

O-341-15

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3015611
BY QUBE STRUCTURES LIMITED
TO REGISTER THE FOLLOWING SERIES OF MARKS IN CLASSES 6, 19 & 37:**



AND

**AN OPPOSITION THERETO (NO. 401386) BY
INSIDE2OUTSIDE LIMITED**

Background and pleadings

1. Qube Structures Limited (“the applicant”) applied for the above series of trade marks on 26 July 2013. They were published for opposition purposes on 18 October 2013. Registration is sought for the following goods and services¹:

Class 6: Metal building materials for prefabricated transportable buildings; transportable buildings; prefabricated, portable and/or re-locatable buildings; modular portable building units for use in the construction of prefabricated re-locatable buildings; prefabricated re-locatable buildings constructed of modular portable building units; modular portable buildings; prefabricated building elements of metal for sale in kit form; offices [buildings]; mobile display units [structures]; mobile homes; parts and fittings for all the foresaid; all the aforesaid goods in relation to portable prefabricated modular buildings and not including canopies and shelters of metal.

Class 19: Building materials (non-metallic) for prefabricated transportable buildings; transportable buildings (non-metallic); prefabricated, portable and/or re-locatable buildings (non-metallic); modular portable building units for use in the construction of prefabricated re-locatable buildings; prefabricated re-locatable buildings constructed of modular portable building units; prefabricated building elements (Non-metallic-) for sale in kit form; structural elements (Non-metallic -) for use in building; structural frameworks (Non-metallic -) for portable modular buildings; building materials, fittings and elements; mobile display units [structures]; mobile homes; all the aforesaid goods in relation to portable prefabricated modular buildings and not including non-metallic canopies and shelters.

Class 37: Construction, installation, maintenance and repair of prefabricated, mobile, portable, modular and re-locatable buildings; not including construction, installation, maintenance and repair of canopies and shelters.

2. Registration is opposed by Inside2outside Limited (“the opponent”). Its grounds of opposition are under sections 5(2)(b), 5(3) & 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under sections 5(2)(b) and 5(3), the opponent relies on the following trade mark registration:

UK registration 2460511 for the mark **QUBE** which was filed on 5 July 2007 and which completed its registration process on 18 April 2008. Although the mark is registered for a wider range of goods (and the opponent indicated that it wished to rely on all of its goods), the opponent made a statement of use (and a claim of reputation) in relation to the following goods only:

Class 6: Canopies [structures] of metal; shelters of metal; shelters [building structures] of metal; portable shelters of metal; shelters made of prefabricated metal insulated materials; shelters made principally of metallic materials;

¹ The goods and services were originally wider than this, but were reduced down following the filing of the opposition.

walkways of metal; covered walkways of glass and having a metal frame; parts and fittings for all the aforesaid

Class 19: Canopies [structures] of non-metallic materials; non-metallic shelters; shelters [building structures] of non-metallic materials; non-metallic modular shelters; non-metallic portable shelters; shelters made of prefabricated non-metallic insulated materials; shelters made principally of non-metallic materials; walkways of non-metallic materials; covered walkways of glass and having a non-metallic frame; protective coatings for walkways [building materials]; parts and fittings for all the aforesaid

3. Under section 5(4)(a), the opponent relies on the use of the sign **The Qube** since 2001 in relation to the goods detailed above. The opponent's main claims are that:

- i) The respective goods are identical or similar and the applied for services are complementary to its goods.
- ii) The marks are highly similar.
- iii) The above leads to a likelihood of confusion.
- iv) The earlier mark, which is an unusual one, has a reputation, such that the use of the applied for mark would lead to the various heads of damage under section 5(3).
- v) The opponent has goodwill associated with the sign **The Qube** which will lead to passing-off by the applicant.

4. The applicant filed a counterstatement. It denies that the marks are similar. It puts the opponent to proof of use. It claims that the opponent only makes canopies which it states are different from the applicant's goods. It states that there are a number of QUBE marks on the register which all co-exist. It claims that there has been honest concurrent use given that it has used its mark for around 8 years and there have been no instances of confusion. It claims that some form of interaction has taken place between the parties. It denies all the pleaded grounds.

5. The opponent is represented by Novagraaf UK, the applicant by Venture Proof Ltd. Both sides filed evidence. Neither side requested a hearing. The applicant filed written submissions in lieu of a hearing, the opponent did not. I will, though, take into account all of the arguments that have been made in the papers before me.

The evidence

Opponent's evidence

6. A witness statement has been provided by the opponent's managing director, Dr Robert Carpenter. The following emerges from his evidence:

- The opponent is a manufacturer and installer of "aluminium framed tensile membrane structures such as school canopies, playground canopies, commercial canopies, domestic canopies, covered walkways and shelters".

