

**O/426/21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003447976**

**BY PREST-O-FIT MFG. INC.**

**TO REGISTER THE TRADE MARK:**

**HOUSE HOME  MORE**

**IN CLASS 35**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 419250**

**BY OGALAS UNLIMITED COMPANY**

## BACKGROUND AND PLEADINGS

1. On 29 November 2019, PREST-O-FIT MFG. INC. (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on the 6 December 2019. The applicant seeks registration for the following services<sup>1</sup>:

Class 35      On-line retail store services in relation to indoor and outdoor rugs, indoor and outdoor carpets, stair treads, step rugs, door mats, patio rugs, RV indoor rugs, bathroom mats, kitchen mats, hall runners, welcome mats, outdoor runners and artificial turf.

2. The application was opposed by OGALAS UNLIMITED COMPANY (“the opponent”) on 27 January 2020. The opposition is based upon sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under section 5(2)(b) the opponent relies on the following trade mark:

## HOME STORE AND MORE

EUTM registration no. 017302811<sup>2</sup>

Filing date 6 October 2017; registration date 16 February 2018

Relying upon all services for which the earlier mark is registered, namely:

Class 35      Retail services connected with the sale of household, health and beauty and electrical goods namely towels, lighting, bedding, bathroom products, cookware, tableware, home décor, cutlery, cleaning products and kitchen products.

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<sup>1</sup> Amendments to the specification were made following the filing of a Form TM21B on 6 November 2020

<sup>2</sup> Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/2020 for further information.

3. Under section 5(2)(b) the opponent claims that there is a likelihood of confusion because the parties' respective trade marks are visually, aurally and conceptually similar, with similar services.

4. Under section 5(4)(a), the opponent relies upon the sign **HOME STORE AND MORE** which it claims to have used throughout the UK since 6 April 2018 in relation to "retail services connected with the sale of household, health and beauty and electrical goods namely towels, lighting, bedding, bathroom products, cookware, tableware, home décor, cutlery, cleaning products and kitchen products".

5. The applicant filed a counterstatement denying the claims made.

6. The opponent is represented by Acuatus Limited and the applicant is represented by Tomkins & Co. Both parties filed evidence in chief. Neither party requested a hearing, but both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

## **EVIDENCE AND SUBMISSIONS**

### **The Opponent's Evidence**

8. The opponent filed evidence in chief in the form of the witness statement of Tristan Geoghegan dated 7 September 2020. Mr Geoghegan is the Chief Financial Officer for the opponent. Mr Geoghegan's statement was accompanied by 33 exhibits.

9. The opponent has submitted the following evidence:

- a) **Exhibit TG1** is a copy of the European Union Trade Mark registration for the mark 017302811 HOME STORE AND MORE.
  
- b) **Exhibit TG2** is a copy of the Irish Times article dated 6 June 2007 on 'Homestore and More plans 12 new stores'. The article details their 2 year €10 million expansion programme to open 12 new stores throughout Ireland including Limerick, Fonthill Retail Park in Clondalkin, Cork, Waterford and south Dublin.
  
- c) **Exhibit TG3** is a copy of the Independent.ie article dated 1 May 2013 on 'Home Retail sells Homestore+More for €13m'. The article details the sale to Ogalas, who paid €11.5 million, with a £1.2 million loan repayment for Homestore+More which operates 13 outlets in Ireland. It also reports that Homestore+More generated a turnover of €40.6 million in the year to the end of January 2012, with the year before generating €30.5 million.
  
- d) **Exhibit TG4** are screenshots from the opponent's UK website showing the different categories of products that they offer including bedroom décor, kitchen accessories, cleaning products, laundry products, pet products, bakeware, bed linen and cookware.
  
- e) **Exhibit TG5** is a screenshot from the opponent's UK website detailing the new store opening in April 2018 in Craigleith Retail Park store in Edinburgh.
  
- f) **Exhibit TG6** is a screenshot of google analytics showing the views from the opponent's UK website from the 23 April 2018 to 13 July 2020.
  
- g) **Exhibit TG7** is a PowerPoint presentation detailing their marketing strategy for the Craigleith branch including a soft launch marketing campaign with door drops, local radio advertising, specifically on Radio Forth, and geo-targeted social media. It also details a new website for the UK market going live in mid-April, newsletter sign-ups for customers via their website and it includes screenshots of the magazines and signs for the store which advertise their rattan garden furniture, gazebos, towels and candles.

- h) **Exhibit TG8** is a screenshot of a Facebook post from 'homestore and more' Facebook profile from 3 April 2018 detailing the opening of the Craigleith store.
- i) **Exhibit TG9** is a screenshot of a Facebook post from 'homestore and more' Facebook profile from 6 April 2018 detailing the opening of the Craigleith store.
- j) **Exhibit TG10** is a screenshot of a Facebook post from 'homestore and more' Facebook profile from 25 June 2018 detailing the opening of the East Kilbride store.
- k) **Exhibit TG11** is a screenshot of a Facebook post from 'homestore and more' Facebook profile from 29 June 2018 detailing the opening of the East Kilbride store.
- l) **Exhibit TG12** is a copy of the Edinburgh Evening News article dated 19 April 2018 on 'Home Store + More opens its doors in Craigleith', its first UK retail store.
- m) **Exhibit TG13** is a copy of an invoice, dated 6 April 2018, of the first recorded sales in the Craigleith Store totalling £79.94. This was in relation to the following goods:
- a. Cookware set
  - b. Lunch boxes
  - c. Oven cleaner
  - d. Water bottles
  - e. Microfiber cloths
  - f. Air fresheners
  - g. Reed diffusers
  - h. Oven sponge
- n) **Exhibit TG14** are 22 statements for google advertising. Mr Geoghegan states they have spent over £93,000 on google advertisements in relation to the UK market and creation of brand awareness.

