

**O-043-21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3395477  
BY EVERBUILD BUILDING PRODUCTS LIMITED  
TO REGISTER AS A TRADE MARK:**

**EB25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 418300  
BY CLEMENT WINDOWS LIMITED**

## **Background and pleadings**

1. On 29 April 2019, Everbuild Building Products Limited (“the applicant”) applied to register **EB25** as a trade mark, under number 3395477. The application was published for opposition purposes on 2 August 2019. The specification has been amended following publication and registration is now sought in respect of a range of goods in classes 1, 2, 3, 4, 7, 16, 17 and 19. The specification is shown in full at the annexe to this decision.

2. The application is opposed by Clement Windows Limited (“the opponent”). The opposition is based upon s. 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against all of the goods in the application.

3. The opponent relies upon the following UK trade marks:

(i) UK 2638313 for the trade mark **EB20**;

(ii) UK 2638314 for the trade mark **EB24**.

Both marks have a filing date of 15 October 2012 and were registered on 18 January 2013. Their specifications are identical and are relied upon in full. They read as follows:

Class 6: Window frames of metal; casement windows of metal; fittings of metal for windows; sash fasteners of metal for windows; window fasteners of metal; door frames of metal; door fittings of metal; doors of metal.

Class 19: Building glass; door panels and doors (not of metal); window glass.

Class 37: Construction and installation services in relation to windows, roof-lights, doors and building closures.

4. The opponent claims that the contested mark is highly similar to the opponent's marks and that the goods and services at issue are identical or similar. It says that there is a likelihood of confusion, including the likelihood of association.

5. The applicant filed a counterstatement denying the grounds of opposition and putting the opponent to proof.

6. Given their dates of filing, the opponent's trade marks qualify as earlier marks in accordance with s. 6 of the Act. In its notice of opposition, the opponent provided a statement that the marks have been used for all of the goods and services relied upon. This statement is made because the marks had completed their registration procedure more than five years before the filing date of the application in suit and they are, as a consequence, subject to the proof of use provisions contained in s. 6A of the Act. In its counterstatement, the applicant requested that the opponent make goods its claim to use for all of the goods and services relied upon under both earlier trade marks. The relevant period for assessing genuine use is 30 April 2014 to 29 April 2019.

7. Both parties filed evidence. A hearing was requested and was held before me by videoconference on 19 November 2020. The opponent was represented at the hearing by Peter Mansfield of Mathys & Squire LLP. The applicant, which is represented by Withers & Rogers LLP, chose not to attend the hearing but filed written submissions in lieu, which I will bear in mind.

### **Preliminary issue**

8. At the hearing, Mr Mansfield complained that the opponent had wished to file evidence in reply but that the tribunal never notified the opponent of its deadline for filing such evidence and had closed the evidence rounds without further notice. An inspection of the official file reveals that, on 14 July 2020, the tribunal invited the opponent to indicate whether it wished to file evidence in reply and the opponent confirmed that it would file evidence in reply in an email to the tribunal dated 11 September 2020. Evidence in reply

was filed on 24 September 2020. The tribunal wrote to the parties on 25 September admitting the opponent's evidence and closing the evidence rounds. I accept that the opponent was not notified of the deadline for filing evidence in reply. However, it is clear from the tribunal's letter of 25 September 2020 that the evidence filed the day previously was being treated as the opponent's evidence in reply. There was no indication in the opponent's letter of 24 September 2020 that it was filing only partial evidence, nor, after receiving the official letter of 25 September 2020, did the opponent's professional representatives contact the tribunal to seek to reopen the evidence rounds on the basis that the evidence filed was incomplete and/or that the failure to set a deadline was a procedural irregularity which required correction. It seems to me that that would have been the appropriate time to raise such an issue; certainly, it should have been raised well before the hearing itself if it was considered material. However, as I did not understand Mr Mansfield to be seeking to reopen of the evidence rounds and as there was no application before me to file additional evidence at this stage of proceedings, it appears that I do not need to comment further.

9. At the hearing, it became evident that the papers before me were incomplete (pp. 50-51 of exhibit PC7 were missing). I confirm that I have now had sight of that evidence and taken it into account.

## **Evidence**

### **Opponent's evidence**

10. Four witnesses give evidence for the opponent. These are:

- Peter Clement. Mr Clement is the Chief Executive and a Director of the opponent;
- Daniel Adeshile, a Director at ADE Architecture;
- James Dunnett, the owner of James Dunnett Architects; and
- Perry Barnes, a Director at Perry Barnes and Greg Watts Architects.

11. The evidence is that the opponent is part of a wider group of companies which includes Clement Holdings Limited, Clement Windows Group Limited and Clement Windows Projects Limited.<sup>1</sup> No point has been taken as to whether the use is by the opponent or with its consent and I will make no further mention of this.

12. UK sales figures for EB24 goods are given for the period 2014 to 2019.<sup>2</sup> Residential sales exceeded £2 million each year in this period; commercial sales were lower and more variable, between £128,000 and £1.1 million annually. Figures are also provided for other brands (EB14, EB16 and EB20 combined), which totalled over £3.3 million residential and commercial sales over the same five years. It is said that these sales included sales of metal window frames, metal door frames and associated metal fittings and glazing (“provided as a complete package for the customer”) as well as installation.<sup>3</sup> Mr Clement’s evidence is that in almost every UK project the opponent carries out the installation of its windows, though that is not always the case.<sup>4</sup> It is said that a single window can cost £2,000.<sup>5</sup> It is said that the numbers in the EB20 and EB24 ranges (as well as others offered by the opponent) indicate the thickness of the glazing.<sup>6</sup>

13. Archive prints of the opponent’s website dated between 2002 and February 2018 are exhibited.<sup>7</sup> The opponent is presented as a specialist in steel windows, later also rooflights and doors. It is said that “Clement” offers a complete service, from design to installation; its window ranges are discussed separately. EB24 windows are mentioned throughout and are said to be available in a range of styles, with various window accessories; EB20 windows appear from January 2017. Prints of the opponent’s website with a copyright date of 2018 are also in evidence; the website is said not to have changed since 2018.<sup>8</sup> These prints mention both EB20 and EB24 windows in a section for residential customers but neither mark is visible on the pages discussing the opponent’s

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<sup>1</sup> Clement 1, §1.

