

O-292-18

TRADE MARKS ACT 1994

**IN THE MATTER OF AN APPLICATION UNDER NO 501543
BY WEARWELL, INC**

**TO CANCEL REGISTRATION NO 3162387
IN THE NAME OF WORK WELL MATS LIMITED**

Background

1. The trade mark **work well mats** is registered under no 3162387 and stands in the name of Work Well Mats Limited (“the proprietor”). It has a filing date of 1 May 2016 and was entered in the register on 5 August 2016 in respect of goods in classes 17 and 27 which I set out later in this decision.

2. On 1 February 2017, an application seeking to have the registration declared invalid was filed by Wearwell, Inc. (“the applicant”) under the provisions of sections 47 and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). In support of its claim, the applicant relies on the following International (“IR”) and European trade mark (“EUTM”) registrations which are registered for goods also set out later in this decision:

1) IR 1201054

 **WEARWELL**

International registration date: 12 March 2014

Date granted protection in EU: 6 March 2015

Priority date from a US trade mark: 2 December 2013

“The mark consists of the word "WEARWELL" appearing to the right of a stylized design of three wavy lines”

2) EUTM 4207346

WEARWELL

Filing date: 17 December 2004

Date of entry in register: 27 March 2006

3. The proprietor filed a counterstatement in which it denied the claims made under section 5(2)(b) of the Act that there is a likelihood of confusion between the respective marks but it conceded that the respective goods are similar.

4. Both parties filed evidence with the applicant also filing written submissions. I will refer to this material as necessary in this decision. The matter came before me for a

hearing where the proprietor was represented by Ms Ashton Chantrielle of Counsel instructed by Chapman IP. The applicant was represented by Mr David Ivison of Counsel instructed by Downing IP Limited.

Decision

5. The relevant part of section 47 states:

“47. – (1)...

(2) The registration of a trade mark may be declared invalid on the ground-

- (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
- (b) ...,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

- (a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,
- (b) the registration procedure for the earlier trade mark was not completed before that date, or
- (c) the use conditions are met.

(2B) The use conditions are met if –

- (a) within the period of five years ending with the date of the application for the declaration the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) 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, and

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

(2D) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Union.

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c).

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that-

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) ...

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

6. The applicant relies on the two earlier marks set out above. Given the respective dates, only the EUTM is subject to the proof of use provisions set out above. The proprietor has put the applicant to proof of use of this mark. The relevant period within which genuine use must be shown is 2 February 2012 to 1 February 2017.

7. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“217. *The law with respect to genuine use.* In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] 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 added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

218. An important preliminary point to which Prof Annand draws attention in her decision is that, whereas the English versions of Articles 10(1) and 12(1) of the Directive and Articles 15(1) and 51(1)(a) of the Regulation use the word “genuine”, other language versions use words which convey a somewhat different connotation: for example, “ernsthaft” (German), “efectivo” (Spanish), “sérieux” (French), “effettivo” (Italian), “normaal” (Dutch) and “sério/séria” (Portuguese). As the Court of Justice noted in *Ansul* at [35], there is a similar difference in language in what is now recital (9) of the Directive.

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising

campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

8. Section 100 of the Act is also relevant and states:

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

9. As indicated above, the mark for which proof of use must be shown is a European trade mark registration (formerly known as a Community trade mark). In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the Court of Justice of the European Union (“CJEU”) noted that:

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

And

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

And

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

The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

10. Also in *London Taxi*, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

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

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

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark,

was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use.”

11. The General Court (“GC”) restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of a Community trade mark.

Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

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

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

The applicant’s evidence

13. The applicant’s evidence consists of four witness statements. Two are by Susan Patricia Power who states that she is Operations Manager and Company Secretary of Wearwell Europe Ltd. She states this company is a wholly-owned subsidiary of the

applicant and licensed by them to use the marks relied upon. The other two are by Nick Hopton who states he is Office Manager at Wearwell Europe Ltd.