- o) **Exhibits TG15, TG16 and TG17** are all spreadsheets relating to transmission times for Radio Forth for an advertising campaign broadcast in May and June 2018 to advertise their Edinburgh and East Kilbride Stores. The cost of the advertising was £5,534.00, £5,445.000 and £10,261.00.
- p) **Exhibits TG18 and TG19** are radio advertisements for HOME STORE AND MORE, advertising their monthly low price deals on rattan garden furniture, gazebos and towels in their Craigleith store. Both adverts say, "this April" and Mr Geoghegan confirms that the TG19 advertisement was in May 2018.
- q) **Exhibit TG20** is a radio advertisement for HOME STORE AND MORE's advertising the opening of the Craigleith store and three low price offers for swing chairs, water fountains and lightweight duvets which is only available until the 30 June. Mr Geoghegan confirms that this is for the year 2018.
- r) **Exhibit TG21** is a copy of a promotional leaflet which is dated May 2018 which sets out the offers which are available in the Craigleith store advertising the following goods:
- a. BBQ's and chimeneas
  - b. BBQ accessories
  - c. Gazebo
  - d. Lightweight luggage
  - e. Bed linen/duvet covers/bedding/pillows
  - f. Curtains
  - g. Photo frames
  - h. Outdoor wall and garden art
  - i. Outdoor plates, cutlery, bunting and cooler bags
  - j. Water bottles
  - k. Gin glasses
  - l. Kitchen utensils

- s) **Exhibit TG22** is a copy of a Whistle (Doordrop Media) Ltd invoice dated 18 April 2018 depicting costs of £4,666.08. Mr Geoghegan states that this invoice is for leaflet drops. The quantity ordered on the invoice was 60,567.
- t) **Exhibit TG23** is a copy of a Whistle (Doordrop Media) Ltd invoice dated 17 May 2018 depicting costs of £4,784.34. Mr Geoghegan states that this invoice is for leaflet drops. The quantity ordered on the invoice was 62,102.
- u) **Exhibit TG24** is a copy of a Phoenix Outdoor Advertising Limited invoice dated 1 May 2018 for Advertising and producing posters costing £10,800.00. Mr Geoghegan states that the posters printed by Phoenix Outdoor Advertising Limited were erected in East Kilbride in June and July 2018.
- v) **Exhibit TG25** is a photo of one of the posters printed by Phoenix Outdoor Advertising Limited, confirmed by Mr Geoghegan. It depicts a bin 'now £39.99' with the Home Store + More logo at the bottom. This is undated, and no description as to the location of this poster has been provided.
- w) **Exhibit TG26** is a spreadsheet of the planned transmission time for the opponent's Scottish TV adverts from the 14 October to 3 November 2019 and the 18 November to the 8 December 2019. The total media cost for the Craigleith and East Kilbride adverts amounted to £25,093.28. Clearly, part of these costs relate to the period after the relevant date.
- x) **Exhibit TG27** is a spreadsheet of the planned transmission time for their Scottish TV adverts for Christmas 2019. The total media cost for the Craigleith and East Kilbride adverts amounted to £14,826.59. However, these costs relate to the period after the relevant date.
- y) **Exhibit TG28** contains the following undated TV advertisements:
  - a. An advertisement showing the Craigleith store presented by the Assistant Manager showcasing their bedding, dining, utility, bathroom departments and products. This is undated.

- b. An advertisement showing the East Kilbride store presented by the Store Manager showcasing their bedding, dining, utility, bathroom departments and products. This is undated.
  - c. A Christmas advertisement for the East Kilbride store showing the short story of the 'Christmas Drummer Boy'. This is undated.
  - d. A Christmas advertisement promoting half price Christmas lights, with the offer ending on the 24 December 2019 at Craigmyle Retail Park.
- z) **Exhibit TG29** shows the annual turnover of £10,302,514.26 in HOME STORE AND MORE's UK stores with the sale of 2,187,500 units of stock, since their opening on the 6 April 2018. This is dated from the 1 March 2018 to the 31 July 2020. Clearly, part of these sales relate to the period after the relevant date.
- aa) **Exhibit TG30** is a screenshot of the Home Store and More followers on Facebook. A clear number is not depicted, but it is somewhere between 300,000-350,000. Mr Geoghegan dates the screenshot at 10 August 2020. Clearly, this relates to the period after the relevant date.
- bb) **Exhibit TG31** is a spreadsheet of Home Store and More's YouTube videos and their views. These are all undated.
- cc) **Exhibit TG32** is a copy of an article from irishexaminer.com dated 25 June 2017 discussing HOME STORE and MORE's new Christmas advert.
- dd) **Exhibit TG33** is a screenshot from YouTube of the viewing figures of a particular video called 'The Reunion' from 24 April 2019 on Home Store + More's YouTube page. From 24 April to 9 August 2020, the total views on the video were 219,797. Mr Geoghegan confirms that the viewing figures exceeded 8,000 people in the period of April 2019. I have not been provided any context for the video, if the mark was used or if any of the opponent's services were advertised.



