brochure also highlights that there are 14 different types and colours of stone cladding that the opponent offers, from dark toned natural slate to golden quartzite. The seventh brochure shows that the opponent offers 18 different types and colours of stone cladding.

23. The third, fourth, fifth and sixth brochures in **exhibit NF1** are pricelists for the years 2018 to 2021. Again, variant 2 of the First Earlier Mark is used on the front pages, as well as on top of every price list, for example:

STONE PANEL
by CUPA GROUP



PRICE LIST 2018 | STONEPANEL™ COLLECTION

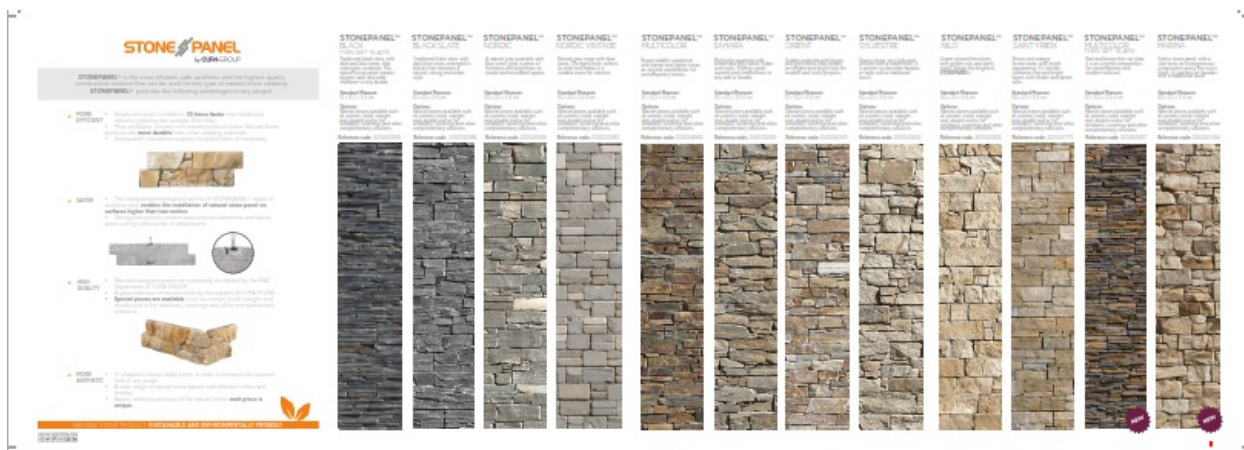
37

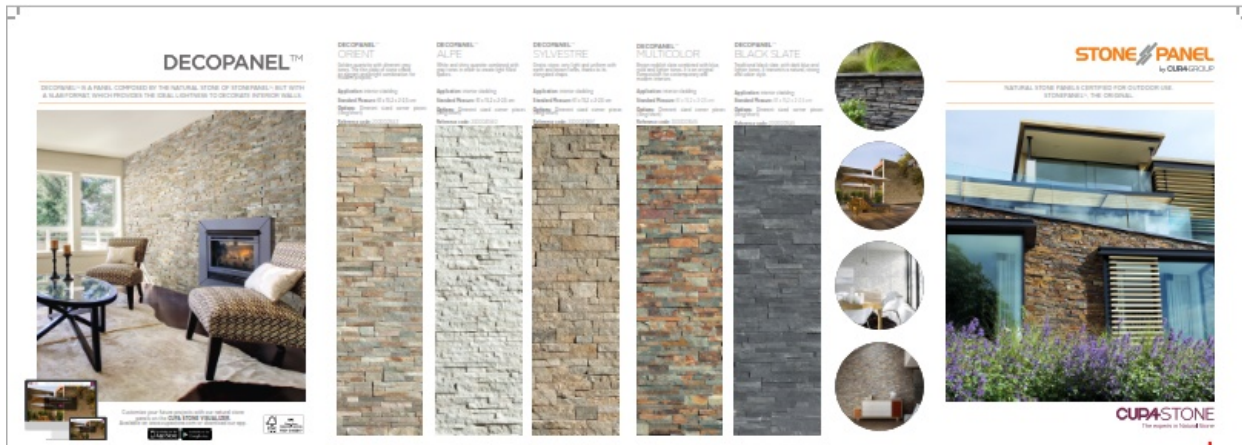
SAP	PRODUCT	USEFUL DIM.	REAL DIM.	M2/PAL	KG/PAL	PCS/PAL	PALS/CONT	CAP/CONT	Units	PRICE EXW PINTO EUR 2018
STONEPANEL™ SKY ORIENT GOLD QUARTZITE										
2000000976	Stonepanel Sky Orient Gold Quartzite	560x152x40mm	610x152x40 mm	10,214	882	120	32	326,861	m2	53,79 €
2000000929	Long Corners Sky for SPZ-14R	585x152x40mm	610x152x40 mm	10,670	861	120	32	3840	pcs	4,89 €
2000000930	Short Corners Sky for SPZ-14R	280x152x40mm	305x152x40 mm	10,214	800,4	240	32	7680	pcs	2,68 €
2000049281	Orient Massive Corner Sky - S	350x152x40 mm	-	-	526,339	100	32	3200	pcs	6,36 €
2000049286	Orient Massive Corner Sky - M	550x152x40 mm	-	-	456,161	60	32	1920	pcs	7,97 €
2000049185	Orient Massive Corner Sky - L	650x152x40 mm	-	-	438,616	50	32	1600	pcs	8,80 €
2000049513	Straight End Short Corner Sky Orient	280x152x40 mm	305x152x40 mm	11,126	865,307	240	32	7680	pcs	2,80 €
2000049514	Straight End Long Corner Sky Orient	585x152x40 mm	610x152x40 mm	11,126	829,584	120	32	3840	pcs	5,45 €

24. I note that these exhibits also use another mark (variant 3), which is the word STONEPANEL with the TM above the letter 'L' (as shown above).

25. The 2018 pricelist is specifically the opponent's pricelist, however the 2019, 2020, and 2021 pricelists are Taylor Maxwell pricelists. I note that all of the products within these brochures are cladding panels, which are categorised by the type of stone and the type of panel e.g. "long corners". I note that all of the panel pricing ranges from €1.58 to €213.28, and that the variety of stone options and prices increase per year.

26. The same brochure evidence is provided in **exhibit NXF1**. However, the first 2 pages clearly shows the range of 17 stone cladding panels which are provided, as well as use of the earlier marks, as follows:





27. **Exhibit NF2** provides 37 invoices relating to the opponent’s STONEPANEL and STONEPANEL SKY cladding goods, 20 of these are the opponent’s own invoices (CUPASTONE). These are dated between 2016 to 2018, and amount to €222,070.17. I note that 2 invoices are addressed to the UK distributor Taylor Maxwell in Edinburgh, and 5 invoices are also addressed to the same Taylor Maxwell in Bristol. I note that the remaining invoices are all addressed to different clients who are located in Dublin, Slovenia, Armenia, the Czech Republic and Belgium.

28. There are also 7 invoices in **exhibit NF2** which are from the company “Ramilo” selling “STONEPANEL” goods. I note that these invoices amount to €121,445.75 and are addressed to Taylor Maxwell in Bristol. The remaining 10 invoices are from “Dachser”. From the invoices, Dachser is labelled as the ‘delivery agent’ and Ramilo is labelled as the ‘shipper’ and Taylor Maxwell is labelled as the ‘consignee’. The goods listed on the Dachser invoices are crates of “natural stone”.

29. **Exhibit NXF2** also contains the above invoices as well as the additional:

- A €16,912.84 Ramilo invoice for STONEPANEL SKY NORDIC dated 10 December 2019 addressed to a customer in Ireland.
- 6 opponent invoices dated between February 2017 and July 2018 addressed to Taylor Maxwell in Edinburgh. The total of these invoices amount to €111,821.84.
- 3 opponent invoices dated between June to July 2019 addressed to Taylor Maxwell in Bristol. The total of these invoices amount to €45,821.56.

- 10 opponent packing lists for Taylor Maxwell.
- 9 Dachser invoices which mark the opponent as the “shipper” and the “notify party” as Taylor Maxwell.

30. **Exhibit NF3** and **NXF3** contains website screenshots using the wayback machine. The screenshots all clearly use the wording ‘STONEPANEL’. I also note the following from these exhibits:

- A screenshot from the opponent’s website dated 29 October 2016 which describes the opponent’s products as pre-mounted stone panels which have passed “demanding and prestigious tests”.
- A screenshot from the opponent’s website dated 17 February 2017 and 10 August 2018. The only information on this page is “the only panel certified for exterior installation”. This page includes use of variant 2 of the opponent’s First Earlier Mark.
- A screenshot from Taylor Maxwell’s website dated 25 November 2020 describing the opponent’s goods as “an innovative cladding system for walls and facades, suitable for both internal and external application”. Variant 1 is clearly displayed on this page within the paragraph describing the opponent’s goods.

31. **Exhibit NXF5** contains a variety of invoices which Ms Fowler states relates to the opponent’s marketing expenditure which amount to €8,510.89. However, the invoices are all in Spanish and are addressed to the opponent’s and Ramilo’s locations in Spain (Léon and Pontevedra). The opponent hasn’t provided any official translations for this documentation, nor have they provided any submissions as to whether the above marketing expenses are just for Spain or pertain to other EU countries.

32. **Exhibit NXF6** contains a Taylor Maxwell case study regarding the use of STONEPANEL products in the UK. Variant 1 is clearly displayed on the second and fourth page of the case study. The case study explains that Taylor Maxwell provided STONEPANEL cladding for a new primary care centre which had been constructed in a town in Staffordshire. I note that the opponent has positive reviews of their cladding

products being good value for money, as well as having an excellent BREEAM rating. The case study makes it clear that “Stonepanel cladding is exclusive to Taylor Maxwell in the UK”, and on the last page it lists all 16 Taylor Maxwell locations including; Glasgow, Leeds, Manchester, Nottingham, Birmingham, Cardiff, Bristol, Barnet and Exeter.

33. **Exhibit NXF7** contains a weblink to a STONEPANEL installation video on YouTube. Evidence containing references to weblinks are not acceptable in proceedings before the Tribunal and I will not undertake any independent research in respect of this article. The weblink will, therefore, be discounted. However, I note that the exhibit does also provide screenshots of a STONEPANEL installation video on YouTube. Therefore, I am able to determine that variant 2 is clearly displayed at the beginning of the video, which is dated 13 May 2015. I note that the screenshots also show that the video has 8,928 views, however, the opponent hasn’t provided a screenshot date.