14. From Ms Power's evidence, the following facts emerge:

- the mark WEARWELL has been used since at least 2012 in a number of European countries including Belgium, France, Germany, Hungary, The Netherlands, Spain and Sweden and has been used in the UK since "around 2005";
- By far the largest volume of sales made have been in the UK. Sales figures since 2012 are given as: £640,828 (2012), £837,907 (2013), £966,704 (2014), £909,423 (2015), £660,188 (2016) and £207,641 ("early 2017");
- Sales made include products bought in from third parties but some 98% of the above sales are estimated to be in relation to the goods for which the mark is registered;
- Some 80% of these goods are estimated to be directly marked with the word WEARWELL, for example by moulding;
- At SPP2 are sample pages from the applicant's product catalogues. Not all pages are dated but, at page 25, is the cover of the 2011/2012 Product Guide for "Anti-fatigue & Safety Matting". It shows a number of photographs of people standing on mats and matting in industrial situations. It shows the WEARWELL mark with the figurative element above it and the words "You're in good company" below it. The text on the following page begins: "WEARWELL has been producing anti-fatigue & safety matting since 1950..." and makes other references to WEARWELL products e.g. "All WEARWELL matting meets appropriate safety standards...". At page 55 is the front cover of the "2013/14 catalog". Again, the mark WEARWELL is shown on the page above the words "Ergonomic Mats & Flooring" and to the right of a figurative element similar to that which appears in the applicant's IR.
- Each of the catalogues at SPP2 are said to have been circulated in the UK though the only detailed circulation figures provided are those in respect of the 2017 catalogue. No detail is given of when in 2017 it was issued but some 2500 copies of this catalogue were produced in total for circulation in the EU

with approximately 600 of them sent to UK addresses with 75 sent to addresses in other EU markets. Hard copies are said to have been sent to firms on the applicant's client list each time a new version was published;

- At SPP3 are other examples of use. At page 110 is an extract from *HSM Health & Safety Matters*, described as the official Journal of the British Safety Industry Federation. The extract refers to the "Safety & Health EXPO 2015" and advises readers that "Wearwell (TMC MATS) is exhibiting its anti-fatigue flooring and matting products, designed for the industrial athlete...". At pages 116 to 121 are photographs of stands at exhibitions that are said to have taken place in 2012 in Birmingham and in 2015 and 2016 in London. The stands advertise "Ergonomic Mats & Flooring" and show the mark WEARWELL, mostly with the figurative device. At pages 111 and 112 is an extract said to be from a UK distributor's brochure from 2015. The mark WEARWELL is shown on these pages again both with the figurative device and alone;
- At SPP1 is exhibited a number of sample invoices which include some addressed to companies in the UK. Each of the invoices bear the mark as shown in the IR and list various products as shown in the product guides.

15. At the hearing, Mr Ivison acknowledged that much, though not all, of the evidence showed use of WEARWELL with a figurative element as shown in the IR rather than alone as registered by the EUTM for which proof of use is required. He referred me to the decisions of the CJEU in *Colloseum Holding AG v Levi Strauss & Co* Case C-12/12 and the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 in support of his submissions that such use amounted to genuine use of the EUTM for the word WEARWELL alone. The applicant had previously referred to these cases in its written submissions and the registered proprietor had indicated it was "bemused" by these submissions and considered them "irrelevant".

16. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under section 46(2) of the Act as follows:

"33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

17. Although this case was decided before the judgment of the CJEU in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

18. In *Hyphen GmbH v EU IPO*, Case T-146/15, the GC held that use of the mark shown on the left below constituted use of the registered mark shown on the right. The court held that the addition of a circle, being merely a banal surrounding for the registered mark, did not alter the distinctive character of the mark as registered.



The court set out the following approach to the assessment of whether the addition of additional components is likely to alter the form of the registered mark to a material extent.

"28. ...a finding of distinctive character in the registered mark calls for an assessment of the distinctive or dominant character of the components

added, on the basis of the intrinsic qualities of each of those components, as well as on the relative position of the different components within the arrangement of the trade mark (see judgment of 10 June 2010, *ATLAS TRANSPORT*, T-482/08, not published, EU:T:2010:229, paragraph 31 and the case-law cited; judgments of 5 December 2013, *Maestro de Oliva*, T-4/12, not published, EU:T:2013:628, paragraph 24, and 12 March 2014, *Borrajo Canelo v OHIM — Tecnoazúcar (PALMA MULATA)*, T-381/12, not published, EU:T:2014:119, paragraph 30).

