O/0435/24

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3820219 BY EUROCELL PROFILES LIMITED TO REGISTER THE TRADE MARK:

LUMA

IN CLASSES 6, 17 & 19

AND

OPPOSITION THERETO UNDER NO. 437883 BY GRUPO ULMA, S. COOP.

BACKGROUND & PLEADINGS

1. Eurocell Profiles Limited ("**the applicant**"), applied to register the trade mark shown on the front page of this decision in the United Kingdom on 15 August 2022. It was accepted and published in the Trade Marks Journal on 7 October 2022. For the purposes of this partial opposition the relevant goods in the specification are:

> **Class 6:** Metal building materials; windows, window frames; window sills, window tracks; roof lights, roof light frames; skylights; skylights frames; doors; door frames; screws, screw caps and covers, nails, metal hooks, nuts and bolts, fixings and fasteners; ironmongery; door, window, roof light and skylight furniture; small items of metal hardware; pipes and tubes of metal; locks, locking devices; door bolts, chains and security fittings, metal flashings, wire, handles, latches, catches, keys, bolts, chains and security fittings; fittings for doors and windows; prefabricated building frames; conservatory frames; conservatories in prefabricated form; rigid pipes; non-rigid profiles; aluminium profiles; components and extrusions for the construction of doors, windows, roof lights, skylights, conservatories and prefabricated buildings; door sills, door tracks; components and extrusions for the construction of windows, doors, roof lights and skylights; parts and fittings for all the aforesaid goods.
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> **Class 19:** Non-metallic building materials; windows, window frames; window sills, window tracks; roof lights, roof light frames; skylights; skylight frames; doors; door frames; screws, screw caps and covers, nails, metal hooks, nuts and bolts, fixings and fasteners; ironmongery; door, window, roof light and skylight furniture; small items of metal hardware; pipes and tubes of metal; locks, locking devices; door bolts, chains and security fittings, non-metallic flashings, handles, latches, catches, fittings for doors and windows; prefabricated building frames; conservatory frames; conservatories in

prefabricated form; rigid pipes; non-rigid profiles; non-metallic profiles; components and extrusions for the construction of doors, windows, roof lights, skylights, conservatories and prefabricated buildings; door sills, door tracks; components and extrusions for the construction of windows, doors, roof lights and skylights; parts and fittings for all the aforesaid goods.

2. GRUPO ULMA, S. COOP. ("**the opponent**") opposes the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 ("**the Act**")[1]. The opponent is the proprietor of the following marks, upon which the opponent relies:

Trade Mark no.	UK00900495630 ('630)
Trade Mark	
Goods & Services for which the mark is registered	Classes 6, 7, 19 & 37
Filing date	10 March 1997
Date of entry in register	8 February 1999

Trade Mark no.	UK00910759686 ('686)
Trade Mark	ULMA
Goods & Services for which the mark is registered	Class 6, 7, 9, 12, 19, 37 & 42
Filing date	26 March 2012
Date of entry in register	7 August 2012

3. On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable

[1] 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.

UK trade marks for all right holders with an existing registered EUTM. As a result, the opponent's earlier EUTM Nos 495630 and 10759686 were automatically converted into comparable UK trade marks. Comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

4. For the purpose of this opposition, the opponent relies on its Classes 6 and 19 goods of the earlier marks as follows:

Earlier mark '630

Class 6: Scaffolding and props of metal; casings of metal; staircases and platforms of metal for scaffolding; greenhouse frames of metal; flanges of metal, forged; metal building materials; pipes and tubes of metal.

Class 19: Building materials (non metallic); non-metallic rigid pipes for building; non-metallic transportable buildings; prefabricated pieces of polymer concrete for drainage and for building construction in general.

Earlier mark '686

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, small items of metal hardware; Pipes and tubes of metal; Safes; Goods of common metal not included in other classes; Ores.

Class 19: Building materials (non-metallic); Non-metallic rigid pipes for building; Asphalt, pitch and bitumen; Non-metallic transportable buildings; Monuments, not of metal.

5. These marks qualify as earlier marks under section 6(1) of the Act. Because they completed the registration process more than five years

before the application date of the contested mark, the opponent has made a statement that it has used the marks for all the goods it relies on.

6. The opponent argues that there is a “a high degree of visual and phonetic similarity between the trade mark application and the Opponent's Earlier Trade Marks.” It also contends that the competing goods are either identical or very similar. Therefore, registration of the contested application should be refused under Section 5(2)(b) of the Act.

7. The applicant filed a defence and counterstatement and put the opponent to proof of use of the earlier marks relied upon, denying the claims made. The applicant asserts that the competing marks are visually, aurally and conceptually different. In addition, it concedes that some of the goods are identical or similar, and some are dissimilar.

Representation and papers filed

8. In these proceedings, the opponent is represented by Stevens, Hewlett & Perkins and the applicant is represented by Freeths LLP.

9. During the evidence rounds, the opponent filed evidence in chief. On 24 July 2023, the applicant responded by filing evidence and submissions making various criticisms of the opponent’s evidence. The opponent initially informed the Tribunal with a letter dated 22 August 2023 of its intention to file evidence and submissions in reply. However, with its letter dated 25 September 2023, it reconsidered its position and filed no further evidence or submissions. The evidence rounds were thereby concluded. The applicant filed submissions dated 31 October 2023 in lieu of an oral hearing (its “final submissions”). Neither party requested an oral hearing and so I have taken this decision following a careful perusal of the papers.

Evidence

Opponent's Witness Statement

10. The opponent filed evidence in the form of a witness statement, dated 24 May 2023, from Lander Diaz De Gereñu, the Chairman of the opponent, who has held this position in the last 4 years, introducing 7 Exhibits. The main purpose of the evidence is to demonstrate that the earlier marks have been genuinely used during the relevant period.

Applicant's Witness Statement

11. The opponent filed evidence in the form of a witness statement from Michaela Kim Selvester of Freeths LLP, who is the legal representative of the applicant. Her witness statement is dated 24 July 2023 and consists of two Exbibits containing the results of Google searches for the meanings of the word elements of the competing marks.

12. I have read and considered all of the evidence and will refer to the relevant parts at the appropriate points in the decision.