10. The opponent filed a second witness statement of Tristan Geoghegan dated 25 February 2021. This was accompanied by 8 exhibits:

a) **2TG1** is a spreadsheet which summarises the sales made in all 4 UK retail stores by product line in Home Store and More stores in week 30 of 2011 totalling £133,090. This breaks down the number of product sales within the following departments:

- a. Bathroom accessories
- b. Bathroom textiles
- c. Bedlinen
- d. Cookware
- e. Curtains and blinds
- f. Filled bedding
- g. Home furnishings
- h. Kitchen
- i. Laundry and cleaning
- j. Personal care
- k. Rugs and mats
- l. SDA
- m. Seasonal
- n. Storage
- o. Table top and tableware

b) **2TG2** is a spreadsheet listing the top 200 products being sold in the 4 UK retail Home Store and More stores in week 32 of 2011. This is broken down into the following categories:

- a. Filled bedding
- b. Bed linen
- c. Storage
- d. Rugs and mats
- e. Home furnishings
- f. Kitchen
- g. Bathroom accessories
- h. Laundry and cleaning

- i. Bathroom textiles
  - j. Cookware
  - k. Table top and tableware
  - l. Personal care
  - m. Curtains and blinds
- c) **2TG3** is a redacted copy of the sales and purchase and repayment agreement of Home Store and More from Home Retail Group (UK) Limited (the seller) to Karumpa Limited (the purchaser) and Ogalas Unlimited Company (the company) dated 1 February 2013. The agreement shows that the seller has agreed to sell Home Store and More to the company who was also assigned its intellectual property rights; *“The seller agrees to: (i) assign to the Company, with effect from the Closing Date, such right title and interest as it holds in or to any intellectual property rights subsisting in the Home Retail Modified Brand [...] the seller shall assign to the Company the Home Retail Modified Trade Marks [...] The seller hereby assigns to the Company such right, title and interest as it holds in or to any unregistered intellectual property right subsisting in the Home Retail Modified Brand.”*
- d) **2TG4** is a map of Ireland, with 10 Home Store and More stores pinpointed in the Republic of Ireland. This falls outside the relevant territory for my assessment of enhanced distinctiveness and passing off. However, Mr Geoghegan submits that as a result of store locations not being far from the Northern Irish boarder, a consequence is a spill-over of advertising in media such as the television station TG4.
- e) **2TG5** is a screenshot of an unknown website which lists TG4, an Irish television channel, available to watch in the UK using analogue, DAB (for radio), Freeview, Sky No Card and Freesat. This screenshot is undated.
- f) **2TG6** is a screenshot from the opponent’s website of the index page for ‘Home Décor’ which includes candles, wall décor, floor décor including door mats floor accessories and rugs, lighting & fans and faux flowers. This screenshot is undated.

- g) **2TG7** is a blurred screenshot, of the floor décor page showing 37 products which include rugs, mats and rug grippers under this category. This screenshot is undated.
- h) **2TG8** is a copy of a UK website sales report for Home Store and More, dated the 1 March 2018 to 31 January 2021. The total sales is £133,557.00. This breaks down the number of product sales within the following departments:
- a. Bathroom
  - b. Bedding
  - c. Candles
  - d. Cleaning
  - e. Cookware
  - f. Curtains
  - g. Filled begging
  - h. Floor décor
  - i. Furniture and storage
  - j. Impulse
  - k. Kitchen
  - l. Kitchen textiles & table décor
  - m. Laundry
  - n. Miscellaneous
  - o. Plunder
  - p. Seasonal
  - q. Tabletop
  - r. Wall décor

11. That concludes my summary of the opponent's evidence insofar as I consider it necessary.

### **The Applicant's Evidence**

12. The applicant filed evidence in chief in the form of the witness statement of Richard H. Prest dated 16 December 2020. Mr Prest is the President of Prest-O-Fit MFG. Inc. Mr Prest's statement was accompanied by 5 annexes:

- a) **Annex 1** is a series of 22 screenshots from the applicant's website depicting the rugs, outdoor carpets, outdoor mats and stair treads that they sell. The last screenshot includes two five-star reviews on their website for their carpets dated 31 May 2015 and 5 October 2017.
- b) **Annex 2** is a copy of a certificate for registration for value added tax from HM Revenue and Customs addressed to Prest-O-Fit to confirm that they are registered for VAT. The certificate was issued on the 20 May 2014.
- c) **Annex 3** is comprised of 2 screenshots from an Amazon page. The screenshot is of 'House, Home and More- Skid-resistant carpet for the indoor area rug floor mat – ivory cream'. Some of the screenshot was difficult to read and therefore I was unable to determine the circled date and the Amazon seller. However, I was able to read a review which is dated 17 January 2014.
- d) **Annex 4** is comprised of multiple screenshots of the following:
- a. Screenshots of a green House, Home and More outdoor turf rug priced at £224.14 (screenshot taken on 26 October 2020). The additional information stated that the date whereby the product was first available was the 23 July 2014. Reviews for this product are also attached with dates varying from 2017 to 2018.
  - b. Screenshots of a navy mat, displaying the mark House, Home and More priced at £43.52. Date first available 10 March 2016.
  - c. Screenshots of a House, Home and More skid resistant carpet, priced at £30.68. Date first available 30 January 2014.
  - d. Screenshots of a House, Home and More, black ripple carpet priced at £58.31. Date first available 29 January 2014.
  - e. Screenshots of a House, Home and More, black carpet priced at £52.80. Date first available 29 January 2014.