29 For the purposes of that finding, account must be taken of the intrinsic qualities and, in particular, the greater or lesser degree of distinctive character of the [registered] mark used solely as part of a complex trade mark or jointly with another mark. The weaker the distinctive character, the easier it will be to alter it by adding a component that is itself distinctive, and the more the mark will lose its ability to be perceived as an indication of the origin of the good. The reverse is also true (judgment of 24 September 2015, *Klement v OHIM — Bullerjan (Form of an oven)*, T-317/14, not published, EU:T:2015:689, paragraph 33).

30 It has also been held that where a mark is constituted or composed of a number of elements and one or more of them is not distinctive, the alteration of those elements or their omission is not such as to alter the distinctive character of that trade mark as a whole (judgment of 21 January 2015, *Sabores de Navarra v OHIM — Frutas Solano (KIT, EL SABOR DE NAVARRA)*, T-46/13, not published, EU:T:2015:39, paragraph 37 and the case-law cited).

31 It must also be remembered that, in order for the second subparagraph of Article 15(1)(a) of Regulation No 207/2009 to apply, the additions to the registered mark must not alter the distinctive character of the mark in the form in which it was registered, in particular because of their ancillary position in the sign and their weak distinctive character (judgment of 21 June 2012, *Fruit of the Loom v OHIM — Blueshore Management (FRUIT)*, T-514/10, not published, EU:T:2012:316, paragraph 38).

32 It is in the light of those considerations that it must be determined whether the Board of Appeal was correct in finding, in paragraph 9 of the contested decision, that it had not been proven that the European Union trade mark rights had been used in a manner so as to preserve them either in the form registered or in any other form that constituted an allowable difference in accordance with the second subparagraph of Article 15(1)(a) of Regulation No 207/2009.”

19. These findings indicate that the relative distinctiveness of the registered mark and the components added to (or omitted from) it in use are relevant factors to take into account in the required assessment. In this instance the addition of a circle around the registered mark was not sufficient to alter the distinctive character of the registered mark.

20. Further the court held that, although it was relatively more distinctive than the registered mark, the addition of the word ‘Hyphen’ to the registered mark in a circle (“sign No.3”) did not alter the distinctive character of the registered mark either. In this connection, the court stated that:

“57 It must borne in mind in that regard that, where several signs are used simultaneously, steps must be taken to ensure that, for the purposes of the application of the second subparagraph of Article 15(1)(a) of Regulation No 207/2009, such use does not alter the distinctive character of the registered sign, having regard inter alia to business practices in the relevant sector (judgment of 24 September 2015, *Form of an oven*, T-317/14, not published, EU:T:2015:689, paragraph 31; see also, to that effect, judgment of 8 December 2005, *CRISTAL CASTELLBLANCH*, T-29/04, EU:T:2005:438, paragraphs 33 and 34).

58 The joint use of a figurative element and a word element on the same textile or clothing item does not undermine the identification function of the registered mark; it is not unusual in the clothing sector to juxtapose a figurative element with word element linked to the designer or manufacturer,

without the figurative element losing its autonomous identification function in the overall impression. This finding extends to all the goods and services referred to in paragraph 6 above.

59 Thus, in sign No 3, the target consumer’s attention will be drawn to both the word element and the figurative element.”

60 It follows that, in sign No 3, the mere addition of the word element ‘hyphen c’ does not alter the distinctive character of the registered mark, as found, in essence, by the Board of Appeal in paragraph 29 of the contested decision.”

21. In *Menelaus BV v EUIPO*, Case T-361/13, the GC found that use of the marks shown on the left and middle below constituted use of the registered mark on the right.



The court held that the word VIGAR was the dominant and distinctive element of all the marks. As regards the other features, the court held that:

“73 [The first sign] sign differs from the earlier mark as registered only in the ascending orientation of its oval background, the use of standard lower-case instead of standard capital letters and the replacement of the crown element by a sequence of three dots. As the Board of Appeal rightly found, a different orientation of the same background, the use of upper-case or lower-case letters when they are standard letters which reproduce the same term, or the substitution of an ornamental element (the sequence of dots) for a laudatory element when both of those elements serve to reinforce the term ‘vigar’, are minor differences that do not alter the distinctive character of the earlier Community trade mark as it was registered.

74 That finding is not called into question if the second form of use, reproduced in paragraph 63 above, is taken into account inasmuch as, even though, in that case, the basic background disappears and the word 'Spain' is present, the latter will be understood as a merely descriptive addition."

