

O/0252/25

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NOS. 3532916 & 3692922

BY EASYGROUP LIMITED

AND

IN THE MATTER OF THE OPPOSITIONS THERETO

UNDER NOS. 423389 & 429904 BY

M.A.C.'S HOLDING GMBH

BACKGROUND AND PLEADINGS

1. These proceedings concern two trade mark applications that were originally filed by Easylife Limited and were assigned to easyGroup Limited (“the applicant”) with effect from 25 July 2022.

2. UKTM(A) 3532916 was filed on 14 September 2020 and is a figurative mark, shown below. I shall refer to this mark as “the contested figurative mark”.



3. UKTM(A) 3692922 was filed on 10 September 2021. It is a series, consisting of the following two marks: **Easylife** and **easylife**. I shall refer to this mark as “the contested word mark”.

4. The services in respect of which registration is sought are the same for both marks. They are as follows:

Class 35

Advertising and marketing services, wholesale services, retail services including on-line retailing, retailing through the medium of broadcasting, retail services conducted by mail order, all connected with the sale of heating apparatus, cooling apparatus, cooking apparatus, refrigeration apparatus, drying apparatus, ventilation apparatus, humidifiers with parts and accessories, dehumidifiers with parts and accessories, burners, boilers, lighting, lights, lanterns and lamps, heaters, steam-generating equipment, televisions, polishers, vacuums, carpet shampooers, electrically heated hair rollers, electric makeup remover appliances, floor coverings, wall coverings, carpets, rugs, mats, matting, linoleum, wall-hangings, wallpaper, furniture, furniture covers, household textiles and items made therefrom, clocks, imitation leather goods, ornaments, figurines of china, wood, wax, plaster or plastic, mirrors, jewellery boxes, trunks, animal skins and hides, pictures and paintings, picture frames, beds, bedding, mattresses, mattress toppers, pillows, bedlinen, duvets and duvet covers, bedclothes, blankets, cushions, cushion covers, curtains, blinds, inflatable furniture, kitchen furniture, bedroom furniture, nursery furniture, outdoor furniture, living-room furniture, bathroom furniture, seats, shelves, barrels, plastic and wooden boxes, storage items, billiard cloth, bolting cloth, brocades,

buckram, calico, cheese cloth, chenille fabric, table linen, cotton fabrics, coasters, chair covers, household implements, containers and utensils, bakeware, cookware, cutlery, earthenware, microwave cookware, glassware, porcelain, kitchen weighing and measuring equipment, tableware, metal packaging articles, metal foils for wrapping and packaging, catering foil, food preparation implements, plastic and wooden bins, bottle racks, changing mats for babies, children's safety gates, baby walkers, baby high chairs, crates, non-metallic ladders, household containers, basins, baskets, bowls, basting spoons, hand beaters, synthetic Christmas trees and other Christmas decorations including crackers and ornaments, Christmas tree stands, knife sharpeners, sterilization equipment, torches, air compressors, audio-visual equipment, musical instruments, CDs, DVDs, computers, computer parts, computer accessories, computer peripherals, calculating machines, software and hardware, stationery, publications, telecommunications equipment, mobile phones, bookbinding materials, adhesives for stationery of household purposes, office furniture including desks and office chairs, hand-held electronic games, computer games, video game apparatus, paper shredders, clothing, footwear, headgear, jewellery, precious and semi-precious stones, watches, cufflinks, badges made of precious metals, leather goods, umbrellas, parasols, bags, luggage, wallets, purses, optical goods, keyrings, medals, tie-pins, tie-clips, watch straps, handbags, baby carriers, music cases, suitcases, briefcases, attaché cases, haversacks, belts, wheeled shopping bags, key cases, leather laces, satchels, game bags, backpacks, robes, wigs, moccasins, specialized underwear, socks, bathroom items, pre-moistened or impregnated tissues or wipes, sanitising wipes, personal hygiene products, apparatus and instruments for monitoring human bodily functions, life-saving and teaching apparatus and instruments, personal weighing and measuring apparatus and equipment, safety clothing, oral hygiene preparations, breath fresheners, breath freshening strips and sprays, mouthwash including antiseptic mouthwash and mouth rinses for medical use, all cleaning preparations for the teeth (commonly known as dentifrice) including toothpaste, tooth polish, tooth powder, preparations for cleaning dentures, tooth-stopping materials, dental wax, body cleaning preparations, bath preparations, deodorants for personal use, antiperspirants, hair preparations, hair treatments, hair dyes, razors, waxing substances, shampoos, conditioners, shaving gels, foams and preparations, pre-shaving and aftershave lotions, manicure tools, pedicure tools, sanitary preparations for medical use, pharmaceutical preparations, baby food, baby beverages, milk powder for infants, infant formula, infant feeding apparatus, nutritional supplements, dietetic food for invalids, dietary supplements, dietetic food for medical use, plasters, dressings and suturing materials, glasses and eyewear, solutions for contact lenses, condoms and other contraceptive devices, deworming and delousing

and anti-parasitic preparations for humans, water-purification products, combs, sponges and body brushes, masks, face shields, visors, protective overalls and coveralls and gloves, disposable items, thermometers, weight-loss solutions, hearing aids, mobility aids, cosmetics, tissues impregnated with cosmetic lotions, toiletries, soaps, soap dispensers, perfumery and fragrances including Eau de Cologne and Eau de Toilette, toilet water, body sprays, perfumed tissues, essential oils, hair lotions, beauty care preparations, hair lotions, hairspray, hair waving, curling and straightening preparations, hair accessories including hair rollers, hair removal preparations, hair cutting, drying and removal implements, makeup including face, eye and cheek powders and creams, together with tools for applying makeup, lipsticks, lip glosses, false eyelashes, nail care preparations, nail varnish, false nails, nail varnish remover, nutritional creams, henna, dietary supplements for animals, dietetic substances adapted for veterinary use, deworming medication, insecticidal products for animals, items of clothing for pets, pet leads, pet beds, bird baths, birdcages, bird feeders, animal fodder, animal bedding and litter, garden buildings, garden accessories, garden furniture, parts and accessories, garden tools, hand tools, home mechanic apparatus and parts and accessories therefor, ironmongery, DIY and home improvement goods, herbicides, insecticides, bells, metal and wooden door hardware, metal and wooden door fittings, metal gates, gate fittings, door fittings, curtain fittings, bins and boxes either wholly or substantially of metal, door and window catches made either wholly or substantially of metal, hooks made wholly or substantially of metal, window fittings, door and window fasteners, windows, doors, hand-operated gardening implements and tools, hand-operated landscaping implements and tools, fire-tending implements, hand tools for cutting and other purposes including drilling, and grinding tools, paint brushes and rollers, non-metallic hardware, string, natural and artificial turf, shower fittings, dummy security cameras, floor protections kits, brooms, motion-sensor lights, fence panels, cleaning products, cleaning equipment, home decorating equipment and implements and parts and accessories therefor, wax for polishing, plastic storage containers, non-metallic pallets, steel wool, shower cleaners, dirt trapping mats, cameras, photographic accessories, photographic equipment, photographic and picture frames, photographs and pictures, photographic apparatus and instruments, exercise mats, gymnastic and sporting articles, hunting and fishing equipment, swimming equipment, children's playground apparatus and equipment, floats for bathing and swimming, swimming belts and jackets, ropes, camping equipment, tents, sleeping bags, nets, awnings and tarpaulins, portable toilet, paper and cardboard and goods made from these materials, artists' materials including paint brushes, paints, varnishes, pigments, dyes, body art tools, binoculars, fireworks, printers' type, printing blocks, craft and modelling equipment, painter's easels, canvas

for tapestry and embroidery, lace, embroidery and embroidery thread, knitting yarns and needles, sewing machines, sewing kits, haberdashery including ribbons, braid, buttons, hooks, eyes, pins, needles, artificial flowers, fruit and vegetables, decorative textile articles, games, toys, caps for toy pistols, vehicles and apparatus for locomotion by land, air or water, bicycles, prams, pushchairs and parts and accessories for such items, preservatives against rust and against deterioration of wood, colorants, mordants, raw natural resins, wood preservatives, wood stains, anti-corrosive and anti-fouling compositions, primers, coatings (paints), bleaching preparations, substances for laundry use, cleaning preparations, polishing preparations, scouring preparations, abrasive preparations, disinfectants, fungicides, preparations for destroying vermin, pest repellents, insecticides, apparatus and instruments for science, surveying, optics, cinematography, measuring, signalling, weighing, nautical navigation, checking, life-saving, teaching, lighting, heating, apparatus and instruments for conducting, switching, accumulating, regulating, controlling and transforming electricity, safety goggles, protective eyewear, surgical, medical, dental and veterinary apparatus and instruments; the organisation, operation and supervision of sales and promotional incentive schemes, loyalty card, reward and membership services; promotional, advertising, business management, the provision of information, consultancy and advisory services related to all such services.

5. On 25 February 2021, M.A.C.'s HOLDING GmbH ("the opponent") opposed the contested figurative mark under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act"). It relies on UKTM No. 801143648, **easy life**, which has a priority date of 12 September 2011 and a registration date of 12 November 2013.¹ This is a comparable trade mark (IR) created on the departure of the UK from the EU as the opponent was, on IP completion day (31 December 2020), the proprietor of International Registration No. 1143648, protected in the EU. The mark is registered for goods in Classes 6, 9, 17, 19, 21, 22 and 24 of the Nice Classification. These are listed in the Annex to this decision. The mark qualifies as an earlier mark by virtue of its earlier filing date.