34. **Exhibit NXF8** contains a wayback machine screenshot which demonstrates that the opponent’s STONEPANEL Technical Information document was circulated as far back as 9 June 2019. The brochure itself is also contained within this exhibit. The first page clearly displays variant 2, with use of variant 1 on every page. It also contains the following content:

- STONEPANEL types (STONEPANEL and STONEPANEL SKY)
- Installation guide
- Environment statement
- Comparison with other panels
- 11 STONEPANEL models (e.g. Black Slate, Nordic and Multicolour)
- Special pieces (e.g. solid corner, straight end and curved)
- Testing and certification

35. I note that some of the above information in **exhibit NXF8** significantly overlaps with the information in the brochure evidence I have already provided above.

Proof of use

36. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark ... or international trade mark (UK) ... 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,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

[...]

37. Section 6A of the Act states:

“(1) This section applies where

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

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

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

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

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

(5)-(5A) [Repealed]

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

38. The opponent’s marks qualify as earlier marks in accordance with section 6(1)(a) and 6(1)(ab) as their filing dates are earlier dates than the priority date of the holder’s marks. As the earlier trade marks had completed their registration process more than five years before the priority date of the marks in issue, they are subject to proof of use pursuant to section 6A(1) and (1A) of the Act.

39. I must assess whether, and to what extent, the above evidence supports the opponent’s statement that it has made genuine use of its marks in relation to the goods and services for which it is registered. The relevant period for the First IR is the five years ending on the priority date, i.e. 20 December 2014 to 19 December 2019. The relevant period for the Second IR is the five years ending on the priority date, i.e. 21 December 2014 to 20 December 2019. I note there is only a 1 day difference between the relevant periods.

40. Consequently, with the majority of the two periods significantly overlapping, the majority of the same evidence above will apply to both, and therefore I will deal with both periods as a collective.

41. The relevant provisions about proof of use in opposition proceedings are contained in section 6A of the Act, which I have set out above. Section 100 of the Act is also relevant, which reads:

“100. 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.”

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

“114.....The 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 Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken 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].”

Form of the mark/how the marks are used

43. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union (“CJEU”) found that (my emphasis):

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestle*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

44. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

"13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

45. Where the opponent's marks have been used as registered this will, clearly, be use upon which the opponent can rely.

46. However, as highlighted above, the opponent has used its First Earlier Mark in the following variants:

- 1) 
- 2) 
- 3) 

47. Variant 1 is the wording 'STONEPANEL', with the 'STONE' element in bold. It also includes the letters 'TM' in a smaller font at the top of the letter L. However, this is present to indicate that the mark is intended to function as a trade mark. I also note that variant 1 contains the wording "NATURAL STONE PANELS" underneath. I consider that the 'STONE' element is presented in bold to reinforce the fact that the words 'STONE' and 'PANEL' are separate words, rather than a whole new invented word. It distinguishes the two words clearly for the average consumer. I also consider that, as highlighted above, at paragraph 16 in *Lactalis McLelland Limited*, the addition of descriptive or suggestive words is unlikely to change the distinctive character of the mark. Consequently, I do not consider that the additional text "NATURAL STONE PANELS" alters the distinctive character because it is descriptive of the opponent's goods and services. However, variant 1 does not include the oblong device in the middle of the words 'STONE' and 'PANEL' as present in the First Earlier Mark. I consider that the distinctive character of the First Earlier Mark lies in it as a whole (the words STONE and PANEL and the oblong device), and therefore by removing the

device it alters the distinctive character of the mark. Consequently, variant 1 is not genuine use of the First Earlier Mark.

48. The opponent submits that variant 2 is use of the Third Earlier Mark. However, the Third Earlier Mark does not contain the oblong device, as present in variant 2, which consequently alters the distinctive character of the mark. Therefore, it cannot be an acceptable variant of the Third Earlier Mark. Alternatively, I consider that variant 2 is use of the First Earlier Mark with an additional element. The presence of the words 'STONE' and 'PANEL' in an orange stylised font, which is separated by the oblong device, is completely replicated, and is in which the distinctive character of the mark lies. However, underneath it includes the 'byCUPAGROUP' element. I do not consider that this addition alters the distinctive character of the mark and therefore variant 2 is acceptable use of the First Earlier Mark.

49. I consider that the same analysis in paragraph 47 applies as above for variant 3. Variant 3 is the word 'STONEPANEL' presented in bold, in either a standard grey or orange typeface, with the 'TM' above the letter L. Variant 3 does not include the oblong device in the middle of the words 'STONE' and 'PANEL'. I consider that the distinctive character of the First Earlier Mark lies in it as a whole (the words STONE and PANEL and the oblong device), and therefore by removing the device it alters the distinctive character of the mark. Consequently, variant 3 is not genuine use of the First Earlier Mark.

Conclusions from the evidence on genuine use

50. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.³

51. As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of

³ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.

52. As all of the earlier marks are EUTMs, I must consider the EU as the market in which the opponent is required to show genuine use.

53. Clearly, there are some issues with the opponent’s evidence. For example, some of the evidence falls after the relevant periods. I also note that the turnover and advertising figures only pertain to the UK. However, use of an EUTM in an area of the Union corresponding to the territory of one Member State can be sufficient to constitute genuine use of an EUTM.

54. The total revenue made by the opponent from 2017 to 2021 in the UK amounts to €2,060,230.00, and is therefore significant. I also note that I have been provided with advertising figures for the UK, from 2017 to 2021, which amounts to €22,525.00, albeit some of the figures fall outside of the relevant periods. I consider that these figures alone for the UK seem significant for both the UK and the EU, considering that the opponent operates within a niche market (stone and rock cladding). Therefore, although I haven’t been provided with market share figures, I consider that they seem notable for what is likely to be a smaller market within the UK/EU. I also note that the turnover figures are supported by invoice, pricelist and brochure evidence.

55. Taking all of this into account, I am satisfied that the opponent has demonstrated genuine use of the First Earlier Mark, with use variant 2, and use of its Second Earlier Mark. However, there is no use of the Third Earlier Mark in any of the opponent’s above evidence. Therefore, as there is no genuine or variant use of the Third Earlier Mark, the opponent cannot rely on it for these proceedings.

Fair Specification

56. I must now consider whether, or the extent to which, the evidence shows use of the services relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*,

BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

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

57. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably

be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

58. The goods and services for which the First and Second Earlier Marks are registered and upon which the opponent relies are a broad range of building and construction goods and services in classes 19 and 37.

59. It is clear from all of the opponent's evidence that the only goods they provide is cladding panels for the inside and outside of buildings. Therefore, I consider that the opponent's "building materials (non-metallic)" specification is too wide because it would cover a whole range of building materials such as cement and bricks etc.

60. Thus, I consider a fair specification for the First and Second Earlier Marks to be:

Class 19 Building materials (non-metallic), namely cladding; Works of stonemasonry.

Section 5(2)(b)

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

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

(a)...

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

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

62. In making this decision, I bear in mind the following principles 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

63. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the

Court of Justice of the European Union (“CJEU”) in Canon, Case C-39/97, the court stated at paragraph 23 that:

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

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors

65. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

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

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

67. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

68. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course,

to the normal and necessary principle that the words must be construed by reference to their context.”

69. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

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

70. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted, as the Appointed Person, in *Sandra Amalia Mary Elliot v LRC Holdings Limited*, BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.” Whilst on the other hand: “... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

Whilst on the other hand:

“... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

71. In making my assessment, I note that the Tribunal Manual states that specifications which include the wording 'namely' should be interpreted as covering only the named goods within that specification. Therefore, the specification is limited to only those goods.

The First IR

Class 6

Metal cladding; facade facings of metal.

72. I consider that the holder's above goods will have some overlap with the opponent's "building materials (non-metallic), namely cladding". All of the goods are types of cladding and therefore they will overlap in method of use and purpose. However, as the holder's goods are made out of metal and the opponent's goods are specifically non-metallic. Therefore, I do not consider they overlap in nature. I consider that there may be an overlap in trade channels because an undertaking may specialise in all types of cladding including both stone and metal. I also consider that there would be an overlap in distribution channels as different types of cladding would be sold in general DIY retail stores. I consider that the goods may be in competition; however, they are not complementary. Consequently, I consider that the goods are similar to between a medium and high degree.

Support profiles and wall holders of metal for wall and façade claddings; holding profiles of metal for building panels.

73. I consider that the holder's above goods will have some overlap with the opponent's "building materials (non-metallic), namely cladding". The holder's goods do not overlap in nature, method of use or purpose because they are support structures to which cladding is attached, however, there may be an overlap in trade channels because I consider that the same undertaking would provide both the support structures and the cladding. I also consider that there will be an overlap in user and that the goods will be complementary, however, they are not in competition.

Taking the above into account, I consider that the goods are similar to no more than a medium degree.

Building materials wholly or partly of metal; prefabricated houses (kits) of metal; prefabricated elements of metal for building; conservatories of metal in prefabricated form; prefabricated buildings made substantially of metal; shelters made of prefabricated metal insulated materials; prefabricated wall structures of metal incorporating mineral wool insulation; reinforcing materials of metal for building; wire rope; metal cable wire; door frames of metal; anchor bolts of metal for bridge connection; structural steels; aluminium; sheets of aluminium; aluminium ingots; curtain walling of metal; metal fasteners for doors and windows; anchors; nails; ironmongery; small items of metal hardware; base rails and corner protection rails, all the aforesaid of metal.

74. I consider that the holder's above goods are dissimilar to the opponent's "building materials (non-metallic), namely cladding" and "works of stonemasonry" in terms of nature, intended purpose and method of use. However, there may be an overlap in distribution channels because general DIY retail outlets would sell all of the above goods, but not in the same aisle. There may be an overlap in user, and some overlap in purpose, as the goods would be used for home improvement and during construction. I do not consider that the goods are in competition nor complementary. I therefore find all of the goods to be similar to between a low and medium degree.

Metal containers for packing, transportation and storage of building materials at building sites, all these containers being empty or filled with non-metallic building materials.

75. I consider that the holder's above goods are dissimilar to the opponent's "building materials (non-metallic), namely cladding" and "works of stonemasonry" in terms of nature, intended purpose and method of use. I also do not consider that there would be an overlap in trade channels because the holder's goods would be sold by construction storage companies whereas the opponent's goods would be sold through a DIY retail outlet. I do not consider that the goods are in competition nor

complementary. Whilst there may be an overlap in users, this is not enough on its own to establish similarity. I therefore find all of the goods to be dissimilar.

Class 17

Building materials with waterproof properties (non-metallic).

