

O- 624-17

TRADE MARKS ACT 1994

IN THE MATTER OF THE APPLICATION UNDER NO. 3182460

BY POD SPACE LIMITED

TO REGISTER THE TRADE MARK:

“Heritage Pod”

FOR GOODS IN CLASSES 6 AND 19

AND

IN THE MATTER OF THE OPPOSITION THERETO UNDER NO. 408108

BY DC TIMBER FRAMED BUILDINGS LIMITED & DC TIMBER PRODUCTS LTD

BACKGROUND AND PLEADINGS

1. On 26 August 2016, Pod Space Limited (“the Applicant”) applied to register as a UK trade mark the words “Heritage Pod” **in respect of the following** goods:

Class 6:

Modular building units (metal-); Modular metallic structures; Modular portable building structures [metal]; Modular portable building units of metal; Modular portable buildings of metal; Modular prefabricated steel framing; Modular shelters of metal; Modular wall panelling of metal; Modular metal stables.

Class 19:

Modular plastic decking to serve as a ground cover; Modular log homes; Modular non-metal stables; Modular chicken houses, not of metal; Modular silos, not of metal; Modular homes, not of metal; Modular animal houses, not of metal; Modular building units (non-metallic-); Modular shelters (non-metallic-); Modular units (non-metallic-) for constructing prefabricated buildings; Modular sign panels of non-metallic materials [non-luminous, non-mechanical].

2. The application was published for opposition purposes in the Trade Marks Journal on 23 September 2016. It is opposed by DC Timber Framed Buildings Limited & DC Timber Products Ltd (“the Opponent”). The Opponent is the proprietor of the following UK and EU trade mark registrations:

Mark 1: EU trade mark 6489322

Applied for: 5 December 2007

“HERITAGE”

Registered: 17 December 2008¹

Class 19: Timber framed outbuildings, barns, garages, summer houses, gazebos, home offices

Class 37: Building construction; repair; installation services

Class 42: Construction design services

¹¹ The Opponent’s statement of grounds states that this mark was “filed on 17 December 2008”, but that is the date that the mark completed its registration.

Mark 2: EU trade mark 2984631

Applied for: 11 February 2003

“”

Registered: 31 August 2004



Mark text (according to the Opponent's statement of ground): HERITAGE ENGLISH BUILDINGS

Class 19: Timber framed outbuildings, barns, garages, summer houses, gazebos, home offices

Class 37: Building construction; repair; installation services

Class 42: Construction design services

Mark 3: EU trade mark 4719266

Applied for: 9 December 2005

Registered: 22 January 2007



Class 19: Timber framed outbuildings, barns, garages, summer houses, gazebos, home offices

Class 37: Building construction; repair; installation services

Class 42: Construction design services

Mark 4: UK registration: 2106880

Applied for: 3 August 1996

Registered: 20 November 1998



Mark text (according to the register):

ENGLISH HERITAGE BUILDING products

Class 19: Timber framed outbuildings, barns, garages, summer houses, gazebos, home offices

3. The opposition is brought on the basis of section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The Opponent claims that the application is for a mark that is visually, phonetically and conceptually similar to the Opponent's trade marks "*in particular, the dominant and distinctive part of the Applicant's mark consists of the Opponent's marks HERITAGE.*"
4. The Opponent relies for this opposition on all of the goods and services covered by its trade marks. The Opponent's notice of opposition included ticked boxes for each of the four marks it relies on, to indicate that it opposed all the goods or services contained within the application. The Applicant has applied for its mark in respect (only) of goods in classes 6 and 19. However, the Opponent's statement of grounds contains a number of irregular references.
5. Firstly, it refers to the Applicant's services in class 37 - this reference appears to be included in error as the Applicant seeks protection for no services.
6. Similarly, the statement of grounds also states that "*the services covered by the Applicant's mark in Classes 6 and 19 are identical or similar to the services covered by the Opponent's marks in Class 19.*" Clearly, though, the Applicant's specification is for goods in those classes, not services.
7. Likewise, the Opponent's statement of grounds goes on to say that "*due to the similarity ... of the services covered by the Applicant's mark to those services covered by the Opponent's marks, it is submitted that there exists a likelihood of confusion on the part of the public, which includes a likelihood of association.*"
8. In view of the actual content of the Applicant's specification and the consistently ticked boxes clearly indicating opposition to the whole of the application, I put these erroneous references to services down simply to error, especially since the statement of grounds concludes that "*the average consumer will therefore believe that the Applicant's goods originate from the Opponent or from an undertaking economically linked to the Opponent.*"
9. However, in support of its opposition, following the submission of its Form TM7 notice of opposition, the Opponent provided written submissions wherein the Opponent states (at paragraph 15) that "*the opposition is limited to the goods in class 19*" which it sets out for