- f. Screenshots of a House, Home and More, set of 12 attachable indoor carpet stair treads priced at £157.33. Date first available 29 January 2014.
- g. Screenshots of a House, Home and More, set of 15 skid resistant carpet stair treads priced at £157.61. Date first available 10 March 2016.
- h. Screenshots of a House, Home and More outdoor carpet runner in blue priced at £77.78. Date first available 23 July 2015.
- i. Screenshots of a House, Home and More outdoor carpet runner in black priced at £104.76. Date first available 14 September 2017.
- j. Screenshots of a House, Home and More skid resistant heavy-duty door mat in Tuscan brown priced at £34.38. Date first available 16 January 2018.
- k. Screenshots of a House, Home and More skid resistant heavy-duty door mat in stormy blue priced at £40.38. Date first available 16 January 2018.
- l. Screenshots of a House, Home and More skid resistant double ribbed carpet stair treads priced at £116.17. Date first available 7 March 2018.
- m. Screenshots of a House, Home and More set of 12 skid resistant double ribbed carpet stair treads priced at £107.86. Date first available 6 March 2018.
- n. Screenshots of a House, Home and More outdoor turf rug in green priced at £224.14. Date first available 23 July 2014, plus customer reviews dated 29 July 2018, 21 June 2017, 2 August 2018, 5 October 2017 and 27 April 2020.

- o. Screenshots of a House, Home and More outdoor turf rug in grey priced at £100.12. Date first available 7 February 2014.

e) **Annex 5** is a copy of sales from Amazon. The following is detailed:

- a. One purchase on the 7 November 2020 to Newcastle Upon Tyne.
- b. One purchase on the 6 October 2019 to Kingston Upon Thames.
- c. One purchase on the 12 September 2018 to Nether Alderley.
- d. One purchase on the 22 August 2018 to Dunton Green.

13. That concludes my summary of the applicant's evidence insofar as I consider it necessary.

### **PRELIMINARY ISSUES**

14. In its submissions in lieu, the applicant made a point that I intend to address as a preliminary issue. They submitted the following:

"[...] The opponent is now trying to introduce new evidence into these proceedings at a state in the proceedings where they are limited to filing a response to the Applicant's evidence.

[...]

We would request that the information and statements relating to the claimed use of the mark of the Opponent in 2011-2012 by a third party is not taken into account in these proceedings."

15. I consider that the evidence was filed in response to the applicant's evidence of prior use in the witness statement of Mr Prest. The opponent was entitled and well within their right to respond to the applicant's submissions. However, I will deal with the relevance of this evidence and its relationship with the opponent's pleadings, below.

## DECISION

### Section 5(2)(b)

16. Section 5(2)(b) reads as follows:

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

(a)...

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

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

17. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of IR for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b) subject to its being so registered.”

18. The trade mark upon which the opponent relies qualifies as an earlier trade mark because it was applied for at an earlier date than the applicant's mark pursuant to section 6 of the Act. As the opponent's mark had not completed its registration process more than 5 years before the filing date of the application in issue, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the services it has identified.

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

19. The following principles 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:

- (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 services**

20. The competing services are as follows:

Opponent's services	Applicant's services
<p><u>Class 35</u></p> <p>Retail services connected with the sale of household, health and beauty and electrical goods namely towels, lighting, bedding, bathroom products, cookware, tableware, home décor, cutlery, cleaning products and kitchen products.</p>	<p><u>Class 35</u></p> <p>On-line retail store services in relation to indoor and outdoor rugs, indoor and outdoor carpets, stair treads, step rugs, door mats, patio rugs, RV indoor rugs, bathroom mats, kitchen mats, hall runners, welcome mats, outdoor runners and artificial turf.</p>

21. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“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 for 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.”

22. Guidance on this issue has come from Jacob J. (as he then was) in 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

23. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

24. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

25. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as the then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

26. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization 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 the responsibility for those goods lies with the same undertaking.”

27. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. 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-0-255-13:

“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.”

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.”

28. In making my assessment, I note that the Tribunal Manual states that specifications which include the wording ‘namely’ should be interpreted as covering only the named services within that specification. Therefore, the specification is limited to only those services.

29. The applicant, in their written submissions, highlights that for comparison purposes, consideration of the actual services for which the mark is applied for/registered should be made. However, the applicant proceeds to submit that their services are sold “online through Amazon and other online sites”, whereas, the opponent’s services are sold through a physical store, which would allow the consumer to “distinguish the goods sold by the Applicant from the goods of the Opponent”. The former submission is the correct one. I have to carry out notional assessment based upon the ways in which the services covered by the respective specifications could be used and sold. The way in which they are used and sold in practice is not relevant to my assessment. Both the opponent’s and applicant’s specifications are retail services which both fall within class 35. The applicant’s specification is solely in relation to on-line retail store services. However, as there has been no limitation imposed on the opponent’s services, I consider that the specification covers both retail services in store and on-line.

30. “On-line retail store services in relation to indoor [...] rugs, indoor [...] carpets, stair treads, step rugs, door mats, [...] RV indoor rugs [...] hall runners” in the applicant’s specification falls within the broader category of “retail services connected with the sale of household, health and beauty and electrical goods namely [...] home décor” in the opponent’s specification. I consider them identical on the principle outlined in *Meric*. Even if I am wrong in this finding, the services will overlap in trade channels, users, method of use, nature and purpose. I consider that they will be highly similar.