6. Under section 5(2)(b), the opponent claims that the marks are similar and that the goods and services covered by the marks are either identical or similar. Consequently,

¹ Priority is claimed from German trade mark No. 30 2011 050 242.

it claims that there exists a likelihood of confusion on the part of the relevant public in the UK.

7. Under section 5(3), the opponent claims that the earlier mark has a reputation for all the goods covered by that mark and that the similarity between the marks is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the marks. It also alleges that use of the contested figurative mark, without due cause:

a) would be detrimental to the distinctive character of the earlier mark, as the ability of the earlier mark to identify the goods for which it is registered and for which it has a reputation as coming from the opponent would be weakened;

b) would be detrimental to the repute of the earlier mark, if the quality provided by the applicant is poor, as there is a risk that consumers would associate their experience of the applicant's services with the opponent; and/or

c) would enable the applicant to ride on the coat tails of the opponent's reputation and marketing effort and gain an unfair advantage from the attractive force of the earlier mark's reputation.

8. On 1 February 2022, the opponent opposed the contested word mark under sections 5(2)(b), 5(3) and 3(6) of the Act. The claims made under sections 5(2)(b) and 5(3) are the same as those made in the other opposition. Under section 3(6), it claims that the mark is identical to an earlier mark (UKTM 3532916, i.e. the contested figurative mark) which had already been opposed by the opponent. It alleges that the application for the contested word mark had been made vexatiously, resulting in increased costs for the opponent and a multiplicity of proceedings before this tribunal. The opponent argues that such action "*falls short of the standards of acceptable commercial behaviour*" and that the application was made in bad faith.

9. The applicant filed defences and counterstatements to both oppositions, denying the claims made and putting the opponent to proof of use of the earlier mark and to the claimed reputation.

EVIDENCE AND SUBMISSIONS

10. Only the opponent filed evidence. This comes in the form of a witness statement from Benjamin Wehner, who states that he is employed as the Intellectual Property Manager of M.A.C.'s HOLDING GmbH, a position he has held since 2019. The witness statement is dated 22 December 2023 and is accompanied by 7 exhibits. It goes to the claims of use and reputation.

11. Neither side requested a hearing, but both filed written submissions in lieu dated 4 June 2024.

REPRESENTATION

12. In these proceedings, the opponent is represented by J A Kemp LLP and the applicant by Kilburn & Strode LLP.

RELEVANCE OF EU LAW

13. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

PRELIMINARY ISSUE

14. Neither party addresses the claim made under section 3(6) in its written submissions, yet I can find nothing on the file to suggest that the claim has been withdrawn. That said, the evidence from Mr Wehner does not touch on this ground at all. Rule 20 of the Trade Marks Rules 2008 states that:

“(2) Where-

(a) the opposition is based on an earlier trade mark of a kind falling within section 6(1)(c); or

(b) the opposition or part of it is based on grounds other than those set out in section 5(1) or (2); or

(c) the truth of a matter set out in the statement of use is either denied or not admitted by the applicant,

the person opposing the registration ('the opposer') shall file evidence supporting the opposition.

(3) Where the opposer files no evidence under paragraph (2), the opposer shall be deemed to have withdrawn the opposition to the registration to the extent that it is based on-

(a) the matters in paragraph (2)(a) or (b); or

(b) an earlier trade mark which has been registered and which is the subject of the statement of use referred to in paragraph (2)(c)."

15. The opponent has filed no evidence concerning the claim under section 3(6). In the absence of any evidence or any submissions from the opponent that, given the nature of the bad faith allegations, the section 3(6) ground does not require the filing of any evidence, I deem that it has been withdrawn. I shall decide these proceedings on the section 5(2)(b) and 5(3) grounds only.

DECISION

Proof of Use

16. Section 6A of the Act is as follows:

"(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 sections 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-

17. (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) 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.

...”

18. The earlier mark is a comparable trade mark (IR) and so paragraph 7 of Part 1, Schedule 2B applies:

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

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

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

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

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

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

(b) the references in section 6A to the United Kingdom include the European Union.”²

19. The relevant five-year period in relation to the contested figurative mark is 15 September 2015 to 14 September 2020. The whole of this period fell before IP completion day. Paragraph 7(2) applies in this instance and I shall consider evidence of use in the EU for the whole of this period. In relation to the contested word mark, the relevant period is 11 September 2016 to 10 September 2021, with just over eight months falling after IP completion day. Paragraph 7(3) applies here, and I shall

² IP completion day means 31 December 2020 at 11pm.

consider use in the EU for the relevant period up to 31 December 2020 and use in the UK thereafter.

20. The case law on genuine use was summarised by Arnold LJ in *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *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 Bundersvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], 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], Case C-689/15 *W. F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles 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]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(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]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(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]. 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].

(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]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(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 [72]; *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].”

107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and *Ferrari* at [73]-[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council* [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

‘19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed

and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know.

...

22. ... it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal ... comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said the public.”

The opponent's evidence

21. The opponent is the parent company of Easy Life GmbH (“the Easy Life company”), which Mr Wehner describes as “*a wholesale supplier of ‘home protection’ and ‘insect repellent’ products*”.³ He states that the range of goods sold includes insect protection windows and doors, roller shutters, jalousies, pleated curtains or curtains, mosquito nets, screens for light shafts, covers for roof gutters, pigeon/bird defence sticks, and sticks for defence against martens, cats, and other small animals.⁴

22. Extracts from the Easy Life company’s website show how the mark appears to the consumer. These were obtained via the Internet Archive Wayback Machine and three have dates within at least one of the relevant periods (31 March 2016, 23 July 2017 and 25 October 2020). The last of these is shown below, but the content is identical.

³ Paragraph 3.

⁴ Paragraph 4.



23. It will be observed that this website is in German. Some other parts of the evidence are in either German or French and no translations have been provided. The practice of this tribunal is to require translations where the party wishes to rely on the contents of an exhibit: see *POLLINI Trade Mark*, BL O/146/02, and section 4.8.4.2 of the Tribunal Practice Manual. In this summary of the evidence, I shall explain what I have been able to take from the untranslated evidence. In the case of this exhibit, I accept that a variant of the earlier mark has been used on the Easy Company's website in the relevant period and on the packaging for goods that appear to be screens.

24. The goods are stocked in the BAUHAUS chain of hardware stores "throughout the European Union" and on the chain's website. Exhibit BW2 contains an extract from the BAUHAUS website, showing the Easy Life company's goods. This is undated, apart from a copyright stamp of 2023. Exhibit BW3 contains undated photographs of product display stands.

25. Mr Wehner has provided EU sales figures in Exhibit BW4. These were €1,699,375 in 2016, €1,651,984 in 2017, €1,688,136 in 2018, €1,670,775 in 2019, €1,934,671 in 2020. The table shows sales in 20 EU Member States, with the biggest markets being Germany and France. Sales in the former were over €1 million in each of the aforementioned years. Mr Wehner confirms that these cover all the goods sold under the mark, but they are not broken down by product. There are no sales figures for the UK.

26. Exhibit BW5 contains a selection of 21 invoices, dating from 23 February 2015 to 23 June 2021. The first three of these fall within neither of the relevant periods. Addresses of the customers have been redacted but Mr Wehner's unchallenged evidence is that all the customers were based in the EU. The price paid for the goods has also been redacted. Some of the invoices are in English, while others are in French or German. I have been able to identify some of the goods on the French and German invoices, where they have product codes also included on the English invoices. The variant mark shown on the website appears at the top of all the invoices.

27. The table below summarises what I have been able to glean from the invoices. The figures for the second relevant period do not include the last three invoices, even though they are dated 22 February 2021, 15 April 2021 and 23 June 2021. This is because there is nothing on the invoices, or in the narrative in the witness statement, to confirm that they concern sales made to UK customers. As I have already noted, for the period after 31 December 2020, it is use in the UK only that is relevant.

Product	Quantity sold in 1st relevant period	Quantity sold in 2nd relevant period
Polyester screens for windows	24,800	24,320
Polyester screens for doors	820	820
Polyester curtain for doors	5,304	5,304
Strip curtain for door with magnets	195	163
Magnetic insect screens	48	40
Flyscreens	11,780	11,780
Flyscreens for windows	946	846
Flyscreen/Stop Pollen	16	16
Insect roller for windows	610	560
Insect roller	12,827	11,631
Screens for doors	34	34
Elastic screen	28	28
Screens	30	30
Aluminium screens	90	90
Fleece stop pollen	520	520

Product	Quantity sold in 1st relevant period	Quantity sold in 2nd relevant period
Mosquito nets	184	184
Aluminium comfort window	12	12
Aluminium comfort door	32	32
Velcro for fly screen, substitution roll	200	200
Fibreglass substitution roll	50	50
Sealing brush	67	67
Fixing kit	730	680
Screens for light shafts	45	45
Pigeon defence sticks	20	20

28. Expenditure on promoting the mark in the EU was €6,444 in 2016, €3,050 in 2017, €3,401 in 2018, €2,639 in 2019 and €6,452 in 2020. Mr Wehner explains that this activity is directed towards retailers, rather than end consumers.⁵ The principal means of advertising the Easy Company's goods are through product catalogues, social media platforms and online. The table below shows the number of catalogues distributed to customers within the EU:⁶

Country	2016	2017	2018	2019	2020	2021
	Units delivered	Units delivered	Units delivered	Units delivered	Units delivered	Units delivered
Germany	4,889	2,172	1,117	6,746	60	1,980
Austria	15	55	-	-	-	-
L/bourg	-	10	-	-	-	-

29. Examples of catalogues are to be found in Exhibit BW6. The catalogues are all in German but appear to show a variety of screens and appear to emphasise the usefulness of the products in protecting against insects. They are, however, undated.