76. I consider that the opponent's "building materials (non-metallic), namely cladding" falls within the holder's above broader category. I consider them identical on the principle outlined in *Meric*.

Plastics materials in the form of sheets [semi-finished products]; plastics in the form of sheets.

77. I consider that the above goods overlap with the opponent's "building materials (non-metallic), namely cladding" because they all would be sold at DIY retail outlets, or hardware stores. I also consider that the goods will overlap in purpose and method of use as the holder's plastic sheets could be used as a form of cladding, and attached to the outside surface of a wall or building. I do not consider that the goods are complementary, however, they may be in competition. Consequently, I consider that the goods are similar to between a medium and high degree.

Fibreglass for insulation; fibreglass fabrics for insulation; glass fiber insulation for use in construction; glass fiber insulation materials for use in construction; glass wool for insulation; insulating materials; insulating materials of all kinds; elasticised insulating materials; insulating panels in the form of heat insulation materials of rigid foam, rock wool, glass wool, mineral fibres, mineral foam, pu foam, pir foam, phenolic resin, cork, hemp, softwood fibres; parts, profiles and rails of plastic for installation in thermal insulation composite devices; insulating materials produced from plastics; plastic film for insulating purposes.

78. I consider that all of the holder's above goods are types of insulation to be used during construction. I note that the opponent's "building materials (non-metallic), namely cladding" can also have insulating purposes, and would be sold through the

same distribution channels, such as a DIY retail outlet. Therefore, the goods will overlap distribution channels and user. However, the goods do not overlap in nature and method of use because the core purpose of the goods is different, one being to provide the outside surface of a wall or building, the other good being used to insulate buildings. I do not consider that the goods are in competition nor complementary. Therefore, I consider that the goods are similar between a low and medium degree.

Acoustic insulating panels; sound absorbing, sound control and sound reflecting building materials.

79. I consider that the holder's above goods are building materials used to absorb sound. I note that these are sold in DIY retail outlets and therefore overlap in trade channels with the opponent's "building materials (non-metallic), namely cladding". I also consider that there is some overlap in purpose as the opponent's cladding does provide some insulation, however that is not its main purpose, which is to provide the outside surface of a wall or building. Therefore, I do not consider that the goods overlap in method of use and nature as the holder's goods are used specifically for sound insulation. I do not consider that the goods are in competition nor complementary. Therefore, I consider that the goods are similar between a low and medium degree.

Plastics materials in the form of tapes [semi-finished products]; plastics materials in the form of foils [semi-finished products]; plastic seals; stuffing materials of plastics; plastics in the form of films, blocks, rods and tubes reinforcing rails of plastic for pipes.

80. I consider that the above goods have limited overlap with the opponent's "building materials (non-metallic), namely cladding" because they all would be sold at DIY retail outlets, or hardware stores. However, I do not consider that the goods would be sold in the same aisle, nor even sold in the same part of the DIY store which sells a wide variety of goods. The goods do not overlap in purpose, nature and method of use because the holder's above goods are a variety of plastic goods to be used for different construction purposes, whereas the opponent's cladding is specifically used on the face of a building to provide protection from the weather. I do not consider that the goods are in competition nor complementary. I therefore find all of the goods to be dissimilar.

Sealing compounds; pipe joint sealants.

81. I consider that the above goods have limited overlap with the opponent's "building materials (non-metallic), namely cladding" because all of the goods would be sold at DIY retail outlets, or hardware stores. However, I do not consider that the goods would be sold in the same aisle, nor even sold in the same part of the DIY store which sells a wide variety of goods. I also do not consider that the goods overlap in nature, method of use and purpose because the holder's above goods are sealants, which are used to seal cracks, holes and gaps within the household, or joints of pipes, whereas the opponent's goods are cladding which is used on the face of a building to provide protection from the weather. The goods are not in competition or complementary. Therefore, I consider that the goods are dissimilar.

Flexible pipes, not of metal; flexible tubes, not of metal.

82. I consider that the above goods have limited overlap with the opponent's "building materials (non-metallic), namely cladding" because all of the goods would be sold at DIY retail outlets, or hardware stores. However, I do not consider that the goods would be sold in the same aisle, nor even sold in the same part of the DIY store which sells a wide variety of goods. I also do not consider that the goods overlap in nature, method of use and purpose because the holder's above goods are pipes and tubes which would be found or installed within the household, whereas the opponent's goods are cladding which is used on the face (outside) of a building. The goods are not in competition or complementary. I consider that the goods are dissimilar.

Adhesive tapes including double-sided adhesive tape, other than stationary and not for medical or household purposes; adhesive masking tapes; expansion joints of fabric, insulating and drywall joint tapes.

83. I consider that the above goods have limited overlap with the opponent's "building materials (non-metallic), namely cladding" because all of the goods would be sold at DIY retail outlets, or hardware stores. However, the goods would not be sold in the same aisle or same part of the DIY store. The holder's above goods are all types of DIY tapes which would be used for a variety of home improvements purposes. The

opponent's goods are cladding which is used on the face of a building to provide protection from the weather. Therefore, the goods do not overlap in nature, method of use and purpose. The goods are not in competition or complementary. Consequently, I consider that the goods are dissimilar.

Class 19

Building materials (non-metallic).

84. I consider that the opponent's "building materials (non-metallic), namely cladding" falls within the holder's above broader category. I consider them identical on the principle outlined in *Meric*.

Ventilated curtain facade systems with support panels (not of metal).

85. I consider that the holder's above goods are a type of cladding and therefore falls within the opponent's broader category of "building materials (non-metallic), namely cladding". Therefore, I consider them identical on the principle outlined in *Meric*.

Masonry bricks; bricks.

86. I consider that the opponent's "works of stonemasonry" falls within the holder's above broader category. I consider them identical on the principle outlined in *Meric*.

Non-metallic panels for building, in particular panels for cladding walls and facades; facade sheets, partly made of stone, artificial stone or with coatings visually reminiscent of stone; building panels, wall panels, non-metallic panels for facade claddings; stone facades, stone-bonded facades, curtain-type, rear-ventilated facades, walls.

87. The façade means the "face of a building".⁴ Therefore, I consider that the opponent's "building materials (non-metallic), namely cladding", which are panels

⁴ <https://www.collinsdictionary.com/dictionary/english/facade> (British English)

made to cover the outside of a building, is self-evidently identical to the holder's above goods.

Non-metallic curtain-type, back-ventilated exterior wall cladding for buildings, including carrier panels for various coating variants.

88. I do not have any evidence or submissions before me as to what the holder's above goods are. However, as the term contains the wording "wall cladding", I consider that the holder's above goods are going to be at least similar to an average degree with the opponent's "building materials (non-metallic), namely cladding".

Prefabricated building elements (non-metallic); prefabricated elements (non-metallic) for building; prefabricated building elements (non-metallic) for onsite assembly; prefabricated wall structures (non-metallic) incorporating heat insulation materials of rigid foam, rock wool, glass wool, mineral fibres, mineral foam, pu foam, pir foam, phenolic resin, cork, hemp, softwood fibres; lightweight prefabricated building elements; prefabricated panels (non-metallic) incorporating heat insulation materials of rigid foam, rock wool, glass wool, mineral fibres, mineral foam, pu foam, pir foam, phenolic resin, cork, hemp, softwood fibres; lightweight prefabricated panels (non-metallic) incorporating heat insulation materials of rigid foam, rock wool, glass wool, mineral fibres, mineral foam, pu foam, pir foam, phenolic resin, cork, hemp, softwood fibres; non-metallic facade elements.

89. I note that "prefabricated buildings are built with parts which have been made in a factory so that they can be easily carried or put together".⁵ I consider that all of the above goods have been made offsite to be ready for use in construction projects. I consider that cladding is also a prefabricated material because it is made offsite, ready for use on a construction site. Therefore, I consider that the opponent's "building materials (non-metallic), namely cladding" falls within all of the holder's above broader categories. I consider them identical on the principle outlined in *Meric*.

⁵ <https://www.collinsdictionary.com/dictionary/english/prefabricated>

Stone; calcareous stone; sandstone; granite; marble; natural ashlar in blocks, slabs, massive stones; pottery stone.

90. As set out in *Les Éditions Albert René v OHIM*,⁶ it is clear that just because a particular good is used as a part, element or component of another, it should not result in a finding of identity/similarity between those goods. However, it does not mean that there can never be similarity between such goods where there is overlap in the factors identified in *Treat*.

91. The opponent's "works of stonemasonry", which are blocks of stone which are used in the creation of buildings, structures and sculpture, can be made out of the above types of stone in the holder's specification. Therefore, the goods overlap in nature. I also consider that all of the goods are to be used for building and construction, and therefore they overlap in purpose, method of use and user. However, I do not consider that there is an overlap in trade channels because the holder's goods would be purchased from a quarry which produces the stone, and it will be the opponent's undertaking which would purchase the stone from the quarry to produce their goods for contractors or the public. I do not consider that the goods are in competition nor complementary. Taking the above into account, I consider that the goods are similar to a medium degree.

Ceramic roofing tiles; tiles.

92. I note that the holder's above goods are used to cover a roof to protect a house or building from bad weather. I therefore consider that there would be an overlap in purpose with the opponent's "building materials (non-metallic), namely cladding" are also used to cover surfaces, on the outside of a building, to protect it from bad weather. I also consider that there would be some overlap in distribution channels because both goods would be sold in a DIY retail outlet. However, I also appreciate that the holder's goods could also be sold by specialist roofing companies. I do not consider that there is an overlap in nature and method of use. Nor do I consider that the goods are in

⁶ Case T-336/03

competition nor complementary. Therefore, I consider that the goods are similar to between a low and medium degree.

Non-metallic prefabricated platforms, prefabricated non-metallic storage sheds; prefabricated non-metallic garages; non-metallic prefabricated houses (kits); prefabricated houses (kits) of wood; modular units (non-metallic) for constructing prefabricated buildings; prefabricated structures (non-metallic) for use as building elements.

93. As highlighted above, I consider that as the opponent's cladding goods are also prefabricated, and therefore, they will to some extent, overlap in nature, with the holder's above goods. I consider that they may also overlap in distribution channels because they all would be sold at DIY retail outlets, or hardware stores. However, the goods do not overlap in method of use and purpose because the opponent's goods are specifically used for used on the face of a building to provide protection from the weather, whereas the holder's above goods are the actual walls and structures for houses, sheds and garages. I do not consider that the goods are in competition, however, they may be complementary because the cladding can be attached to the walls of these goods. I therefore find all of the goods to be similar to a low degree.