31. “On-line retail store services in relation to [...] bathroom mats” in the applicant’s specification falls within the broader category of “retail services connected with the sale of household, health and beauty and electrical goods namely [...] bathroom products [...] home décor” in the opponent’s specification. I consider them identical on the principle outlined in *Meric*.

32. “On-line retail store services in relation to [...] kitchen mats” in the applicant’s specification falls within the broader category of “retail services connected with the sale of household, health and beauty and electrical goods namely [...] home décor [...] kitchen products” in the opponent’s specification. I consider them identical on the principle outlined in *Meric*.

33. “On-line retail store services in relation to [...] outdoor rugs, [...] outdoor carpets, [...] patio rugs, [...] welcome mats, outdoor runners [...]” in the applicant’s specification overlaps with “retail services connected with the sale of household, health and beauty and electrical goods namely [...] home décor” in the opponent’s specification. Both are retail services, which sell similar goods, and therefore they overlap in nature, method of use and user. However, their purpose differs because the applicant is retailing rugs, mats and outdoor runners which are for the outside, whereas, the opponent is retailing goods which are used inside the home. They will also overlap in user as they will all be used by the general public. I consider that there may be an overlap in trade channels as both are likely to be sold through the same undertakings such as general home stores. I do not consider the services to be complementary, nor in competition. Taking the above into account, I consider the services to be similar to a high degree.

34. That leaves “retail services connected with the sale of household, health and beauty and electrical goods namely [...] artificial turf” in the opponent’s specification. I consider this to overlap with the nature of the applicant’s services because they are both retail services which relate to goods which can be used in/around someone’s property. They overlap in method of use because you can shop online for both. They overlap in purpose because both are retail services which allow you to purchase goods, albeit, they are selling goods which would be used in different parts of the home or garden. I consider that they overlap in user. However, in the absence of any evidence to the contrary, I see no reason for there to be an overlap in trade channels.

I do not consider the services to be complementary, nor in competition. Taking the above into account, I consider the services to be similar to a medium degree.

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

35. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which the services are likely to be selected by the average consumer. 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.”

36. The average consumer for the services will be members of the general public. The cost of purchase is likely to be relatively low and the frequency is likely to vary. The average consumer will take various factors into consideration such as the location, ease of access, availability of products and the range of products on offer. Therefore, the level of attention paid during the purchasing process will be medium.

37. The services are likely to be selected from websites, advertisements and signs on a physical outlet. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase through advice sought from a sales assistant or through word-of-mouth recommendations.


## Comparison of the trade marks

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

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

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

40. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade marks
HOME STORE AND MORE	 The applicant's trade mark consists of the words "HOUSE HOME" in a grey sans-serif font, followed by a red icon of a house with a white outline, and the word "MORE" in the same grey font. The entire mark is set against a light grey rectangular background.



41. The opponent's mark consists of the words HOME STORE AND MORE presented in upper-case. The overall impression of the mark lies in the combination of these words.

42. The applicant's mark consists of the words HOUSE, HOME, MORE. Between HOME and MORE sits a pentagon device, filled in orange, housing an ampersand. I consider that the overall impression lies in the combination of these elements.

43. Visually, as submitted by the applicant, the marks coincide in the presence of the words HOME and MORE. HOME is the first word of the opponent's mark and the second word of the applicant's mark, with MORE appearing at the end of both marks. The presence of these words all act as visual points of similarity. However, the opponent's mark contains the words STORE and AND, which have no counterpart in the applicant's mark. The applicant's mark contains the word HOUSE, the ampersand and the orange pentagon device which all have no counterpart in the opponent's mark. These act as visual points of difference. Taking the above into account, I consider the marks to be visually similar to between a low and medium degree.

44. The words HOME and MORE will be pronounced identically in both marks. The word HOUSE in the applicant's mark creates an aural differentiation between the marks. The word STORE in the opponent's mark also creates an aural differentiation between the marks. The rhyming of STORE and MORE in the opponent's mark, which has no counterpart in the applicant's mark, also creates another point of aural difference. The ampersand in the applicant's mark will be pronounced identically to the word AND in the opponent's mark. I consider the marks to be aurally similar to a medium degree.

45. Conceptually, the HOME word element in both the applicant's and opponent's marks will be given its ordinary dictionary meaning of the house or flat where someone lives.<sup>3</sup> This concept overlaps with the applicant's mark which contains both the word HOME and HOUSE (which will also be given its ordinary dictionary meaning of 'a

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<sup>3</sup> <https://www.collinsdictionary.com/dictionary/english/home>

building in which people live’).<sup>4</sup> The orange pentagon device in the applicant’s mark may be viewed as a silhouette of a house, given the words that it appears beside. If that is the case, then it will reinforce both of these concepts. If it is not recognised as a house, then it will convey no clear meaning. The word MORE in the applicant’s and opponent’s marks will be given its ordinary dictionary meaning, which will be identical for both marks. The marks overlap conceptually, therefore, to the extent that they both refer to the concept of HOME and the offering of MORE. I recognise that the word STORE in the opponent’s mark has no counterpart in the applicant’s mark. However, the impact of this is likely to be reduced given the services in issue. I consider that there is at least a medium degree of conceptual similarity between the marks.

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

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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 promotion of the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or

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<sup>4</sup> <https://www.collinsdictionary.com/dictionary/english/house>

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).”

47. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

48. The opponent has filed evidence to demonstrate that the mark has acquired enhanced distinctive character through use. The relevant market for assessing this is the UK market. In Mr Geoghegan’s second witness statement, he submits that between 2011 and 2012 The Home Retail Group operated under the name of Home Store and More, which had 4 outlets located in UK in the locations of Harlow, Cambridge, Aylesbury and Abingdon. Exhibit 2TG1 provides a spreadsheet summarising the sales of week 30 in 2011 for each of the 4 stores, by product type, with the majority of these sales relating to the goods for which the services are applied for. Between 2011 and 2012, whilst operating within the UK, the opponent submits that Home Store and More had a gross revenue of £7,169,275.

49. Mr Geoghegan’s first witness statement submits that in February 2013, The Home Retail Group sold Home Store and More’s brand, goodwill and reputation, which was acquired by the opponent. This is supported by the redacted sales agreement of Home Store and More to the opponent’s company.<sup>5</sup> Home Store and More then re-entered the UK market, under the opponent’s company Ogalas Unlimited Company in April 2018. The period of 2011 to 2012, and the 19 months of use from April 2018 to the relevant date only amounts to 2 years and 7 months of total use. The opponent currently has 22 outlets in the Republic of Ireland and 2 outlets located in Scotland. The Republic of Ireland falls outside of the relevant UK market. Therefore, with only 2 outlets located in Scotland, and the previous 4 outlets all located in the South of England, the geographical spread of use in the UK has been limited. Sales figures

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<sup>5</sup> Exhibit 2TG3

have been provided for their 2 UK outlets, for the period of 1 March 2018 to 31 July 2020. The sales amounted to £10,302,514.26.<sup>6</sup> Sales figures for their UK website has also been provided for the period of 1 March 2018 to 31 July 2020. The sales amounted to £133,557.<sup>7</sup> Clearly, at least part of these sales relate to the period after the relevant date. Although I have no evidence as to the extent of the home retail market for the UK, the sales demonstrated by the opponent (even assuming that a significant part of the sales listed related to the period prior to the relevant date), whilst not insignificant, are unlikely to represent a significant share of what is undoubtedly a significant market.

50. The opponent's evidence confirms that it has approximately spent €1.1 million on advertising in all media in the UK since its launch in 2018, with £93,000 spent on Google advertisements. However, I note that not all of this would relate to the period prior to the relevant date. This is accompanied by exhibits of radio, TV, leaflet and poster advertisements. The opponent spent £21,240 on Radio Forth advertising in May to June 2018 to advertise their Edinburgh and East Kilbride stores.<sup>8</sup> Examples of these radio advertisements were provided by the opponent.<sup>9</sup> I note that the radio advertisements submitted by the opponent refer to 'this April' which differs from the narrative evidence that these files are in relation to the Radio Forth advertising campaign in May and June 2018 and the Bauer campaign broadcast in July 2018. However, I have no reason to doubt that these advertisements are in relation to the year 2018, whether it be April, May, June or July, and they still fall prior to the relevant date. A further £10,800 was spent on advertising and producing posters which were erected in East Kilbride in June and July 2018.<sup>10</sup> However, I note that the services advertised by the opponent in their radio and leaflet advertisements are broader than those covered by the opponent's specification.<sup>11</sup> For example, they include garden furniture. I also note that the opponent's website, immediately prior the relevant date, only had 30,000 page views a month. Whilst I recognise that use of the mark has not

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<sup>6</sup> Exhibit TG29

<sup>7</sup> Exhibit 2TG8

<sup>8</sup> Exhibits TG15, TG16 and TG17

<sup>9</sup> Exhibits TG18 and TG19

<sup>10</sup> Exhibit TG24

<sup>11</sup> Exhibits TG18, TG19, TG20 and TG21

been insignificant, I do not consider that the evidence is sufficient to demonstrate that the distinctiveness of the mark has been enhanced through use.

51. I now turn to the inherent distinctiveness of the opponent's mark. The earlier mark consists of the words HOME, STORE, AND, MORE. The words HOME and STORE when taken as a whole conveys the concept of a store which sells homeware. The addition of the 'AND MORE' element suggests that there are other unidentified goods which are being sold, other than those expected to be sold in a homeware store. The earlier mark's distinctiveness, therefore, lies in the combination of all of these elements because the mark will be viewed as a whole. Overall, given the services relied upon, I consider the opponent's mark to be inherently distinctive to a low degree.

### **Likelihood of confusion**

52. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where 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 services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to 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 that he has retained in his mind.

53. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to between a low and medium degree.

- I have found the marks to be aurally similar to a medium degree.
- I have found the marks to be conceptually similar to at least a medium degree.
- I have found the earlier mark to be inherently distinctive to a low degree.
- I have identified the average consumer to be members of the general public, who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process.
- I have found the parties' services to vary from being similar to between a medium degree to identical.

54. Taking all of the factors listed in paragraph 53 into account, particularly the visual and aural differences between the marks, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other, notwithstanding the principle of imperfect recollection. I do not consider that the different beginnings of the marks, HOUSE HOME in the applicant's mark and HOME STORE in the opponent's mark, will go unnoticed by the average consumer. I do not consider that the word HOUSE and the orange pentagon device in the applicant's mark will be overlooked by the average consumer. I also do not consider that the average consumer would overlook the word STORE and the memorable rhyme it creates with the word MORE in the opponent's mark, which has no counterpart in the applicant's mark. Taking the above into account, I do not consider there to be a likelihood of direct confusion.

55. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

"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.”

56. In *Deubros 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 to mind another mark. This is mere association not indirect confusion.