⁵ Paragraph 12.

⁶ Paragraph 13.

30. Exhibit BW7 shows screenshots from a selection of promotional videos on YouTube. The first was published on 8 April 2015, the second on 30 November 2016 and the third on 9 July 2017. The image below shows the second video and the variant mark can be seen in the top left corner. The videos have had 708,428, 11,837 and 14,474 views respectively. However, these figures were presumably current at the date the screenshots were captured, rather than at either of the filing dates of the contested marks.



Use with Consent

31. Mr Wehner states that it is a subsidiary of the opponent that has used the mark. Section 6A(3)(a) of the Act provides that use may be by the proprietor, or with its consent. Although Mr Wehner has not explicitly said that the earlier mark was used with the opponent's consent, I consider that it is reasonable to infer that the subsidiary's use of the parent company's mark satisfies the criteria set out in section 6A(3)(a).

Variant Use

32. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Professor Phillip Johnson, sitting as the Appointed Person, considered the correct approach to assessing whether a variant mark was acceptable. 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 supposed 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.”

33. The earlier mark is a word mark **easy life**. The form in which it appears in the evidence is shown below:



34. The word “easy” appears in grey, lower-case letters. The second word, “life”, is shown in white, on a lime green circular background, surrounded by a white border and a thinner lime green border. A diagonal line in the upper left of the mark cuts off a small part of this circle. In my view, the colours and the figurative elements do not alter the distinctive character of the earlier mark which lies in the two-word combination “easy life”. Consequently, I find that the form used in the evidence is an acceptable variant of the earlier mark.

Sufficiency of Use

35. In order to find that the opponent has made genuine use of the earlier mark, I need to be satisfied that it was real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the EU (in the case of the contested figurative mark) and the EU and then the UK (in the case of the contested word mark) during the relevant periods. In making my assessment, I also bear in mind that I must consider the evidence in the round and that *“it cannot be ruled out that an accumulation of items of evidence may allow the necessary facts to be established, even though each of those items of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts”*: see *New Yorker SHK Jeans GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-415/09, paragraph 53.

36. It is clear from the evidence that the vast majority of sales took place in Germany. In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the Court of Justice of the European Union (“CJEU”) noted that:

“36. It should, however, be observed that ... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.

...

50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national mark.

...

55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

37. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited* [2016] EWHC 52, Arnold J (as he then was) reviewed the case law since *Leno* and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issue in London and the Thames Valley. On that basis, the General Court dismissed the applicant’s challenge to the Board of Appeal’s conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant’s argument is not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that ‘genuine use in the Community will in general require use in more than one Member State’ but ‘an exception to that general

requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State'. On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use."

38. The General Court restated its interpretation of *Leno* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of that judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

39. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the European Union during the relevant five-year period, or the part of that period falling before 1 January 2021. In making this assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown;
- ii) The nature of the use shown;
- iii) The goods and services for which use has been shown;
- iv) The nature of those goods/services and the market(s) for them; and
- v) The geographical extent of the use shown.

40. The opponent's strongest evidence comes from the invoices, as the majority of these are dated within both of the relevant periods and they provide specific information on the products sold in the EU. As I have already noted, the customer address materials have been redacted, but Mr Wehner's statement that they were all based in the EU has not been challenged. The website screenshots also show screens and indicate that the variant form of the mark was used on the packaging of products and in promotional videos.

41. The opponent's Class 6 goods cover a variety of building materials made from common metals, along with the metals themselves and their alloys. The invoices show sales of doors and windows made from aluminium, aluminium screens, screens for basement and light shafts, pigeon defence sticks, and insect protection rollers. Screens labelled "Alu", which I infer from comparing the English invoices to the other invoices, refers to "aluminium", can be seen on the website screenshots in Exhibit BW1. The sales volumes of some of these products are fairly low, but I remind myself that there is no *de minimis* level of sales that can be considered genuine, and that the invoices represent a sample of the sales. I also note that these goods are unlikely to be regular purchases. The screens for basement and light shafts and pigeon defence sticks only appear on a single invoice, with no other dated evidence indicating the level of sales. Although the catalogues are not dated, they all stress the purposes of the opponent's goods as being protection from insects. On magnification of the website screenshots, I can see that the packaging of the screens shows a picture of an insect (marked with an arrow below). For the purposes of reproduction in this decision, it is clearer on one of the undated screenshots,⁷ but the same symbol appears on packaging in screenshots taken on dates within both the relevant periods.

⁷ Exhibit BW1, page 4.



42. The opponent submits that sales of a product called “Fixing kit for fibreglass” are evidence of genuine use of the mark for the following goods in Class 6: *Goods of common metal, not included in other classes; windows, doors and parts thereof, made of metal, in particular insect protection windows and doors, rodent protection windows, the above-mentioned goods also as assembly kits; frames of metal for building purposes, in particular frames for mounting fly screens on windows and doors.* However, there is nothing to show me what is included in the fixing kit, and so I dismiss this argument.

43. I find that there has been genuine use of the mark for insect protection doors and windows, insect protection screens and insect protection rollers, all made from aluminium.

44. The invoices also show sales of screens and insect rollers made from PVC and polyester, so I also accept there has been genuine use of the mark for these goods in Class 19 also.

45. The goods in Class 9 are electrical appliances for deterring or killing pests. I can see no examples in the evidence of the mark being used in relation to these goods.

46. The opponent submits that sales of fibreglass substitution roll show that the mark was genuinely used for *Fibreglass fabrics for insulation; insulating materials, included in this class*. These are the only Class 17 goods that are specified in its submissions. I note that it says that the table provided at paragraph 1.11 of those submissions is not exhaustive, but I cannot see any other goods that might fall within this class. There have been sales of fibreglass substitution roll throughout the relevant periods, but the only image (albeit undated) is from the BAUHAUS website:⁸



47. Fibreglass fabrics have many different uses and it does not appear to me from this image that this particular product would be insulating material. One would expect such materials to be thicker. In my view, the opponent has not shown genuine use of the mark for any of the goods in Class 17.

48. The goods in Class 21 are traps for rodents and insects. I can see no examples in the evidence of the mark being used in relation to these goods.

49. The opponent refers me to sales of screens as evidence of genuine use of the mark for the goods in Class 22. However, in my view the average consumer would not describe these as “awnings”, which it would understand to be a sheet of fabric stretched over a frame above a door or window. I do not consider that the average consumer would describe the goods as tarpaulins, tents or sails. I note that the

⁸ Exhibit BW2, page 13.

specification also refers to “nets”, but mosquito nets are included in the Class 24 specification and so I shall consider them shortly. I find that the opponent has not shown genuine use of the mark for the goods in Class 22.

50. The final class in the opponent’s specification is Class 24, which includes a variety of different textile goods. The invoices show sales of polyester curtains, strip curtains for doors, mosquito nets and fleeces for protecting against pollen, throughout the relevant periods. I note the focus of the opponent’s goods on protecting against insects, and the admittedly undated BAUHAUS website showing insect protection curtains. There is no evidence at all that the opponent sells curtains that also serve a decorative purpose and contribute to the “look” of a room. I find that the mark has been genuinely used for insect protection curtains, pollen protection fleeces and mosquito nets. It is possible that the “Strip curtain for door with magnets” that appears on some of the invoices is a curtain consisting of slats, given that slats are narrow strips of material. These have been sold throughout the relevant periods. The undated BAUHAUS website also shows a product called “Slat curtain”, but the dimensions of the two products are different and so they cannot be the same goods. I also note that the French description of the “Polyester curtain for doors, black” contains the word “lamelles”. However, no translation has been given and, following the Appointed Person’s decision in *POLLINI*, it would not be appropriate for me to translate this of my own accord. On the basis of the evidence before me, I am unable to find that there is genuine use for *Curtains of textile or synthetic materials consisting of slats*.

51. The opponent submits that use of the mark for “Velcro for flyscreen, substitution roll” is also evidence of use for *Textiles and textile goods, not included in other classes; curtains of textile or synthetic materials; mosquito nets*. I understand Velcro to be a fastener consisting of two strips, one covered with loops and the other with hooks. It is not necessarily made from textiles; it could equally be made from plastic, particularly if it is important that the fastener is water-resistant. There is no evidence to tell me whether the goods sold by the opponent are textile or not.

52. Finally, the opponent also argues that use of the mark for “Sealing brush” is also evidence of use for *Textiles and textile goods, not included in other classes; curtains of textile or synthetic materials; mosquito nets*. The only reference to these goods is an image on the undated BAUHAUS website. The description states that it is an

adhesive fastening. I cannot see whether it is a tape (and so therefore potentially covered by the Class 17 specification). Neither is it clear to me that it is a textile good.



Fair specification

53. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors*, [2017] EWCA Civ 1834, Kitchin LJ (as he then was) set out the approach to be followed when considering partial revocation of a trade mark. The same approach is relevant when framing a fair specification during a proof of use assessment. He said:

“244. As I described in *Maier v Asos*, the approach to be adopted is relatively straightforward (although I readily acknowledge that it may on occasion be difficult to apply) and it is in my view consistent with the earlier decisions of the Court of Appeal to which I referred at paragraph [63]. On reflection, I think it can be expressed more clearly as follows.