comparison, with no explicit mention of the Applicant's class 6 goods. The conclusion of the Opponent's submissions state that on the basis of section 5(2)(b) "*the application should be refused for class 9*". Since there are no class 9 goods at issue, I put this latter reference down to typographical error, which should read class 19.

10. Convoluting matters further, the Opponent also provided written submissions in lieu of a hearing, in which it compares the goods at issue under separate headings of "Applicant's Class 19 Goods" and "Applicant's Class 6 Goods". Taking account of the numerous discrepancies in the Opponent's paperwork, and noting no comment on those points from the Applicant, I will proceed to decide this opposition on the basis that the Opponent challenges the application in respect of the Applicant's goods both in class 6 and 19.
11. I bear in mind the all submissions and shall refer to them in this decision where appropriate.
12. The Applicant filed a Form TM8 notice of defence, including a counterstatement in which "*the Applicant submits that the applicant's mark for HERITAGE POD is significantly different to the Opponent's mark when taken as a whole. The Applicant submits that the Applicant's mark reflects the pattern of a similar mark that the Applicant holds i.e. GLIDE POD (registration number 00003177657) as well as the names of the other buildings in its range i.e Micro Pod, Skye Pod, Eco Pod.*

The Applicant submits that other building materials with the term HERITAGE within the title are actively trading and do not appear to be causing confusion on the part of the public e.g,

<http://www.theheritagewindowcompany.co.uk>

<http://www.theheritagecollection.co.uk>

<http://www.europeanheritage.co.uk>

<http://www.heritagetimber.co.uk>

<http://heritagetimbersashwindows.co.uk> ..."

13. The Applicant also provided written submissions in support of its application, recapturing the above and making supplementary points to which I shall refer later in this decision.

14. The Opponent is represented in these proceedings by Briffa. The Applicant is self-represented in these proceedings. No hearing was requested and so this decision is taken following a careful consideration of the papers.

DECISION

15. The Opponent's claim is based on section 5(2)(b) of the Act, which states:

"... 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."

16. Since the Opponent's registered trade marks all have dates of application for registration earlier than that of the Applicant's trade mark they each qualify as an "earlier trade mark" under Section 6(1)(a) of the Trade Marks Act 1994 ("the Act").
17. Since all of the Opponent's earlier marks had been registered for five years or more when the Applicant's mark was published for opposition they are subject to the proof of use provisions under section 6A of the Act. The Opponent has duly provided a statement of use in respect of all goods and services covered by its earlier marks, but the Applicant indicated in its Form TM8 that it does not ask the Opponent to provide proof of use of its earlier trade marks. The Opponent is therefore entitled to rely in this opposition on all of its trade marks for all of the goods or services for which they are registered.
18. The following decisions of the EU courts provide the principles to be borne in mind when considering section 5(2)(b) of the Act:

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.

19. The principles are that:

- (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.
20. Looking at the Opponent's four earlier marks, I find that Mark 1 and Mark 3 are clearly closer in similarity to the Applicant's word mark "Heritage Pod" since Marks 2 and 4 contain additional word elements that are not part of Mark 1 or Mark 3. I further find that the Applicant's word mark "Heritage Pod" is closest in similarity to the Opponent's word mark "Heritage" (Mark 1), mainly because Mark 3 contains distinctive figurative components. Since the Opponent's specified goods and services are the same under both those two earlier European Union trade marks², I will make my decision based on consideration first of Mark 1, and will consider Mark 3 only if necessary. (Clearly, if the Opponent were not successful on the basis of Mark 1 or Mark 3, it would not succeed on the basis of Marks 2 or 4.)