- The opponent was originally called Aluminium Structure Services Limited. It changed its name to its current name in 2007.
- The opponent originally installed temporary aluminium frame structures at various sporting and public events.
- Due to technological developments, the opponent introduced a range of tensile membrane structures to the market, designed specifically for schools. This was its POCCA range (an acronym for “permanent outdoor covered curriculum areas”).
- In 2001, a product called the “Qube”, an aluminium framed tensile membrane canopy, was introduced as part of the POCCA range. The product has been one of its best sellers. It is a heavy duty canopy with a long lasting aluminium frame with a translucent tensile fabric roof. It has integral guttering. It is a made to measure product. It is clearly marketed towards schools and other educational establishments, but it is, according to Dr Carpenter, suitable for use in other environments.
- Although the Qube is designed as a free standing structure, its design means that it can be used as a unit to function as an open shelter (such as a smoking shelter). By joining units together, it can cover larger areas to create covered walkways. Optional extras include glazed side panels, polycarbonate walls and decking. This means that it can be turned into a room.
- Since 2007 the POCCA name has been phased out with greater emphasis placed on the “Qube”.
- Turnover in the last five years has ranged between £2.4 million (2009, 2010 & 2011) to £1.2 million in 2013. Unit sales in this period have ranged between 228 and 104 and the amount spent on promotion between £253k (in 2009) and £45k in (2012).
- The mark has been used on labels, tags, pamphlets, brochures, invoices, quotes and on its website. Reference is made to advertising in magazines and at trade exhibitions.

7. Dr Carpenter provides a single exhibit, but it contains various documents as follows:

- Invoices from 2002 issued by Aluminium Structures Services, the customers are all schools. The goods are identified as “Qube” or “Qube structure”. I note that one invoice includes “roller shutter doors to front”.
- Various invoices from 2008-2013 issued by Inside2Outside. Most (but not all) of the customers are educational establishments. Some refer to “Pocca Cube” others to “bespoke/standard Qube”. Additional parts are listed on some of the invoices including side walls, a roller wall, leg pads etc.
- What is described as pre-2007 promotional material. This contains photographs and information about the product. The pictures show fairly large outdoor canopies mainly attached to existing buildings. Some appear to have integral guttering. There is no mention of walls or shutters. The goods are identified with reference to the trade mark QUBE, often as in “QUBE from/by Pocca”.

- Post-2007 promotional material is provided. A brochure (from 2009) is heavily branded with Inside2Outside, but it is clear that one of their products is QUBE. Other sub-brands are also used. The product is depicted in a similar way that I have described above. Reference is made to the creation of walkways by having more than one unit. Some of the brochures identify optional extras (for all canopies not just Qube) which include roller shutters for security, curtain/mesh walls, double glazing and doors.
- A copy of a 2012 brochure, again branded Inside2Outsie. It includes a section on “The Qube Canopies”. Other brands are also detailed. One of the pictures shows a QUBE with what appears to be glazed side/front wall.
- Website prints showing similar product information as above.
- Some customer testimonials taken from the opponent’s website which include pictures of a freestanding Qube, and, also, some attached to buildings and some forming walkways. None are used to make a walled room.
- Extracts from the website of Companies House showing the opponent’s company details.

Applicant’s evidence

8. A witness statement has been provided by the applicant’s director and founder, Mr Michael Spittle. Mr Spittle states that the applicant has used its mark for the applied for goods/services since May 2006 (initially as a sole trader, but subsequently through the applicant company). The following emerges from his evidence:

- The applicant’s mark is used in relation to the applied for goods/services, including being placed directly on the goods themselves, on uniforms, company vehicles etc.
- The business relates strictly to “portable prefabricated and modular buildings” for commercial and residential use. It is stated that the mark has not been used for canopies or shelters.
- Mr Spittle believes the respective goods to be distinct from each other. He states that residential and commercial customers in what he terms “the bespoke buildings market” are acutely aware of the difference between complete customised prefabricated and modular buildings to that of metal canopies and shelters. He does not consider the goods to compete.
- The applicant’s projects include sound/video recording studios, music rooms, spa treatment rooms, home extensions, doctors’ surgeries, science labs and accommodation. He is not aware of the opponent being involved in such projects.
- He states that a Google search for “the Qube” reveals the applicant’s mark and that it supplies “commercial modular buildings”. He states that neither the opponent’s website, nor any mention of its mark, appear on the first page of results.
- The name “The Qube” was inspired by the efficiency of a cube shape, with attractive clean lines.