DECISION

Relevant Date/Period

13. As the earlier marks relied upon had been registered for more than five years on the date on which the contested application was filed, Section 6A of the Act applies, which states:

> "(1) This Section applies where–
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> (a) an application for registration of a trade mark has been published,

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

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

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes -

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

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

(5)-(5A) [Repealed]

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

14. As the earlier marks are comparable marks, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

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

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

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

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

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

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

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

15. The relevant period for proof of use of the opponent's marks is **16 August 2017 to 15 August 2022**. In the present proceedings, the opponent relies on UK comparable marks, and, thus in accordance with paragraph 7(3) of Part 1 of Schedule 2A of the Act, the assessment of use shall take into account any use of the corresponding EUTM prior to IP Completion Day, being 31 December 2020. Therefore, for the portion of the relevant five year period between **16 August 2017 and 31 December 2020**, evidence of use of the mark in the EU may be taken into account. For completeness, for the remaining period (1 January 2021 to 15 August 2022), it is only the UK use that counts.

16. The relevant date for the assessment of likelihood of confusion as per Section 5(2)(b) is the date on which the contested application was filed, namely **15 August 2022**.

Proof of Use

17. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

"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 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken 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]; *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]."

18. As the earlier marks are comparable marks, the comments of the Court of Justice of the European Union ("CJEU") in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11 are also relevant. The court 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. […]
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> 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 trade mark. […]
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> 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)."

19. The court held that:

> "Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to 'genuine use in the Community' within the meaning of that provision.
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> A Community trade mark is put to 'genuine use' within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity."

20. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. 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 issues 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 was 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 multifactorial one which includes the geographical extent of the use."

21. The General Court restated its interpretation of *Leno Merken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the 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.

22. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5 year period. In making the required 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

    v. The geographical extent of the use shown

23. The onus is on the proprietor of the earlier mark to show use. This is in accordance with Section 100 of the Act, which states:

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

24. Proven use of a mark which fails to establish that "the commercial exploitation of the marks is real" because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark" is, therefore, not genuine use.

Form of the Marks

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

> "31. It is true that the 'use' through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas 'genuine use', within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, 'use' within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark."
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> 32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

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

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

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

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

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

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

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

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

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

27. There are examples of use of the earlier marks as registered in the evidence, such as in brochures and websites. There is also use in the following form:

28. I consider that the manner of presentation shown above is a clear example as per *Colloseum.*[2] Consequently, I find that the form of use set out above may also be taken into account. If I am wrong, I do not consider that the use in this form alters the distinctiveness of the registered marks, and this is a variant upon which the opponent can rely, as per *Lactalis*.

Genuine Use

29. As indicated in the case law cited above, use does not always need to be quantitatively significant to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as "warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark".

30. In making my determination as to whether the evidence presented shows the necessary genuine use, I also take account of judicial comment as to probative and evidential issues in such cases. In *Awareness Limited v Plymouth City Council*, Case BL O/230/13, Daniel Alexander KC sitting as the Appointed Person stated that:

> "22. The burden lies on the registered proprietor to prove use […]. However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little

[2] Pertaining to the *Colloseum* principles.

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 (which in many cases will be the Hearing Officer in the first instance) 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."

31. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs KC, sitting as the Appointed Person stated that:

> 22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not 'show' (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

32. In *Naazneen Investments Ltd v OHIM*, Case T-250/13, EU:T:2015:160, the General Court upheld a decision by the OHIM Board of Appeal that the sale of EUR 800 worth of non-alcoholic beverages under a mark over a 5 year period, which had been accepted was not purely to maintain the trade mark registration, was insufficient, in the economic sector concerned, for the purposes of maintaining or creating market share for the goods

covered by that Community trade mark. The use was therefore not genuine use. The relevant part of the judgment of the General Court is as follows:

> "46. In the fifth place, the applicant argues that, in accordance with the case-law cited in paragraph 25 above, use of a trade mark is to be regarded as token if its sole purpose is to preserve the rights conferred by the registration of the mark. It claims that the Board of Appeal contradicted itself by stating, on the one hand, in paragraph 31 of the contested decision, that the total amount of transactions over the relevant period seemed to be token, and by stating, on the other hand, in paragraph 42 of the contested decision, that it did not doubt the intention of the proprietor of the mark at issue to make real use of that mark in relation to the goods in question.
>
> 47. In this connection, suffice it to point out that the applicant's argument is based on an incorrect reading of the contested decision. The Board of Appeal used the term 'token' to describe the total amount of transactions, approximately EUR 800, and not to categorise the use of the mark at issue.
>
> 48. In the sixth place, the applicant claims that the Board of Appeal, by relying solely on the insufficient use made of the mark at issue, did not comply with the case-law according to which there is no quantitative threshold, determined a priori and in the abstract, that must be chosen in order to determine whether use is genuine. The Board of Appeal also failed to comply with the case-law according to which even minimal use may be sufficient in order to be deemed genuine.
>
> 49. According to the case-law, the turnover achieved and the volume of sales of the goods under the mark at issue cannot be assessed in absolute terms but must be assessed in relation to other relevant factors, such as the volume of commercial activity, the production or marketing capacities or the degree of diversification of the undertaking using the trade mark and the characteristics of the goods

or services on the relevant market. As a result, use of the mark at issue need not always be quantitatively significant in order to be deemed genuine (see, to that effect, judgments in *VITAFRUIT*, cited in paragraph 25 above, EU:T:2004:225, paragraph 42, and *HIPOVITON*, cited in paragraph 27 above, EU:T:2004:223, paragraph 36). Even minimal use can therefore be sufficient in order to be deemed genuine, provided that it is warranted, in the economic sector concerned, to maintain or create market shares for the goods or services protected by the mark. Consequently, it is not possible to determine a priori, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine. A de minimis rule, which would not allow OHIM or, on appeal, the General Court, to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, to that effect, order of 27 January 2004 in *La Mer Technology*, C-259/02, ECR, EU:C:2004:50, paragraphs 25 and 27, and judgment of 11 May 2006 in *Sunrider* v *OHIM*, C-416/04 P, ECR, EU:C:2006:310, paragraph 72).

50. In the present case, contrary to what the applicant claims, the Board of Appeal did not determine a minimum threshold ‘a priori and in the abstract’ so as to determine whether the use was genuine. In accordance with the case-law, it examined the volume of sales of the goods in question in relation to other factors, namely the economic sector concerned and the nature of the goods in question.