Rendering base, concrete repair materials for repairing concrete parts in structural and civil engineering; self-levelling concrete for use in building construction.

94. The holder's above goods can be sold in DIY retail outlets, and therefore I consider that they overlap in trade channels and user with the opponent's "building materials (non-metallic), namely cladding". However, I do not consider that the goods would be sold in the same aisle. I note that the holder's goods are multifunctional and can be used for multiple parts of construction such as the foundations and floors of a building. I note that the opponent's goods are used on the face of a building to provide protection from the weather. Therefore, although they are all used for construction purposes, they differ in nature and method of use. However, I do not consider that the goods are in competition nor complementary. Consequently, I find that the goods are dissimilar.

Timber mouldings; dado rails; rubber cove bases; beams, bars, rails, strips, profiles, non metallic brackets and corners, window sills, window frames, lintels, door sills, door frames, not of metal; filling compounds, quick repair mortar; drilling hole filling compounds; filling foam.

95. I consider that all of the above goods are those which would be sold at a DIY general retail outlet, to carry any home improvement or to fix any household problems. Therefore, I consider that there would be a limited overlap in distribution channels and user with the opponent's "building materials (non-metallic), namely cladding". However, I do not consider that the goods would be sold in the sale aisle. The goods also do overlap in nature, method of use and purpose because the opponent's goods are used to cover the face of a building to provide protection from the weather. I do not consider that the goods are in competition nor complementary. Consequently, I find all of the goods to be dissimilar.

Fibreboard for building.

96. I consider that the above goods would also be sold at a DIY general retail outlet. Therefore I consider that there would be a limited overlap in distribution channels and user with the opponent's "building materials (non-metallic), namely cladding". However, the goods would not be sold in the same aisle. The applicant's above goods can be used for an array of things, however, it is typically used in the construction industry for making furniture and cabinets. Therefore I do not consider that the goods overlap in nature, method of use and purpose with the opponent's cladding goods. The goods are not in competition nor complementary. Therefore, I find all of the goods to be dissimilar.

Non-metallic pipes for roof drainage installations.

97. The holder's above goods are pipes which are used for roof drainage installations. I consider that this may overlap with the opponent's "building materials (non-metallic), namely cladding" on the basis that they all would be sold at a DIY retail outlet or a hardware store. However, I do not consider that the goods would be sold in the sale aisle, nor even sold in the same part of the DIY store which sells a wide variety of

goods. I also do not consider that the goods would overlap in nature, method of use and purpose because the holder's goods are used for roof drainage whereas the opponent's goods are used to cover the outside of a building. I do not consider that the goods are in competition nor complementary. Consequently, I find all of the goods to be dissimilar.

Mosaic tiles for walls and floors; glass mosaics for use in building construction; ceramic tiles; interior and exterior stone floors.

98. I note that the holder's above goods are used to cover an interior or exterior surface, such as walls and floors. The opponent's "building materials (non-metallic), namely cladding" are also used to cover surfaces, and therefore they have minimal overlap in purpose. However, cladding is normally used on the outside of a building to protect it from bad weather. Therefore the goods do not overlap in nature and method of use. I consider that there would be an overlap in distribution channels and user as all of the goods would be sold in a DIY retail outlet. However, I do not consider that the goods would be sold in the sale aisle, nor even sold in the same part of the DIY store which sells a wide variety of goods. The goods are not complementary or in competition. I find all of the goods to be dissimilar.

Finishing coats of plasters for indoor and outdoor applications, decorative plaster for indoor and outdoor applications; artificial resin plaster, silicate plaster, silicone resin plaster, dry plaster (in powder form).

99. Plaster, which is normally sold in powdered form, to be mixed with water, forms a smooth paste, which dries hard, and is used to cover walls and ceilings. The opponent's "building materials (non-metallic), namely cladding" is normally used on the outside of a building to protect it from bad weather. Therefore, I do not consider that the goods overlap in nature, method of use and purpose. However, all of the goods would be sold at a DIY retail outlet, and therefore they overlap in trade channels, but I do not consider that the goods would be sold in the sale aisle, nor even sold in the same part of the DIY store which sells a wide variety of goods. I do not consider that the goods are in competition nor complementary. Therefore, I find all of the goods to be dissimilar.

Decorative compositions for floor coatings; non-metallic building profiles for building, non-metallic floor coatings based on cement, screed, mortar or concrete, including in combination with epoxy resins and polyurethanes.

100. I consider that the above goods may be provided by a flooring specialist, specifically in decorative compositions or epoxy resin, however, I also consider that the goods will be found in DIY retail outlets. Therefore, I consider that there would be limited overlap with the opponent's "building materials (non-metallic), namely cladding" on the basis that they are sold through the same distribution channels. However, I do not consider that the goods would be sold in the same aisle, nor even sold in the same part of the DIY store which sells a wide variety of goods. I consider that there may be an overlap in user, but the goods do not overlap in use, nature and purpose as all of the holder's above goods are coatings which cover floors whereas cladding is used to cover the face of a building to protect it against the weather. I do not consider that the goods are in competition nor complementary. I therefore consider that the goods are dissimilar.

Non-metallic fixing and bordering elements therefor; non-metallic fired refractory materials; woven fabrics in rolls, pieces or prefabricated platforms, not of metal for use in building, including fabric angles and corners; non-metallic refractory blocks; non-metallic refractory construction materials; reinforcing materials, not of metal, for building; non-metallic structure profiles for building; ceiling and wall coatings with rigid foam granules; non-metallic decorative mouldings and decorative trim for use in building construction, in particular of rigid foam and foamed beads.

101. For the above goods, without any evidence or submissions before me, it is not fully clear what the goods are. However, I note that 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.**”

102. Therefore, by taking into account that the terms appear in a class 19 specification, it is clear that all of the above goods are to be used for building and construction purposes. However, I still consider that the above would be dissimilar to the opponent’s “building materials (non-metallic), namely cladding” and “works of stonemasonry” goods. I do not consider that the goods would overlap in nature, intended purpose and method of use as opponent’s cladding is used on the face of a building to provide protection from the weather and its works of stonemasonry are blocks of stone which are used in the creation of buildings, structures and sculpture. Whilst there may be an overlap in users, and I appreciate that generically all of the goods will be used during construction, this is not enough to establish similarity on its own. As highlighted above, the opponent’s goods would be provided by cladding or stonemasonry specialists, or would be found in a DIY retail outlet. Therefore, even of the above goods were also to be found in a DIY retail outlet, I do not consider that the goods would be sold in the sale aisle, nor even sold in the same part of the DIY store which sells a wide variety of goods. Consequently, I consider that all of the goods are dissimilar.

Asphalt, pitch and bitumen; pitch, tar, bitumen and asphalt.

103. I consider that the holder’s above goods are more specialised, and are used in order to make surfaces, including, for example, roads, car parks and playgrounds. Therefore I do not think that these goods would overlap in trade channels, nature, method of use and purpose with the opponent’s “building materials (non-metallic), namely cladding” and “works of stonemasonry” goods which are used on the face of a building to provide protection from the weather/used in the creation of buildings, structures and

sculpture. I do not consider that the goods are in competition nor complementary. Therefore, I find all of the goods to be dissimilar.

The Second IR

Class 6

Metal cladding; facade facings of metal.

104. The same comparison applies in paragraph 72 above. Consequently, I consider that the goods are similar to between a medium and high degree.

Support profiles and wall holders of metal for wall and façade claddings; holding profiles of metal for building panels.

105. The same comparison applies in paragraph 73 above. Taking the above into account, I consider that the goods are similar to no more than a medium degree.

Prefabricated houses (kits) of metal; prefabricated elements of metal for building; conservatories of metal in prefabricated form; prefabricated buildings made substantially of metal; shelters made of prefabricated metal insulated materials; prefabricated wall structures of metal incorporating mineral wool insulation; reinforcing materials of metal for building; wire rope; metal cable wire; frames, in particular window frames of metal; metal fastening anchors; structural steels; aluminium; sheets of aluminium; aluminium ingots; curtain walling of metal; metal fasteners for doors and windows; mechanical fasteners of metal, in particular dowels, hooks, brackets, supports, mounts, anchors, suspension fasteners, screws, nuts, washers and flat washers, nails, clamps, ironmongery and small items of metal hardware; base rails and corner protection rails, all the aforesaid of metal; small items of metal hardware.

106. The same comparison applies in paragraph 74 above. I therefore find all of the goods to be similar to between a low and medium degree.

Acoustic panels of metal; acoustic panels of metal for ceilings; acoustic panels of metal for walls.

107. The same comparison applies in paragraph 79 above. Therefore, I consider that the goods are similar between a low and medium degree.

Metal containers for packing, transportation and storage of building materials at building sites, all these containers being empty or filled with non-metallic building materials.

108. The same comparison applies in paragraph 75 above. I therefore find all of the goods to be dissimilar.

Pipes, tubes and hoses, and fittings therefor, including valves, of metal.

109. I consider that the above goods have limited overlap with the opponent's "building materials (non-metallic), namely cladding". All of the goods would be sold at DIY retail outlets, or hardware stores. However, I do not consider that the goods would be sold in the sale aisle, nor even sold in the same part of the DIY store which sells a wide variety of goods. I also do not consider that the goods overlap in nature, method of use and purpose because the holder's above goods are pipes, tubes and hoses and fittings therefor which would be found or installed within the household, whereas the opponent's goods are cladding which is used and placed on the face of a building. The goods are not in competition or complementary. I consider that the goods are dissimilar.

Air ducts of metal for buildings; air grilles of metal.

110. I consider that the holder's above goods would be sold by ventilation specialist undertakings. The opponent's cladding is used on the face of a building to provide protection from the weather and its works of stonemasonry are blocks of stone which are used in the creation of buildings, structures and sculpture. These goods would be sold by stonemasons or in a DIY retail outlet. Consequently, I do not consider that these goods would overlap in trade channels, nature, method of use and purpose with

the opponent's "building materials (non-metallic), namely cladding" and "works of stonemasonry" goods. I do not consider that the goods are in competition nor complementary. I find all of the goods to be dissimilar.

Sills, not of metal, window frames, lintels, door sills, door frames of metal.

111. I consider that the holder's above goods are dissimilar to the opponent's "building materials (non-metallic), namely cladding" and "works of stonemasonry" in terms of nature, intended purpose and method of use. There may be an overlap in distribution channels and user because general DIY retail outlets would sell all of the above goods. However, I do not consider that the goods would be sold in the sale aisle, nor even sold in the same part of the DIY store. I do not consider that the goods are in competition nor complementary. I therefore find all of the goods to be dissimilar.

Aluminium profiles for use with information or display apparatus.