22. As Ms Power states in her witness statement, the mark used by the applicant has been subject to some changes over the years but the mark WEARWELL, in plain block capitals, has featured consistently. The mark most commonly shown in the evidence is that protected by the IR i.e. the word WEARWELL in plain block capitals and to the right of the figurative device. I have no doubt that its use as part of the composite mark does not alter the distinctive character of the EUTM and is sufficient to prove use of that EUTM. In any event, the word alone is shown in plain, block capitals throughout the text which appears in product guides and other promotional and technical material exhibited as an indicator of origin of goods under that mark. Taking all matters into account, I am satisfied that genuine use of the EUTM has been shown to have been made within the relevant period and I go on to consider what constitutes a fair specification of goods in view of the use which has been shown to have been made.

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

"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."

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

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

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

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

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

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark

has been used and which are not in substance different from them;
Mundipharma AG v OHIM (Case T-256/04) ECR II-449; EU:T:2007:46.”

25. The EUTM is registered for *Floor coverings; mats and matting; safety, anti-fatigue and floor mats*. The terms *Floor coverings; mats and matting* are broad ones and will include e.g. domestic carpeting and kitchen or garden mats but no evidence has been filed which would support use of the mark on such goods nor does the applicant claim to have used the mark on such goods. Indeed, in its evidence it describes itself as having produced “anti-fatigue & safety matting since 1950” (SPP2, page 26), its “catalog” (SPP2, page 55) refers to its “Ergonomic Mats & Flooring” and a brochure (SPP2, page 57) refers to “Ergonomic Surfaces for Industrial Athletes”. At SPP2, page 67, the following definition is given:

“What is ergonomic flooring?

Ergonomic flooring is made up of interlocking tiles. This modular design lets users replace damaged sections easily and expand or contract ergonomic work areas as needed...

Why choose ergonomic flooring?

Because your team doesn't just stand – they move – ergonomic flooring is your team's best defense against slips, trips, falls, heel strike, back pain, and muscle aches.”

26. Ms Chantrielle submitted that a fair specification for the use shown would be *ergonomic flooring or safety, anti-fatigue and floor mats*, however, taking the evidence as a whole, it is clear that the applicant's use of the mark has been in relation to a wider range of goods than *mats* and goods other than in the form of interlocking tiles. Brochures exhibited a SPP2, for example, shows “decking” for anchoring to subfloors (page 42), modular flooring for use in wet, dry, oily or hygiene sensitive areas (pages 47-51) as well as mats and matting of various sizes for use in various industrial applications and for its safety and anti-fatigue properties. The catalogue shown at pages 57 to 59 refers to flooring and surfaces and the photographs on the following pages show wide expanses of industrial flooring as well as mats and runners.

27. Taking the evidence as a whole, I consider a fair specification for the use shown is:

Floor coverings, mats and mattings for industrial use; safety, anti-fatigue and floor mats for industrial use.

28. With this specification in mind, I go on to consider the objection under section 5(2)(b) of the Act. Section 5(2)(b) states:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

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

The principles

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely

upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

Comparison of the respective goods

30. The applicant claims that some of the respective goods are similar and some are identical. In its counterstatement, the proprietor concedes the respective goods are similar. In view of the slightly different positions between the parties and in light of my findings regarding what constitutes a fair specification of goods for the use shown of the EUTM, I go on to carry out a full comparison of the respective goods which are as follows:

Applicant's goods	Proprietor's goods
<p>IR1201054 Class 27 Anti-fatigue floor mats; anti-slip floor mats made primarily of rubber or pvc; floor mats.</p> <p>EUTM 4207346 Class 27 (following proof of use) Floor coverings, mats and mattings for industrial use; safety, anti-fatigue and floor mats for industrial use.</p>	<p>Class 17 Insulating mats; Insulating matting; Adhesive tapes for use in securing floor coverings; Parts and fittings for all the aforesaid goods.</p> <p>Class 27 Mats; Non-slip mats; Underlay for mats; Carpets, rugs and mats; Textile floor mats for use in the home; Non-slip floor mats for use under apparatus; Matting; Matting [for covering existing floors]; Floor coverings; Protective floor coverings; Coverings for existing floors; Hard surface coverings for floors; Anti-slip material for use under floor coverings; Parts and fittings for all the aforesaid goods.</p>

31. In determining whether goods can be considered as identical, I take note of the decision in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, where the GC stated:

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

32. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

33. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

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

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

35. The proprietor’s *insulating mats* and *insulating matting* in class 17 are flooring intended to insulate the user from particular risks. They are very highly similar if not identical to the applicant’s *floor mats* (IR) and *Floor coverings, mats and mattings for industrial use* (EUTM) as registered in class 27.