51. The Board of Appeal accordingly took the view that the market for the goods in question was of a significant size (paragraph 28 of the contested decision). It found also that the goods in question, namely non-alcoholic beverages, were for everyday use, were sold at a very reasonable price and that they were not expensive, luxury goods sold in limited numbers on a narrow market (paragraph 29 of the contested decision). Furthermore, it took the view that the total amount of transactions over the relevant period, an amount of EUR 800, seemed to be so token as to suggest, in the absence of supporting documents or convincing explanations to demonstrate otherwise, that use of the

mark at issue could not be regarded as sufficient, in the economic sector concerned, for the purposes of maintaining or creating market shares for the goods covered by that mark (paragraph 31 of the contested decision).

52. It is therefore apparent, contrary to what the applicant claims, that it was in accordance with the case-law cited in paragraph 49 above that the Board of Appeal took the view that, in the present case, minimal use was not sufficient to be deemed genuine."

33. In *JUMPMAN Trade Mark*, BL O/222/16, the Appointed Person upheld a Hearing Officer's finding that sales of around 55,000 pairs of trainers over a 16-month period were insufficient to qualify as genuine use for an EUTM registration.

34. I include these extracts from case law merely as examples of instances where certain levels of sales have been insufficient to establish genuine use, but clearly, each case must be determined on its own merits, facts, and relevant factors, and I do not overlook that the relevant territory in the present case includes both the UK and the EU.

Consideration of the evidence of use

35. The opponent's evidence consists of seven Exhibits. In his witness statement Mr Lander Diaz De Gereñu states that the opponent "is a business group of nine cooperatives, which include ULMA Architectural Solutions and ULMA Construction. My company operates in a number of different business fields, including agriculture, forklift trucks, constructions, conveyor components, embedded solutions and handling systems" which "has built up a reputation for the development and production of a wide range of building materials and products sold under the ULMA trade mark and which are sold across the United Kingdom and the European Union."

36. **Exhibit 1** consists of screenshots taken from the WayBack Machine Internet archive. These are dated 30 October 2020 and 21 April 2021 and

are extracted from the website of the opponent, *ulma.com*, demonstrating information about the company and its organisational model where it is stated that "[t]he ULMA Group operates based on strategic business units; ULMA Advanced Forged Solutions, ULMA Agricola, ULMA Architectural Solutions, ULMA Construction, ULMA Conveyor Components, ULMA Embedded Solutions, ULMA Handling Systems, ULMA Maintenance Services and ULMA Packaging." However, the Exhibit includes Wikipedia articles regarding the ULMA Group, ULMA Architectural Solutions, and ULMA Construction, which have a print date of 23 May 2023. This date falls outside the relevant period, and since Wikipedia is a community-based encyclopaedia that any user can contribute to at any time, the content may be unverified. Therefore, the evidential value of the Wikipedia articles is dubious.

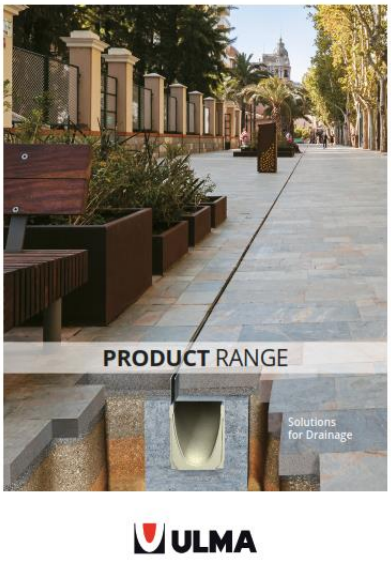
37. **Exhibit 2** comprises of screenshots taken from the WayBack Machine Internet archive, dated 26 November 2020 and 12 June 2021. These screenshots demonstrate the history and news sections of the opponent's website, *ulma.com*.

38. **Exhibit 3** consists of screenshots from the website *ulmaarchitectual.com* demonstrating the landing page and the 'PROJECTS' section, as taken from the WayBack Machine Internet archive and dated 23 August 2020 and 21 September 2020, respectively. The 'PROJECTS' section lists three projects: '*New Gourmet Market "La Alqueria", with ULMA's Ventilated Facade*', '*ULMA Engineered stone ventilated facade in the new national Unielectrica Headquarters*', and '*A clean, simple and durable facade for Cienpozuelos Hospital, Madrid*'. There is nothing in the evidence to confirm when these projects were initiated or completed. Although the page itself is dated within the relevant period, there is no evidence to confirm whether these projects were historical and completed before the relevant period or if they were planned projects set to start after the date of the webpage. In the absence of confirmation either way and due to the lack of detail, they are of limited evidential value.

39. Additionally, the Exhibit contains undated technical catalogues and brochures, including ‘STONEO ENGINEERED STONE’, and ‘User Guide CC-4 PANEL’. These catalogues offer a wide range of building construction products, such as window sills, copings, mouldings, and formwork systems, but their evidential value is limited due to the lack of a date on these materials. I also note that the catalogue ‘SOLUTIONS NEW CONSTRUCTIONS RESTORATION’ dated 2012 June falls outside of the relevant period. It will, therefore, not assist the opponent.