245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of

subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other categories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.”

54. I found that the opponent’s evidence showed use of the earlier mark for goods in Classes 6, 19 and 24.

55. The terms in Class 6 that cover the goods in relation to which the mark has been genuinely used during the relevant periods are as follows: *Metal building materials; goods of common metal, not included in other classes; windows, doors and parts thereof, made of metal, in particular insect protection windows and doors; roller-shutters of metal, in particular insect protection roller shutters for windows; screens of metal, in particular fly screens, insect screens.* The first two of these terms (*Metal building materials* and *goods of common metal, not included in other classes*) are very broad terms that would include a fairly large number of subcategories capable of being viewed independently. Some examples are given in the opponent’s own specification: *pipes, roller shutters, cables and wires.* Therefore, it is my view that a fair specification would not include these broad terms. I also consider that it would be too broad to allow a fair specification to include *Windows, doors and parts thereof.* The opponent’s goods are intended to perform a particular function, namely, to protect against insects. They are made from materials that allow air to circulate and light to pass through, while keeping unwanted insects out. The roller shutters and screens would have the same

properties. In my view, a fair specification for Class 6 would be *Insect protection windows and doors, made of metal; insect protection roller shutters of metal for windows; fly screens of metal; insect screens of metal.*

56. The terms in Class 19 that cover the goods in relation to which the mark has been genuinely used during the relevant periods are as follows: *Building materials (non-metallic); windows, doors and parts thereof, not of metal, in particular insect protection windows and doors; roller shutters, not of metal and not of textile material, in particular insect protection roller shutters for windows; screens, not of metal, in particular fly screens, insect screens.* The same rationale applies here as it did in my consideration of Class 6. In my view, a fair specification would be *Insect protection windows and doors, not of metal; insect protection roller shutters, not of metal and not of textile material, for windows; fly screens, not of metal; insect screens, not of metal.*

57. The terms in Class 24 that cover the goods in relation to which the mark has been genuinely used during the relevant periods are as follows: *Textiles and textile goods, not included in other classes; curtains of textile or synthetic materials; fleeces (textiles), in particular pollen protection fleeces; mosquito nets.* *Textiles and textile goods, not included in other classes* is a broad category that would include a number of different subcategories, such as towels and bed linen, as well as curtains. It would not be fair, in my view, to allow the opponent to rely on such a broad term. I also take the view that the curtains for which the mark has been used are a specialist product with a particular purpose, namely insect protection. They are not the same as curtains chosen for their colour or pattern that are purchased in order to keep out the dark and contribute to the appearance of a room. I also consider that the opponent's pollen protection fleeces are a specialist product with a particular purpose. In my view, a fair specification for Class 24 would be *Curtains of textile or synthetic materials, namely insect protection curtains; pollen protection fleeces; mosquito nets.*

Section 5(2)(b)

58. Section 5(2)(b) of the Act is as follows:

“A trade mark shall not be registered if because—

...

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

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

59. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the CJEU 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 BV* (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their 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 greater 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; and
- 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

60. It is settled case law that I must make my comparison of the goods and services on the basis of all relevant factors. These include the nature of the goods and services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. As the General Court (“GC”) said in *Boston Scientific Ltd v OHIM*, Case T-325/06, goods and services are complementary when

“82. ... there is a close connection between them in the sense that one is indispensable or important for the use of the other in such a way that

customers may think that the responsibility for those goods lies with the same undertaking.”

61. In *SEPARODE Trade Mark*, BL O-399-10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, said that:

“5. The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”⁹

62. The applicant’s specification covers advertising, promotional, retail and wholesale services in relation to a long list of different goods. I shall be comparing them to the opponent’s goods that survived the proof of use assessment. In *Oakley, Inc. v OHIM*, Case T-116/06, the GC held that, although retail services are different in nature, purpose and method of use from goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels and therefore similar to a degree: see paragraphs 46-57 of that judgment.

63. In *Tony Van Gulck v Wasabi Frog Ltd*, BL O/391/14, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, reviewed the law concerning the comparison of retail services and goods. He said:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether

⁹ The same applies in respect of services.

there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applies for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are '*similar*' to goods are not clear cut."

64. However, on the basis of the European courts' judgments in *Sanco SA v OHIM* (Case C-411/13 P) and *Assembled Investments (Proprietary) Ltd v OHIM* (Case T-105/05), upheld on appeal in *Waterford Wedgwood Plc v Assembled Investments (Proprietary) Ltd* (Case C-398/07 P), Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark were registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

65. It is clear from this case law that where the applicant's retail services are to be compared to the opponent's goods, the retail services will be different in nature, purpose and method of use from those goods. Despite these differences, where there is some complementarity and shared trade channels, retail services *may* be similar to goods. It is equally clear that complementarity alone will not suffice for a finding of similarity, where from the consumer's point of view, the retail services of the applicant would not normally be offered by the same undertaking as the goods. Furthermore, I

note that I must not treat the retail services as goods, although consideration of the retail services normally associated with the opponent's goods should be made.

Advertising and marketing services, wholesale services, retail services including on-line retailing, retailing through the medium of broadcasting, retail services conducted by mail order, all connected with the sale of ... floor coverings, wall coverings, carpets, rugs, mats, matting, linoleum, wall-hangings, wallpaper, furniture, furniture covers, ... bedding, mattresses, mattress toppers, pillows, bedlinen, duvets and duvet covers, bedclothes, blankets, cushions, cushion covers, curtains, blinds, inflatable furniture, kitchen furniture, bedroom furniture, nursery furniture, outdoor furniture, living-room furniture, bathroom furniture, seats, shelves, ... billiard cloth, bolting cloth, ... cheese cloth, chenille fabric, table linen, cotton fabrics, coasters, chair covers, household implements, ... tableware, ... other Christmas decorations, ... camping equipment, tents, sleeping bags, nets, awnings and tarpaulins

66. The opponent submits that the goods that are the subject of these services are similar to its Class 22 and Class 24 goods "... on the basis that the various retail items listed may be of a similar nature and fulfil the same or a similar purpose (where they may be made of textile fabric or materials)." I must be mindful of the need to compare the opponent's goods with the applicant's services, not the goods in relation to which the services are offered. The relevant goods that have survived the proof of use assessment are *Curtains of textile or synthetic materials, namely insect protection curtains; pollen protection fleeces; mosquito nets.*

67. The applicant's services are various types of wholesale and retail services, along with advertising and marketing services. Some of the goods to which these services relate are covered by terms in the opponent's fair specification. These are *Curtains* and *Nets*, which are broader terms encompassing *Insect protection curtains* and *Mosquito nets* respectively. The wholesale and retail services will be offered in places where the goods are sold, and, consequently, the trade channels are shared.

68. The GC confirmed in *Oakley* that when retail services relate to the specific goods in question, those services will be provide at the point at which the goods are sold. It said:

“54. ... As the Court held in paragraph 34 of *Praktiker Bau- und Heimwerkermärkte*, paragraph 17 above, the objective of retail trade is the sale of goods to consumers, the Court having also pointed out that that trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. Such services, which are provided with the aim of selling certain specific goods, would make no sense without the goods.”

69. I consider that the same principle applies with regard to wholesale services.

70. I find that where the opponent's goods are the subject of the applicant's retail and wholesale services, those goods are indispensable to the applicant's services, as these would not exist without the goods. In my view, the complementarity between the goods and services is sufficiently pronounced for the average consumer to assume that the goods and services are offered by the same undertaking.

71. I also consider that there will be some overlap in user between the goods and the retail services. In the case of wholesale services, the user is likely to be a business or a tradesperson who purchases goods through these services in order to supply them to a customer or to use them in their own premises. I therefore find there is some degree of overlap in user between the goods and these services too.

72. Taking all these factors into account, I find that there is a medium degree of similarity between the applicant's retail and wholesale services in relation to *Curtains* and *Nets*.

73. I now come to the *Advertising and marketing services* connected with the sale of *Curtains* and *Nets*. The applicant submits that *Advertising and marketing services* should be interpreted separately, but I will be guided by the punctuation used in the specification. The difference between a semi-colon and a comma is important when interpreting a term. Commas are used to separate items within a category or expression, whereas a semicolon indicates a separation between categories within the same class: see *Louis Vuitton Malletier v OHIM*, Case C-97/12 P, paragraphs 96-97. The specification of each of the contested marks begins: “*Advertising and marketing services, wholesale services, retail services including on-line retailing, retailing through the medium of broadcasting, retail services conducted by mail order, all connected*

with the sale of ...". There then follows a long list of goods before a semi-colon separates these services from "*The organisation, operation and supervision of sales and promotional incentive schemes, loyalty card, reward and membership services*". Therefore, I will treat the *Advertising and marketing services* as being in relation to specified goods.

74. In construing this term, I keep in mind the comments of Lord Kitchin in *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36. He said:

"365. ... The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 195; [2004] RPC 40 at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specification of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case."