² And noting that no greater breadth of protection arises from any other of the Opponent's marks.

Comparison of the goods and services

21. The goods and services to be compared are:

Applicant's goods
<p>Class 6: Modular building units (metal-); Modular metallic structures; Modular portable building structures [metal]; Modular portable building units of metal; Modular portable buildings of metal; Modular prefabricated steel framing; Modular shelters of metal; Modular wall panelling of metal; Modular metal stables.</p> <p>Class 19: Modular plastic decking to serve as a ground cover; Modular log homes; Modular non-metal stables; Modular chicken houses, not of metal; Modular silos, not of metal; Modular homes, not of metal; Modular animal houses, not of metal; Modular building units (non-metallic-); Modular shelters (non-metallic-); Modular units (non-metallic-) for constructing prefabricated buildings; Modular sign panels of non-metallic materials [non-luminous, non-mechanical].</p>
Opponent's goods and services
<p>Class 19: Timber framed outbuildings, barns, garages, summer houses, gazebos, home offices</p> <p>Class 37: Building construction; repair; installation services</p> <p>Class 42: Construction design services</p>

22. In comparing the parties' specifications I give the words their natural meaning with neither undue extension nor constraint, and I bear in mind the case law that sets out the following principles that apply in assessing the extent to which goods or services may be considered identical or similar.

23. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, the General Court stated³ that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category designated by the trade mark application, or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.

24. In *YouView TV Ltd v Total Ltd* [2012]⁴ Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise Nevertheless the principle should not be taken too far Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

25. I also take account of the factors identified by the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97⁵, where at paragraph 23 of its judgment it states that:

"In assessing the similarity of the goods all the relevant factors relating to those goods .. 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".

26. In the *Treat*⁶ case, Jacob J. (as he then was) identified that the relevant factors for assessing similarity also include the respective users of the respective goods or services and the trade channels through which the goods or services reach the market. He also stated that an inquiry into the extent to which the respective goods or services are competitive 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.

³ Case T- 133/05 at paragraph 29 of that judgment.

⁴ *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J

⁵ *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment.

⁶ *British Sugar Plc v James Robertson & Sons Limited* ("Treat") [1996] R.P.C. 281

27. I also take note that In *Kurt Hesse v OHIM*⁷, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific*⁸, the General Court described goods as “complementary” in circumstances where “... *there is a close connection between [the goods], 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*”.
28. Both parties have specified goods in class 19 and I find that there are terms within the respective specifications, which are general categories that encompass terms within the other party’s specified goods and which may therefore be considered identical on the basis of the *Meric* principle. Thus, the Applicant’s “*Modular building units (non-metallic-)*” and “*Modular units (non-metallic-) for constructing prefabricated buildings*” may encompass all of the Opponent’s class 19 goods: “*Timber framed outbuildings, barns, garages, summer houses, gazebos, home offices.*” This is because a modular building unit may of course may be made with a timber frame, just as a timber framed construction may of course be modular. Likewise, “*Timber framed outbuildings, barns*” may include “*Modular non-metal stables; Modular chicken houses, not of metal; Modular animal houses, not of metal.*” Similarly, “*Modular shelters (non-metallic-)*” may include “*garages, summer houses, gazebos*”.
29. Nothing in the remainder of the Applicant’s goods within class 19 can be considered identical to anything in the Opponent’s specification, but when I take account of various relevant factors I find there to be some similarity, in varying degrees, as follows.
30. The Applicant’s “*Modular homes, not of metal; Modular log homes;*” are similar to the Opponent’s “*summer houses; home offices*” in that they are all buildings to be occupied (at times) for personal use and therefore share something of the same nature, intended purpose and method of use. They may attract the same users (homeowners) and could share the same channels of trade (building design and/or construction providers). Since one may consider a modular log home as an alternative to a summer house those goods

⁷ Case C-50/15 P

⁸ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

are also competitive. I find “*Modular homes, not of metal; Modular log homes*” to be similar to “*summer houses; home offices*” to a reasonably high degree.