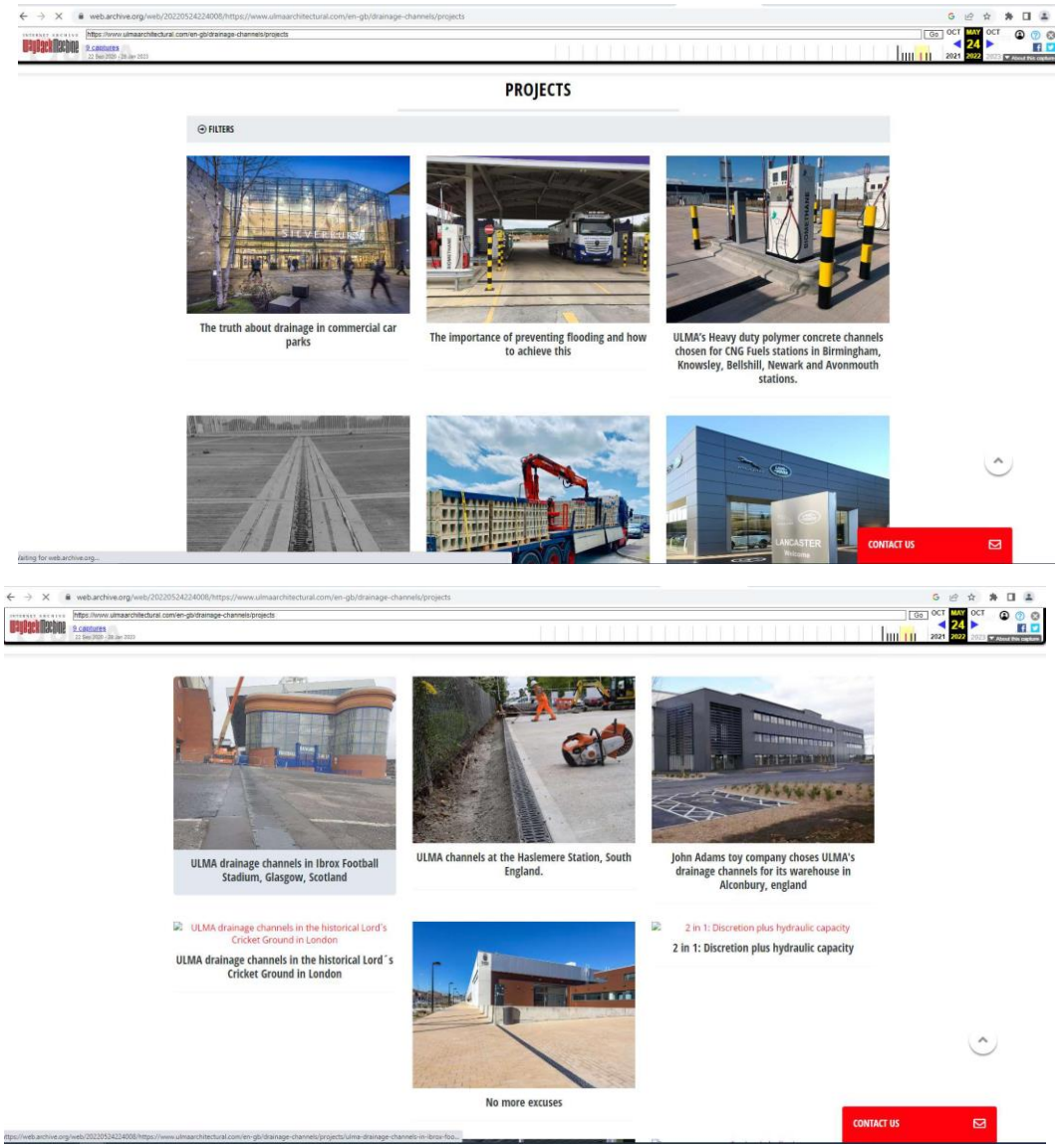
40. **Exhibit 4** is stated to be evidence of drainage solutions and architectural products. The Exhibit features screenshots from the *ulmaarchitectual.com* website, which showcase tiled sections on drainage solutions, channels, and applications. Again, these screenshots were obtained via the WayBack Machine Internet archive and dated from 6 to 7 July 2020.

41. In addition, two product catalogues (cover pages shown below), namely ‘PRODUCT RANGE - Solutions for Drainage’, dated October 2021, and ‘COMPACT CHANNEL – KOMPAQDRAIN®’, dated June 2019, are exhibited and contain a range of drainage products/solutions, including channels for pedestrian and sport facilities, and low height and composite channels, as well as gratings for drainage channels.



I note that the technical dossier titled ‘DRAINAGE SYSTEMS’ is undated and, therefore, of limited evidential value.

42. **Exhibit 5** contains two screenshots, obtained via the WayBack Machine and dated 24 May 2022, from the website *ulmaarchitectual.com* which demonstrate a number of drainage projects that took place in various sites in the UK, such as London, Glasgow, Northampton, Birmingham, Haslemere, and Alconbury, as shown below:



I also note that although the webpage dated 24 May 2022 lists the projects, it is not clear as to when these projects took place. In addition to the above screenshots, Exhibit 5 includes some undated online articles corroborating some of the mentioned projects. These articles offer detailed descriptions

of the construction process, the drainage systems, and products used. That said, I note the following shortcomings:

a. The article titled "*The truth about drainage in commercial car parks*" concludes by suggesting that the drainage system of the Silverburn Shopping Centre car park played a role in it being named "the UK's best shopping centre" in 2019.[3] While this statement hints at a possible link between the two, this alone does not provide conclusive evidence to support this claim or determine the period during which the project took place.