75. The core of the possible meanings of the term *Advertising and marketing services* consists of services purchased by undertakings wishing to promote their products and encourage consumers to choose their goods over those of their competitors. They are likely to involve the provision of information about the goods in a way calculated to appeal to particular groups of consumers. The users of these services are different from those of the goods. The services and goods also differ in nature, purpose and method of use. They are also likely to be accessed through different trade channels. As with the retail and wholesale services, I find that the goods are indispensable for the services, but I do not consider that any complementarity is so pronounced that the average consumer would think that the goods and services come from the same

undertaking. I find that the *Advertising and marketing services* are dissimilar to the goods.

76. The remaining retail and wholesale services in this group are further removed from the goods on which the opponent may rely. While trade channels and users may be shared, I do not consider that there is any complementarity between the services and the goods. In *Unicorn Studio Inc v Veronese (Société par Actions Simplifiée)* [2014] EWHC 1098 (Ch), Mr Iain Purvis KC, sitting as a deputy High Court judge, said:

“23. ... It seems to me the greater the level of generality at which some similarity under *Canon* factors can be found (i.e. both goods are ‘*sold in large department stores*’ or both goods are ‘*used by ordinary people*’) the less relevant could it be to any question of confusion, and any assessment of similarity of goods should take that into account.”

77. I consider that this is a case where any similarity between the goods and services is at such a level of generality that I find them to be dissimilar for the purposes of my assessment under section 5(2)(b) of the Act. Therefore, I find that, with the exception of retail and wholesale services in relation to *Curtains* and *Nets*, all the services listed above paragraph 66 are dissimilar to the opponent’s goods.

Advertising and marketing services, wholesale services, retail services including on-line retailing, retailing through the medium of broadcasting, retail services conducted by mail order, all connected with the sale of heating apparatus, cooling apparatus, refrigeration apparatus, drying apparatus, ventilation apparatus, humidifiers with parts and accessories, burners, boilers, white goods, lighting, lights, lanterns and lamps, heaters, steam-generating equipment, televisions, polishers, vacuums, carpet shampooers, electrically heated hair rollers, electric makeup remover appliances, multiplug apparatus, ... torches, air compressors, audio-visual equipment, musical instruments, CDs, DVDs, computers, computer parts, computer accessories, computer peripherals, calculating machines, software and hardware, ... telecommunications equipment, mobile phones, ... hand held electronic games, computer games, video game apparatus, ... motion-sensor lights, ... photographic accessories, photographic equipment.

78. The opponent submits that the goods that are the subject of the above services are similar to its Class 9 goods. However, none of these goods survived the proof of use assessment. I cannot see that there is any similarity between these services and any of the opponent's goods that I found to be in a fair specification. Therefore, I find them to be dissimilar.

Advertising and marketing services, wholesale services, retail services including on-line retailing, retailing through the medium of broadcasting, retail services conducted by mail order, all connected with the sale of ... ironmongery, ... metal and wooden door hardware, metal and wooden door fittings, metal gates, gate fittings, door fittings, curtain fittings, bins and boxes either wholly or substantially of metal, door and window catches made either wholly or substantially of metal, hooks made wholly or substantially of metal, window fittings, door and window fasteners, windows, doors, ... non-metallic hardware, ... shower fittings, ... home decorating equipment and implements and parts and accessories.

79. The opponent submits that the goods that are the subject of the above services are similar to its Class 6 goods because “these goods are similar on the basis that they are of a similar nature and where these items are commonly sold alongside one another, including for example in DIY or home improvement stores”. The goods that survived the proof of use assessment are as follows: *Insect protection windows and doors, made of metal; insect protection roller shutters of metal for windows; fly screens of metal; insect screens of metal.*

80. I understand *Ironmongery* to mean tools and fittings made of metal and in my view it could include *Insect screens of metal* for fitting to windows or doors. I also consider that they would be included in *metal ... door hardware, metal ... door fittings, door fittings, window fittings*. The opponent's *Insect protection windows and doors* would also be included in *Windows and doors*. *Fly screens* and *insect screens* not of metal in Class 19 would also be included in *non-metallic hardware*. For the reasons given in paragraphs 67-72 above, I find that the retail and wholesale services in relation to *ironmongery, ... metal ... door hardware, metal ... door fittings, ... door fittings, ... window fittings, ... windows, doors, ... non-metallic hardware* are similar to the aforementioned goods to a medium degree.

81. I accept that some of the other retail and wholesale services may be offered alongside the opponent's insect protection windows and doors and screens to the same users. In my view, these would be the services connected to the sale of ... *wooden door hardware, ... wooden door fittings, ... door and window catches made either wholly or substantially of metal, door and window fasteners*. However, these are all goods that would be sold by the same specialist door and window retailers and wholesalers. For this reason, I find that there is some similarity between the goods and services, although this is at a low degree.

82. I find that the remaining retail and wholesale services and the Advertising and marketing services are dissimilar to the opponent's goods for the reasons given in paragraphs 75 to 77 above.

Advertising and marketing services, wholesale services, retail services including on-line retailing, retailing through the medium of broadcasting, retail services conducted by mail order, all connected with the sale of ... abrasive preparations, disinfectants, fungicides, preparations for destroying vermin, pest repellents, insecticides ...

83. The opponent submits that the goods that are the subject of the above services are similar to some of its Class 9 goods. However, as I have already noted, none of these survived the proof of use assessment. I cannot see that there is any similarity between these services and any of the opponent's goods that I found to be in a fair specification. Therefore, I find them to be dissimilar.

Advertising and marketing services, wholesale services, retail services including on-line retailing, retailing through the medium of broadcasting, retail services conducted by mail order, all connected with the sale of ... clocks, ornaments, figurines of china, wood, wax, plaster or plastic, mirrors, jewellery boxes, trunks, animal skins and hides, pictures and paintings, picture frames, beds, ... barrels, plastic and wooden boxes, ... brocades, buckram, calico, ... containers and utensils, bakeware, cookware, cutlery, earthenware, microwave cookware, glassware, porcelain, kitchen weighing and measuring equipment, ... metal foils for wrapping and packaging, catering foil, food preparation implements, plastic and wooden bins, bottle racks, changing mats for babies, children's safety gates, baby walkers, baby high chairs, crates, non-metallic ladders, household containers, basins, baskets, bowls, basting spoons, hand beaters,

synthetic Christmas trees ... , crackers and ornaments, Christmas tree stands, knife sharpeners, sterilization equipment, ... stationery, publications, ... bookbinding materials, adhesives for stationery or household purposes, office furniture, namely desks and office chairs, ... paper shredders, clothing, footwear, headgear, jewellery, precious and semi-precious stones, watches, cufflinks, badges made of precious metals, umbrellas, parasols, bags, luggage, wallets, purses, optical goods, keyrings, medals, tie-pins, tie-clips, watch straps, handbags, baby carriers, music cases, suitcases, briefcases, attaché cases, haversacks, belts, wheeled shopping bags, key cases, leather laces, satchels, game bags, backpacks, robes, wigs, moccasins, specialized underwear, socks, bathroom items, per-moistened or impregnated tissues or wipes, sanitising wipes, personal hygiene products, apparatus and instruments for monitoring human bodily functions, life-saving and teaching apparatus and instruments, personal weighing and measuring apparatus and equipment, safety clothing, oral hygiene preparations, breath fresheners, breath freshening strips and sprays, mouthwash, namely antiseptic mouthwash and mouth rinses for medical use, all cleaning preparations for the teeth (commonly known as dentifrice), namely toothpaste, tooth polish, tooth powder, preparations for cleaning dentures, tooth-stopping materials, dental wax, body cleaning preparations, bath preparations, deodorants for personal use, antiperspirants, hair preparations, hair treatments, hair dyes, razors, waxing substances, shampoos, conditioners, shaving gels, foams and preparations, pre-shaving and aftershave lotions, manicure tools, pedicure tools, sanitary preparations for medical use, pharmaceutical preparations, baby food, baby beverages, milk powder for infants, infant formula, infant feeding apparatus, nutritional supplements, dietetic food for invalids, dietary supplements, dietetic food for medical use, plasters, dressings and suturing materials, glasses and eyewear, solutions for contact lenses, condoms and other contraceptive devices, deworming and delousing and anti-parasitic preparations for humans, water-purification products, combs, sponges and body brushes, masks, face shields, visors, protective overalls and coveralls and gloves, disposable items, namely Eau de Cologne and Eau de Toilette, toilet water, body sprays, perfumed tissues, essential oils, hair lotions, beauty care preparations, hair lotions, hairspray, hair waving, hair curling and straightening preparations, hair cutting, drying and removal implements, makeup, namely face, eye and cheek powders and creams, together with tools for applying makeup, lipsticks, lip glosses, false eyelashes, nail care preparations, nail varnish, false nails, nail varnish