<sup>2</sup> Clement 1, §8.

<sup>3</sup> Clement 2, §§2-3.

<sup>4</sup> Clement 2, §3; Clement 3, §8.

<sup>5</sup> Clement 3, §3.

<sup>6</sup> Clement 1, §6.

<sup>7</sup> PC3-1.

<sup>8</sup> PC10; Clement 3, §6.

services. An abbey restoration project in Leicestershire which used EB20 windows is mentioned. EB24 doors are mentioned in a web print from October 2011 (before the relevant date).

14. Undated case studies are provided of projects in the UK for which the opponent has supplied windows and doors.<sup>9</sup> EB24 bespoke windows and doors and EB20 windows are mentioned. The projects appear to have been both private residential and commercial projects (the latter being Old Marylebone Town Hall and the Melia hotel, London (both for EB24 windows)). Door furniture is specified separately, e.g. 158SFKL-SC Brook handle. The installation services of the opponent are mentioned in the Melia hotel information; no separate contractor is specified in a project for replacement windows of the same abbey restoration project which appears at PC10. However, where consultancy and installation services are concerned, clients are quoted as referring to Clement rather than the earlier marks, e.g. “[the] Clement team were great to work with” and “Clement’s slick manufacturing process and the skill set of the installers”.<sup>10</sup>

15. A brochure dated 2002 shows the “EB24 range of steel windows” for sale, along with images of what appear to be previous projects.<sup>11</sup> Clement Steel Windows is said to offer services including advice, survey, CAD, manufacture and installation. Installation information (for example, that allowance must be made when fitting for damp proof courses) is visible. There are also undated technical specifications for both EB20 and EB24 windows, along with undated brochures which refer to previous projects and which mention both EB20 windows and EB24 windows and doors.<sup>12</sup> Various glazing, window bar, box section, cill and leading options are available. Although there is reference in the technical specifications to doors (“[the] mild steel sections used for Clement window and door frames are precision rolled [...]”), EB20 only appears in direct connection to windows. It is also indicated in the technical information that whilst the windows are generally factory glazed, in some cases windows will have to be glazed on site. In the

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<sup>9</sup> PC6.

<sup>10</sup> PC6, pp. 18, 19.

<sup>11</sup> PC3-2.

<sup>12</sup> PC7 - PC9.

brochures, door handles are itemised separately and are not identified as either EB20 or EB24. One project in London (the Cooperage), which used EB24 doors, won an award in 2017.<sup>13</sup> Where there are any references to collaboration with, for example, architects, they are to the mark “Clement” or “Clement Windows”.

16. Marketing expenditure for the company has been between £39,000 and £86,500 each year between April 2014 and March 2019.<sup>14</sup> The figures are not broken down by method or trade mark. Advertising is said to have taken place on the opponent’s website, augmented by “PPC” keyword searches which highlight the site, and in lifestyle/home magazines.<sup>15</sup> Trade advertising is said to take the form of trade publications and directories both online and in hard copy. The opponent has attended lectures and roadshows and sponsors local companies. Some evidence of such publications is provided.<sup>16</sup> Neither earlier mark is visible, though Mr Clement does state that a November 2019 Building magazine advert and the images of a trade stand (PC4 and PC5) feature “our EB range of windows”.<sup>17</sup>

17. Press releases dated April 2018 and January 2019 are in evidence.<sup>18</sup> The former mentions the Old Marylebone Town Hall project, the latter concerns a project at Battersea Power Station and both mention EB24 steel windows (or “screens”: these appear to be internal windows: Clement 2, §2). The design and installation services provided by the opponent are by reference to “Clement” or “Clement Windows Group”

18. Mr Adeshile, Mr Dunnett and Mr Barnes all give evidence that they have used and/or are aware of the opponent, and they give their opinions on the likelihood of confusion. I do not need to go into any more detail concerning their evidence.

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<sup>13</sup> PC8, p. 65.

<sup>14</sup> Clement 1, §2.

<sup>15</sup> Clement 1, §3.

<sup>16</sup> Exhibits PC1-PC5.

<sup>17</sup> Clement 1, §3.

<sup>18</sup> PC11.

## Applicant's evidence

19. This consists of the witness statement of Jennie Lumley, the applicant's Marketing Manager. Some of Ms Lumley's 'evidence' is, in fact, submission, which I will not set out here but which I will take into account and refer to if and when necessary later in this decision.

20. Information is provided about the applicant's EB25 product, which Ms Lumley says is a sealant and adhesive product with a variety of applications and which was launched in May 2019 (i.e. after the relevant date).<sup>19</sup> It is said to be sold mainly through builders' merchants and retails for £11 to £12 which, it is said, makes it a premium product.<sup>20</sup> Advertising strategy material is also provided, though this is not specific to the EB25 mark.<sup>21</sup>

21. Ms Lumley states that the adhesive/sealant market is a specialist market dominated by international speciality chemicals businesses such as Sika group (of which the applicant is part), Henkel and Bostik.<sup>22</sup> It is said that adhesive/sealant products are reliant on complex polymer chemistry and resources for research and development.

22. It is said that alphanumeric branding is very common for adhesives and sealants.<sup>23</sup> Web prints, which bear only printing dates in 2020, show adhesives and sealants on sale with such names, for example, "AC50", "Dowsil 785" and "Everflex Premium+ 500".<sup>24</sup>

23. Ms Lumley gives evidence about common practice in the window trade; her qualifications for making such statements are unclear.<sup>25</sup> There is evidence from the *Which* website, as well as from the Anglian and Everest websites, which shows that such

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<sup>19</sup> §§3-4.