112. I consider that the above goods have limited overlap with the opponent's "building materials (non-metallic), namely cladding". All of the goods would be sold at DIY retail outlets, or hardware stores. However, I do not consider that the goods would be sold in the sale aisle, nor even sold in the same part of the DIY store which sells a wide variety of goods. I also do not consider that the goods overlap in nature, method of use and purpose because the holder's above goods are profiles made from aluminium to be used with information or display apparatus and would be found, installed and used within the household, whereas the opponent's goods are cladding which is used on the face of a building. The goods are not in competition or complementary. I consider that the goods are dissimilar.

Rails for installation of thermal insulation systems for buildings.

113. The holder's above goods are used to fix insulation boards to the wall of a building. I consider that these goods would be sold by more specialist insulation undertakings, rather than in a general DIY store, as these are most likely installed during the construction of a building, rather than a home improvement purchase. I

therefore do not consider that there would be any overlap in trade channels with the opponent's "building materials (non-metallic), namely cladding" and "works of stonemasonry" goods. I also consider that as the opponent's cladding is used on the face of a building to provide protection from the weather, and its works of stonemasonry are blocks of stone which are used in the creation of buildings, that they do not overlap in nature, method of use or purpose with the holder's above goods. The goods are neither in competition nor complementary. Therefore, I consider that the goods are dissimilar.

Class 17

Building materials with waterproof properties (non-metallic).

114. The same comparison applies as paragraph 76 above. I consider them identical on the principle outlined in *Meric*.

Plastics in the form of sheets.

115. The same comparison applies as paragraph 77 above. Therefore, I consider that the goods are similar between a medium and high degree.

Fibreglass for insulation; fibreglass fabrics for insulation; glass fiber insulation for use in construction; prefabricated glass fiber insulation for use in construction; glass wool for insulation; packing, stopping and insulating materials, in particular thermal insulating materials for insulating buildings and for facades of buildings; insulating materials of all kinds; elasticised insulating materials; insulating panels in the form of heat insulation materials of rigid foam, rock wool, glass wool, mineral fibres, mineral foam, pu foam, pir foam, phenolic resin, cork, hemp, softwood fibres; parts, profiles and rails of plastic for installation in thermal insulation composite devices; insulating materials produced from plastics; plastic film for insulating purposes.

116. The same comparison applies in paragraph 78 above. Therefore, I consider that the goods are similar between a low and medium degree.

Sound absorbing, sound control and sound reflecting building materials; acoustic insulating panels.

117. The same comparison applies in paragraph 79 above. Therefore, I consider that the goods are similar between a low and medium degree.

Plastics materials in the form of profiles [semi-finished products]; plastic seals; stuffing materials of plastics; plastics in the form of films, blocks, rods and tubes.

118. The same comparison applies as paragraph 80 above. I therefore find all of the goods to be dissimilar.

Fittings, not of metal, for rigid pipes; fittings [non-metallic] for flexible pipes; couplings (non-metallic -) for flexible pipes; couplings.

119. I consider that the above goods have limited overlap with the opponent's "building materials (non-metallic), namely cladding". All of the goods would be sold at DIY retail outlets, or hardware stores. However, I do not consider that the goods would be sold in the sale aisle, nor even sold in the same part of the DIY store which sells a wide variety of goods. I also do not consider that the goods overlap in nature, method of use and purpose because the holder's above goods are pipes, couplings and their fittings which would be found and fitted within the household, whereas the opponent's goods are cladding which is used and attached on the face of a building. The goods are not in competition or complementary. I consider that the goods are dissimilar.

Sealing compounds, fillers for expansion joints for crack-filling; pipe joint sealants; flexible pipes, not of metal; flexible tubes, not of metal.

120. The same comparison applies in paragraph 81 above. Therefore, I consider that the goods are dissimilar.

Sealing and adhesive tapes for use in building; expansion joints of fabric, insulating and drywall joint tapes.

121. The same comparison applies in paragraph 83 above. I consider that the goods are dissimilar.

Paints for insulating cement and concrete.

122. Without any evidence or submissions before me, I consider that the above goods are specialist in nature, and therefore wouldn't be found at a DIY retail outlet. Therefore, I do not consider that these goods would overlap with the opponent's "building materials (non-metallic), namely cladding" and "works of stonemasonry". There will not be an overlap in trade channels, nor do I consider that they will overlap in nature, method of use and purpose. I note that both cladding and that paints have some sort of insulating purpose, however, I do not consider that is enough by itself to establish similarity. I do not consider that the goods are in competition nor complementary. Therefore, I find that the goods are dissimilar.

Sealing profiles, joint packings, joint seals.

123. I consider that the above goods have limited overlap with the opponent's "building materials (non-metallic), namely cladding". All of the goods would be sold at DIY retail outlets, or hardware stores. However, I do not consider that the goods would be sold in the same aisle, nor even sold in the same part of the DIY store which sells a wide variety of goods. I also do not consider that the goods overlap in nature, method of use or purpose because the holder's above goods are used to connect and seal joints, whereas the opponent's goods are cladding which is used on the face of a building to provide protection from the weather. The goods are not in competition or complementary. Therefore I consider that the goods are dissimilar.

Extruded plastics [semi-finished products]; extruded plastic in the form of bars, blocks, pellets, rods, sheets and tubes for use in manufacturing

124. Extruded plastics are where the plastic has been extruded, which means it is forced or squeezed out of a small opening.⁷ Therefore, I note, as highlighted by the

⁷ <https://www.collinsdictionary.com/dictionary/english/extrude>

specification the goods can be made into sheets or tubes. This therefore could be made into other goods such as those for construction. However, the above goods are semi-finished products for use in manufacturing. Therefore, I consider that they are dissimilar from the opponent's "building materials (non-metallic), namely cladding" and "works of stonemasonry". They do not overlap in method of use, nature or purpose. I do not consider that there is an overlap in trade channels or user as the applicant's above goods would be brought from an extruded plastic manufacturer. The goods are neither in competition nor complementary. Consequently, I consider that the goods are dissimilar.

Class 19

125. I note that the Second IR's class 19 specification covers all of the First IR's class 19 goods above excluding, natural ashlar in blocks, slabs, massive stones and non-metallic structure profiles for building. However, it also includes the following additional terms:

Marble, sand and gravel; mortar, screed, concrete; lime as a construction material, cement, plaster; reinforcing materials, not of metal, for building; non-metallic structure profiles for building; non-metallic rigid pipes [building].

126. I consider that the holder's above goods may overlap with the opponent's "building materials (non-metallic), namely cladding" because all of the goods would be sold through general DIY retail outlets. However, I do not consider that there would be an overlap in nature, intended purpose and method of use because the opponent's goods are cladding which is used on the face of a building to provide protection from the weather. I do not consider that the goods are in competition nor complementary. I therefore find all of the goods to be dissimilar.

Class 37

Installation of prefabricated building elements.

127. “Building materials (non-metallic), namely cladding” in the opponent’s specification, as established above, is a type of prefabricated building element. Although there will not be an overlap in nature, method of use and purpose between the goods and services, I consider that there would be an overlap in trade channels because the same undertaking would provide both the goods and the services to install the goods. Therefore, the goods and services are complementary, and the users will overlap. Therefore the goods and services are similar to a medium degree.

Building construction; advisory services in building construction, in particular in thermal insulation, refurbishing and colour design; providing of information relating to building construction, including online.

128. I consider that building construction covers any, and a wide range of physical activity that would occur on a construction site, and therefore would cover from the erection of a structure to cladding. However, I still do not consider that the holder’s above services would overlap with the opponent’s “building materials (non-metallic), namely cladding”. I consider that the holder’s services would be provided by a construction company, whereas the opponent’s goods would be provided by a DIY retail outlet. These products would then be brought by the construction companies to carry out the works. Therefore, I do not consider that there is an overlap in user or trade channels. The goods and services do not overlap in nature, method of use or purpose. Nor are they in competition or complementary. Therefore I consider that the goods and services are dissimilar.

Rental of machines, tools and apparatus for building construction.

129. I consider that the holder’s above services wouldn’t overlap with the opponent’s “building materials (non-metallic), namely cladding” and “works of stonemasonry” goods. I do not consider that there would be an overlap in trade channels because the opponent’s goods would be provided by cladding specialists, or brought from DIY retail outlets, and the holder’s services would be provided by machine rental companies. I do not consider that there would be an overlap in method of use, nature and purpose. I do not consider that the goods and services are in competition or complementary.

There may be an overlap in user, however, this is not enough on its own to establish similarity. Therefore, the goods and services are dissimilar.

Consultancy on the use of sustainable materials in building construction.

130. I consider that the above services wouldn't overlap with the opponent's "building materials (non-metallic), namely cladding" and "works of stonemasonry" goods. I do not consider that there would be an overlap in trade channels because the holder's services would be provided by consultancy construction companies which either sell sustainable materials, or specialise in sustainability in construction. I do not consider that there would be an overlap in method of use, nature and purpose. I do not consider that the goods and services are in competition or complementary. The goods and services are dissimilar.

Erection of prefabricated buildings and structures.

131. I consider that the holder's above services wouldn't overlap with the opponent's "building materials (non-metallic), namely cladding" and "works of stonemasonry" goods. I do not consider that there would be an overlap in trade channels because the holder's services would be provided by construction companies which specifically erect the building and structures. I do not consider that there would be an overlap in method of use, nature and purpose. I do not consider that the goods and services are in competition or complementary. There may be an overlap in user, however, this is not enough on its own to establish similarity. The goods and services are, therefore, dissimilar.

132. It is a prerequisite of section 5(2)(b) that the goods be identical or at least similar. The opposition will, therefore, fail in respect of the above goods and services that I have found to be dissimilar.⁸

The average consumer and the nature of the purchasing act

⁸ eSure Insurance v Direct Line Insurance, [2008] ETMR 77 CA

133. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. 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.”

134. The average consumer for the goods will be professionals who work in the building or construction industry, as well as members of the general public. The cost of purchase is likely to vary, with the holder's goods being on the lower end of the scale, and the opponent's goods being on the higher end of the scale. The frequency of the purchase is also likely to vary, although it is unlikely to be particularly regular. The average consumer will take various factors into consideration such as the materials, cost, durability, quality and suitability for the user's needs. Consequently, I consider that between a medium and high degree of attention will be paid by the average consumer when selecting the goods.

135. The average consumer for the services will be members of the general public. The cost and frequency of the purchase is likely to vary. However, the average consumer will take various factors into consideration when selecting the services such as the location, cost, availability of products, the range of services on offer and the reputational standing of the provider. Therefore, I consider that the average consumer will also pay between a medium and high degree of attention during the purchasing process.