- The price of the product starts at around £18k, rising to £200k for larger projects.
- In the last five years, turnover has ranged between £534k and £1.4million. Promotional expenditure has been between £20k and £45k in the same period.
- Various locations across England are given in order to demonstrate its customer base.
- Between 2007 and 2013 it has “served” 89 customers and installed 97 building projects.
- The goods have featured in various magazines including *Grand Designs* and *The Mail On Sunday Live Magazine*. The business was a finalist in the 2007 *Grand Designs Award*.
- Mr Spittle has never considered there to be a conflict with the opponent, nor is he aware of any confusion.
- Mr Spittle states that the opponent has been aware of the applicant’s use for some time. He states that the opponent contacted the applicant in March 2008 enquiring about a possible commercial relationship, although no relationship ultimately arose. He states that the opponent was/is well aware of the applicant and made no objection at the time or since. He notes that the opponent filed its mark one month after the applicant company was incorporated.

9. Mr Spittle provides various exhibits as follows:

- MJS1 – A product brochure which shows the applied for mark (albeit in blue) and which includes information about the product, its various uses, sizes, prices etc.
- MJS2 – Website prints and various photographs of completed projects.
- MJS3 – A print of the Google search mentioned earlier.
- MJS4 – Invoices (from 2008) for advertising space in Spaces Magazine and a domain name registration invoice from the same year.
- MJS5 – Various invoices issued by the applicant. They show the mark (most often in blue) at the top centre. They are dated between June 2007 and July 2013. The customers are varied, but some are schools.
- MJS6 – A map of the UK showing where its customers are located. The customers are spread across England. The extract also shows a number of “Customer Quotes”, which are, essentially, testimonials. All are from schools.
- MJS7 – Examples of press advertising including an advertisement in “4 homes” dated February 2007, a brochure for “Best of 2007” which has an entry about The Qube, a feature in “Live” a Mail On Sunday Magazine dated September 2007 were readers can win a garden studio produced by The

Qube, an advertisement in "Move or Improve?" from August 2007 and an editorial about The Qube in "Metro Home" dated June 2008.

Opponent's reply evidence

10. This comes, again, from Dr Carpenter. He states that the goods his company produces are, in fact, portable, prefabricated and modular structures. At Exhibit RC he provides a "Head teachers Update Guide to Canopies" produced by the opponent which he considers to show, in essence, that the goods are no different to those sold by the applicant. He adds that both parties are in the "building construction market". He states that the parties have similar markets such as schools, commercial businesses, care homes, hospitals, local authorities and residential home owners. He provides a web-print which he considers to show the types of market the opponent supplies. He considers the parties to be in direct competition.

11. Dr Carpenter states that its brand position on Google is not relevant, but highlights, anyway, that one of the reasons that the opponent is not ranked as highly as the applicant is because QUBE is just one of its products; it also trades under the name Inside2Outside. It is stated that the applicant's goods are generally more expensive, but are still in the same price range. He states that the opponent has a larger customer database of 1500 to the applicant's 89, but many are the same type of customer as those the applicant has identified.

12. In terms of the contact between the parties, he states that Mr Spittle is factually incorrect. He states, as far as he can recollect, that the opponent contacted the applicant in September 2009 (not 2008) because it had seen a flyer for the applicant's business in the same magazine the opponent advertises in. The opponent considered there to be a clear case of conflict and it wanted to make clear to the applicant that it was not happy with it using the opponent's trade mark. The applicant approached the opponent about a possible commercial relationship and there was a meeting at the beginning of October 2009 about this. However, nothing was agreed. Exhibit RC4 contains an Outlook diary entry showing an entry for this meeting.

13. Dr Carpenter states that he did not agree to the applicant using the opponent's established trade mark and it was made clear that the opponent was not happy for such use to continue. Dr Carpenter states that the opponent was unaware of the applicant's continued use, most likely because of its relatively small sales. He states that the trade figures provided by the applicant show that sales are increasing which, Dr Carpenter considers, may increase the likelihood of conflict and confusion.

The proof of use provisions.

14. The earlier mark must meet the use conditions in respect of the goods upon which the opponent relies.

Legislation and leading-case-law

15. The use conditions are set out in section 6A of the Act as follows:

“(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application 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 [.....]”

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered [.....]

(5) “In relation to a Community trade mark [.....], any reference in subsection (3) [.....] to the United Kingdom shall be construed as a reference to the European Community”.

16. Section 100 is also relevant, it reads:

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

17. In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch), Arnold J commented on the case-law of the Court of Justice of the European Union (“CJEU”) in relation to genuine use of a trade mark:

“In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in 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 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

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

(2) The use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(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, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is

aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating 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: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”

18. Although minimal use may qualify as genuine use, the CJEU stated in Case C-141/13 P, *Reber Holding GmbH & Co. KG v OHIM* (in paragraph 32 of its judgment), that “*not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question*”. The factors identified in point (5) above must therefore be applied in order to assess whether minimal use of the mark qualifies as genuine use.