remover, nutritional creams, henna, dietary supplements for animals, dietetic substances adapted for veterinary use, deworming medication, insecticidal products for animals, items of clothing for pets, pet leads, pet beds, bird baths, birdcages, bird feeders, animal fodder, animal bedding and litter, garden buildings, garden tools, hand tools, home mechanic apparatus and parts and accessories therefor, ... herbicides, insecticides, bells, ... hand-operated gardening implements and tools, hand-operated landscaping implements and tools, fire-tending implements, hand tools for cutting and other purposes, namely drilling, and grinding tools, paint brushes and rollers, ... string, natural and artificial turf, ... dummy security cameras, floor protections kits, brooms, ... fence panels, cleaning products, cleaning equipment, ... wax for polishing, plastic storage containers, non-metallic pallets, steel wool, shower cleaners, dirt trapping mats, cameras, .. photographic and picture frames, photographs and pictures, photographic apparatus and instruments, exercise mats, gymnastic and sporting articles, hunting and fishing equipment, swimming equipment, children's playground apparatus and equipment, floats for bathing and swimming, swimming belts and jackets, ropes, ... portable toilet, artists' materials, namely paint brushes, paints, varnishes, pigments, dyes, body art tools, binoculars, fireworks, printers' type, printing blocks, craft and modelling equipment, painter's easels, canvas for tapestry and embroidery, lace, embroidery and embroidery thread, knitting yarns and needles, sewing machines, sewing kits, haberdashery, namely ribbons, braid, buttons, hooks, eyes, pins, needles, artificial flowers, fruit and vegetables, games, toys, caps for toy pistols, vehicles and apparatus for locomotion by land, air or water, bicycles, prams, pushchairs and parts and accessories for such items, preservatives against rust and against deterioration of wood, colorants, mordants, raw natural resins, wood preservatives, wood stains, anti-corrosive and anti-fouling compositions, primers, coatings (paints), bleaching preparations, substances for laundry use, cleaning preparations, polishing preparations, scouring preparations, ... apparatus and instruments for science, surveying, optics, cinematography, measuring, signalling, weighing, nautical navigation, checking, life-saving, teaching, lighting, heating, apparatus and instruments for conducting, switching, accumulating, regulating, controlling and transforming electricity, safety goggles, protective eyewear, surgical, medical, dental and veterinary apparatus and instruments; the organisation and supervision of sales and promotional incentive schemes, loyalty card, reward and

membership services; promotional, advertising, business management, the provision of information, consultancy and advisory services related to all such services.

84. The opponent submits that these services are similar to the opponent's goods as "providers of retail services often market and sell a wide range of goods. Accordingly, there is a possibility that the Opponent's goods may be marketed and sold alongside all of the items expressly listed in the Applicant's Class 35 specification." This is the kind of argument that Mr Purvis warned against in the *Veronese* decision I have already cited. I cannot see that there is any similarity between these services and the goods I found to be in a fair specification. Therefore, I find them to be dissimilar.

85. In *eSure Insurance Limited v Direct Line Insurance Plc* [2008] EWCA Civ 842 CA, Lady Justice Arden said that

"49. ... If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity."

86. This means that, for those services where I found dissimilarity, the opposition under section 5(2)(b) fails at this point. It continues in respect of the following services:

Class 35

Wholesale services, retail services including on-line retailing, retailing through the medium of broadcasting, retail services conducted by mail order, all connected with the sale of ...curtains, ... ironmongery, metal and wooden door hardware, metal and wooden door fittings, ... door fittings, ... door and window catches made either wholly or substantially of metal, ... window fittings, door and window fasteners, windows, doors, ... non-metallic hardware, ... nets.

Average consumer and the purchasing process

87. The average consumer is deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary

according to the category of goods and services in question: see *Lloyd Schuhfabrik*, paragraph 26.

88. Neither party has made any submissions on the identity of the average consumer. In my view, they are likely to be either a member of the general public, a business or tradesperson. If the consumer is a member of the public, the purchases are likely to be infrequent. Most of the goods would be relatively low in price and I would expect the average consumer to pay a medium level of attention when purchasing them or choosing a retailer or wholesaler. In the case of *Insect protection doors and windows*, I consider it likely that a slightly higher than medium level of attention would be paid if the goods were to be fitted into the fabric of the building. In my view, the attention paid by a business would be a little higher than that paid by a member of the public.

89. I consider that it is likely that the purchasing process will be largely visual, with the average consumer browsing websites and printed matter, and seeing the goods for sale in shops. They are also likely to see the mark used on signage outside retail and wholesale outlets. This means that the visual aspects of the mark will be most significant. However, as the average consumer may also receive word-of-mouth recommendations, I shall also take account of how the marks sound.


Comparison of marks

90. It is clear from *SABEL* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo* that:

“34. ... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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.”

91. Artificial dissection of the marks would therefore be wrong, although it is necessary for me to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

92. The respective marks are shown below:

Contested marks	Earlier mark
<p>The contested word mark:</p> <p>Easylife</p> <p>easylife</p> <p>The contested figurative mark:</p> 	<p>easy life</p>

93. The contested word mark is a series of two marks, with the only difference being that the first letter of one mark in the series is in upper case, while the first letter of the other mark is in lower case. In my view, the marks would be seen as the words “easy” and “life” conjoined into a single word. This is because the average consumer tends to break down a verbal sign into words known to them: see *Vitakraft-Werke Wührmann & Sohn GmbH & Co KG v OHIM*, Case T-356/02, paragraph 51. As these marks are word marks, it is those words that are protected, irrespective of colour, form or typeface: see *LA Superquimica v European Union Intellectual Property Office (EUIPO)*, Case T-24/17, paragraph 39.

94. The contested figurative mark consists of the word “easylife” in very slightly stylised blue lower-case letters. Underneath this word, in smaller letters there is the phrase “everyday solutions”. At the left of the verbal element is a blue circle containing a white

tick. In my view, the dominant and distinctive element of this mark is the word “easylife”, with the remaining elements, including the colour, making only minor contributions to the overall impression of the mark. The phrase “everyday solutions” would be perceived as a strapline, while the figurative element is relatively commonplace.

95. The earlier mark is a word mark consisting of two words: “easy” and “life”. The average consumer is likely to see these as a unit, as the word “easy” qualifies the word “life”. The overall impression lies in the combination of the words.

The contested word mark

96. The only visual difference between the contested word mark and the earlier mark is that the letters are presented as a single word in the case of the contested mark and two words in the case of the earlier mark. Consequently, I find that they are visually highly similar.

97. Turning to the aural comparison, I consider that the words would be given their ordinary English pronunciation, which would be identical.

98. The conceptual message conveyed by both marks is of a life that is straightforward and without problems. I find the marks to be conceptually identical.

The contested figurative mark

99. The contested figurative mark contains additional elements, notably a strap line and the device. The colour will have no bearing on my comparison, as fair use of the earlier mark would include its use in the same shade of blue. I remind myself that the average consumer sees the mark as a whole and would notice the additional elements of the mark. Bearing in mind the dominant and distinctive element of the contested mark, together with these additional elements, I find that the marks are visually similar to a medium degree.

100. The opponent admits that the verbal element “everyday solutions” is a point of aural difference between the marks, which suggests that it believes that it will be articulated by the average consumer. If that is the case, the beginnings of the marks are identical. The beginnings of marks tend to have more aural impact than the ends: see *El Corte Inglés SA v OHIM*, Joined Cases T-183/02 and T-184/02, paragraph 82.

Taking account of the dominant and distinctive element of the contested mark, I find that the marks are aurally highly similar.

101. The opponent submits that the marks are conceptually identical. I have already found that the phrase “easy life” would convey the message of a straightforward life without problems. The strapline “everyday solutions” would bring to mind simple solutions to any problems that do occur. Consequently, I find that the marks are conceptually highly similar.

Distinctive character of the earlier mark

102. Distinctive character is a measure of how strongly a mark distinguishes the goods or services of one undertaking from those of others. The factors that I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer*.

“23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered, the market share held by the mark, how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark, the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking, and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

103. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of the mark can be enhanced by the use that has been made of it.

104. Although the opponent has filed evidence of use of the mark, none of this evidence appears to relate to use in the UK, and it is that territory that is relevant for an assessment of whether the inherent distinctive character of the earlier mark has

been enhanced through use. Consequently, I have only the inherent position to consider.

105. The earlier mark does not contain any elements that are descriptive or suggestive of the goods on which the opponent may rely. Consequently, I find that the inherent distinctive character of the mark is medium.

Conclusions on likelihood of confusion

106. Making an assessment of the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer of the goods and services at issue and determining whether they are likely to be confused. When doing this, I am required to bear in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them that they have in their mind. This means that the global assessment emulates what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark. The courts have not said what weight should be attached to each of the factors or provided a formula that can be applied to any set of circumstances. However, I am required to take account of the interdependency principle, i.e. that 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 or vice versa.

107. There are two types of confusion: direct and indirect. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised 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.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI', etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

108. In *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ commented that:

"12. This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.

13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/291/16) at [16] 'a finding of likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of

circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”

109. Earlier in my decision, I found that:

- a) The applicant's services listed in paragraph 86 above are similar to the opponent's goods to a medium or low degree;
- b) The average consumer is a member of the general public, a business or a tradesperson. Where the average consumer is a member of the general public, they will pay a medium level of attention when purchasing the goods and services, except in the case of windows and doors that are to be fixed into the fabric of a building, where the level of attention paid would be slightly higher;
- c) The business or tradesperson would pay a slightly higher level of attention than the member of the general public;
- d) The purchasing process would be largely visual, although there is a role for word-of-mouth recommendations;
- e) The contested word mark is visually highly similar to the earlier mark and aurally and conceptually identical;
- f) The contested figurative mark is visually similar to the earlier mark to a medium degree, and aurally and conceptually highly similar;
- g) The earlier mark has a medium degree of distinctive character.

110. The average consumer is unlikely, in my view, to remember whether “easy life” is presented as a single word or as two. I therefore consider that there is a likelihood of direct confusion between the earlier mark and the contested word mark if the latter is used in relation to the services that are still in play. I also take the view that, as the words “easy life” comprise the dominant and distinctive element of the contested figurative mark, the average consumer is unlikely to remember whether the earlier mark contained any figurative elements or straplines. I find there is a likelihood of direct

confusion for this mark too. But even if the average consumer recalls the differences between the marks, it is my view that they will assume that they are simply a word mark and a figurative mark belonging to the same undertaking and so there is a likelihood of indirect confusion.