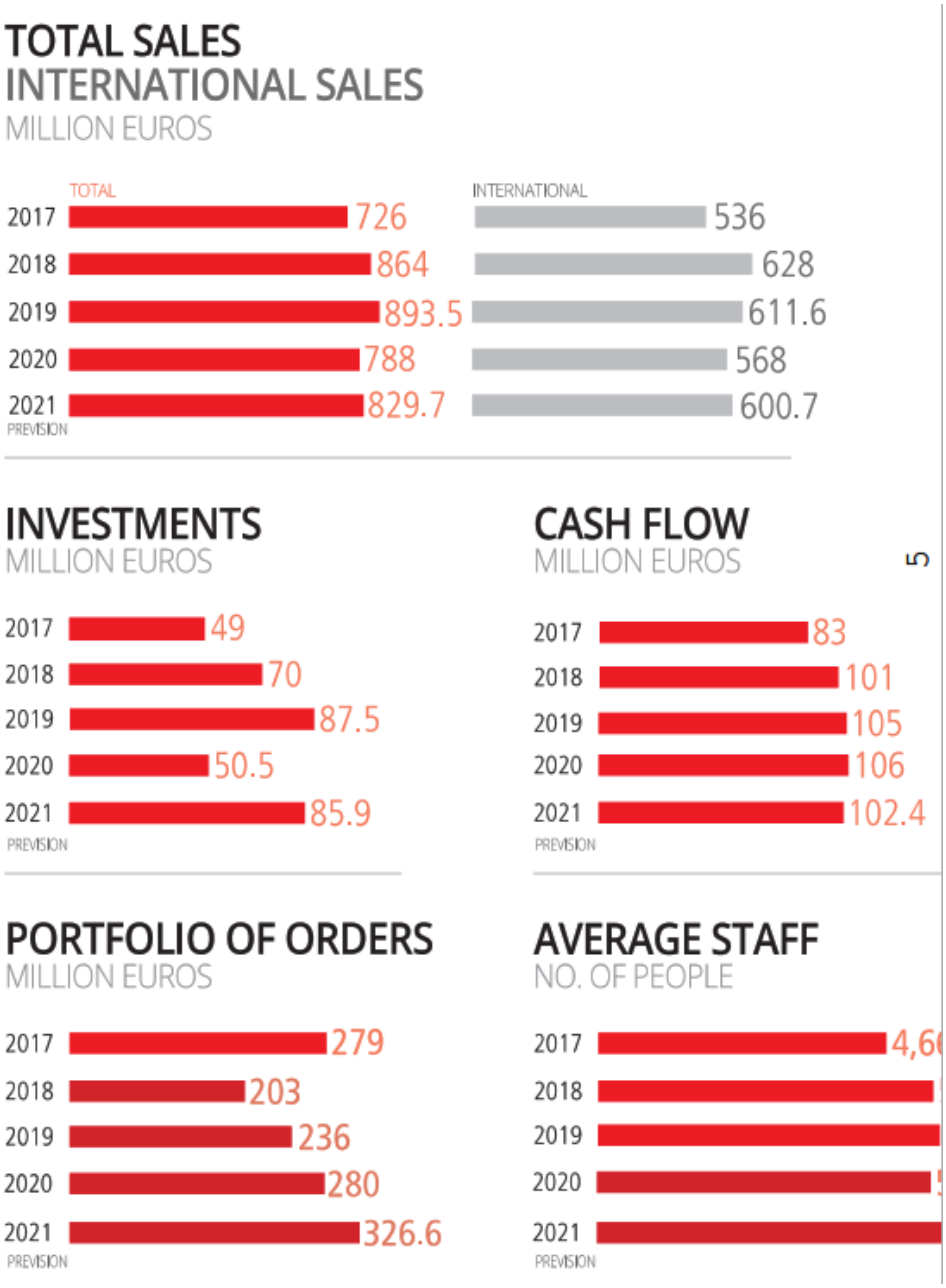
b. The article titled "*ULMA's Heavy Duty Polymer Concrete Channels Chosen for CNG Fuels Stations in Birmingham, Knowsley, Bellshill, Newark, and Avonmouth Stations*" mentions that the Avonmouth station became fully operational in February 2022. This suggests that the article was written after that date. However, it is unclear when the project itself took place, though it must have been before the publication of the article.

c. The article about "*Essex Industrial Area with ULMA's CIVIL-F range*" makes reference to a drainage channel that was "just" being installed. Although the webpage (shown above) is dated 24 May 2022, it is unclear when this project occurred and when the article first appeared on the website. Furthermore, it remains uncertain how long news articles like this remain visible on the webpage.

d. I also note that there are some articles which refer to the EU (e.g. Barcelona, and Nantes Saint-Nazaire in France). Since these are undated, it is unclear whether these projects were executed before or after the IP Completion Day.

[3] It particularly states that: "The perfect duo for the Silverburn Shopping Centre car park, which, incidentally, was named "the UK's best shopping centre" 2019. There must be a reason, right?".

43. In his witness statement, Mr Lander Diaz De Gereñu states that the opponent's annual turnover is approximately 100 million Euros. **Exhibit 6** consists of the opponent's 2020 Annual Report which provides a breakdown of figures. I note that the sales figures included in this report are cumulative and do not distinguish between regional sales, apart from the international sales as depicted in the following chart:



I further note that the report indicates that growth was noticed in three markets, namely Italy (2%), Germany (4%), and Canada (71%), with "a

turnover in foreign markets of € 204.8 million, 15% below the 2019 figure."[4] It is also stated in the report that the "most important markets being France and Germany (whose combined sales already account for a third of total turnover). During the year, exports were made to 36 countries worldwide."[5] Although the above figures are significant, no context or a breakdown is given as to what proportion of the turnover relates to each of the earlier marks and the goods relied upon. The report also contains other information about the opponent's assets, equity, and liabilities, as well as technology and innovation models and solutions. However, even in this instance, such information does not provide any insights into the sales of goods relied upon for the purposes of this opposition.

44. **Exhibit 7** comprises of the following marketing materials:

a. An undated screenshot of an advertisement for the 'KOMPAQDRAIN' product which is said that it is published every year in RIBA Magazine (Royal Institute of British Architects), though there is no visible web address.

b. An undated screenshot showing a recruitment advertisement titled *'The stars of the campaign are young people, all under 25 and from all of ULMA's different Business Units. They all chose, and they chose ULMA!*' from the opponent's website, *ulma.com*. The content of the advertisement appears to be irrelevant to the case at hand, and the lack of a date on this material limits its evidential value.

c. An undated photo that shows the opponent's mark '630 as advertised on scaffolding at a building site. However, there is no other information on the relevance of this advertisement or its

[4] Page 14 of the report.

[5] Ibid.

impact. Therefore, the lack of more substantive information and a date on this material again limits its evidential value.

d. Two screenshots of an online article titled '*Once again presenting our drainage solutions in IFAT 2022-Munich'*. The article details the participation of ULMA Architectural Solutions in the "World's Leading Trade Fair for Water, Sewage, Waste, Raw Materials Management". I note that these screenshots were obtained via the WayBack Machine Internet archive from the website *ulmaarchitectural.com* and are dated 30 June 2022. However, as highlighted earlier in this decision, following the IP Completion Day, evidence of use of the marks in the EU cannot be taken into account. Thus, I consider that such evidence has very little, if any, evidential value.

Conclusion on evidence of genuine use

45. I have given close consideration to the evidence provided by the opponent in order to demonstrate that the use of its earlier marks, in respect of the goods relied upon, during the relevant period, meets the requirements for genuine use as per *easyGroup,* set out earlier in this decision. I also have in mind the guidance from the *Dosenbach-Ochsner* and *Awareness* appeal cases emphasising the need to consider what the evidence fails to "show" and what might reasonably have been conclusively shown. In my analysis in the paragraphs above, I have highlighted the deficiencies in the evidence.

46. In its written submissions and final submissions, the applicant made a series of points about the inadequacies and deficiencies of the evidence filed. It is worth noting that even though the opponent has had the opportunity to file evidence in reply or respond in full to the applicant's criticisms, it elected not to. I concur with the majority of the applicant's submissions and note that the body of evidence adduced is thin. Its evidential value is limited due to the various notable shortcomings I

explained earlier in this decision, and, thus, it is not possible to deduce from the evidence whether the goods relied upon were sold throughout the relevant period.