57. I bear in mind the decision of the CJEU in *L’Oréal SA v OHIM*, Case C-235/05 P, in which the court confirmed that weak distinctive character of the earlier trade mark does not preclude a likelihood of confusion. Further, I bear in mind the comments of Mr Iain Purvis Q.C., sitting as the Appointed Person, in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

58. In other words, it is important to ask, ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

59. Having identified the visual and aural differences between the marks, I do not consider that the average consumer would conclude that they originate from the same or economically linked undertakings. Even though the marks share the common element 'HOME' and 'AND MORE', these elements are in themselves allusive or descriptive and low in distinctiveness for the services for which the applicant's and opponent's marks are applied for/registered. The consumer would have no reason to believe that only one undertaking would use the words 'HOME' and 'AND MORE' in relation to home retail services. It is more likely to be viewed as a coincidence, rather than indicating that the marks originate from the same or economically linked undertakings. I do not, therefore, consider there to be a likelihood of indirect confusion.

60. The opposition based upon section 5(2)(b) is dismissed.

#### **Section 5(4)(a)**

61. Section 5(4)(a) of the Act states as follows:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

aa)...

b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

62. Subsection (4A) of section 5 of the Act states:



“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

63. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

### **Relevant date**

64. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of s.5(4)(a) of the Act and stated as follows:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows: ‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before

the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.”

65. The prima facie relevant date is the date of application in issue i.e. 29 November 2019. However, it is also necessary to consider what the position would have been at the start of the behaviour complained about. In this case, that date will be the date on which the applicant began using the applied-for mark in the UK. This appears to have been at some point in 2014. The applicant submitted a Certificate of Registration from HM Revenues and Customs with an effective date of the 5 May 2014, and the issue date of 20 May 2014.<sup>12</sup> The applicant also submitted a screenshot from amazon.co.uk which depicts a ‘House Home and More’ outdoor turf rug which is dated as first available on 23 July 2014.<sup>13</sup> The opponent submits in their second witness statement that the Amazon screenshot is not evidence of actual sales to consumers in the UK, however, to my mind the offering of these goods for sale could still have been an act complained about by the opponent.

66. In *CASABLANCA*, Case BL O/349/16, Mr Thomas Mitcheson Q.C. as the Appointed Person stated that:

“34. [...] The question raised by the Opponent is whether she did so correctly and how should the earlier use be taken into account. In particular, does such use, as the Opponent submitted, have to be sufficient to generate its own goodwill?”

35. I think it is clear from the remainder of §165 of the judgment of Kitchin LJ that generation of goodwill by the applicant is not required. This is because he goes on to explain that it is the opponent who must show that he had the necessary goodwill and reputation to render that use actionable on the date that it (i.e. the applicant’s use) began.”

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<sup>12</sup> Annex 2

<sup>13</sup> Annex 4

67. This case makes it clear that it is not necessary for the applicant to have actually acquired goodwill in order for there to be an earlier relevant date. As the applicant had clearly commenced the behaviour complained about by July 2014, I will assess the position at that relevant date also.

## **Goodwill**

68. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in customers. It is the one thing which distinguishes an old-established business from a new business at its first start.”

69. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; 54 evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

70. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

71. In the TM7 Form, the opponent pleaded that they had used the sign throughout the UK since 6 April 2018. However, in the opponent's second witness statement they introduce evidence of use prior this date, for the periods of 2011 to 2012. I note that there has been no application to amend their original proceedings. As highlighted previously, the applicant has been using their mark since July 2014 and, therefore, on the pleaded case the opponent has failed at the first hurdle. However, in any event, I will go on to consider what the position would have been if they had amended their pleadings.

72. The applicant submits that “the goodwill in the mark will have expired or become extinct over the next five and a half years in which there was no use of the mark and the consumer was not exposed to the mark in any form”. When a business ceases permanently or temporarily, there are some circumstances in which they can still rely

on their goodwill. I must consider whether the opponent had goodwill at each relevant date.

73. In *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pats) it was stated that:

“It is difficult to define any minimum threshold. It will all depend on the facts. How big was the reputation when use stopped? How lasting in the public eye are the goods or services to which the mark is applied? How, if at all, has the person asserting the existence of the goodwill acted in order to keep the reputation in the public eye? The greater each of these elements is, the longer, it seems to me, it will take for any goodwill to dissipate.”

74. As noted above, the opponent submits that there was trading under the HOME STORE AND MORE sign in the period of 2011 to 2012. The opponent has provided evidence of sales of week 30 in 2011 for their 4 UK stores in a spreadsheet.<sup>14</sup> A breakdown of the proportion of the figures relating to the different products sold has been provided, which relate to the retail services that the earlier right has been used for. The spreadsheet included the categories of bathroom accessories, bathroom textiles, bed linen, cookware, filled bedding, home furnishings, kitchen, rugs and mats, and table top and tableware. Units sold and cost value excluding VAT is also noted. Whilst operating in the UK during 2011 to 2012 the opponent submits that Home Store and More had a gross revenue of £7,169,275. Therefore, taking the above into account, by the end of their trading in 2012, I consider that there would have been a reasonable amount of goodwill generated in the HOME STORE AND MORE sign.