31. *Modular silos, not of metal*: A silo may be defined⁹ as “*a tall tower or pit on a farm used to store grain*”. A silo may typically be found on a farm, as too may “*Timber framed outbuildings, barns*”. Since they may all be used by farmers for various storage and shelter, I find that they share the same users and something of the same nature and intended purpose. They may also share channels of trade. I find “*Modular silos, not of metal*” to be similar to “*Timber framed outbuildings, barns*” to a medium degree.
32. *Modular plastic decking to serve as a ground cover*: Since various of the Opponent’s class 19 goods are outdoor buildings that may entail a practical hardwearing flooring surface - particularly “*Timber framed outbuildings, gazebos*” - I find that there is a degree to which those goods are complementary, serving as parts to complete or complement those structures. Those goods may share channels of trade and users. I find “*Modular plastic decking to serve as a ground cover*” to be similar to “*Timber framed outbuildings, gazebos*” to a low degree. The Opponent’s services offer no greater degree of similarity.
33. The remaining component of the Applicant’s class 19 goods is “*Modular sign panels of non-metallic materials [non-luminous, non-mechanical]*”. Notwithstanding that such a panel may optionally be incorporated as part of, say, an outbuilding, I find no similarity, with the Opponent’s goods. When I compare such panels against the Opponent’s services, I bear in mind the cautionary guidance of Jacob J. (as he then was) *in Avnet*¹⁰, where he stated his view that “... *specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.*” Despite the Opponent’s protection around “*building construction; repair; installation and construction design*” I find no similarity between those services and the Applicant’s *Modular sign panels of non-metallic materials [non-luminous, non-mechanical]*.

⁹ See *oxforddictionaries.com*

¹⁰ *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16

34. Turning to the Applicant's goods in class 6, I do not find any of the goods to be identical as they are pointedly differentiated by the specified nature of the material used – metal as opposed to timber. However, despite that difference in material, and although some of the goods are described as portable, I find similarity in relation to these modular building goods as follows:
35. I find that "*Modular building units (metal-); Modular metallic structures*" are wide terms and are similar to "*Timber framed outbuildings, barns, garages, summer houses, gazebos, home offices*". Even to disregard the possibility that metal building units and structures could have timber frames, there is similarity deriving from their shared intended purpose, method of use and users, and from the fact that such goods may be in competition with one another. I find similarity to at least a medium degree.
36. Likewise, and on the same bases, I find similarity to at least a medium degree between the Opponent's "*Timber framed outbuildings, barns*" and "*Modular shelters of metal; Modular metal stables*".
37. "*Modular portable building structures [metal]; Modular portable building units of metal; Modular portable buildings of metal*": I find the portability aspect of these goods suggests an additional point of difference that I do not readily associate with all of the timber-framed constructions such as listed in the Opponent's class 19 goods. Nonetheless, insofar as these portable items retain the essential function of offering accommodation or storage in the form of a building, there remains similarity with Opponent's "*Timber framed outbuildings; gazebos*" on the basis of shared purpose, method of use and users, and from the fact that such goods may be in competition with one another. Despite the portability point, I find similarity to at least a medium degree.
38. "*Modular prefabricated steel framing*": I find that there is some similarity with the Opponent's "*Timber framed outbuildings, barns, gazebos*" on the basis that a user may choose to use such framing as the basis of an alternative to a timber framed construction. To that extent the goods could be in competition and may share users. I find a low degree of similarity. The Opponent's services offer no greater degree of similarity.
39. "*Modular wall panelling of metal*": I find that there is some similarity with the Opponent's "*Timber framed outbuildings, barns*" on the basis that even though the Opponent's goods

are timber framed, their construction may entail panelling which could be metal. To that extent the goods may be considered complementary (the wall panelling serving as parts of such outbuildings) and may share users. I find a low degree of similarity and again the Opponent's services offer no greater degree of similarity.