111. The opposition under section 5(2)(b) is successful in relation to the following services:

Class 35

Wholesale services, retail services including on-line retailing, retailing through the medium of broadcasting, retail services conducted by mail order, all connected with the sale of ...curtains, ... ironmongery, metal and wooden door hardware, metal and wooden door fittings, ... door fittings, ... door and window catches made either wholly or substantially of metal, ... window fittings, door and window fasteners, windows, doors, ... non-metallic hardware, ... nets.

Section 5(3)

112. Section 5(3) of the Act is as follows:

“A trade mark which—

(a) is identical with or similar to an earlier trade mark,

[...]

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

113. As the earlier mark is a comparable trade mark (IR), Paragraph 10 of Part 1 of Schedule 2B of the Act applies. It reads as follows:

“(1) Sections 5 and 10 apply in relation to a comparable trade mark (IR), subject to the modifications set out below.

(2) Where the reputation of a comparable trade mark (IR) falls to be considered in respect of any time before IP completion day, references in sections 5(3) and 10(3) to-

(a) the reputation of the mark are to be treated as references to the reputation of the corresponding (IR); and

(b) the United Kingdom include the European Union.”

114. The conditions of section 5(3) are cumulative. First, the marks at issue must be identical or similar. I have already made such a finding under section 5(2)(b). Secondly, the opponent must satisfy me that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the relevant public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the application. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods/services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

115. The relevant case law can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case C-408/01), *L'Oréal SA & Ors v Bellure & Ors* (Case C-487/07), *Interflora Inc & Anor v Marks and Spencer plc & Anor* (Case C-323/09) and *Environmental Manufacturing LLP v OHIM* (Case C-383/12 P). The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon*, paragraph 29, and *Intel*, paragraph 63.

d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods and/or services, the extent of the overlap between the relevant consumers for those goods and/or services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or that there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68. Whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

f) The more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oréal*, paragraph 44.

g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods and/or services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods and/or services for which the earlier mark is registered, or a serious risk that this will happen in the future; *Intel*, paragraphs 76 and 77, and *Environmental Manufacturing*, paragraph 34.

h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly

where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L'Oréal*, paragraph 40.

j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation; *Interflora*, paragraph 74, and the court's answer to question 1 in *L'Oréal*.

Reputation

116. In *General Motors Corp v Yplon SA*, Case C-375/97, the CJEU held that:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or services marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and

duration of its use and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

117. I have already set out what the evidence shows about the use of the earlier mark in paragraphs 21 to 30 above. I found a fair specification for that mark to be as follows:

Class 6

Insect protection windows and doors, made of metal; insect protection roller shutters of metal for windows; fly screens of metal; insect screens of metal.

Class 19

Insect protection windows and doors, not of metal; insect protection roller shutters, not of metal and not of textile material, for windows; fly screens, not of metal; insect screens, not of metal.

Class 24

Curtains of textile or synthetic materials, namely, insect protection curtains; pollen protection fleeces; mosquito nets.

118. The opponent submits that the earlier mark has a reputation. This means that it must be known by a significant proportion of the relevant public, which is the general public or a professional public, such as the building trade. However, in my view, the evidence has a number of shortcomings in this regard. First, it is not clear the proportion of turnover that can be attributed to each of these goods. This makes it difficult to draw any inferences about the likely market share of the opponent's goods sold under the mark. There is also only a limited amount of dated evidence showing the mark in use in a way that could be seen by the relevant public. There are some website screenshots and evidence of three videos posted to YouTube. However, it is not entirely clear what products are highlighted in these videos, or how many people in the EU had viewed them by the relevant dates, which are the filing dates for each of

the marks. On the basis of the evidence before me, I am unable to find that the earlier mark has a reputation. I would come to this view even if I confined the relevant public to the building trade. However, in case I am wrong in this finding, I shall consider whether there is a link between the marks, on the assumption that the earlier mark has a moderate reputation in the EU for the goods listed in the previous paragraph.

Link

119. In assessing whether the public will make the required mental link between the marks, I must take account of all relevant factors, which were identified by the CJEU in *Intel*: see paragraph 42. I shall consider each of them in turn.

The degree of similarity between the conflicting marks

120. I adopt the findings that I made under section 5(2)(b). The contested word mark is visually highly similar to the earlier mark and aurally and conceptually identical to it. The contested figurative mark is visually similar to the earlier mark to a medium degree, and aurally and conceptually highly similar to it.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

121. I adopt the findings that I made under section 5(2)(b). The services that are similar are the following: *Wholesale services, retail services including on-line retailing, retailing through the medium of broadcasting, retail services conducted by mail order, all connected with the sale of ... curtains, ... ironmongery, metal and wooden door hardware, metal and wooden door fittings, ... door fittings, ... door and window catches made either wholly or substantially of metal, ... window fittings, door and window fasteners, windows, doors, ... non-metallic hardware, ... nets*. I found them to be similar to the opponent's goods to a medium or low degree. I found the remaining services to be dissimilar. However, I note that similarity is not required under section 5(3).

The strength of the earlier mark's reputation

122. I am proceeding on the basis that the earlier mark has a moderate reputation in the EU.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

123. I adopt the findings that I made under section 5(2)(b). The earlier mark has a medium degree of inherent distinctive character, which has not been enhanced through use.

Whether there is a likelihood of confusion

124. I adopt the findings that I made under section 5(2)(b). I found a likelihood of confusion for all the services considered to be similar. I do not consider that there is a likelihood of confusion under section 5(3) in relation to services I found to be dissimilar.

Conclusions on link

125. In *Iron & Smith kft v Unilever NV*, Case C-125/14, the CJEU held that:

“If the earlier Community trade mark has already acquired a reputation in a substantial part of the territory of the European Union, but not with the relevant public in the Member State in which registration of the later national mark concerned by the opposition has been applied for, the proprietor of the Community trade mark may benefit from the protection introduced by Article 4(3) of Directive 2008/95 where it is shown that a commercially significant part of that public is familiar with that mark, makes a connection between it and the later national mark, and that there is, taking account of all the relevant factors in the case, either actual and present injury to its mark, for the purposes of that provision or, failing that, a serious risk that such injury may occur in the future.”

126. There is nothing in the evidence that leads me to find that the relevant public in the UK would make a link between the marks, given that there is no evidence of sales

in the UK or no evidence of any marketing efforts that would have brought the earlier mark to the attention of the relevant public. The section 5(3) ground is unsuccessful.

Outcome

127. The oppositions have been partially successful and Applications Nos 3532916 and 3692922 are refused in respect of the following services:

Class 35

Wholesale services, retail services including on-line retailing, retailing through the medium of broadcasting, retail services conducted by mail order, all connected with the sale of ... curtains, ... ironmongery, ... metal and wooden door hardware, metal and wooden door fittings, ... door fittings, ... door and window catches made either wholly or substantially of metal, ... window fittings, door and window fasteners, windows, doors, ... non-metallic hardware, ... nets.

128. They may proceed to registration in respect of the following services. I have underlined the parts where additional words are required to give effect to my decision:

Class 35

Advertising and marketing services, wholesale services, retail services including on-line retailing, retailing through the medium of broadcasting, retail services conducted by mail order, all connected with the sale of heating apparatus, cooling apparatus, cooking apparatus, refrigeration apparatus, drying apparatus, ventilation apparatus, humidifiers with parts and accessories, dehumidifiers with parts and accessories, burners, boilers, lighting, lights, lanterns and lamps, heaters, steam-generating equipment, televisions, polishers, vacuums, carpet shampooers, electrically heated hair rollers, electric makeup remover appliances, floor coverings, wall coverings, carpets, rugs, mats, matting, linoleum, wall-hangings, wallpaper, furniture, furniture covers, household textiles and items made therefrom, clocks, imitation leather goods, ornaments, figurines of china, wood, wax, plaster or plastic, mirrors, jewellery boxes, trunks, animal skins and hides, pictures and paintings, picture frames, beds, bedding, mattresses, mattress toppers, pillows, bedlinen, duvets and duvet covers, bedclothes, blankets, cushions, cushion covers, ... blinds, inflatable furniture, kitchen furniture, bedroom furniture, nursery furniture, outdoor furniture, living-room