<sup>20</sup> §§5-7; JL1.

<sup>21</sup> JL2.

<sup>22</sup> §§10, 2. See also JL3.

<sup>23</sup> §§22-23.

<sup>24</sup> JL10.

<sup>25</sup> §11-21.



companies provide windows, doors and associated furniture, along with the installation services for such products.<sup>26</sup> Additional website prints show various companies' window and door products whose names include numbers, such as "Elite 70" and Heritage 2800.<sup>27</sup> It appears not to be disputed that these numbers, or those in the opponent's marks, may be descriptive.<sup>28</sup>

### **Proof of Use**

24. The proof of use provisions are at s. 6A of the Act, which reads:

"(1) This section applies where

(a) an application for registration of a trade mark has been published,

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

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

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

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

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<sup>26</sup> JL4-JL7

<sup>27</sup> JL9.

<sup>28</sup> §20.

(3) The use conditions are met if –

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

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

(4) For these purposes -

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

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

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

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

25. Section 100 is also relevant and states as follows:

“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.”

26. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114. [...] The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kameradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, 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 Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* 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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *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]”.

27. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use [...]. However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal

will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public”,

and further at paragraph 28:

“28. [...] I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted”.

28. As regards a fair specification, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

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

29. The applicant does not accept that the evidence shows genuine use in relation to any of the goods or services relied upon, placing particular emphasis in its submissions on the absence of clearly dated evidence. The applicant’s criticisms of the evidence are not entirely without foundation: as is so often the case before this tribunal, the opponent’s evidence leaves a lot to be desired.

#### Classes 6 and 19

30. There is not a great deal of evidence clearly dated in the relevant period and the sales figures are not broken down for the categories of goods and services relied upon (or, in the case of the EB20 mark, for that mark alone). There are, however, archive prints of the opponent’s website showing both marks in the relevant period (EB20 from 2017); Mr Clement has given evidence that the website has not changed since 2018: no evidence has been filed which undermines that statement and cross-examination was not sought. The marks appear on the website in relation to windows, with one exception from 2011 (I remind myself that this is before the relevant period) for doors under the EB24 mark.

#### *The EB24 mark*

31. It is impossible to date most of the evidence of projects completed by the opponent. There are two exceptions: the Old Marylebone Town Hall project (windows) is reported in April 2018 and the Cooperage restoration (doors) won an award in 2017: it is unlikely that these projects would have been reported or received awards in 2018 and 2017, respectively, had they been completed several years earlier (i.e. before the start of the

relevant period). Turning to the advertising figures, although not insubstantial sums are given, they are not particularised for either mark and the only evidence of the EB24 mark in third-party publications consists of two press releases, both in relation to windows. The sales figures are said to include sales of complete windows and doors, their fittings and installation. Figures are provided for sales under the EB24 mark for the relevant period but they are not broken down further. Given the opponent's evidence that a single window can cost £2,000, the sales are unlikely to represent a sizeable part of the market for the goods or services. However, they are spread across both residential and commercial sectors over a number of years. Notwithstanding the deficiencies in the evidence, I am satisfied that there has been genuine use of the EB24 mark in relation to windows in the relevant period.

32. The opponent's windows are advertised as bespoke pieces and are available in various styles. Fittings and fasteners are integral parts of such windows, likely to be considered part and parcel of the window. Indeed, it is entirely possible that no conscious choice is made by the consumer in relation to such goods (for example, even a commercial customer is unlikely to decide which particular hinges are used). Were the fittings and fasteners made by a third party, it is doubtful that a consumer would select them on the basis of a manufacturer's mark, even were such a mark present on the goods. Further, any third-party branding is unlikely to be visible to the end consumer on the completed window and the opponent is likely to be held responsible for any defects: as far as the customer is concerned, they have selected an EB24 window from the opponent and the opponent will be held solely responsible for the quality of the window, including its individual components. I therefore extend my finding of genuine use to the window fittings and fasteners in the specification.

33. At the hearing, Mr Mansfield said that the opponent was not asserting use outside windows. When I asked him to clarify, he said that the opponent still relied upon the earlier specifications in their entirety but that there was a question mark over sash fasteners as it was "unlikely" that the opponent would provide such goods. Given that the civil standard is the balance of probabilities, this appears to be a concession that there has been no



use on or in relation to sash fasteners. Sash window fasteners are likely to be a distinct type of fastener used only on sash windows. There is no evidence that sash windows feature among the opponent's various windows and as Mr Mansfield appears to accept that genuine use has not been shown for these goods, I will restrict the fair specification accordingly.

34. I recognise that a door frame may be either the skeleton of a panelled door or the frame into which the door fits but there is in the evidence no apparent distinction between these goods, nor does it seem necessary for me to make such a distinction: the opponent appears to manufacture both glazed metal doors and door frames in the latter sense, which are provided as complete sets. The evidence in relation to these goods is weaker than the evidence regarding windows. That said, doors were first shown to be on sale in 2011 under the EB24 mark; this is not the only instance of EB24 doors being used in a project (admittedly most of the other evidence is undated). However, it is more likely than not that there was a completed project (the Cooperage) in or around 2017 using EB24 doors. Mr Clement's evidence is that the EB24 sales figures include sales of metal door frames under the mark, though to an indeterminate extent. Whilst I recognise the weaknesses of the evidence, when taken as a whole it seems to me that it would be unrealistic to conclude that there has been no use of EB24 in relation to door frames of metal and door fittings of metal, the latter being integral parts of the doors manufactured by the opponent (and which would include goods such as hinges and locking mechanisms) to which the same considerations apply as to window fittings. There is no evidence that the opponent has produced doors other than metal doors with glazed panels and I do not consider a fair specification would include doors of metal at large, which would cover any type of metal door, including, for example, metal security and metal fire doors.