The average consumer and purchasing process

40. It is necessary to determine who is the average consumer for the goods and services at issue and how the consumer is likely to select them. The average consumer is a legal construct and is deemed to be reasonably well informed and reasonably observant and circumspect.¹¹ It must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.¹²
41. The Opponent's goods may typically be accessed by members of the public at large. They include outbuildings and barns, which may be attractive to workers in agricultural or other contexts, but even these items may be targeted at the public. Likewise the Opponent's services (which have played little role in this decision) are services for the public, notwithstanding that they may also attract business users. The Applicant's goods may also be made available to the public at large, although they include items that would be more targeted to agricultural enterprises, who may use silos and may keep livestock (class 19) and for whom the portability component of goods in class 6 may be an attractive criterion.
42. The goods and services are not everyday purchases and I would expect the average consumer to pay at least a normal level of attention in their purchase. The goods and services are likely to be selected from advertisements, internet promotion and/or from signs on any relevant business premises. Therefore the degree of visual and conceptual similarity between the marks is more important than the level of aural similarity. That said, since the goods or services are liable to be the subject of word of mouth

¹¹ See Birss J. at paragraph 60 of *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).

¹² *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

recommendations (or the opposite) the level of aural similarity between the marks retains some relevance.

Comparison of marks

43. It is clear from *Sabel* 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.
44. The CJEU stated in *Bimbo* 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 therefore be wrong to dissect the trade marks artificially, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are shown below:

Earlier mark (Opponent's Mark 1)	Applicant's mark
HERITAGE	Heritage Pod

46. The earlier Mark 1 is simply the word “HERITAGE”, from which the overall impression of the mark must therefore solely derive. It is an ordinary English word, with which the average consumer will be familiar and which the dictionary¹³ defines as: “*features belonging to the culture of a particular society, such as traditions, languages, or buildings,*

¹³ dictionary.cambridge.org

that were created in the past and still have historical importance.” The Applicant submits that *“the word HERITAGE has a generic meaning and is widely used in the general population to indicate tradition or history.”* I say more below about the Applicant’s comment as to HERITAGE having a generic meaning, where I consider the distinctive character of the earlier mark. Suffice at this point to say that I find the word distinctive in the Opponent’s mark.

47. The Applicant’s mark comprises simply the two words “Heritage” and “Pod.” The Applicant submits that its *“Application for HERITAGE POD uses the word HERITAGE in a descriptive form and the word POD to reflect the nature of the work Pod Space undertake.”* In the Applicant’s mark I find that both words contribute to the overall impression, even though the word “Heritage” tends to characterise the word that follows it (bringing the connotations of tradition or history as the Applicant submits).
48. The word “Pod” is an ordinary English word, which has various meanings, but in the context of the Applicant’s application, I think it likely that the average consumer would perceive the word as referencing a small simple building¹⁴ (as in, for example an “eco-pod” on a campsite). Such an interpretation would broadly reflect the nature of the modular building components within the application.
49. Since the word “Heritage” comprises eight letters and three syllables versus the three letters and single syllable of “Pod”, and since “Heritage” will be read first, I find that that word is marginally more striking in the overall impression. The extent to which “Heritage” dominates the overall impression is no more than marginal because although “Pod” may be somewhat descriptive of the Applicant’s goods, “Heritage” is also allusive, and “Pod” is perhaps a less widely encountered word than “heritage”.

Visual similarity

50. The Applicant’s mark contains the whole of the earlier Mark 1. The Opponent’s word mark is recorded in the register in uppercase, but normal use of the mark would allow its presentation in title case (mixing upper and lower case) as is the case with the Applicant’s mark. (Likewise normal use of the Applicant’s word mark would permit a change to

¹⁴ See dictionary.cambridge.org

uppercase.) In any case the average consumer is not likely to attach any significance to such differences in case, if they are noticed at all. The Opponent's word mark represents the first eight of the eleven letters that make up the Applicant's mark. In the context of the overall impression I find the respective marks are visually similar to at least a medium degree.