The relevant period

19. As per section 6A(3)(a) of the Act, the relevant period in which genuine use must be established is the five period ending on the date of publication of the applied for mark, so, in these proceedings, the relevant period is 19 October 2008 to 18 October 2013.

Analysis

20. In its written submissions, the applicant makes no comment on the test for genuine use and/or whether the opponent has discharged the onus placed upon it. Indeed, much of its argument in these proceedings is premised on a comparison

between its goods and the goods the opponent has sold. Whilst I do not go so far as to suggest that this is an implicit acceptance that genuine use has been established, there is no submission against genuine use having been established.

21. I have noted the applicant's submission that there has been "inconsistent use" by the opponent of various brands, but this submission is based not on the genuine use test, but instead on the impact that this has had on the likelihood of confusion. I will return to the actual submission later, but in relation to genuine use, I am easily satisfied that the opponent has made genuine use of its mark during the relevant period. There are invoices which use the word QUBE. There is publicity material featuring the word and the evidence brings forward reasonable turnover figures. That the unit sales are not huge does not significantly affect the overall picture painted by the evidence. I accept that much of the use is alongside the primary brand of Inside2Outside, and alongside other sub-brands, but this does not impact upon the finding of genuine use. QUBE is clearly being used as a self-standing trade mark (albeit a secondary mark) and the opponent has provided evidence (such as sales figures) specifically for its QUBE goods. QUBE is being used in a manner consistent with the essential function of a trade mark and the level/nature of use is sufficient to meet the test for genuine use.

22. What is perhaps more pertinent in the analysis is to consider what the mark has, as matter of fact, been used in relation to, and what would represent a fair specification for such use. In terms of deciding upon a fair specification, Geoffrey Hobbs Q.C., sitting as the Appointed Person, when deciding case *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, 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."

23. More recently, in *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) set out the correct approach for devising a fair specification where the mark has not been used for all the goods/services for which it is registered; he said:

"63. The task of the court is to arrive, in the end, at a fair specification and this in turn involves ascertaining how the average consumer would describe the goods or services in relation to which the mark has been used, and considering the purpose and intended use of those goods or services. This I understand to be the approach adopted by this court in the earlier cases of *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1828, [2003] RPC 32; and in *West v Fuller Smith & Turner plc* [2003] EWCA Civ 48, [2003] FSR 44. To my mind a very helpful exposition was provided by Jacob J (as he then was) in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch); [2004] FSR 19. He said at paragraph [20]:

“... I do not think there is anything technical about this: the consumer is not expected to think in a pernickety way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. ... Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods – are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

64. Importantly, Jacob J there explained and I would respectfully agree that the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be adopted is, in essence, a relatively simple one. The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories.

65. It follows that 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 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. But conversely, if the average consumer would consider that the goods or services for which the mark has been used form a series of coherent categories or sub-categories then the registration must be limited accordingly. In my judgment it also follows that a proprietor cannot derive any real assistance from the, at times, broad terminology of the Nice Classification or from the fact that he may have secured a registration for a wide range of goods or services which are described in general terms. To the contrary, the purpose of the provision is to ensure that protection is only afforded to marks which have actually been used or, put another way, that marks are actually used for the goods or services for which they are registered.”

24. The opponent's statement of use reads:

Class 6: Canopies [structures] of metal; shelters of metal; shelters [building structures] of metal; portable shelters of metal; shelters made of prefabricated metal insulated materials; shelters made principally of metallic materials; walkways of metal; covered walkways of glass and having a metal frame; parts and fittings for all the aforesaid

Class 19: Canopies [structures] of non-metallic materials; non-metallic shelters; shelters [building structures] of non-metallic materials; non-metallic modular shelters; non-metallic portable shelters; shelters made of prefabricated non-metallic insulated materials; shelters made principally of non-metallic materials; walkways of non-metallic materials; covered walkways of glass and having a non-metallic frame; protective coatings for walkways [building materials]; parts and fittings for all the aforesaid

25. If one were to strip away from the statement of use the material of construction, the claim boils down to:

- i) Canopies [structures].
- ii) Shelters, shelters [building structures] and portable shelters.
- iii) Walkways and covered walkways.
- iv) Protective coatings for walkways.
- v) Parts and fittings for all of the aforesaid.