35. Similar factors apply to the claimed use in relation to the goods in class 19. There is no evidence that the opponent has manufactured goods other than metal-framed windows and doors. Glass panes are plainly an integral part of such goods and, for the end consumer, the glass will be perceived as one essential component of the windows

and doors; it is unlikely to be chosen on the basis of a manufacturer's mark. As the manufacturer of the complete windows and doors, the opponent is the entity likely to be held responsible for the quality of the goods. Although I accept that a manufacturer's mark may sometimes appear on the panes in windows, that is not always the case. In this regard, I also bear in mind that there is nothing in the evidence to suggest that third parties do supply the glazing for the opponent's goods (unlike paint, where the manufacturer is specified) and that Mr Clement's evidence is that the sales figures include sales of the panes of glass for doors, windows and screens.<sup>29</sup> I conclude that there has been genuine use in relation to glass for doors and windows. There is no evidence that the opponent has supplied glass other than in windows and doors and retention of "building glass" at large, which would include other distinct categories such as glass roofs, glass cladding or foam glass, would be too generous. There is also no evidence that the opponent has supplied door panels in any non-metallic material other than glass, nor that its doors have been anything other than metal-framed with glazed panels. I do not, therefore, consider that "door panels and doors (not of metal)" should feature unrestricted in a fair specification.

### *The EB20 mark*

36. The EB20 mark is less conspicuous in the evidence as a whole. There are, for example, no instances of this mark appearing in press or marketing material. There is, however, evidence that the EB20 range of windows was promoted on the opponent's website from January 2017. As the prints from 2016 and earlier do not mention the EB20 range, it is a reasonable inference that the evidence of the abbey restoration project would be no earlier than 2017; the applicant has provided no evidence which would suggest that the project was commissioned or completed after April 2019. There is no breakdown of the sales figures which relate to the EB20 mark and, given the absence of the EB20 mark from the website before 2017, I treat with caution the assertion that the sales figures from 2014 include sales of the EB20 mark. The figures from 2017 to 2019 show an uptick in sales from previous years, from around £350,000 combined in 2016 to around £1.7 million

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<sup>29</sup> See PC7, p. 26 and Clement 2, §2.

in 2019, though it is impossible to say what portion of this is attributable to the EB20 mark. Given that EB20 windows were promoted on the website for over two years at the end of the relevant period and that there is at least one restoration project likely to have taken place in the relevant period, I am prepared to find that there has been genuine use of the EB20 mark in relation to window frames, fittings and fasteners of metal, the reasoning in relation to the component parts being the same as given above. I also extend my finding to window glass, for the same reasons as given above. However, there is no evidence whatsoever of use of the EB20 mark in relation to doors, door frames, door fittings or door panels, which are separate categories. I do not consider that these goods fall within a fair specification for the EB20 mark.

### Class 37

37. As regards construction and installation services in class 37, in my judgement the average consumer would not consider such services to be provided under either earlier mark, although it is clear from the evidence that the opponent offers fitting services. In so saying, I bear in mind that the use provisions do not require the trade mark to be affixed to the goods/services and that use “in relation to” services will suffice. I note at the outset that “construction services in relation to windows, roof-lights, doors and building closures” are, at their core, construction (i.e. building) services and are not interchangeable with window manufacture, which is the opponent’s business. The evidence suggests that the opponent offers, and is perceived by customers as offering, installation services under the name Clement/Clement Windows, whilst the EB20 and EB24 brands are no more than window ranges marketed as specific sub-brands, i.e. used in relation to goods, not services. I recognise that Mr Clement’s evidence is that the sales figures include installation costs. However, as is apparent from the case law cited above, where a party wishes to rely on a range of terms in a specification, the evidence must be clear as to the extent of use in relation to those terms. While the technical information about EB20 and EB24 windows contains references to the method of installation, the context is that of providing to the potential customer bare technical information as to the fixing method. Even were it dated within the relevant period it would be insufficient on its own to establish

use of the earlier marks in relation to the services. There are no invoices or quotations for completed projects, which would typically itemise the costs for each of the various goods and services, to support Mr Clement's assertion that installation services were provided under the earlier marks, as distinct from the name "Clement". In the absence of a breakdown of the extent to which installation services were provided under the marks, or clear evidence that the services were promoted under the earlier marks, in combination with evidence that suggests that the average consumer is likely to consider that the services were provided under the "Clement" mark, I find that there has been no genuine use in relation to the class 37 services.

38. A fair specification for the respective trade marks is as follows:

UK 2638314 EB24:

Class 6: Window frames of metal; casement windows of metal; fittings of metal for windows; window fasteners of metal, not including sash fasteners; door frames of metal; door fittings of metal; metal-framed doors.

Class 19: Door panels of glass; window glass.

UK 2638313 EB20:

Class 6: Window frames of metal; casement windows of metal; fittings of metal for windows; window fasteners of metal, not including sash fasteners.

Class 19: Window glass.

### **Section 5(2)(b)**

39. Section 5(2)(b) of the Act reads as follows:

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

[...]

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

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

40. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, EU:C:1997:528, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, EU:C:1998:442, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, EU:C:1999:323, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, EU:C:2000:339, *Matratzen Concord GmbH v OHIM*, Case C-3/03, EU:C:2004:233, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, EU:C:2005:594, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P, EU:C:2007:333, and *Bimbo SA v OHIM*, Case C-591/12P, EU:C:2016:591:

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

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

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

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

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

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

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

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

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

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

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

## Comparison of goods

41. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

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

42. Guidance on this issue has also come from Jacob J. (as he then was) *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

43. A further factor which must be taken into account is whether there is a complementary relationship between the respective goods. It was explained by the CJEU in *Kurt Hesse v OHIM*, Case C-50/15 P, EU:C:2016:34, that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, EU:T:2009:428, the General Court 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”.

44. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes”,

whilst on the other hand:



“[...] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together”.

45. Mr Mansfield indicated at the hearing that the sealing, filling and insulating materials and compounds in classes 17 and 19 are of most concern to the opponent, though the opposition against the other goods was not dropped. He submitted that the goods are all building materials which are sold in the same general market. In respect of sealants, he submitted that a sealant is almost always needed when fitting a window and that it must adhere to and seal the window frame and wall without corroding the window frame. These goods are, in his submission, complementary. He further submitted that sealants and windows have the same purpose, which is providing a weathertight aperture which allows light to pass through. It was also submitted that companies selling and installing windows do provide goods, such as paint.

46. Given my findings on genuine use, the specifications of the earlier marks to be used in the comparison are:

UK 2638314 EB24:

Class 6: Window frames of metal; casement windows of metal; fittings of metal for windows; window fasteners of metal, not including sash fasteners; door frames of metal; door fittings of metal; metal-framed doors.

Class 19: Door panels of glass; window glass.

UK 2638313 EB20:

Class 6: Window frames of metal; casement windows of metal; fittings of metal for windows; window fasteners of metal, not including sash fasteners.

Class 19: Window glass.

## Class 1

*Putties; paste fillers; synthetic putty; chemical substances for use as bonding agents*

47. The putties and fillers above are pliable semi-solid substances which may be used in the manufacture, installation or repair of windows and glazed doors. They are not similar in nature to any of the goods in the earlier specifications, which are all goods of metal and/or glass. Turning to whether there are other points of similarity first with the earlier window frames of metal, which is where Mr Mansfield focused his submissions, albeit in relation to sealants and fillers in classes 17 and 19, I do not consider that there is a shared purpose between these goods: the purpose of putties and fillers is to fix window glass in the frame, whilst the purpose of a window frame (i.e. an unglazed frame rather than a complete window) is to provide the structure for a transparent weathertight aperture in the outer wall of a building. There is no competition between these goods and their method of use is different. There may be some overlap in users, more likely among professionals who manufacture windows than members of the public, but an overlap in users is in any event a fairly superficial point of similarity. The applicant accepts that sealants and windows/doors may both be purchased from builders' merchants but does not comment on window frames separately. It seems to me unlikely that window frames would be available through general-purpose shops such as builders' merchants and DIY outlets but that they are instead likely to reach the market through specialist firms or directly from the manufacturer. Whilst it is plausible that a specialist company retailing window frames would also offer for sale the putties and fillers which may be used in the glazing of the frame, they are likely to be in separate areas of the premises or their online equivalents. As for complementarity, I accept that putties and window frames are often, even routinely, used together. It is less clear to me that the second limb of the complementarity test is satisfied, i.e. that the average consumer of such goods would consider that they are the responsibility of the same manufacturer. The applicant has submitted that the sealant/adhesive market is the preserve of specialist chemicals companies. Although Mr Mansfield submitted that window companies provide goods such as paint, there is no evidence to that effect and it is not a fact of which I am prepared to take judicial notice.

On the contrary, whilst I do not find the applicant's evidence of assistance, I prefer its submission, which is equally applicable to these goods in class 1. The differences between the materials used in the construction of window frames and the specialist chemistry involved in the manufacture and development of putties and fillers point towards manufacture by entirely separate companies with different expertise. In my view, it is unlikely that the average consumers of these goods, whether professional or not, would regard window frames and the putties and fillers, above, as the responsibility of the same undertaking. They are not complementary. Taking all of these factors into account, I conclude that these goods are not similar.

48. The opponent's position is no better in relation to the other goods in its specifications. Essentially the same considerations as above apply to door frames and to window glass. Windows, fittings and fasteners are further removed, being dissimilar in the same ways as above as well as being neither important nor essential for the use of putties or fillers and thus not complementary goods.

*Chemicals for use in industry; unprocessed artificial resins; unprocessed plastics; tempering and soldering preparations; adhesives for use in industry; cement oil; white spirit; solvents; absorbents for cleaning solvents; chemicals for use in removing paint; lime; sand*

49. I can see no basis for a finding of similarity in respect of these goods. They are different in nature, purpose and method of use from all of the earlier goods. They are not substitutes for the earlier goods and are, therefore, not competitive, nor are they complementary. There is potential for the goods to be sold in the same premises but they will not be in the same sections, whilst the overlap in users is at too high a level of generality to result in similarity. These goods are dissimilar.

## Class 2

*Paints, varnishes; lacquers; coating compositions, preservatives against rust and against deterioration of wood; anti-corrosives; enamels, painters' colours, distempers, lacquers, paint and varnish driers, wood preservatives, wood stains, anti-corrosive, and anti-fouling compositions, and anti-corrosive oils; decorative spray coatings, namely cobwebbing; floor lacquers and finishes; metals in foil and powder form for use in painting and decorating; primers*

50. These goods differ in nature, purpose and method of use from all of the earlier goods. As with the goods above, there may be some overlap in users and channels of trade but this is likely to be at only a very high level. Whilst some of the opponent's goods, such as window and door frames, may be painted or preserved, it is most unlikely that a consumer would consider the manufacturer of the above goods to be the same as that of any of the goods in the earlier specifications. There is no similarity.

## Class 3

*Cleaning, polishing, scouring and abrasive preparations and substances; solvents for removing paints and varnishes; solvent cleaners for household use; solvent cleaning preparations; alcoholic solvents being cleaning preparations; paint stripper and remover; environmentally and eco friendly solvent cleaning preparations; cleaning preparations for the treatment of floors; waxes and wax preparations for the treatment of floors*

51. The high point of any argument for similarity between these goods appears to me to be that they may be used to clean, polish etc. or remove substances such as lacquer from the goods of the earlier specifications. That is not a compelling basis for overall similarity. Whilst I accept that both users and channels of trade may intersect to an extent, the goods are likely to be in discrete areas of any sale premises. None of the remaining factors applies and there is no similarity between these goods and those of the earlier specifications.