36. The proprietor’s *Adhesive tapes for use in securing floor coverings; Parts and fittings for all the aforesaid goods* in class 17 are each goods which will be highly similar to each of the applicant’s goods. The respective goods are complementary and will have the same users, be used together to provide, install and secure a flooring solution and be sold through the same trade channels.

37. The proprietor’s *Mats/mats; Non-slip mats; Non-slip floor mats for use under apparatus; Matting; Matting [for covering existing floors]; Floor coverings; Protective floor coverings; Coverings for existing floors; Hard surface coverings for floors*; will include all of the applicant’s goods in both the IR and EUTM. These are identical goods.

38. The applicant's IR includes within its specification *floor mats*. These are not limited in any way so will include mats for domestic as well as industrial use and made of whatever materials. On this basis, I find they are identical to the proprietor's *Textile floor mats for use in the home*.

39. I go on to consider the proprietor's *Carpets* and *rugs*. In general terms, rugs tend to be smaller in size and moveable whereas carpets tend to be larger and fitted however both are used by the same users as floor coverings so there is a degree of competition between them and both are sold through the same trade channels such that I find them to be at least highly similar goods. In addition the terms *rugs* and *mats* are synonymous and so are identical goods.

40. I find the proprietor's *Underlay for mats*; and *Anti-slip material for use under floor coverings*; to be highly similar to each of the applicant's goods. Again, I do so on the basis that the goods are complementary and will have the same users, be used together to provide, install and/or secure a flooring solution and be sold through the same trade channels. That leaves the proprietor's *Parts and fittings for all the aforesaid goods* in class 27 which I find to be highly similar to the applicant's goods for the same reasons.

Average consumer and the nature of the purchasing process

41. 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 or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

42. 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. Each of the respective goods being floor coverings and associated goods, are such as will be used by the general public in the home, by businesses such as offices, hotels and restaurants, flooring fitters and by those in manufacturing who use e.g. protective or safety matting in the course of their production processes. This would include e.g. those who seek to protect employees from e.g. physical stresses, electrocution or spills during the production or other processes. Whether for domestic or business/industrial use, they are goods which are not an everyday purchase, which often incur significant outlay and will be bought through specialist suppliers with a fairly high degree of care to ensure they are fit for purpose in terms of e.g. their composition, function, size, price and aesthetics. The purchase is primarily a visual one with the goods being bought from a store, ordered online or via printed catalogues or technical brochures though I do not exclude the aural aspects of the purchase, particularly where e.g. a bespoke solution is required to address a specific technical purpose.

Comparison of marks

44. The marks to be compared are:

Earlier marks	Proprietor’s mark
<p>(IR)</p>  <p>(EUTM) WEARWELL</p>	<p>work well mats</p>

45. The applicant’s EUTM consists of the word WEARWELL presented in plain, block capitals. Whilst presented as a single word it naturally breaks down into the

two component parts WEAR and WELL though neither dominates the other and they form a unit with both contributing equally to the distinctive character of the mark.

46. The word WEARWELL, again in plain, block capitals, also appears in the applicant's IR. To the left of it is a figurative element which is described in Ms Power's witness statement as the letter W. I can see no reason why it would be seen as the letter W and note the description of it in the register as being "wavy lines" which is how it is described in the applicant's skeleton argument. However it is seen, the figurative element will not be overlooked but, given their respective sizes and the long-established principle that "words speak louder than devices", it is the word element of the mark which is its dominant element.

47. The proprietor's mark consists of the three words **work well mats**. The word "mats" is descriptive of such goods. The words "work" and "well" form a unit with both contributing equally to the distinctive character of the mark.

48. Comparing first, the applicant's EUTM with the proprietor's mark, there are some visual and aural similarities between them. Both include the word WELL preceded by a four-letter word which begins with the letter W and contains the letter 'R/r'. There are also some visual and aural differences both in the respective positioning of the letter "R/r" and the fact that the other letters making up the words are not the same. There is a general rule that the beginnings of words or marks tend to have more visual and aural impact than their endings. When taken as wholes, I find there is a medium degree of visual and aural similarity between the marks.