26. In terms of actual use, it is clear that the mark has been used in relation to canopies. This is the term most often used in the publicity materials and by Dr Carpenter in his commentary. Dr Carpenter does describe the goods differently at times, albeit most often when he is attempting to show that the goods the opponent offers are the same/similar to those of the applicant. However, I think it clear that the evidence demonstrates use of a canopy, albeit a structural one that is used to provide additional outdoor space for certain activities to take place. Therefore, use has been made in relation to "canopies [structural]". In terms of shelters, whilst it is possible to shelter under a canopy, that is not what the opponent is providing. They are providing canopies. I find that no use has been made of shelters, above and beyond the use on canopies. The same applies to walkways. Whilst it is highlighted in the evidence that two or more of the canopies can be combined to create a walkway, that is not what the opponent is really selling. The opponent is not creating or maintaining a share of the walkway market, it is creating or maintaining a share of the canopy [structural] market. I could find no specific use in relation to "protective coatings for walkways". The final term is part and fittings. Given what I have already found, such a term can relate only to canopies. There are examples of constituent parts being sold e.g. roller doors, corner brackets, sealing strips, leg pads, curtain walls with windows, fixed panels, post protectors. Other parts are mentioned in the brochures including "plexi-glass" sides, double glazing and doors, although it is not clear if any have been sold.

27. Taking the above findings forward, I do not consider it necessary to limit the canopies to precise material and the term can be retained in both classes. In terms

of the parts and fittings, the mark has been used in relation to a variety of them, so the term can stand as is. I consider a fair specification to read:

Class 6: Canopies [structures] of metal; parts and fittings for all the aforesaid.

Class 19: Canopies [structures] of non-metallic materials; parts and fittings for all the aforesaid.

Section 5(2)(b)

28. Section 5(2)(b) of the Act states that:

“5.-(2) A trade mark shall not be registered if because –

(a) ...

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

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

29. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

Comparison of goods/services

30. When making this determination, all relevant factors relating to the goods/services should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

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

31. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

“(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

32. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06 the General Court (“GC”) stated:

“It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

33. In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston.”

34. The applied for goods are:

Class 6: Metal building materials for prefabricated transportable buildings; transportable buildings; prefabricated, portable and/or re-locatable buildings; modular portable building units for use in the construction of prefabricated re-locatable buildings; prefabricated re-locatable buildings constructed of modular portable building units; modular portable buildings; prefabricated building elements of metal for sale in kit form; offices [buildings]; mobile

display units [structures]²; mobile homes; parts and fittings for all the foresaid; all the aforesaid goods in relation to portable prefabricated modular buildings and not including canopies and shelters of metal.

Class 19: Building materials (non-metallic) for prefabricated transportable buildings; transportable buildings (non-metallic); prefabricated, portable and/or re-locatable buildings (non-metallic); modular portable building units for use in the construction of prefabricated re-locatable buildings; prefabricated re-locatable buildings constructed of modular portable building units; prefabricated building elements (Non-metallic-) for sale in kit form; structural elements (Non-metallic -) for use in building; structural frameworks (Non-metallic -) for portable modular buildings; building materials, fittings and elements; mobile display units [structures]; mobile homes; all the aforesaid goods in relation to portable prefabricated modular buildings and not including non-metallic canopies and shelters.

35. All of the underlined (by me) goods are either buildings, or elements in kit form for making a building (essentially a construct-it-yourself version). They have the feature of portability/transportability/re-locatability. This suggests that what is being provided is not a traditional building such as a house or office block. Whilst this does not rule out the goods from being permanent (or at least semi permanent) buildings, part of their character will be of this non-traditional nature. The goods could be used, for example, for adding extra rooms to existing buildings by way of extension or small standalone buildings in a garden or on other land.

36. The goods of the earlier mark, despite the opponent's submission to the contrary, are not buildings per se. Even if shutters or panels were added, I doubt that one would ever describe the resulting structure as a building. The applicant has provided evidence of exactly what the building it produces looks like. It would be fair to describe them as sleek, wooden, contemporary products. However, the assessment should not be limited to actualities, but to the goods from a notional perspective. A portable/re-locatable building could be a simple affair comprised of a frame, wall panels, door and a roof.

37. There are some similarities. Both goods have a roof and a frame. The purpose of both could be to provide a simple and cost effective way of making use of spare outdoor space, as opposed to having to construct a traditional building or structure. However, the end products have some differences as a building would have much more substance to it than a canopy, even a structural canopy. The users could, though, be the same. There is dispute as to whether the parties have the same actual customers. For the purposes of this assessment the actual customers of the parties do not matter. What matters is the notional customer. From that perspective, I consider that there could be a great deal of overlap. This is mainly in the business/public sector, but also, to a degree, domestically. The channels of trade is a more difficult factor to assess. Those that specialise in this field may sell direct to the public. These are not the type of goods that will be browsed for in a retail establishment. However, I see no reason why a particular undertaking would not sell

² This would include portable structures used, for example, at exhibitions which form, essentially a room/building for displaying promotional materials etc.

both sets of goods even if the parties here focus purely on their own thing. That being said, the goods are not really complementary. In terms of competition, this is limited. Whilst a potential purchaser may consider his or her options, when he or she has an idea of what they are looking for then a competitive choice between a portable building or a structural canopy will not really materialise. The goods are not highly similar, indeed, I struggle to say that they are reasonably similar. The level of similarity falls, in my view, between low and moderate.