47. Considering that the opponent is a business group comprising nine cooperatives operating in different fields, it is important to note that the exhibited annual report 2020[6] demonstrates the group's overall turnover, and it is evident in various instances that a wide range of goods and services are offered by the opponent.[7] Nevertheless, it should be acknowledged that only a portion of the 2019/2020 turnover is applicable to the EU market in this case. I also consider that despite the opponent's claim that the annual turnover from the sales of the goods amounted to approximately 100 million Euros per annum, this is not sufficient per se to establish genuine use. These figures alone do not allow for discerning the scale, frequency, and the extent of use of the registered marks in relation to the goods relied upon during the relevant period, including when the use commenced, how long it lasted, or the number of customers, which are all vital factors in establishing genuine use. It would have been of more probative value if these figures had they been broken down based on the product type or terms within the opponent's specifications.

48. In addition, I note that it is typical to see evidence, such as invoices under the earlier marks, particularised in relation to the goods relied upon. Such information should have been available to the opponent and relatively easy to provide. Despite having full access to its company records and despite disclosing that the turnover was significant, the evidential picture is silent in crucial aspects.

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[6] Exhibit 6.

[7] For instance, packaging, maintenance, handling, construction and architectural solutions, advanced forged solutions, conveyor components, and handling systems, as well as products, such as scaffolding configurator software, and advanced equipment for intensive crops, are mentioned in the report.

49. Further, although there is limited evidence[8] concerning the promotion of goods related to drainage channels under the marks, there is no evidence highlighting the scale of use of such marketing and promotional materials. Further, there is no evidence demonstrating the marketing expenditure or the extent of marketing and promotional activities carried out by the opponent throughout the relevant period. Again, this is evidence which would have been readily available and easy for the opponent to provide.

50. In light of the above and after careful consideration, the evidential picture as a whole is not sufficiently consistent, and what relevant evidence there is, is of limited value. Although there is some evidence of the opponent undertaking various projects in the relevant jurisdictions, where there appears to have been some use of the earlier marks, there are difficulties, particularly with dating these projects, outlined earlier in this decision. Therefore, I am unable to determine that they represent use in the relevant period. It is, therefore, my view that the evidence is not sufficiently "solid or specific to enable proper and fair evaluation of the scope of protection to which the opponent is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the [applicant], the opponent and, it should be said, the public."[9] Consequently, the above evidence fails to show real commercial exploitation of the marks to create and maintain a share of the UK and EU markets for the goods relied upon.

51. However, even if I am wrong in my finding and the opponent had made use of the earlier marks during the relevant period, there is still no use shown for Class 6 goods. I will proceed and consider below what a fair specification would be for the use shown for Class 19 goods.

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[8] See Exhibit 4.

[9] See *Awareness Limited v Plymouth City Council*, Case BL O/230/13.

Fair specification

52. I must now consider what a fair specification would be for the use shown in the event that I am wrong in my finding that the use is insufficient to establish genuine use.

53. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

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

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

> "iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].
>
> iv) In cases of partial revocation, pursuant to Section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

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

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc [2015] EWCA Civ 220 ("Asos")* at [56] and [60].

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

55. The applicant, in its submissions, asserts that no proof of use has been supplied in relation to Class 6 goods while the scope of Class 19 goods should be limited to 'cement drainage channels'. However, in its notice of opposition, the opponent has claimed that the earlier marks have been used in relation to all the goods relied upon in this opposition.

56. At best, the evidence shows use for only some of the Class 19 goods in the earlier specifications and some terms are far too broad to properly reflect the use shown and would not represent a fair description. From my perspective, the evidence only really shows use of the marks on goods that directly concern drainage channel goods. Consequently, I will proceed on the basis that the opponent can rely upon the following specifications, as this represents the opponent's best case on the evidence filed:

> Earlier mark '630
>
> **Class 19:** Building materials (non metallic) **in relation to drainage channels**; prefabricated pieces of polymer concrete for drainage and for building construction in general.
>
> Earlier mark '686
>
> **Class 19:** Building materials (non-metallic) **in relation to drainage channels**.

Section 5(2)(b)

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

> "5(2) A trade mark shall not be registered if because-
>
> […]
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

58. Section 5A states:

> "Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect

of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

59. The principles considered in this opposition stem from the decisions of the European Courts in *SABEL BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (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, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of Goods

60. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

> "In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00

Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

61. Taking into account the fair specification as set out earlier in this decision, the competing goods to be compared are shown in the following table:

Opponent's Goods	Applicant's Goods
Earlier mark '630 **Class 19:** Building materials (non-metallic) **in relation to drainage channels**; prefabricated pieces of polymer concrete for drainage and for building construction in general. Earlier mark '686 **Class 19:** Building materials (non-metallic) **in relation to drainage channels**.	**Class 6:** Metal building materials; windows, window frames; window sills, window tracks; roof lights, roof light frames; skylights; skylights frames; doors; door frames; screws, screw caps and covers, nails, metal hooks, nuts and bolts, fixings and fasteners; ironmongery; door, window, roof light and skylight furniture; small items of metal hardware; pipes and tubes of metal; locks, locking devices; door bolts, chains and security fittings, metal flashings, wire, handles, latches, catches, keys, bolts, chains and security fittings; fittings for doors and windows; prefabricated building frames; conservatory frames; conservatories in prefabricated form; rigid pipes; non-rigid profiles; aluminium profiles; components and extrusions for the construction of doors, windows, roof lights, skylights, conservatories and prefabricated buildings; door sills, door tracks; components and extrusions for the construction of windows, doors, roof lights and skylights; parts and fittings for all the aforesaid goods. **Class 19:** Non-metallic building materials; windows, window frames; window sills, window tracks; roof lights, roof light

	frames; skylights; skylight frames; doors; door frames; screws, screw caps and covers, nails, metal hooks, nuts and bolts, fixings and fasteners; ironmongery; door, window, roof light and skylight furniture; small items of metal hardware; pipes and tubes of metal; locks, locking devices; door bolts, chains and security fittings, non-metallic flashings, handles, latches, catches, fittings for doors and windows; prefabricated building frames; conservatory frames; conservatories in prefabricated form; rigid pipes; non-rigid profiles; non-metallic profiles; components and extrusions for the construction of doors, windows, roof lights, skylights, conservatories and prefabricated buildings; door sills, door tracks; components and extrusions for the construction of windows, doors, roof lights and skylights; parts and fittings for all the aforesaid goods.