49. Comparing the applicant's IR with the proprietor's mark, the visual differences are slightly greater given the inclusion of the figurative element which has no equivalent in the proprietor's mark such that I find them similar to a low to medium degree. The aural position remains the same, however, with a medium degree of similarity given that the figurative element will not be articulated.

50. Despite each of the respective marks containing the word WELL, as combinations of ordinary, everyday words in the English language whose meanings will be well-known, I consider that, in relation to the goods for which they are

registered, the applicant's marks both bring to mind floor coverings that are hardwearing. The proprietor's mark brings to mind mats that work effectively. The respective marks are conceptually distinct.

Distinctiveness of the earlier marks

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

“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).”

52. The EUTM consists of the mark WEARWELL which I consider to be a mark of less than average distinctive character, the whole, as I state above, suggestive of something that is hardwearing. The IR, with the additional figurative element, has a degree of inherent distinctive character which I would categorise as average.

53. Earlier in this decision I reviewed the applicant's evidence of use. Sales in the UK are said to have totalled just over some £4m in the period 2012 to "early" 2017. This is not an insignificant sum however no evidence has been provided which allows me to put those sales into context in terms of the relevant market as a whole, a market which I take to be a very large one. I have not overlooked the following reference to the applicant's trade as set out in the 2011/2012 catalogue exhibited at SP2 pages 25 onwards. At page 26 the text states:

"WEARWELL has been producing anti-fatigue & safety matting since 1950..."

and goes to state:

"As category leaders, our primary focus is the development of matting products...."

54. The applicant company is an American one. Given, in her witness statement, Ms Power states the mark has been in use in the UK only since "around 2005" the reference to the company being active since 1950 and being category leaders I take to be a reference to its business in the US. I find support for this from other material exhibited at SPP2, which refers to the "65 Years of Expertise" of the Wearwell product and shows values in US dollars or uses the American spelling "Catalog".

55. Whilst marketing by way of the issuing of catalogues has been made, the only details given of their circulation is that approximately 600 copies of the 2017 version were sent to those on the applicant's client list and that it was also published on their website. No details are given, for example, of the date of issue of the catalogue (i.e. whether it was before the relevant date) nor of the number of visitors to the website whether from the UK or elsewhere. Whilst the company had a stand at trade exhibitions in the UK over a number of years, no details of who or how many people may have attended those exhibitions have been given. In short, I am unable to put the use into any sort of context such that it would enable me to find that it has enhanced the distinctive character of either earlier mark to any material extent.

Likelihood of confusion

56. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the earlier trade marks as the more distinctive they are, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

57. I pause at this point to mention that in its written submissions, the proprietor referred to the honest concurrent use of its mark with those of the applicant. No specific claim of this nature had been made in its Notice of Defence and counterstatement but even if it had been, such a claim would have failed for want of evidence. The only evidence filed by the proprietor is the witness statement of Mr Gardner, its Director. At LG1 he exhibits a page downloaded on 29 August 2017 from the workwellmats.co.uk website which refers to 17 years of trading by a company named Treadwell but he gives no evidence of e.g. any turnover or sales, whether by the proprietor or with its consent or any predecessor in business. There is no evidence of any advertising. At LG3 he exhibits what he states are "Two Fax Invoices of Work Well Mats dating back to 1999 and 2001". The first of these is in the form of, and headed, "Facsimile Message" most of which is unreadable but which has been sent to an undisclosed address from an Australian address though refers to them "waiting for pricing on the freight to U.K. or FRANCE". The second is, in fact in letter form and appears to be an offer made by the company rather than an order received by them. At LG4 is an email dated August 2017, from a Merseyside address asking for a quote. The remaining exhibit, at LG2, merely shows another page downloaded from the workwellmats.co.uk website along with a Nominet record showing when the website was registered.