38. The other goods are essentially component parts. The parts for one could be of a similar nature to the parts of the other, although, the purpose is tied to the end purpose of the complete structure. There is, again, a degree of similarity that falls between low and moderate.

39. In coming to the findings in the preceding paragraphs. I have not ignored the limitation “not including canopies or shelters” in the applied for specification. All this does is to exclude identical goods; identical goods were not in play anyway.

40. The applied for services in class 37 must also be considered. The specification reads:

Construction, installation, maintenance and repair of prefabricated, mobile, portable, modular and re-locatable buildings; not including construction, installation, maintenance and repair of canopies and shelters.

41. This is the type of field in which there is a clear and inextricable link between goods on the one hand and the construction/installation/maintenance/repair on the other. However, I must bear in mind that the construction (etc) is in relation to the goods of the earlier mark (portable buildings etc) against canopies [structures]. Nevertheless, it seems to me that some similarity remains, albeit of only a low degree.

Average consumer and the purchasing act

42. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose 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 in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

43. The average consumer will be a business in the public or private sector, or, potentially, a domestic consumer. Either way, the respective goods are neither cheap nor frequently purchased. The selection process will be a carefully considered one. Marks in the respective field will most often be encountered visually, on websites, brochures, invoices etc. However, aural use should not be ignored completely as discussions may take place over the telephone etc.

Comparison of marks

44. 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.”

45. 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. I will focus on just one of the applied for marks (the black and white version) because the addition of colour is not something that should count as a difference due to the fact that the earlier mark is registered without regard to colour so could be used in any colour scheme. The marks to be compared are:



46. The earlier mark consists simply of the word QUBE which, therefore, is the only aspect of its overall impression. In terms of the applied for mark, it consists of a square of colour/monochrome, towards the bottom of which are the words “the Qube”. In terms of these words, the word “Qube” is presented in a much larger font than the definite article. I come to the view that the word QUBE has the greatest relative weight in the overall impression of the mark. The figurative square element is not, though, negligible even if it has less relative weight. The definite article has least relative weight (given its size and the nature of the word), although, again, it is not negligible, so will not be ignored in the comparison I make.

47. Conceptually, the marks are identical, the concept of both being based upon the word cube, albeit both being spelt in the same unusual way. Aurally, the marks are similar to a very high degree. The only difference is the additional articulation “the” in the applied for mark (some average consumers may not even articulate it anyway) which, in my view, creates little difference. Visually, the marks share the same letters QUBE which comprise the totality of the earlier mark and the element of the applied for mark which has the greatest relative weight. Whilst I bear in mind the differences I have already identified, I come to the view that there is, nevertheless, a high degree of visual similarity between the marks.

Distinctiveness character of the earlier marks

48. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

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

49. From an inherent perspective, the word QUBE has a suggestive quality indicative of a structure with cubic characteristics. The simplicity/brevity of the message (without any additional wording) together with its misspelling, adds to its distinctiveness. I consider the earlier mark to be possessed of a medium degree of inherent distinctive character as the net result of the points I have made.

50. In terms of the use made, I do not consider that the level of distinctive character has been enhanced to any material extent. Although the earlier mark has been used, it is mainly marketed at one type of consumer (educational establishments) and, even then, its sales figures do not seem that high. No evidence of market share has been provided.

Co-existence/concurrent use

51. The applicant relies on co-existence/concurrent use. However, it is difficult to understand exactly what relevance the claim is meant to have. At paragraph 5.5 of its counterstatement the applicant summed up its position thus:

“5.5. Therefore, as there have been no reported instances of confusion on the part of the public in all this time, if the Opponent provides evidence that its mark has been used in the UK we contend that there will have therefore been concurrent use without confusion, thus again reinforcing the arguments above that there is no likelihood of confusion.”