#### Class 4

*Industrial oils and greases; wax; coating oils; wetting and binding compositions*

52. The opponent has not made any submissions on the potential application or similarity of these goods to the earlier specifications. Whilst they may be used, for example, in the manufacture of windows and doors (for example, to grease hinges), they are not likely to be considered the responsibility of the same undertaking and there is no other obvious basis for a finding of similarity. These goods are not similar.

#### Class 7

*Machine tools; power operated tools; machines and apparatus for the application of adhesives*

53. There is no obvious point of similarity between these goods and those of the earlier specification and the opponent has posited no reason why they should be considered so. They are dissimilar.

#### Class 16

*Brushes, pads, rollers and applicators, all for the application of paints, preservatives and decorating substances; painting and decorating applicators; paint trays and containers; painting and decorating applicators; stencils; stationery and printed matter; instructional and teaching materials; adhesives; adhesive tapes; rolls of paper for wiping glass; cardboard display stands; self-adhesive tapes; adhesive tapes of cloth and of fiber glass; adhesive tapes for household and office use; adhesive tape dispensers; plastic sheets, films and bags*

54. There is no obvious point of similarity between these goods and the goods in the earlier specifications, nor has any been identified. They are dissimilar.

## Class 17

*Fillers for insulating and sealing purposes; sealing compounds; insulating materials; insulating compounds in liquid, paste, foam-like, powdered, sprayable and/or extrudable form; sealing and insulation material; insulating materials; sealants, sealing putty*

55. The above goods represent those which Mr Mansfield indicated at the hearing are of most concern to the opponent, or they are broader terms which incorporate the goods of concern. I will again focus on window frames first, since those are the goods on which Mr Mansfield based his submissions.

56. There is a difference in nature and method of use between these goods and window frames. I disagree with Mr Mansfield that the purpose is the same: the purpose of filling and sealing compounds is to plug holes and/or to make any gaps (e.g. between frame and wall) water or weathertight. It is certainly not to let light through. The purpose of a window frame is to provide the skeleton of a window. As I indicated above, I think it unlikely that unglazed window frames will be sold in DIY outlets or builders' merchants: they are more likely to be found in specialist outlets or be sourced directly from the manufacturer. Given that sealants and fillers are products for the installation, rather than the fabrication of windows, there is little likelihood that they will be sold through such channels but, even if they are, they are likely to be situated in different sections of the premises or in different categories online. Whilst the above goods are often or always used in the fitting of window frames to buildings, I do not consider that they are complementary goods in the meaning laid down in the case law: the different materials and the different technical competences required in their manufacture are unlikely to result in the average consumer believing that the goods derive from the same undertakings. Even accounting for some slight overlap in trade channels and users, I find that there is no similarity between these goods and window frames.

57. I consider that essentially the same reasoning applies to windows themselves. Although completed windows may be found in general DIY outlets or builders' merchants,

they will still be in distinct sections, separate from sealants and adhesives. Users may intersect but, as I have said above, that is not a strong basis on which to find similarity.

58. The same findings are equally applicable to the remaining earlier goods, which are further removed: there is no evidence that these sealants and fillers would be used in the manufacture of windows/glazed doors and it seems unlikely. As a consequence, window/door glass in class 19 is not complementary to these goods, not being an essential or important product for the use of sealants, or vice versa. I see no meaningful similarity concerning the other goods, nor have any submissions been provided.

*Polyurethane foams, expanded foams, foams for insulating and sealing purposes; Packings and stoppings (in the nature of packings); sealing plastics; insulating dyes and varnishes; insulating compounds in liquid, paste, foam-like, powdered and/or sprayable form; membranes made of plastic (semi-manufactured products); water proofing membranes; injection moulding products made of plastic; packing and stopping materials; masking tape.*

59. I have no specific submissions on why these goods would be similar to the goods of the earlier specifications. I can see no obvious point of similarity, the goods being different in nature, purpose, method of use, not being in competition and not having any meaningful degree of overlap in channels of trade or users. There is also no complementarity: even were such goods used with windows and doors, the average consumer would not, in my view, consider them to be made by the same undertaking. They are dissimilar.

#### Class 19

*Filler, sealing compounds and coatings containing plastic for building purposes; plastic tempered mortar; assembly compounds in liquid, paste, foam-like, powdered, sprayable and/or extrudable form for building purposes*

60. Given their presence in class 19, the fillers and sealing compounds at issue here will be goods such as filler for mending walls or bitumen sealants for roofing. The opponent has not identified any goods which are analogous to the fillers and sealants in class 17 but which would be included in the above terms and, because of the oddities of classification, fall in class 19. To the extent that such goods exist, my findings at paragraphs 55 to 58 would apply. I see no reason why the above fillers and sealing compounds in class 19, or indeed any of the other goods listed above, would be similar to the earlier goods. Again, there may be a superficial overlap in channels of trade and users but I do not consider that there is any other point of similarity, including complementarity.

61. Where there is no similarity between the goods, there can be no likelihood of confusion and the opposition must fail.<sup>30</sup> In case I am wrong that “putties; paste fillers; synthetic putty; chemical substances for use as bonding agents” in class 1, “fillers for insulating and sealing purposes; sealing compounds; insulating materials; insulating compounds in liquid, paste, foam-like, powdered, sprayable and/or extrudable form; sealing and insulation material; insulating materials; sealants, sealing putty” in class 17 and/or “filler and sealing compounds containing plastic for building purposes; assembly compounds in liquid, paste, foam-like, powdered, sprayable and/or extrudable form for building purposes” in class 19 are not similar, I will also carry out an assessment of confusion on the presumption that there is a low degree of similarity between the respective goods.