62. For the purpose of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons.[10]

63. For reasons of procedural economy, I will not at this stage undertake a full comparison of the competing goods. The examination of the opposition will proceed by considering identical goods between the competing specifications as it represents the opponent's best case.

[10] *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

Earlier Mark '630

64. The applicant's specification includes the contested term "*Non-metallic building materials*" which is a broad term and would encompass the opponent's terms "*Building materials (non-metallic) in relation to drainage channels; prefabricated pieces of polymer concrete for drainage and for building construction in general.*" Thus, I find the competing goods to be identical as per *Meric*.

Earlier Mark '996

65. Again, in this instance, the contested term "*Non-metallic building materials*" is a broad term that would encompass the opponent's terms "*Building materials (non-metallic) in relation to drainage channels*". I find the competing goods to be *Meric* identical.

Average Consumer and the Purchasing Act

66. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer,* Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J (as he then was) described the average consumer in these terms:

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

67. I find that the average consumer of the goods at issue will be primarily business users or professionals in the construction industry without excluding members of the public. Such goods are usually offered for sale in specialist stores, such as bricks and mortar retail outlets and builders' merchants, brochures, catalogues, and online websites specialising in such goods. The goods will be displayed on shelves in retail premises, where they will be viewed and self-selected by consumers. Similarly, for online stores, consumers will select the goods relying on the images displayed on the relevant webpages. Therefore, visual considerations will dominate the selection of the goods in question, but aural considerations will not be ignored in the assessment, as advice may be sought from a sales assistant or representative. Also, the average consumer will likely examine the relevant goods to ensure that they are fit for purpose. Therefore, the degree of attention will be medium to high depending on the importance, cost, and suitability of the goods, with professionals and businesses potentially paying a slightly higher degree of attention.

Comparison of Trade Marks

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

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

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

70. The marks to be compared are:

<table>
<tr><th>Earlier Mark ‘630</th><th>Contested Mark</th></tr>
<tr><td>  </td><td rowspan="3">LUMA</td></tr>
<tr><th>Earlier Mark ‘686</th></tr>
<tr><td>ULMA</td></tr>
</table>

Overall Impression

71. The earlier mark ‘630 is a composite mark consisting of a U-shaped figurative element and the word “ULMA” in a standard uppercase typeface and bold font. The figurative element, presented in black, red, and white colours, appears to be more prominent in size than the verbal one. Despite the size difference, I consider that both elements make a roughly equal contribution to the overall impression.

72. The earlier mark ‘686 and the contested mark are word only marks in upper case and in a standard typeface. Registration of word marks protects the

words in the marks, which can be used in any standard font or case.[11] The overall impression resides in the words themselves.

Visual Comparison

Earlier mark '630 and contested mark

73. The word elements in the competing marks are of the same length. Bearing in mind, as a rule of thumb, that the beginnings of words tend to have more impact than the ends,[12] the marks share the same endings ("-MA"). However, the beginnings are different as the first two characters of the marks are in reverse order, namely "LU-/UL-". Further, the competing marks differ in the presence/absence of the figurative element. These act as points of visual difference. I also bear in mind that there is no special test which applies to the comparison of short marks, the visual similarities must be assessed in the normal way.[13] However, the change of one letter to a mark which is only three letters long is more significant than a change of one letter to a longer mark.[14] Taking all this into account, including the overall impression, I find that there is a low degree of visual similarity.

Earlier mark '686 and contested mark

74. Similarly, in this case, the word marks "ULMA" and "LUMA" share the same endings, with the first two characters being in different positions. The competing marks are considered short in length, and, in this case, that

[11] See *LA Superquimica v EUIPO*, T-24/17, para 39; and *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

[12] See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

[13] *Bosco Brands UK Limited v Robert Bosch GmbH*, Case BL- O/301/20, paragraph 44.

[14] I refer to the finding of Mr Iain Purvis Q.C. (as he then was), acting as the Appointed Person in BL O/277/12, who stated: "In considering visual similarity, it was clearly right to take into account the shortness of the marks, since a change of one letter in a mark which is only 4 letters long is clearly more significant than such a change in a longer mark."

difference is noticeable.[15] Considering all the factors, including the overall impression, the respective marks are visually similar to a medium degree.

Aural Comparison

75. The verbal elements in the competing marks are two syllables long and will be pronounced as “UHL-MAH” and “LOO-MAH”. The marks share only the second syllable and differ significantly in the first. In the instance of the earlier mark ‘630, I do not consider that the average consumer will attempt to verbalise the figurative element. Considering all the factors, the respective marks are aurally similar to a medium degree.

Conceptual Comparison

76. In its written submissions, the applicant states:

> “ULMA is a female first name and a surname which means “peaceful, systematic mind, mysterious” or “intuition, enlightenment, dreams, incoherence, anxiety, charisma and a timid persona.” Please refer to the accompanying Witness Statement of Michaela Selvester and Exhibit MKS 1.
>
> LUMA means “a monetary subunit of the dram”; “the brightness in an image, as opposed to the saturation or chroma”; or “light”. Please refer to the accompanying Witness Statement of Michaela Selvester and Exhibit MKS 2.
>
> The Applicant asserts that the respective trade marks LUMA and ULMA are conceptually dissimilar.”

77. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the General Court and the CJEU including *Ruiz Picasso v*

[15] Ibid.

OHIM [2006] ECR I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

78. The earlier marks contain the verbal element "ULMA". Although the evidence adduced by the applicant show that the term 'Ulma' is a female name, I am not ready to accept that the entirety of the relevant public in the UK will see it as a name.[16] In my view, the significant proportion of the consumers will perceive the term as an invented word with no particular meaning, whereas a smaller group of consumers may recognise it as a name, albeit an uncommon one.[17]

79. The contested mark is the word "LUMA", which the applicant claims that it has a dictionary meaning. The applicant has provided definition entries for the word "luma" from the *merriam-webster.com*, *wiktionary.org*, and *wordsense.eu* websites, which state that it means 'a currency unit of Armenian dram' or 'light/bright'. However, I note that the Merriam-Webster is an American-based dictionary website, and the *wordsense.eu* appears to be a European one, and thus they target a non-UK audience. I also take into account that the Wiktionary website can be collaboratively edited by any user. Against this background, despite the former dictionary references, I consider it unlikely that the average consumer in the UK will be aware of the given meanings. At the very least, a significant proportion of average consumers will view the terms as invented or foreign words.[18]. As such, they are conceptually neutral.