52. The applicant’s “arguments above” include a claim that there are other QUBE marks on the register which, it considers, counters the opponent’s argument that its mark is highly unusual. It states that the competing marks have co-existed without confusion. Therefore, on the face of it, the claim made by the applicant is what I will describe as the “proof of the pudding” test. The essence of the test is the proposition that despite both marks being used, there have been no instances of confusion, which, therefore, demonstrates that no likelihood of confusion in these proceedings will arise. In terms of the absence of confusion, this has been dealt with in a number of cases, one of the most recent being *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, where Kitchen L.J. stated that:

“80.the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

53. I also note that *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett L.J. stated that:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

54. Despite the length of time the competing marks have been used, I am not satisfied that the proof of the pudding test is met. The two main reasons for this are that the opponent clearly uses a primary mark (Inside2Outside) with QUBE being one of a number of subbrands. So, the actual use does not mirror the notional assessment that must be made between the marks at issue in these proceedings. Furthermore, it is clear that the opponent focuses its marketing particularly towards

educational consumers. Although the applicant has some educational customers, there may nevertheless have been limited opportunities for confusion to arise due to the competing marketing strategies. The argument on the basis of absence of confusion is rejected.

55. The applicant does, though, also appear to rely on co-existence in the marketplace. In *Budejovicky Budvar NP v Anheuser-Busch Inc*, Case C-482/09, the CJEU held that:

“74. In that context, it follows from the foregoing that Article 4(1)(a) of Directive 89/104 must be interpreted as meaning that a later registered trade mark is liable to be declared invalid where it is identical with an earlier trade mark, where the goods for which the trade mark was registered are identical with those for which the earlier trade mark is protected and where the use of the later trade mark has or is liable to have an adverse effect on the essential function of the trade mark which is to guarantee to consumers the origin of the goods.

75. In the present case, it is to be noted that the use by Budvar of the Budweiser trade mark in the United Kingdom neither has nor is liable to have an adverse effect on the essential function of the Budweiser trade mark owned by Anheuser-Busch.

76. In that regard, it should be stressed that the circumstances which gave rise to the dispute in the main proceedings are exceptional.

77. First, the referring court states that Anheuser-Busch and Budvar have each been marketing their beers in the United Kingdom under the word sign ‘Budweiser’ or under a trade mark including that sign for almost 30 years prior to the registration of the marks concerned.

78. Second, Anheuser-Busch and Budvar were authorised to register jointly and concurrently their Budweiser trade marks following a judgment delivered by the Court of Appeal (England & Wales) (Civil Division) in February 2000.

79. Third, the order for reference also states that, while Anheuser-Busch submitted an application for registration of the word ‘Budweiser’ as a trade mark in the United Kingdom earlier than Budvar, both of those companies have from the beginning used their Budweiser trade marks in good faith.

80. Fourth, as was stated in paragraph 10 of this judgment, the referring court found that, although the names are identical, United Kingdom consumers are well aware of the difference between the beers of Budvar and those of Anheuser-Busch, since their tastes, prices and get-ups have always been different.

81. Fifth, it follows from the coexistence of those two trade marks on the United Kingdom market that, even though the trade marks were identical, the beers of Anheuser-Busch and Budvar were clearly identifiable as being produced by different companies.

82. Consequently, as correctly stated by the Commission in its written observations, Article 4(1)(a) of Directive 89/104 must be interpreted as meaning that, in circumstances such as those of the main proceedings, a long period of honest concurrent use of two identical trade marks designating identical products neither has nor is liable to have an adverse effect on the essential function of the trade mark which is to guarantee to consumers the origin of the goods or services.”

See also: *Budejovicky Budvar NP v Anheuser-Busch Inc*, [2012] EWHC Civ 880 CoA)

56. I add, though, that co-existence must be peaceful to have any bearing on the likelihood of confusion. In *Aceites del Sur-Coosur SA v OHIM*, Case C-498/07 P, the CJEU found that:

“82. First, although the possibility cannot be ruled out that the coexistence of two marks on a particular market might, together with other elements, contribute to diminishing the likelihood of confusion between those marks on the part of the relevant public, certain conditions must be met. Thus, as the Advocate General suggests at points 28 and 29 of his Opinion, the absence of a likelihood of confusion may, in particular, be inferred from the ‘peaceful’ nature of the coexistence of the marks at issue on the market concerned.

83. It is apparent from the file, however, that in this case the coexistence of the La Española and Carbonell marks has by no means been ‘peaceful’ and the matter of the similarity of those marks has been at issue between the two undertakings concerned before the national courts for a number of years.”

57. The essence here is that the concurrent use has led to a situation in which there will no longer be any (or at least a reduced) adverse impact upon the essential distinguishing function of the trade mark. However, I note that the CJEU specifically highlighted that there were “exceptional circumstances” in play in the case before it. The size of the respective businesses do not, in view, give rise to exceptional circumstances. The level of use made will have had little, if any, impact on the likelihood of confusion. The use would not, in my view, remove or reduce the potential adverse effect on the essential distinguishing function. As stated earlier, the nature of the earlier mark and the way in which it has been marketed does not mirror the test before the tribunal.