### **The average consumer and the nature of the purchasing act**

62. It is necessary for me to determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. The average consumer is a legal construct deemed to be reasonably well informed and reasonably circumspect: *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The*

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<sup>30</sup> *Waterford Wedgwood plc v OHIM*, C-398/07 P, EU:C:2009:288 at [34].



*Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch) at [60]. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question: *Lloyd Schuhfabrik*.

63. There appears to be no dispute that the average consumer will include both professionals (e.g. tradespersons or contractors) and members of the general public. The particular goods at issue are goods which a tradesperson would install or use in their trade, or are available in building merchants and DIY stores for wider purchase and may be bought by building contractors and homeowners.

64. The applicant submits that the level of attention will be high for the opponent's goods and at least average for the contested goods. The opponent contends that the level of attention for the contested goods will be low. I agree with the applicant that at least a medium level of attention will be paid in the selection of the contested goods: they are relatively inexpensive (although the applicant's product may be expensive in comparison to other sealants, that is not the correct basis for the assessment, and £11-12 is not a great deal of money in any event). There will be some attention paid to the particular characteristics of the goods, such as colour or any special (e.g. anti-fungal) properties. Whilst I acknowledge that the opponent's goods may be at the expensive end of the scale, it is not the case that the earlier goods will be costly across the board. For goods such as windows and doors, factors such as aesthetics and sound-reducing capacity may play a part; for goods such as fittings, fasteners and glass, some attention will be paid to, for example, the style, material or level of obscurity. The general public's level of attention is likely to be at least medium, whilst professionals are likely to pay a reasonably high degree of attention, given the potentially larger order quantities and associated costs.

65. The purchasing method is likely to be primarily visual for both groups of consumer, with the goods selected from the shelves of retail premises, their online equivalents or catalogues. Aural considerations may also play a part, given the potential for discussions

with, for example consultants/architects, or for orders to be placed orally over the counter or the telephone.

### **Distinctive character of the earlier trade mark**

66. In *Lloyd Schuhfabrik*, 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)”.

67. The earlier marks are a combination of the letters “EB” with the numbers “20” and “24”, respectively. The opponent asserts that the numeral indicates the thickness of its glazing units. Whilst the opponent’s consumers may know that to be the case in respect of its windows, and while the applicant does not appear to dispute that numbers may be

descriptive, the evidence does not establish that numbers in a trade mark for windows will usually be seen as indicating the thickness of the glazing. That said, it does seem to me that numbers are frequently used by manufacturers to indicate a number in a series of products and that this type of use will be recognised by average consumers for all of the earlier goods. A two-letter combination is not strikingly distinctive but nor is it particularly weak, not having any connection to the goods for which the earlier marks may be relied upon. The distinctiveness of the earlier marks rests in the combination of the letter and numbers and the marks are distinctive to a medium degree, though for the reasons I have given the balance of distinctiveness will be slightly in favour of the letters “EB” in both.

68. I do not consider that the evidence is sufficient to establish that the distinctiveness of either mark has been enhanced through the use which has been made of it. I bear in mind that the market in steel windows may be a niche subset of the window market generally but there is no evidence to assist me in determining the extent to which the opponent is a player in that market: the opponent’s own assertions of its reputation are not persuasive evidence. The sales figures are not sufficient to establish that any significant market share under the earlier marks is held by the opponent, a matter which is not assisted by the absence of a breakdown in the sales figures for the particular goods to which they are said to relate and, in the case of the EB20 mark, no clear evidence of the level of sales under this mark alone.

### **Comparison of trade marks**

69. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel* (particularly paragraph 23). *Sabel* also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *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”.

70. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the marks. Due weight must be given to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

<b>Earlier marks</b>	<b>Contested mark</b>
EB20  EB24	EB25

71. The applicant submits that there is no more than a moderate degree of similarity between the marks; the opponent claims that they are highly similar.

72. The overall impression of the earlier marks will be of the wholes “EB20” and “EB24”. For the reasons I have already given, the balance of distinctiveness is slightly in favour of the letters “EB”.

73. The overall impression of the contested mark is also contained in the whole combination “EB25”. I see no reason why the numbers in this mark would not also be

perceived as potentially indicating a product number or its place in a range and, therefore, the balance of distinctiveness in this mark also tends towards the letters.

74. Visually, both earlier marks and the contested mark feature the letters “EB” and the number “2” as their first, second and third characters, respectively. The final character, namely “0”, “4” or “5”, is different. The respective marks are visually similar to a high degree.

75. As the numbers are not clearly divided from the letters, nor are the numbers obviously wholly descriptive, the marks are likely to be pronounced in their entirety. The letters are likely to be pronounced conventionally as “EE-BEE”. It is possible that there may be some variation in the pronunciation of the numbers: for example, the numbers in “EB20” may be articulated as “TWO-ZERO”, “TWO-OH”, “TWO-NOUGHT” or “TWENTY”. Similar variations are possible for “EB24” and “EB25”. Whichever pronunciation is used for one mark is likely to be used for the other. Where the numbers are pronounced as single digits, the final syllable will differ (the final two if the articulation of “20” is “TWO-ZERO”) whilst the remaining syllables in the marks will be identical. Where they are not, “EB20” will be four syllables, whilst “EB24” and “EB25” will be five. The level of aural similarity between the marks will, in any of these scenarios, be high.

76. Conceptually, the letters “EB” have no meaning beyond the fact that they are the same two letters in the alphabet. That is how they are likely to be perceived. The numbers in the marks are also likely to be perceived just as numbers: I do not consider that the potential reference to a product range is strong enough to convey a clear concept. As neither mark has a distinct meaning, other than as a combination of letters and numbers, the conceptual position is neutral.