136. The goods are likely to be obtained by self-selection from the shelves of a DIY retail outlet, wholesale outlet, or its online equivalent. The services are likely to be purchased from specialist construction retailers or online equivalent. Alternatively, the goods and services may be purchased following perusal of advertisements or inspection of a catalogue. Visual considerations for both are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase through advice sought from sales assistants or word-of-mouth recommendations.


Comparison of the trade marks

137. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

139. The respective trade marks are shown below:

Opponent's trade marks	Holder's trade marks
 <p data-bbox="308 488 683 524">("the First Earlier Mark")</p> <p data-bbox="236 663 753 730">Stonepanel Sky</p> <p data-bbox="284 808 705 844">("the Second Earlier Mark")</p>	<p data-bbox="938 344 1257 412">StoPanel</p> <p data-bbox="986 477 1209 512">("the First IR")</p> <p data-bbox="887 651 1305 808">StoPanel Technology</p> <p data-bbox="962 851 1233 887">("the Second IR")</p>

Overall Impression

140. The First Earlier Mark is the words 'stone' and 'panel' written in an orange stylised font, separated by a device which is on a diagonal, composed of 4 grey oblongs, one on the top and bottom, and two in the middle. I note that as the words 'stone' and 'panel' together are descriptive of the opponent's goods. However, I consider that overall impression of the mark lies in the combination of the words, device and stylisation elements.

141. The Second Earlier Mark is composed of the words Stonepanel Sky. I note that the word 'Stonepanel' is comprised of two ordinary dictionary words; stone and panel. I consider the meaning of 'Stonepanel' is descriptive of the opponent's goods. I also consider that the two words play independent distinctive roles, with the word 'sky' being the most dominant and distinctive element within the mark, and therefore, playing a greater role in the overall impression, with the word 'stonepanel' playing a lesser role.

142. The First IR is comprised of the invented word ‘StoPanel’. I note that the average consumer will recognise the ordinary dictionary word ‘Panel’ within the mark, which is combined with the beginning element ‘Sto’ which isn’t a recognisable word. There are no other elements to contribute to the overall impression which lies in the word itself.

143. The Second IR is the words ‘StoPanel Technology’. I do not consider that the word ‘Technology’ is allusive or descriptive of the holder’s goods and services. Therefore, I consider that the overall impression of the mark lies in the combination of these words.

The First Earlier Mark and the First IR

Opponent’s trade mark	Holder’s trade mark
 <p data-bbox="304 1137 687 1182"> (“the First Earlier Mark”)</p>	<p data-bbox="938 1021 1257 1088">StoPanel</p> <p data-bbox="986 1126 1209 1171"> (“the First IR”)</p>


144. Visually, the marks coincide in the presence of the letters S, t and o at the beginning of both marks, and the word ‘panel’ at the end of the marks. However, the First Earlier Mark also contains the letters ‘n’ and ‘e’ in the middle of the mark and the oblong device which separates the words ‘stone’ and ‘panel’. These act as visual points of difference. I also bear in mind that fair and notional use of a registration of a word only mark covers use in any standard typeface and in any colour. I do not, therefore, consider that the slight stylisation and use of colour in the First Earlier Mark creates a real point of difference between them. However, taking the above into account, I consider that the marks are visually similar to between a low and medium degree.

145. Aurally, the First Earlier Mark will be pronounced as ST-OWN PAN-ELL. The device element will not be verbalised. The First IR will be pronounced as ST-OH-PAN-

ELL. Therefore, as the marks overlap in the first, third and fourth syllable, and share the ‘O’ element of the second syllable, I consider that the marks are aurally similar to between a medium and high degree.

146. Conceptually, both marks share the word ‘panel’ which is a flat piece of material, and which may form part of a larger object. However, the First Earlier Mark begins with the ordinary dictionary word ‘stone’. I consider that the First Earlier Mark, as a whole, will be understood to mean panels made of stone, which is descriptive of the opponent’s goods. The First IR starts with the word ‘Sto’ which I consider the average consumer would recognise as an invented word with no meaning. Regardless, as both marks share the word ‘panel’, I consider that the marks are conceptually similar to a medium degree.

The First Earlier Mark and the Second IR

Opponent’s trade mark	Holder’s trade marks
 <p data-bbox="304 1308 683 1346"> (“the First Earlier Mark”)</p>	<p data-bbox="887 1146 1310 1305">StoPanel Technology</p> <p data-bbox="963 1346 1233 1384"> (“the Second IR”)</p>

147. Visually, the same comparison applies in paragraph 144 as above, however, the Second IR ends with the word ‘Technology’. Therefore, the marks are visually similar to a low degree.

148. Aurally, I consider that the same comparison in paragraph 145 applies above. However, the Second IR ends with the word ‘Technology’ which will be pronounced as TEC-NOL-OH-GEE. Therefore, I consider that the marks are aurally similar to a medium degree.

149. I consider that the same conceptual comparison in paragraph 146 applies above. However, the Second IR ends with the word ‘Technology’. As highlighted above, I do not consider that the word technology is descriptive or allusive of the holder’s goods and services.

150. Regardless, as both marks share the word ‘panel’. I consider that the marks are conceptually similar to a medium degree.

The Second Earlier Mark and the First IR

Opponent’s trade mark	Holder’s trade mark
<p style="text-align: center;">Stonepanel Sky</p> <p style="text-align: center;">(“the Second Earlier Mark”)</p>	<p style="text-align: center;">StoPanel</p> <p style="text-align: center;">(“the First IR”)</p>

151. Visually, the marks coincide in the presence of the letters S, t and o at the beginning of both marks, and the word ‘panel’ at the end of the marks. However, the Second Earlier Mark also contains the letters ‘n’ and ‘e’ in the middle of the mark, which results in the first part being the words ‘stone’ and ‘panel’ conjoined. It also has the word ‘Sky’ at the end of the mark. These act as visual points of difference. Therefore, I consider that the marks are visually similar to a medium degree.

152. Aurally, the Second Earlier Mark will be pronounced as ST-OWN PAN-ELL SK-EYE. The First IR will be pronounced as ST-OH-PAN-ELL. The marks therefore overlap in the first, third and fourth syllable, and share the ‘O’ element of the second syllable. Consequently, the marks are aurally similar to a medium degree.

153. Conceptually, the first element of the Second Earlier Mark are the words ‘stone’ and ‘panel’ conjoined. Its overall meaning is descriptive of the opponent’s goods. However, the addition of the word ‘Sky’ is added at the end of the mark, which is

neither allusive nor descriptive of the goods. I do not consider that the words ‘Stonepanel’ and ‘Sky’ link together. They remain as separate elements with their own meanings.

154. The First IR starts with the word ‘Sto’ which I consider the average consumer would recognise as an invented word with no meaning. Therefore, conjoined with the word ‘panel’, it remains as a whole an invented word. However, as both marks share the word ‘panel’, I consider that the marks are conceptually similar to between a low and medium degree.

The Second Earlier Mark and the Second IR

Opponent’s trade mark	Holder’s trade mark
<p style="text-align: center;">Stonepanel Sky</p> <p style="text-align: center;">(“the Second Earlier Mark”)</p>	<p style="text-align: center;">StoPanel Technology</p> <p style="text-align: center;">(“the Second IR”)</p>

155. Visually, the marks coincide in the presence of the letters S, t and o at the beginning of both marks, and the word ‘panel’ at the end of the marks. However, the Second Earlier Mark also contains the letters ‘n’ and ‘e’ in the middle of the mark, and ends in the word Sky. The Second IR ends in the word ‘Technology’. These act as visual points of difference. Therefore, I consider that the marks are visually similar to between a low and medium degree.

156. Aurally, the Second Earlier Mark will be pronounced as ST-OWN PAN-ELL SK-EYE. The Second IR will be pronounced as ST-OH-PAN-ELL TEC-NO-LOW-GEE. The marks therefore overlap in the first, third and fourth syllable, and share the ‘O’ element of the second syllable. Therefore the marks are aurally similar to between a low and medium degree.

157. Conceptually, the first element of the Second Earlier Mark are the words 'stone' and 'panel' conjoined. Its overall meaning is descriptive of the opponent's goods. However, the addition of the word 'Sky' is added at the end of the mark, which is neither allusive nor descriptive of the goods. I do not consider that the words 'Stonepanel' and 'Sky' link together. They remain as separate elements with their own meanings.

158. The Second IR starts with the word 'Sto' which I consider the average consumer would recognise as an invented word with no meaning. Therefore, conjoined with the word 'panel', it remains as a whole an invented word. I also consider that this with the word technology does not evoke a concept as a whole. However, as both marks share the word 'panel', I consider that the marks are conceptually similar to a low degree.

Distinctive character of the earlier trade mark

159. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promotion of the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or

services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

160. I also find the guidance set out in *Formula One Licensing BV v OHIM*⁹ to be useful in this case:

“41.it is not possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack of distinctive character, provided by Article 7(1)(b) of Regulation No 40/94 and Article 3(1)(b) of Directives 89/104 and 2008/95. In this respect, it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43. However, as the appellant rightly points out, their verification has limits.

44. Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii).”

161. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as

⁹ Case C-196/11P

invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

162. I will begin by assessing the inherent distinctive character of the earlier trade marks.

163. As highlighted above, I consider that the First Earlier Mark is made up of the words 'stone' and 'panel', which together would be understood to mean panels made of stone. I consider that this is descriptive of the opponent's stone cladding goods. The words are written in an orange stylised font, separated by a simple device which is on a diagonal, composed of 4 grey oblongs. I consider that a significant proportion of average consumers would recognise the device as a representation of stone panels, however, I also consider that there may be a proportion that may not assign the device any conceptual meaning.

164. As per *Formula One*, the earlier marks must be considered to have at least some distinctive character. Consequently, I consider that the distinctiveness of the First Earlier Mark to lie in both the combination of the words 'stone' and 'panel', alongside the device. Therefore, I consider that the First Earlier Mark, for the opponent's goods, is inherently distinctive to between a low and medium degree.

165. I consider that the Second Earlier Mark, as highlighted above, is made up of the words 'stone' and 'panel', however, presented as one word, which is followed by the ordinary dictionary word 'Sky'. I consider that the word 'Sky' in combination with 'stonepanel' have no overall meaning because they do not link together. Therefore, I consider that the Second Earlier Mark is inherently distinctive to a medium degree.