58. In any event, there is also the point that the co-existence must be peaceful. There is a conflict of evidence on this. The opponent states that it saw one of the applicant’s advertisements and then informed the applicant that it was not happy about this. A meeting took place to discuss whether any form of commercial agreement could be reached. No agreement was reached. The opponent states that it told the applicant that it was not happy for such use to continue. The opponent states that it was unaware of the applicant’s continued use, most likely because of its relatively small sales. On the other hand, the applicant states that the opponent simply contacted it enquiring as to a possible commercial relationship. It states that the opponent made no objection at the time or since. There is also a dispute as to when the contact between the parties took place. The applicant states that it was in

March 2008. The opponent states that it was later than this, providing an electronic diary entry from the beginning of October 2009 showing when the meeting took place.

59. I have noted that in its written submissions filed in lieu of a hearing, the applicant provided much more detail from its perspective than was included in its evidence. It is not appropriate to consider such material. If the applicant wished to provide greater evidence of fact on this matter then it should have been included in its primary evidence, or a request made for leave to file further evidence.

60. In my view, even if I had found that the concurrent use made had an impact on the proceedings, such use would not have been of peaceful co-existence. The opponent has explained the position in detail indicating exactly what it saw and what action it took. It has provided a diary entry showing when the meeting took place. The applicant, on the other hand, has been less explicit and has even got the date wrong. I do not accept its submission that the diary entry has been doctored. There is no reason to come to this conclusion. In short, the opponent's evidence on this matter is to be preferred to that of the applicant. Having accepted the opponent's evidence, the situation is that the opponent was unhappy with the applicant's use and informed it that it was unhappy for such use to continue. It then did not encounter the applicant's use. Whilst it would have been better for the opponent to have investigated the matter to see if the use had actually stopped, the picture painted by the evidence is not one of peaceful co-existence.

61. I will briefly touch on the issue of acquiescence, in case this was what the applicant was trying to argue. The provisions of statutory acquiescence are:

“48. - (1) Where the proprietor of an earlier trade mark or other earlier right has acquiesced for continuous period of five years in the use of a registered trade mark in the United Kingdom, being aware of that use, there shall cease to be any entitlement on the basis of that earlier trade mark or other right-

(a) to apply for a declaration that the registration of the later trade mark is invalid, or

(b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used, unless the registration of the later trade mark was applied for in bad faith.”

62. Statutory acquiescence does not apply because such provisions relate to the owner of an earlier trade mark acquiescing (for more than five years) to the use of a later registration. This is not the situation here. There is also common law acquiescence, however, this requires, applied to this case, the opponent to have encouraged or induced the use that it now complains of, and for the applicant to have acted upon that encouragement. It is, essentially, a question of whether the conduct that took place makes the complaint now made unconscionable. Given my findings above, this is not the situation.

Likelihood of confusion

63. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. The submission I noted earlier of the applicant regarding “inconsistent use” of brands does not, in my view, impact upon the likelihood of confusion. That the actual use of the opponent may be alongside a primary brand and other sub-brands is not a feature of the notional test I must apply. I must consider a likelihood of confusion based on the notional use of the mark as filed and the mark as registered.

64. That there is a high degree of similarity between the marks (indeed there is identity on an aural and conceptual basis) is an important point because this may offset the lesser degree of similarity between the goods and services. Confusion does not, though, follow the event. I must bear in mind that the goods and services will be selected in a careful manner. This would often militate against the effects of imperfect recollection, so reducing the likelihood of confusion. However, in this case there is little difference between the marks and the key conceptual hook that will be recalled by the average consumer will be that of QUBE or THE QUBE. I come to the view that, notwithstanding the careful nature of the purchasing process, and notwithstanding the lesser degree of similarity between the goods/services, there is a likelihood of confusion. Put simply, the average consumer will believe, given the closeness of the marks and the inherent level of distinctiveness, that the same (or economically linked) business is responsible for the respective goods and services. The high level of similarity will be put down to economic connection and not coincidence. There is a likelihood of confusion in respect of all the goods and services. The opposition succeeds.

Other grounds of opposition

65. For reasons of procedural economy, I do not consider it necessary to comment upon the other grounds of opposition.

Costs

66. The opponent has succeeded and is entitled to a contribution towards its costs. My assessment is as follows:

Official fee - £200

Preparing a statement and considering the other side’s statement - £400

Filing and considering evidence - £800

Total - £1400

67. I therefore order Qube Structures Ltd to pay Inside2outside Limited the sum of £1400. This should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24th day of July 2015

**Oliver Morris
For the Registrar,
The Comptroller-General**