80. For completeness, I do not consider that the average consumer will extract any meaning from the figurative element of the earlier mark '630. Even if they perceive it as a highly stylised 'U' letter, no concept will be attached to it. Therefore, the conceptual position will still be neutral.

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[16] See *Chorkee Ltd v Cherokee Inc*., Case BL O/048/08.

[17] See *Interflora Inc v Marks and Spencer plc* [2013] EWHC 1291 (Ch).

[18] Ibid.

DISTINCTIVE CHARACTER OF THE EARLIER TRADE MARKS

81. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

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

82. 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.

83. As detailed in the previous section, the opponent's marks contain the verbal element "ULMA", which is not allusive or descriptive of the goods in

question. Therefore, I find that the earlier mark '686 is inherently distinctive to a high degree, whilst the earlier mark '630 may be slightly more distinctive on account of the figurative element.

Enhanced Distinctiveness

84. I should stress here that, whilst the earlier marks are comparable marks, it is the position in the UK that must be considered because the question is whether the average consumer in the UK will be confused. I find the evidence insufficient to demonstrate that the marks have acquired an enhanced degree of distinctive character through use in the UK for the relevant goods. Although turnover figures are provided, they are not broken down or explained as relating to any particular goods, and there is no indication of the market share held by the marks. Also, no evidence of promotional material indicates any extensive media coverage nor intensive advertising or promotional activities in the UK. I do not consider that the use shown establishes enhanced distinctiveness for the average consumer as a whole or even for a significant enough subset of average consumers. Overall, the evidence is insufficient to demonstrate enhanced distinctiveness.

LIKELIHOOD OF CONFUSION

85. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that 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.[19] It is essential to keep in mind the distinctive character of the opponent's trade mark since the more distinctive the trade mark, the greater may be the likelihood of confusion. I must also keep in mind that the average consumer rarely has the

[19] See *Canon Kabushiki Kaisha*, paragraph 17.

opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.[20]

86. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.

87. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis Q.C., (as he then was) sitting as the Appointed Person, explained that:

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

[20] See *Lloyd Schuhfabrik Meyer*, paragraph 27.

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).”

These examples are not exhaustive. Rather, they were intended to be illustrative of the general approach.[21]

88. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, the Court of Appeal dismissed an appeal against a ruling of the High Court that trade marks for the words EAGLE RARE registered for whisky and bourbon whiskey were infringed by the launch of a bourbon whiskey under the sign “American Eagle”. In his decision, Lord Justice Arnold stated that:

> “13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] "a finding of a 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.”

[21] See *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.

89. In *Robert Bosch GmbH v Bosco Brands UK Limited*, BL O/301/20, Mr James Mellor Q.C. as the appointed person highlighted that there is no special test for 'short' marks. He said:

> "38. In my view, it is clear that none of these cases establish any sort of special test for short marks. The point is a common sense one – that if marks differ e.g. by one letter, the difference may have a greater impact in marks which consists of two letters than four etc. But every comparison must be conducted according to the approach laid down in the CJEU case law and every comparison will depend on its own facts."

In addition, he went on to say:

> "43. All the cases to which I have made reference on this topic establish that there are no special tests which apply to 'short' marks – whatever falls within the supposed category of 'short' marks. In reality, the tribunal simply has to apply the well-established propositions for assessing the visual, aural and conceptual similarities."

90. Earlier in this decision I have concluded that:

- I have carried out my assessment on the basis of identical goods as that represents the opponent's best case;
- the average consumer of the goods will be business users or professionals in the constructions industry without excluding members of the public. The selection process is predominantly visual without discounting aural considerations. The degree of attention will be medium to high depending on the importance, cost, and suitability of the goods, with professionals and businesses potentially paying slightly a higher degree of attention;

- the contested mark and the earlier mark '630 are visually similar to a low degree, aurally similar to a medium degree and conceptually neutral;
- the contested mark and the earlier mark '686 are visually similar to a medium degree, aurally similar to a medium degree, and conceptually neutral;
- the earlier mark '686 is inherently distinctive to a high degree, whilst the earlier mark '630 may be slightly more distinctive on account of the figurative element. The use is not sufficient to establish enhanced distinctiveness of the marks.

91. Taking into account the above factors, I find that there is no likelihood of direct confusion. As established above, the length of the competing marks is short, and therefore, the differences are more likely to be noticed. This is particularly so in this case as there is a visual and aural difference at the beginning of the respective marks, namely "ULMA/LUMA", a position which is generally considered more impactful than the endings of the marks.[22] Notwithstanding the principle of imperfect recollection, the common endings do not counteract the differences between the competing marks. In addition, given the medium to high degree of attention paid, I do not consider that the average consumer would overlook the different beginnings, which would create an impression of a different invented word and hence would not mistake one mark for the other. It follows that there will be no direct confusion, even on identical goods.

92. In terms of indirect confusion, even when the differences between the marks are identified by the average consumer, I cannot see a reason why the average consumer would put the common endings of the marks, "-MA", with different beginnings as linking the two marks by way of the same or an economically linked undertaking. I find that the guidance given in *Duebros* is more appropriate in this case, namely that an average consumer may merely associate the common characters in the marks but

[22] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

would not confuse the two. Thus, I consider that there is no likelihood of indirect confusion.

OUTCOME

93. The opposition under Section 5(2)(b) of the Act is **unsuccessful in its entirety**. Therefore, subject to appeal, the application can proceed to registration.

COSTS

94. This opposition has failed in its entirety and the applicant is entitled to a contribution towards its costs of defending its application. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. I award costs as follows:

Considering the other side's statement and preparing a counterstatement	**£350**
Preparing evidence and considering and commenting on the other side's evidence	**£950**
Preparing and filing submissions in lieu	**£500**
Total	**£1,800**

95. I, therefore, order, GRUPO ULMA, S. COOP. to pay Eurocell Profiles Limited the sum of £1,800. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 15th day of May 2024

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General