166. The opponent has not pleaded that its First and Second Earlier Marks have acquired enhanced distinctiveness. However, for the sake of completeness, I will make a finding as to whether I consider the evidence sufficient to demonstrate enhanced distinctiveness. The relevant market for assessing this is the UK market.

167. The opponent has provided sales figures, for the last 5 years in the UK, to enable me to assess the extent of use made of the marks. I note that the revenue made by

the opponent from 2017 to 2021 amounts to €2,060,230.00, and is therefore significant. I also note that I have been provided with advertising figures for the UK, from 2017 to 2021, which amounts to €22,525.00. However, I note that some of these figures fall outside the relevant periods (20 December 2014 to 19 December 2019 and 21 December 2014 to 20 December 2019). Furthermore, I haven't been provided with any evidence of how many product sheets and brochures were distributed throughout the UK, or seen by UK members of the general public. I also note that, although the opponent's UK distributor, Taylor Maxwell, has 16 locations across the UK, the invoice evidence only shows the goods being distributed to Taylor Maxwell facilities in Bristol and Edinburgh. Therefore, I do not consider that there is evidence of geographical spread of the mark within the UK. Lastly, I note that I haven't been provided with UK market share figures. Consequently, taking all of the above into account, I do not consider the evidence sufficient to establish enhanced distinctiveness.

Likelihood of confusion

168. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. 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. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact 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 that he has retained in his mind.

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

The First Earlier Mark and First IR

- The First Earlier Mark and the First IR are visually similar to between a low and medium degree.
- The First Earlier Mark and the First IR are aurally similar to between a medium and high degree.
- The First Earlier Mark and the First IR are conceptually similar to a medium degree.
- I have found the First Earlier Mark to be inherently distinctive to between a low and medium degree.
- I have identified the average consumer for the goods and services to be professionals who work in the building or construction industry as well as members of the general public, who will select the goods primarily by visual means.
- I have concluded that between a medium and high degree of attention will be paid during the purchasing process.
- Excluding the goods and services which I have found not to be similar, I have found the parties' goods services to be identical to similar to a very low degree.

The First Earlier Mark and Second IR

- The First Earlier Mark and the Second IR are visually similar to a low degree.
- The First Earlier Mark and the Second IR are aurally similar to a medium degree.
- The First Earlier Mark and the Second IR are conceptually similar to a medium degree.
- I have found the First Earlier Mark to be inherently distinctive to between a low and medium degree.
- I have identified the average consumer for the goods and services to be professionals who work in the building or construction industry as well as members of the general public, who will select the goods primarily by visual means.

- I have concluded that between a medium and high degree of attention will be paid during the purchasing process.
- Excluding the goods and services which I have found not to be similar, I have found the parties' goods and services to be identical to similar to a very low degree.

The Second Earlier Mark and First IR

- The Second Earlier Mark and the First IR are visually similar to a medium degree.
- The Second Earlier Mark and the First IR are aurally similar to a medium degree.
- The Second Earlier Mark and the First IR are conceptually similar to between a low and medium degree.
- I have found the Second Earlier Mark to be inherently distinctive to a medium degree.
- I have identified the average consumer for the goods and services to be professionals who work in the building or construction industry as well as members of the general public, who will select the goods primarily by visual means.
- I have concluded that between a medium and high degree of attention will be paid during the purchasing process.
- Excluding the goods and services which I have found not to be similar, I have found the parties' goods and services to be identical to similar to a very low degree.

The Second Earlier Mark and Second IR

- The Second Earlier Mark and the Second IR are visually similar to a to between a low and medium degree.
- The Second Earlier Mark and the Second IR are aurally similar to between low and medium degree.

- The Second Earlier Mark and the Second IR are conceptually similar to between a low and medium degree.
- I have found the Second Earlier Mark to be inherently distinctive to a medium degree.
- I have identified the average consumer for the goods and services to be professionals who work in the building or construction industry as well as members of the general public, who will select the goods primarily by visual means.
- I have concluded that between a medium and high degree of attention will be paid during the purchasing process.
- Excluding the goods and services which I have found not to be similar, I have found the parties' goods and services to be identical to similar to a very low degree.

170. I bear in mind the decision of the CJEU in *L'Oréal SA v OHIM*, Case C-235/05 P, in which the court confirmed that weak distinctive character of the earlier trade mark does not preclude a likelihood of confusion. Further, I bear in mind the comments of Mr Iain Purvis Q.C., sitting as the Appointed Person, in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

171. I also take into account the decision *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch) in which the court confirmed that if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.

172. Therefore, taking all of the above case law into account, I consider that it is important to ask, 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

The First Earlier Mark

173. Albeit the First Earlier Mark and the holder's marks contain the word 'panel', as highlighted above, the distinctiveness of the First Earlier Mark, although lower in nature (between a low and medium degree), lies in the mark as a whole. Therefore, taking all of the above case law and factors listed in paragraph 169 into account, particularly the visual and conceptual differences between the marks, I am satisfied that all of the marks are unlikely to be mistakenly recalled or misremembered as each other. This is particularly the case given the lower visual similarity (low degree and low and medium degree) between the marks and the predominantly visual purchasing process. Consequently, I do not consider that the average consumer would overlook the differing letters in the middle of the marks (N and E in the opponent's mark) especially because the effect of this element is to create a clear conceptual hook in which to differentiate the marks; STONE which is a recognisable dictionary word vs STO which is a distinctive invented word with no concept. I also do not consider that they would overlook the rectangular device in the First Earlier Mark which splits the wording 'stone' and 'panel'. Nor would the average consumer overlook the word 'Technology' in the Second IR. This will particularly be the case given that the average consumer will be paying between a medium and high degree of attention during the purchasing process. For all of the above reasons, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other, even when used on identical goods. Taking the above into account, I do not consider there to be a likelihood of direct confusion.

The Second Earlier Mark

174. The dominant and distinctive elements of the Second Earlier Mark resides in the word ‘Sky’ which is neither descriptive or allusive of the opponent’s goods and services. Consequently, as highlighted by the above case law, this further points to a finding of no likelihood of direct confusion, because the dominant and distinctive part of the Second Earlier Mark is not present within either of the holder’s IRs.

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

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

176. 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.

177. Having noticed that the competing trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. Even though the marks share the common word 'panel', I consider that this element is descriptive of the form of the goods for which the opponent's marks are applied for/registered. I do not think that the common element is of such a level of distinctiveness that the average consumer would believe that only one undertaking would use it, especially in relation to the class 6, 17, 19 and 37 construction/building goods and services. It is more likely to be viewed as a coincidence, especially, as highlighted above, the average consumer does not dissect the mark, it will be viewed as a whole. Therefore, I do not consider that the average consumer would think that the holder's trade marks were connected with the opponent, and vice versa. Even if the opponent's marks are brought to mind, this is mere association, not confusion: see *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81. Consequently, I consider there is no likelihood of indirect confusion.

CONCLUSION

178. The opposition is unsuccessful, and the applications may proceed to registration.

COSTS

179. The holder has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the holder the sum of **£1,250** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering both Notices of opposition and preparing a Counterstatement	£400
Preparing and filling witness statements and Exhibits	£500
Filing written submissions	£350

Total

£1,250

180. I therefore order CUPA STONE S.L.U. to pay Sto SE & Co. KGaA the sum of £1,250. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 18th day of October 2022

L FAYTER

For the Registrar

ANNEX

First IR

Class 6

Building materials wholly or partly of metal; prefabricated houses (kits) of metal; prefabricated elements of metal for building; conservatories of metal in prefabricated form; prefabricated buildings made substantially of metal; shelters made of prefabricated metal insulated materials; prefabricated wall structures of metal incorporating mineral wool insulation; reinforcing materials of metal for building; wire rope; metal cable wire; door frames of metal; anchor bolts of metal for bridge connection; structural steels; aluminium; sheets of aluminium; aluminium ingots; facade facings of metal; metal cladding; curtain walling of metal; metal fasteners for doors and windows; anchors; nails; ironmongery; small items of metal hardware; holding profiles of metal for building panels; base rails and corner protection rails, all the aforesaid of metal; support profiles and wall holders of metal for wall and façade claddings; metal containers for packing, transportation and storage of building materials at building sites, all these containers being empty or filled with non-metallic building materials.

Class 17

Plastics materials in the form of tapes [semi-finished products]; plastics materials in the form of foils [semi-finished products]; plastics materials in the form of sheets [semi-finished products]; plastic seals; insulating materials produced from plastics; plastic film for insulating purposes; stuffing materials of plastics; extruded plastics [semi-finished products]; plastics in the form of sheets, films, blocks, rods and tubes; extruded plastic in the form of bars, blocks, pellets, rods, sheets and tubes for use in manufacturing; double profiles and expansion profiles of plastic; reinforcing rails of plastic for pipes; fibreglass for insulation; fibreglass fabrics for insulation; glass fiber insulation for use in construction; glass fiber insulation materials for use in construction; glass wool for insulation; acoustic insulating panels; insulating materials; insulating materials of all kinds; elasticised insulating materials; sound absorbing, sound control and sound reflecting building materials; insulating panels in the form of heat insulation materials of rigid foam, rock wool, glass wool, mineral fibres, mineral foam, pu foam, pir foam, phenolic resin, cork, hemp, softwood fibres; sealing

compounds; pipe joint sealants; flexible pipes, not of metal; adhesive tapes including double-sided adhesive tape, other than stationary and not for medical or household purposes; adhesive masking tapes; expansion joints of fabric, insulating and drywall joint tapes; building materials with waterproof properties (non-metallic); parts, profiles and rails of plastic for installation in thermal insulation composite devices; flexible tubes, not of metal.