Aural similarity

51. The Opponent's mark represents the first three of the four syllables that make up the Applicant's mark. Those three syllables would of course be sounded first and in the same way in both marks. In the context of the overall impression I find the respective marks are aurally similar to at least a medium degree.

Conceptual similarity

52. The Opponent's mark, used in relation the Opponent's building-related services and the structures that are its goods, evokes the concept of tradition and continued history. The word carries the same implication in the Applicant's mark, so there is conceptual identity to that extent. The inclusion of the second word in the Applicant's mark anchors the concept to the idea of a small built unit, so is less generalised than the concept in the Opponent's mark. However, since the notion of buildings of the past is present in the definition of "heritage", the extent to which the addition of the word "pod" alters the concept is curtailed. I find the respective marks are conceptually similar to at least a medium degree.

Distinctive character of the earlier mark

53. The distinctive character of an earlier mark must be considered, and can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public.¹⁵

¹⁵ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91

54. The more distinctive the earlier mark, either by inherent nature or by use, the greater may be the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer*¹⁶ 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).”*

55. The Opponent has filed no evidence, so I therefore have only the inherent distinctive character of the earlier mark to consider. I have already noted that the Applicant has submitted that the word “heritage” has a generic meaning, widely used in the general population to indicate tradition or history and that the Applicant’s mark “*uses the word in a descriptive form.*”

56. The way the Applicant has characterised the word may imply that the Opponent’s earlier mark is non-distinctive for the goods or services for which it is registered. It could also imply that if the only common element is devoid of any distinctive character, there is no distinctive similarity between the marks and therefore no likelihood of confusion. Although

¹⁶ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

I have acknowledged that the Opponent's word mark possesses a degree of allusiveness in relation to its goods and services, I do not find it directly describes them. Moreover, case law¹⁷ makes it clear that it is not open to me to find that an earlier mark has no distinctive character (is descriptive or generic) because this would be tantamount to a finding that the earlier mark is invalidly registered. Overall, I assess the inherent distinctive character of the earlier mark to be lower than average.

Likelihood of confusion

57. I now turn to make a global assessment as to the likelihood of confusion between the marks if they were used in relation to the goods specified. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of weighing up the combined effect of all relevant factors in accordance with the authorities I have set out in this decision. One such principle states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa.¹⁸ Earlier in this decision I concluded that:

- some of the competing goods are identical; for others, I found similarity in various degrees: reasonably high; at least medium; medium; low. I found no similarity in respect of the Applicant's *Modular sign panels of non-metallic materials [non-luminous, non-mechanical]*;
- the average consumer of the goods or services is a member of the public, but also those engaged in agricultural or other work requiring such constructions, and that the average consumer will pay at least a normal degree of attention in the purchasing process;
- although the goods or services at issue may be selected by predominantly visual means, aural considerations will also play a part in the selection process;

¹⁷ See CJEU in *Formula One Licensing BV v OHIM*, Case C-196/11P, paragraphs 41 - 44.

¹⁸ *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*

- the overall impression conveyed by the Opponent’s trade mark (Mark 1) derives from the word HERITAGE and the mark has a lower than average degree of inherent distinctive character;
- while both words in the Applicant’s trade mark contribute its overall impression, its distinctiveness is weighted marginally in favour of the word Heritage;
- the competing trade marks are visually, aurally and conceptually similar to at least a medium degree.

58. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises that the trade marks are not the same but puts the similarity that exists between the trade marks/goods down to the responsible undertakings being the same or related.

59. Indirect confusion, was considered by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*,¹⁹ where he noted that the average consumer “taking account of the common element in the context of the later mark as a whole” may conclude that it is another brand of the owner of the earlier mark. However, no likelihood of confusion arises where a later mark merely calls to mind the earlier mark (mere association). As emphasised by James Mellor QC, sitting as the Appointed Person in *Eden Chocolat*²⁰: “... it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element.”

60. In order for there to be a likelihood of confusion, it is necessary that there is at least some similarity between the goods in question.²¹ Since I have found there to be no similarity in respect of “Modular sign panels of non-metallic materials [non-luminous, non-mechanical]”, there is no likelihood of confusion to be considered in respect of those goods.