58. The applicant has filed what it claims is evidence of actual confusion between the respective marks. In his witness statements, Nick Hopton, Office Manager for Wearwell Europe Ltd, the applicant's subsidiary, refers to contact his company had from a Ms Thompson of Quality Tooling. He states that on 13 October 2016 he was forwarded (he does not state by whom) the details of an email from Ms Thompson and, at NH1, he exhibits what he says is "an extract from the email record". The very brief email is from Ms Thompson, is addressed to "Orders" and gives the subject as "Enquiry". It reads:

"Please quote price and delivery
16 off Dura Tred mat 1.2m x 3 metres"

59. Whilst both Mr Hopton and the proprietor in its written submissions appear to agree that it is not unusual for potential customers to contact a supplier to request prices etc. for goods equivalent to those available under a certain name from third parties, Mr Hopton does not consider that is what Ms Thompson was doing. In his evidence in reply, he states that her email was not "received out of the blue" as his company had paid Ms Thompson visits the previous August and September. He states that as his company did not produce a Dura Tred product he queried things with her and she responded by sending him a copy of an advertising flyer. He exhibits a copy of this at NH7. It is undated but bears the proprietor's address details, the web address wwmuk.uk and shows the trade mark WORK WELL MATS at the top left of the page. The flyer shows some nine different "matting solutions for every situation" including "Dura-Tred". Mr Hopton states he interprets this as indicating Ms Thompson had been under a misapprehension that the applicant could supply Dura Tred products because she had mistakenly believed the flyer was from the applicant. There is no evidence of what was actually said by either Mr Hopton or Ms Thompson during the telephone call referred to and Ms Thompson has not filed evidence herself so I cannot be sure what she believed or what she intended when sending her email.

60. In her evidence in reply, Ms Power also refers to what she considers is an incidence of actual confusion. She states that in January 2017 her company received an order from a company which had an account with it. Despite being an account

holder, the customer had asked to be sent a pro forma invoice for payment. Ms Power states that the order form was made out in favour of Barclaycard Customer Services (“BCS”). She states she contacted the customer to query the order and was told by whoever dealt with her call that BCS was routinely put on orders in circumstances where it had no account set up with the supplier. Ms Power states that as the order also had the reference “HM-WORKWELL” this led her to believe that the customer had confused WORKWELL with her company.

61. The person with whom Ms Power spoke has not been identified and it is not clear whether this person was the same person who placed the order in the first place. Whether one and the same or not, absent evidence from the person placing the order, I cannot be sure why that person used the reference WORKWELL on the order form nor why (s)he did not seek to make use of the company’s account (if, indeed, (s)he was aware of that account’s existence given Ms Power’s indication that it was not a regular customer having only “occasionally ordered goods from it in the past”).

62. I accept that it is possible that both Ms Thompson and the person placing the order referred to by Ms Power were confused but the test under section 5(2)(b) of the Act is one that requires me to consider the *likelihood* of confusion not the *possibility* of confusion. I have to consider both direct confusion (where one mark is mistaken for another) and indirect confusion (where the average consumer realises the marks are different but, because of the similarities in the context of the latter mark as a whole, concludes that it is another brand of the owner of the earlier mark).

63. I have found the respective goods to be at least highly similar. I have found them to be goods which are bought with a fairly high degree of care by the general public or professionals who will make the purchase primarily on a visual basis but I do not exclude the aural aspects of the purchasing process. I found the applicant’s earlier EUTM to share a medium degree of visual and aural similarity with the proprietor’s mark and that they are conceptually distinct. I found the applicant’s earlier IR to share a low to medium degree of visual similarity with the proprietor’s mark, a medium degree of aural similarity and to be conceptually distinct. I found the IR to have an average degree and the EUTM to have a less than average degree of

inherent distinctive character with neither shown to have been enhanced through their use to any material extent.

64. I also bear in mind the following comments of the CJEU in *The Picasso Estate v OHIM* Case C-361/04P:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

65. Taking all factors into account, I find that the differences between the respective marks outweigh their similarities such that there is no likelihood of either direct or indirect confusion, even where identical goods are involved.

Summary

66. The application for cancellation fails.

Costs

67. The registered proprietor having successfully defended its registration is entitled to an award of costs in its favour. I make the award on the following basis:

For reviewing the statement and filing a counterstatement:	£200
Reviewing and filing evidence:	£700
For attendance at a hearing:	£700
Total:	£1600

68. I order Wearwell, Inc to pay Work Well Mats Limited the sum of £1600. This sum is 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 15th day of May 2018

**Ann Corbett
For the Registrar
The Comptroller-General**