Class 19

Building materials (non-metallic); prefabricated building elements (non-metallic); non-metallic prefabricated platforms, prefabricated non-metallic storage sheds; prefabricated non-metallic garages; non-metallic prefabricated houses (kits); prefabricated houses (kits) of wood; prefabricated elements (non-metallic) for building; modular units (non-metallic) for constructing prefabricated buildings; prefabricated structures (non-metallic) for use as building elements; prefabricated building elements (non-metallic) for onsite assembly; prefabricated wall structures (non-metallic) incorporating heat insulation materials of rigid foam, rock wool, glass wool, mineral fibres, mineral foam, pu foam, pir foam, phenolic resin, cork, hemp, softwood fibres; lightweight prefabricated building elements; prefabricated panels (non-metallic) incorporating heat insulation materials of rigid foam, rock wool, glass wool, mineral fibres, mineral foam, pu foam, pir foam, phenolic resin, cork, hemp, softwood fibres; lightweight prefabricated panels (non-metallic) incorporating heat insulation materials of rigid foam, rock wool, glass wool, mineral fibres, mineral foam, pu foam, pir foam, phenolic resin, cork, hemp, softwood fibres; non-metallic facade elements; non-metallic fixing and bordering elements therefor; non-metallic fired refractory materials; woven fabrics in rolls, pieces or prefabricated platforms, not of metal for use in building, including fabric angles and corners; timber mouldings; dado rails; rubber cove bases; beams, bars, rails, strips, profiles, non metallic brackets and corners, window sills, window frames, lintels, door sills, door frames, not of metal; non-metallic panels for building, in particular panels for cladding walls and facades; fibreboard for building; facade sheets, partly made of stone, artificial stone or with coatings visually reminiscent of stone; building panels, wall panels, non-metallic panels for facade claddings; non-metallic curtain-type, back-ventilated exterior wall cladding for buildings, including carrier panels for various coating variants; masonry bricks; mosaic tiles for walls and floors; ceiling and wall coatings with rigid foam granules; non-

metallic decorative mouldings and decorative trim for use in building construction, in particular of rigid foam and foamed beads; stone; non-metallic refractory blocks; non-metallic refractory construction materials; calcareous stone; sandstone; granite; marble; natural ashlar in blocks, slabs, massive stones; pottery stone; ceramic tiles; ceramic roofing tiles; stone facades, stone-bonded facades, curtain-type, rear-ventilated facades, walls; interior and exterior stone floors; tiles; bricks; glass mosaics for use in building construction; filling compounds, quick repair mortar; finishing coats of plasters for indoor and outdoor applications, decorative plaster for indoor and outdoor applications; artificial resin plaster, silicate plaster, silicone resin plaster, dry plaster (in powder form); reinforcing materials, not of metal, for building; non-metallic structure profiles for building; filling foam; decorative compositions for floor coatings; non-metallic pipes for roof drainage installations; drilling hole filling compounds; rendering base, concrete repair materials for repairing concrete parts in structural and civil engineering; asphalt, pitch and bitumen; pitch, tar, bitumen and asphalt; non-metallic building profiles for building, non-metallic floor coatings based on cement, screed, mortar or concrete, including in combination with epoxy resins and polyurethanes; ventilated curtain facade systems with support panels (not of metal); self-levelling concrete for use in building construction.

Second IR

Class 6

Pipes, tubes and hoses, and fittings therefor, including valves, of metal; acoustic panels of metal; acoustic panels of metal for ceilings; acoustic panels of metal for walls; air ducts of metal for buildings; air grilles of metal; aluminium profiles for use with information or display apparatus; prefabricated houses (kits) of metal; prefabricated elements of metal for building; conservatories of metal in prefabricated form; prefabricated buildings made substantially of metal; shelters made of prefabricated metal insulated materials; prefabricated wall structures of metal incorporating mineral wool insulation; reinforcing materials of metal for building; wire rope; metal cable wire; sills, not of metal, window frames, lintels, door sills, door frames of metal; frames, in particular window frames of metal; metal fastening anchors; structural steels; aluminium; sheets of aluminium; aluminium ingots; facade facings of metal; metal cladding; curtain walling of metal; metal fasteners for doors and windows; mechanical fasteners of metal, in particular dowels, hooks, brackets, supports,

mounts, anchors, suspension fasteners, screws, nuts, washers and flat washers, nails, clamps, ironmongery and small items of metal hardware; holding profiles of metal for building panels; base rails and corner protection rails, all the aforesaid of metal; support profiles and wall holders of metal for wall and façade claddings; metal containers for packing, transportation and storage of building materials at building sites, all these containers being empty or filled with non-metallic building materials; small items of metal hardware; rails for installation of thermal insulation systems for buildings.

Class 17

Plastics materials in the form of profiles [semi-finished products]; plastic seals; insulating materials produced from plastics; plastic film for insulating purposes; stuffing materials of plastics; extruded plastics [semi-finished products]; plastics in the form of sheets, films, blocks, rods and tubes; extruded plastic in the form of bars, blocks, pellets, rods, sheets and tubes for use in manufacturing; fittings, not of metal, for rigid pipes; fittings [non-metallic] for flexible pipes; couplings (non-metallic -) for flexible pipes; couplings; fibreglass for insulation; fibreglass fabrics for insulation; glass fiber insulation for use in construction; prefabricated glass fiber insulation for use in construction; glass wool for insulation; acoustic insulating panels; packing, stopping and insulating materials, in particular thermal insulating materials for insulating buildings and for facades of buildings; insulating materials of all kinds; elasticised insulating materials; sound absorbing, sound control and sound reflecting building materials; insulating panels in the form of heat insulation materials of rigid foam, rock wool, glass wool, mineral fibres, mineral foam, pu foam, pir foam, phenolic resin, cork, hemp, softwood fibres; sealing profiles, joint packings, joint seals; paints for insulating cement and concrete; sealing compounds, fillers for expansion joints for crack-filling; pipe joint sealants; flexible pipes, not of metal; sealing and adhesive tapes for use in building; adhesive tapes including double-sided adhesive tape, other than stationary and not for medical or household purposes; adhesive masking tapes; expansion joints of fabric, insulating and drywall joint tapes; building materials with waterproof properties (non-metallic); parts, profiles and rails of plastic for installation in thermal insulation composite devices; flexible tubes, not of metal.

Class 19

Building materials (non-metallic); prefabricated building elements (non-metallic); non-metallic prefabricated platforms, prefabricated non-metallic storage sheds; prefabricated non-metallic garages; non-metallic prefabricated houses (kits); prefabricated houses (kits) of wood; prefabricated elements (non-metallic) for building; modular units (non-metallic) for constructing prefabricated buildings; prefabricated structures (non-metallic) for use as building elements; prefabricated building elements (non-metallic) for onsite assembly; prefabricated wall structures (non-metallic) incorporating heat insulation materials of rigid foam, rock wool, glass wool, mineral fibres, mineral foam, pu foam, pir foam, phenolic resin, cork, hemp, softwood fibres; lightweight prefabricated building elements; prefabricated panels (non-metallic) incorporating heat insulation materials of rigid foam, rock wool, glass wool, mineral fibres, mineral foam, pu foam, pir foam, phenolic resin, cork, hemp, softwood fibres; lightweight prefabricated panels (non-metallic) incorporating heat insulation materials of rigid foam, rock wool, glass wool, mineral fibres, mineral foam, pu foam, pir foam, phenolic resin, cork, hemp, softwood fibres; non-metallic facade elements; non-metallic fixing and bordering elements therefor; non-metallic fired refractory materials; woven fabrics in rolls, pieces or prefabricated platforms, not of metal for use in building, including fabric angles and corners; timber mouldings; dado rails; rubber cove bases; beams, bars, rails, strips, profiles, non metallic brackets and corners, window sills, window frames, lintels, door sills, door frames, not of metal; n-metallic panels for building, in particular panels for cladding walls and facades; fibreboard for building; facade sheets, partly made of stone, artificial stone or with coatings visually reminiscent of stone; building panels, wall panels, non-metallic panels for facade claddings; non-metallic curtain-type, back-ventilated exterior wall cladding for buildings, including carrier panels for various coating variants; masonry bricks; mosaic tiles for wall and floor; ceiling and wall coatings with rigid foam granules; non-metallic decorative mouldings and decorative trim for use in building construction, in particular of rigid foam and foamed beads; stone; non-metallic refractory blocks; non-metallic refractory construction materials; calcareous stone; sandstone; granite; marble; pottery stone; ceramic tiles; ceramic roofing tiles; stone facades, stone-bonded facades, curtain-type, rear-ventilated facades, walls; interior and exterior stone floors; tiles; bricks; glass mosaics for use in building construction; marble, sand and gravel; filling compounds, quick repair mortar; mortar, screed, concrete; finishing coats of plasters for indoor and outdoor applications, decorative plaster for indoor and outdoor

applications; artificial resin plaster, silicate plaster, silicone resin plaster, dry plaster (in powder form); lime as a construction material, cement, plaster; reinforcing materials, not of metal, for building; non-metallic structure profiles for building; filling foam; decorative compositions for floor coatings; non-metallic rigid pipes [building]; non-metallic pipes for roof drainage installations; drilling hole filling compounds; rendering base, concrete repair materials for repairing concrete parts in structural and civil engineering; asphalt, pitch and bitumen; pitch, tar, bitumen and asphalt; non-metallic building profiles for building, non-metallic floor coatings based on cement, screed, mortar or concrete, including in combination with epoxy resins and polyurethanes; ventilated curtain facade systems with support panels (not of metal); self-levelling concrete for use in building construction.

Class 37

Building construction; advisory services in building construction, in particular in thermal insulation, refurbishing and colour design; providing of information relating to building construction, including online; rental of machines, tools and apparatus for building construction; consultancy on the use of sustainable materials in building construction; erection of prefabricated buildings and structures; installation of prefabricated building elements.

The First Earlier Mark

Class 19

Building materials (non-metallic); Non-metallic rigid pipes for building; Asphalt, pitch and bitumen; Non-metallic transportable buildings; Monuments, not of metal; Cabanas, not of metal; Works of stonemasonry; Arbours (structures); Buildings, not of metal; Memorial plaques, not of metal.

Class 35

Advertising; Business management; Business administration; Office functions.

Class 37

Construction; Repair of ships; Installation services; Cleaning of buildings [exterior surface]; Quarrying services; Mining extraction; Construction information; Repair information.

The Second Earlier Mark

Class 19

Building materials (non-metallic); Non-metallic rigid pipes for building; Asphalt, pitch and bitumen; Non-metallic transportable buildings; Monuments, not of metal; Cabanas, not of metal; Works of stonemasonry; Arbours (structures); Buildings, not of metal; Memorial plaques, not of metal.

Class 37

Construction; Repair of ships; Installation services; Cleaning of buildings [exterior surface]; Quarrying services; Mining extraction; Construction information; Repair information.

Class 42

Design of signs; Graphic design; Decoration of interiors and commercial premises; Industrial design; Window and frontage design.

The Third Earlier Mark

Class 19

Building materials (non-metallic); Non-metallic rigid pipes for building; Asphalt, pitch and bitumen; Non-metallic transportable buildings; Monuments, not of metal; Cabanas, not of metal; Works of stonemasonry; Arbours (structures); Buildings, not of metal; Memorial plaques, not of metal.

Class 37

Construction; Repair of ships; Installation services, waterproofing; Cleaning of buildings [exterior surface]; Quarrying services; Mining extraction; Construction information; Repair information.

Class 42

Sign design, graphic design, interior design and commercial premises design; Industrial design; Window and frontage design.