¹⁹ Case BL-O/375/10

²⁰ Case BL O-547-17 *Eden Chocolat be more chocstanza (word & device) v Heirler Cenovis GmbH* (27 October 2017) at paragraph 81.4.

²¹ See for example paragraph 22 of *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97

61. Where I have assessed the similarity of goods to be low (as recapped at outcome below), and taking into account that the lower than average distinctiveness of the earlier mark, I again find that there is no likelihood of confusion. (This takes account too of my consideration of the Opponent's services²², wherein I find that any similarity as may be present is no more likely to lead to confusion than a comparison between the respective goods.)
62. For all of the other goods of the Applicant, I find, taking into account all relevant factors, that there is a likelihood of confusion, in particular through consumers believing that the Applicant's mark is a variant of the Opponent's mark and used by the same undertaking, or by an economically related undertaking.
63. I have already pointed to the requirement in case law that an opponent's earlier registered trade mark must be considered to have at least a minimum degree of distinctive character. In *L'Oréal SA v OHIM*²³, the CJEU considered an appeal from a judgment of the Court of First Instance, which had found that there was a likelihood of confusion between the marks FLEXI AIR and FLEX for hair products. The applicant in that case submitted that the word FLEX was low in distinctiveness and could not therefore provide a proper basis for the finding that there was a likelihood of confusion between the marks. The CJEU rejected that contention, stating at paragraph 45 that:

"... The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference

²² (including installation services)

²³ Case C-235/05 P, 2005.

between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

64. Although I have given my decision as to a likelihood of confusion, I should address the Applicant’s argument that there are companies actively trading with the name “heritage” inherent within their brand, such that the Applicant submits that it is unlikely that the average consumer will believe that the Applicant's goods originate from the Opponent or from an undertaking economically linked to the Opponent. The Applicant submits the companies listed at paragraph 12 of this decision “*provide building components*” and submits that there is a further company - <http://www.heritagegardensheds.co.uk> – which, the Applicant states, “*provides bespoke buildings*”.
65. In response to the Applicant’s points the Opponent submits that a list of domain names incorporating the word “heritage” is not relevant to a comparison of the parties’ marks and that in any case the Applicant has “*provided no evidence that the listed domain names have registered trade marks or that any such marks are currently being used for similar goods ...*” I agree with the Applicant’s points. Moreover, it should be noted that even if there were registered trade marks that included the word “heritage”, no relevance²⁴ would attach to that circumstance, not least because an assessment of likelihood of confusion must be made in respect of particular marks and in light of all relevant circumstances.

OUTCOME

66. The opposition has largely succeeded and the Applicant **may not register its mark in respect of the majority** of its goods in class 6 or 19. However, the Applicant’s registration **may proceed** in respect of the goods that bear no or only low similarity with the Opponent’s goods or services, as follows: **Class 6:** *Modular prefabricated steel framing; Modular wall panelling of metal.* **Class 19:** *Modular sign panels of non-metallic materials [non-luminous, non-mechanical]; Modular plastic decking to serve as a ground cover.*

²⁴ This is so-called state of the register ‘evidence’ - on which, see, for example, Millett L.J. in *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283; the comments of Kitchin L.J. at para 80 *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220; and comments of the General Court at para 73 of *Zero Industry Srl v OHIM*, Case T-400/06.

COSTS

67. The Opponent has been largely successful and is entitled to a contribution towards its costs. In awarding costs I take account of the scale published in Tribunal Practice Notice 2/2016 and of the fact that I have found that the Applicant may proceed in respect of the few goods specified above. In the circumstances, I award the Opponent the sum of £400 (four hundred pounds) as a contribution towards the cost of the proceedings, calculated as follows:

Reimbursement of the official fee for Notice of Opposition and Statement of Grounds:	£100
Preparing submissions and considering the other side's statement:	£300
Total:	£400

68. I therefore order Pod Space Limited to pay DC Timber Framed Buildings Limited & DC Timber Products Ltd the sum of £400 to 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 6th day of December 2017

Matthew Williams
For the Registrar,
the Comptroller-General