furniture, bathroom furniture, seats, shelves, barrels, plastic and wooden boxes, storage items, billiard cloth, bolting cloth, brocades, buckram, calico, cheese cloth, chenille fabric, table linen, cotton fabrics, coasters, chair covers, household implements, containers and utensils, bakeware, cookware, cutlery, earthenware, microwave cookware, glassware, porcelain, kitchen weighing and measuring equipment, tableware, metal packaging articles, metal foils for wrapping and packaging, catering foil, food preparation implements, plastic and wooden bins, bottle racks, changing mats for babies, children's safety gates, baby walkers, baby high chairs, crates, non-metallic ladders, household containers, basins, baskets, bowls, basting spoons, hand beaters, synthetic Christmas trees and other Christmas decorations including crackers and ornaments, Christmas tree stands, knife sharpeners, sterilization equipment, torches, air compressors, audio-visual equipment, musical instruments, CDs, DVDs, computers, computer parts, computer accessories, computer peripherals, calculating machines, software and hardware, stationery, publications, telecommunications equipment, mobile phones, bookbinding materials, adhesives for stationery of household purposes, office furniture including desks and office chairs, hand-held electronic games, computer games, video game apparatus, paper shredders, clothing, footwear, headgear, jewellery, precious and semi-precious stones, watches, cufflinks, badges made of precious metals, leather goods, umbrellas, parasols, bags, luggage, wallets, purses, optical goods, keyrings, medals, tie-pins, tie-clips, watch straps, handbags, baby carriers, music cases, suitcases, briefcases, attaché cases, haversacks, belts, wheeled shopping bags, key cases, leather laces, satchels, game bags, backpacks, robes, wigs, moccasins, specialized underwear, socks, bathroom items, pre-moistened or impregnated tissues or wipes, sanitising wipes, personal hygiene products, apparatus and instruments for monitoring human bodily functions, life-saving and teaching apparatus and instruments, personal weighing and measuring apparatus and equipment, safety clothing, oral hygiene preparations, breath fresheners, breath freshening strips and sprays, mouthwash including antiseptic mouthwash and mouth rinses for medical use, all cleaning preparations for the teeth (commonly known as dentifrice) including toothpaste, tooth polish, tooth powder, preparations for cleaning dentures, tooth-stopping materials, dental wax, body cleaning preparations, bath preparations, deodorants for personal use, antiperspirants,

hair preparations, hair treatments, hair dyes, razors, waxing substances, shampoos, conditioners, shaving gels, foams and preparations, pre-shaving and aftershave lotions, manicure tools, pedicure tools, sanitary preparations for medical use, pharmaceutical preparations, baby food, baby beverages, milk powder for infants, infant formula, infant feeding apparatus, nutritional supplements, dietetic food for invalids, dietary supplements, dietetic food for medical use, plasters, dressings and suturing materials, glasses and eyewear, solutions for contact lenses, condoms and other contraceptive devices, deworming and delousing and anti-parasitic preparations for humans, water-purification products, combs, sponges and body brushes, masks, face shields, visors, protective overalls and coveralls and gloves, disposable items, thermometers, weight-loss solutions, hearing aids, mobility aids, cosmetics, tissues impregnated with cosmetic lotions, toiletries, soaps, soap dispensers, perfumery and fragrances including Eau de Cologne and Eau de Toilette, toilet water, body sprays, perfumed tissues, essential oils, hair lotions, beauty care preparations, hair lotions, hairspray, hair waving, curling and straightening preparations, hair accessories including hair rollers, hair removal preparations, hair cutting, drying and removal implements, makeup including face, eye and cheek powders and creams, together with tools for applying makeup, lipsticks, lip glosses, false eyelashes, nail care preparations, nail varnish, false nails, nail varnish remover, nutritional creams, henna, dietary supplements for animals, dietetic substances adapted for veterinary use, deworming medication, insecticidal products for animals, items of clothing for pets, pet leads, pet beds, bird baths, birdcages, bird feeders, animal fodder, animal bedding and litter, garden buildings, garden accessories, garden furniture, parts and accessories, garden tools, hand tools, home mechanic apparatus and parts and accessories therefor, ... DIY and home improvement goods, herbicides, insecticides, bells, ... metal gates, gate fittings, ... curtain fittings, bins and boxes either wholly or substantially of metal, ... hooks made wholly or substantially of metal, ... hand-operated gardening implements and tools, hand-operated landscaping implements and tools, fire-tending implements, hand tools for cutting and other purposes including drilling, and grinding tools, paint brushes and rollers, ... , string, natural and artificial turf, shower fittings, dummy security cameras, floor protections kits, brooms, motion-sensor lights, fence panels, cleaning products,

cleaning equipment, home decorating equipment and implements and parts and accessories therefor, wax for polishing, plastic storage containers, non-metallic pallets, steel wool, shower cleaners, dirt trapping mats, cameras, photographic accessories, photographic equipment, photographic and picture frames, photographs and pictures, photographic apparatus and instruments, exercise mats, gymnastic and sporting articles, hunting and fishing equipment, swimming equipment, children's playground apparatus and equipment, floats for bathing and swimming, swimming belts and jackets, ropes, camping equipment, tents, sleeping bags, ... awnings and tarpaulins, portable toilet, paper and cardboard and goods made from these materials, artists' materials including paint brushes, paints, varnishes, pigments, dyes, body art tools, binoculars, fireworks, printers' type, printing blocks, craft and modelling equipment, painter's easels, canvas for tapestry and embroidery, lace, embroidery and embroidery thread, knitting yarns and needles, sewing machines, sewing kits, haberdashery including ribbons, braid, buttons, hooks, eyes, pins, needles, artificial flowers, fruit and vegetables, decorative textile articles, games, toys, caps for toy pistols, vehicles and apparatus for locomotion by land, air or water, bicycles, prams, pushchairs and parts and accessories for such items, preservatives against rust and against deterioration of wood, colorants, mordants, raw natural resins, wood preservatives, wood stains, anti-corrosive and anti-fouling compositions, primers, coatings (paints), bleaching preparations, substances for laundry use, cleaning preparations, polishing preparations, scouring preparations, abrasive preparations, disinfectants, fungicides, preparations for destroying vermin, pest repellents, insecticides, apparatus and instruments for science, surveying, optics, cinematography, measuring, signalling, weighing, nautical navigation, checking, life-saving, teaching, lighting, heating, apparatus and instruments for conducting, switching, accumulating, regulating, controlling and transforming electricity, safety goggles, protective eyewear, surgical, medical, dental and veterinary apparatus and instruments; advertising and marketing services, all connected with the sale of curtains, ironmongery, metal and wooden door hardware, metal and wooden door fittings, door fittings, door and window catches made either wholly or substantially of metal, window fittings, door and window fasteners, windows, doors, non-metallic hardware, nets; the organisation, operation and supervision of sales and promotional incentive schemes, loyalty card, reward and

membership services; promotional, advertising, business management, the provision of information, consultancy and advisory services related to all such services.

Costs

129. Both parties have had some success in these proceedings, with the greater share going to the applicant. The applicant is therefore entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice No. 2/2016. In calculating my award, I have taken account of the fact that, to a large extent, the pleadings in each of the proceedings were identical. The award is calculated as follows:

£350 for preparing statements and considering the other side's statements;

£400 for considering the other side's evidence;

£350 for preparing written submissions in lieu of a hearing.

£1100 in total

130. I therefore order M.A.C.'S Holding GmbH to pay easyGroup Limited the sum of £1100. This sum is to be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 19th day of March 2025

Clare Boucher

For the Registrar,

The Comptroller-General

Annex: Specification of UKTM No. 801143648

Class 6

Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery and small items of metal hardware; pipes and tubes of metal; goods of common metal, not included in other classes; windows, doors and parts thereof, made of metal, in particular insect protection windows and doors, rodent protection windows, the above-mentioned goods also as assembly kits; roller shutters of metal, in particular insect protection roller shutters for windows; jalousies of metal; screens of metal, in particular fly screens, insect screens, sun screens, screens for basement shafts, screens for light shafts, screens as covers for roof gutters, plant climbing trellises, plant climbing supports; frames of metal for building purposes, in particular frames for mounting fly screens on windows and doors; pigeon defense sticks; awning constructions of metal.

Class 9

Electrical insect bait and extermination appliances, in particular traps for mosquitos or other insects with UV light and high-voltage screens; electrical appliances for repelling pests and vermin, such as insects, voles, moles, rats, mice, or martens, in particular electric appliances for repelling pests and vermin by means of resonance vibrations, infrasound noise, ultrasound noise, structure-borne noise, and/or vibrations.

Class 17

Rubber, gutta-percha, gum and goods made of these materials and not included in other classes; plastic in extruded form for use in manufacture; packing, stopping and insulating materials; caulking materials; fibreglass fabrics for insulation; insulating materials, included in this class; flexible pipes (not of metal); artificial and synthetic resins (semi-finished products); films, in particular shading films, antiglare films for windows (tinted); insulating and sealing tapes, in particular for windows and doors; door gaskets; adhesive tapes, self-adhesive tapes other than stationery and not for medical or household purposes.

Class 19

Building materials (non-metallic); non-metallic rigid pipes for building; non-metallic transportable buildings; windows, doors and parts thereof, not of metal, in particular insect protection windows and doors, rodent protection windows, the above-mentioned goods also as assembly kits; roller shutters, not of metal and not of textile material, in particular insect protection roller shutters for windows; jalousies, not of metal; screens, not of metal, in particular fly screens, insect screens, sun screens, screens for basement shafts, screens for light shafts, screens as covers for roof gutters, plant climbing trellises, plant climbing supports; profile rails for building purposes, not of metal; porches, not of metal, for building; roller shutters of textile materials; jalousies of textile materials.

Class 21

Traps for rodents, such as mice or rats; insect traps.

Class 22

Awnings made of textile materials and/or synthetic materials; awnings, tarpaulins, nets, tents, sails (included in this class) made of of textile or synthetic materials for windows or other building openings, for balconies or terraces; sails, in particular sun sails; tarpaulins; tents; nets.

Class 24

Textiles and textile goods, not included in other classes; curtains of textile or synthetic materials; pleated curtains of textile or synthetic materials; fleeces (textiles), in particular pollen protection fleeces; mosquito nets; curtains of textile or synthetic materials consisting of slats.