### **Likelihood of confusion**

77. In determining whether there is a likelihood of confusion, all of the above factors need to be borne in mind. They must be considered globally (*Sabel* at [22]), from the

perspective of the average consumer. In making my assessment, I must keep in mind 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 (*Lloyd Schuhfabrik* at [26]). The factors considered above have a degree of interdependency (*Canon* at [17]): for example, 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.

78. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, where Iain Purvis Q.C. explained that:

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

79. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls another mark to mind. This is mere association not indirect confusion.

80. As there is no material difference between the issues whichever earlier mark is considered, I will take them together. There is a high degree of both visual and aural similarity between the earlier trade marks and the contested mark. Further, the difference that there is falls at the end of the respective marks and it is easy to envisage an average consumer misremembering the precise number. That would point towards a likelihood of confusion. However, in this case the goods are similar to no more than a low degree. Indeed, the similarity between the goods is so low that my primary finding is that they are not similar at all. The medium level of distinctiveness of the earlier marks, the similarities between the earlier and contested trade marks and the absence of a clear conceptual difference are insufficient, in my view, to bridge the gap between the respective goods, particularly in a marketplace where there is no reason to believe that the average consumer has been conditioned to expect putties, fillers or sealants to be manufactured by the same entities and where there is no evidence to show that it is either normal or would be a reasonable extension of a party's business to do so. There is no likelihood of direct confusion. The low degree of similarity between the goods also causes me to conclude, for the same reasons as above, that, notwithstanding the other factors in favour of the opponent, the average consumer, having correctly remembered one mark and noticed the difference between that mark and the other, is unlikely to think that the marks are variants or brand extensions used by the same undertaking. I have considered whether there is a likelihood of indirect confusion in the sense that the low degree of similarity between the goods might suggest to the average consumer an arrangement between companies to produce goods which are to be used in conjunction under similar brands. In the absence of any evidence that such arrangements exist, or are likely to exist, between companies operating in different market sectors, I do not think that this is likely and I also reject the opposition on that basis.

#### Final remarks under s. 5(2)(b)

81. Mr Mansfield made much of the existence of other similar trade marks used by the opponent (e.g. EB16), none of which has been pleaded. It is not, in a case under s. 5(2)(b), appropriate to take into account the existence of trade marks which have not been

pleaded as a basis of the opposition.<sup>31</sup> Had the opponent wished to rely on a family of marks argument, it ought to have made such a claim clear and pleaded all of the marks on which it based its case. In the present case, only two marks are relied upon and two trade marks do not a family make. This line of argument is dismissed accordingly.

### **Conclusion**

82. The opposition has failed. The application will proceed to registration.

### **Costs**

83. The applicant has been successful and is entitled to an award of costs. I see no reason to depart from the normal Registry scale, contained in Tribunal Practice Notice 2/2016. I award costs to the applicant as follows:

Considering the notice of opposition and filing the counterstatement:	£300
Filing evidence and considering the other party's evidence	£600
Written submissions in lieu of a hearing:	£300
<b>Total:</b>	<b>£1,200</b>

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<sup>31</sup> *Les Éditions Albert René Sàrl v OHIM*, Case C-16/06P EU:C:2008:739, particularly paragraphs 100-101. On the “family of marks” issue, see *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06 EU:C:2007:514.



84. I order Clement Windows Limited to pay Everbuild Building Products Limited the sum of **£1,200**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 14th day of January 2021**

**Heather Harrison**

**For the Registrar**

**The Comptroller-General**

## ANNEXE

### **UK 3395477: specification**

Class 1: Chemicals for use in industry; unprocessed artificial resins; unprocessed plastics; tempering and soldering preparations; adhesives for use in industry; putties; paste fillers; cement oil; synthetic putty; chemical substances for use as bonding agents; white spirit; solvents; absorbents for cleaning solvents; chemicals for use in removing paint; lime; sand.

Class 2: Paints, varnishes; lacquers; coating compositions, preservatives against rust and against deterioration of wood; anti-corrosives; enamels, painters' colours, distempers, lacquers, paint and varnish driers, wood preservatives, wood stains, anti-corrosive, and anti-fouling compositions, and anti-corrosive oils; decorative spray coatings, namely cobwebbing; floor lacquers and finishes; metals in foil and powder form for use in painting and decorating; primers.

Class 3: Cleaning, polishing, scouring and abrasive preparations and substances; solvents for removing paints and varnishes; solvent cleaners for household use; solvent cleaning preparations; alcoholic solvents being cleaning preparations; paint stripper and remover; environmentally and eco friendly solvent cleaning preparations; cleaning preparations for the treatment of floors; waxes and wax preparations for the treatment of floors.

Class 4: Industrial oils and greases; wax; coating oils; wetting and binding compositions.

Class 7: Machine tools; power operated tools; machines and apparatus for the application of adhesives.

Class 16: Brushes, pads, rollers and applicators, all for the application of paints, preservatives and decorating substances; painting and decorating applicators; paint trays and containers; painting and decorating applicators; stencils; stationery and printed

matter; instructional and teaching materials; adhesives; adhesive tapes; rolls of paper for wiping glass; cardboard display stands; self-adhesive tapes; adhesive tapes of cloth and of fiber glass; adhesive tapes for household and office use; adhesive tape dispensers; plastic sheets, films and bags.

Class 17: Polyurethane foams, expanded foams, foams and fillers for insulating and sealing purposes; Packings and stoppings (in the nature of packings); sealing compounds and plastics; insulating materials; insulating dyes and varnishes; insulating compounds in liquid, paste, foam-like, powdered, sprayable and/or extrudable form; sealing and insulation material; membranes made of plastic (semi-manufactured products); water proofing membranes; injection moulding products made of plastic; packing, stopping and insulating materials; sealants, sealing putty; masking tape.

Class 19: Filler, sealing compounds and coatings containing plastic for building purposes; plastic tempered mortar; assembly compounds in liquid, paste, foam-like, powdered, sprayable and/or extrudable form for building purposes.