75. The period of 2012, when HOME STORE AND MORE first ceased trading, to 2014, when the applicant started the behaviour complained about, is a two year gap, and therefore, a relatively short period of time. The goods that were being sold under the services in 2011 to 2012 are long lasting homeware goods, that you would expect to be replaced relatively infrequently. Therefore, once the item would need to be re-purchased, it is likely that the consumer may expect to go back to Home Store and

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<sup>14</sup> Exhibit 2TG1

More to replace that item. Taking all of this into account, I consider that the opponent would still have had some residual goodwill by the 2014 relevant date in relation to retail services connected with the sale of household, health and beauty and electrical goods namely towels, bedding, bathroom products, cookware, tableware, home décor, cleaning products and kitchen products.

76. However, I note that there is very little evidence during this relevant period which relates to the lighting and cutlery retail services that the opponent claims to have used the sign in relation to. The only evidence provided by the opponent for the retail of lighting is a screenshot of an index page from their website, whereby under home décor, lighting and fans, bulbs and lamps were listed, which is undated.<sup>15</sup> The only evidence provided by the opponent for the retail of cutlery during this relevant period is in the opponent's spreadsheet for week 30 of 2011,<sup>16</sup> which details the sale of 'table top and tableware' goods, which could include cutlery. However, this is such a broad category which could encompass a range of goods, it is impossible to attribute a figure of sales just to cutlery itself. It is, therefore, not sufficient to show to what extent that services in relation to the retail of cutlery were sold, and under the HOME STORE AND MORE sign. I do not, therefore, consider that the opponent has demonstrated any residual goodwill in relation to these services at the earlier relevant date.

77. The opponent also provided evidence of trading for the period of 1 March 2018 to 31 July 2020. The sales made in their 2 UK outlets amounted to £10,302,514.26. The UK online sales figures for the same period amounted to £133,557. However, part of these sales were after the prima facie relevant date (29 November 2019) and the overall figures have not been broken down by product or department. However, I note that a breakdown has been provided for their online sales for departments such as bathroom, bedding, cleaning, cookware, floor décor, kitchen, kitchen textiles and table décor and tabletop.<sup>17</sup> The opponent provided figures and evidence of advertising the sign prior to the relevant date. It had approximately spent €1.1 million on advertising in all media in the UK since its launch in 2018 (although not all of this would relate to the period prior to the prima facie relevant date). £21,240 was spent on Radio Forth

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<sup>15</sup> Exhibit 2TG6

<sup>16</sup> Exhibit 2TG1

<sup>17</sup> Exhibit 2TG8

advertising in May to June 2018.<sup>18</sup> £10,800 was spent on advertising and producing posters in June and July 2018 advertising their Edinburgh and East Kilbride stores and £9,450.42 was spent on 122,669 leaflet drops in April and May 2018.<sup>19</sup> The opponent had also spent £25,093.28 on Scottish TV adverts for their Cragleith and East Kilbride stores from the 14 October to 3 November 2019 and the 18 November to the 8 December 2019.<sup>20</sup> However, part of these costs relate to the period after the prima facie relevant date. Again, I note that there is very little evidence which relates to the lighting and cutlery retail services that the opponent claims to have used the sign in relation to. As highlighted above, the undated screenshot of their index page is the only evidence of the retail of lighting. The only further evidence provided by the opponent for the retail of cutlery is a copy of a promotional leaflet which included the advertisement of outdoor cutlery which was being sold in their Cragleith store.<sup>21</sup> I do not consider the evidence to be sufficient to show to what extent that the services in relation to the retail of lighting and cutlery were sold, and under the HOME STORE AND MORE sign. Consequently, I do not consider that the opponent has demonstrated any residual goodwill in relation to these services at the prima facie relevant date.

78. Taking the evidence as a whole into account, I am satisfied that Ogalas Unlimited Company has demonstrated a modest degree of goodwill prior to both relevant dates in relation to retail services connected with the sale of household, health and beauty and electrical goods namely towels, bedding, bathroom products, cookware, tableware, home décor, cleaning products and kitchen products. Examples have been provided of the mark appearing in radio and TV advertisements, posters, social media and invoices. In light of this, I am also satisfied that the earlier sign was distinctive of the opponent's goodwill at both of the relevant dates.

## **Misrepresentation and damage**

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<sup>18</sup> Exhibits TG15, TG16 and TG17

<sup>19</sup> Exhibits TG22 and TG23

<sup>20</sup> Exhibit TG26

<sup>21</sup> Exhibit TG21

79. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

80. I recognise that the test for misrepresentation is different from that for likelihood of confusion in that it entails “deception of a substantial number of members of the public” rather than “confusion of the average consumer”. However, as recognised by Lewison L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that to be the case here.



81. Even if the opponent had pleaded goodwill from the earlier date, I consider that the differences between the marks would be sufficient to avoid misrepresentation occurring. I consider that these differences are sufficient to avoid a substantial number of members of the relevant public purchasing the applicant's services in the mistaken belief that they are provided by the opponent's business. As there is no misrepresentation, there can be no damage.

82. The opposition under section 5(4)(a) is unsuccessful.

## **CONCLUSION**

83. The opposition is unsuccessful, and the application may proceed to registration.

## **COSTS**

84. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£1,350** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the Notice of opposition and preparing a Counterstatement	£300
Preparing evidence and considering the opponent's evidence	£700
Preparing and filling written submissions in lieu	£350
<b>Total</b>	<b>£1,350</b>

85. I therefore order OGALAS UNLIMITED COMPANY to pay PREST-O-FIT MFG. INC. the sum of £1,350. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 7<sup>th</sup> day of June 2021**

**L FAYTER**

**For the Registrar**