

O/0828/25

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER UK00003968828
BY THE MOSAIC TILE CO. LTD
TO REGISTER THE FOLLOWING TRADE MARK:**



IN CLASS 19

AND

**AN OPPOSITION THERETO UNDER NUMBER OP000445770
BY ROADSTONE LIMITED**

BACKGROUND AND PLEADINGS

1. On 18 October 2023, The Mosaic Tile Co. Ltd (“the applicant”) applied to register in the UK the trade mark shown on the cover page of this decision (“the contested mark”). The application was accepted and published for opposition purposes on 10 November 2023 and registration is sought for the following goods:

Class 19 Wall and floor tiles; handmade floor and wall tiles; porcelain, ceramic, stone or mosaic tiles; marble, granite, tumbled marble, travertine marble, limestone, natural stones, terracotta, glass, Jerusalem stone, slate; building products in the nature of slate, slate tiles, quartzite.

2. On 9 February 2024, Roadstone Limited (“the opponent”) opposed the application in full under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following UK trademark:

UK00003777834, with a filing date of 14 April 2022 and a registration date of 15 July 2022.

VERONA

3. For the purposes of these proceedings, the opponent is reliant upon all of the goods for which the earlier mark is registered:

Class 19 Non-metallic building, construction and civil and structural engineering materials; road making, road marking, road coating and road repair materials; road, airport runway, race-track, playground and all weather sports surfacing materials; blocks, bricks, tiles, slates, lintels, flags, slabs, paving sets, posts, dense concrete masonry and non-metallic cladding for walls and roofs;

non-metallic building blocks; concrete blocks; masonry blocks; paving blocks; paving flags; aggregates for concrete, filling, foundations and road making; rock, stone, crushed stone, fine stone powder, pebbles, sand, gravel and slag; asphalt, tarmacadam, pitch and bitumen; natural stone, artificial and reconstituted stone; porous asphalt; polymer modified binders; concrete, ready mixed concrete, mortar, plaster, gypsum, cement and wall rendering and lining materials; non-metallic rigid pipes; swimming pools [structures, not of metal].

4. Given the filing date, the opponent's mark is an earlier mark in accordance with section 6 of the Act. However, as it had not been registered for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified within section 6A of the Act. As a consequence, the opponent may rely upon all of the goods for which the earlier mark is registered without having to establish genuine use.
5. Under section 5(2)(b), the opponent claims that the applicant's mark is visually, aurally and conceptually similar to the opponent's mark and the goods applied for in Class 19 are identical and similar to the opponent's Class 19 goods. It contends that, as a result, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the opponent's mark.
6. The applicant filed a defence and counterstatement denying the grounds of the opposition.
7. The opponent is represented by Withers & Rogers LLP and the applicant is represented by Bailey Walsh & Co LLP. Neither party filed evidence or submissions during the evidence rounds. Neither party requested a hearing nor did they file written submissions in lieu.
8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule

2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

DECISION

Section 5(2)(b)

9. Sections 5(2)(b) and 5A of the Act state:

“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.

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

Relevant law

10. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca*

Mode CV v Adidas AG & Adidas Benelux BV, Case C-425/98, Matratzen Concord GmbH v OHIM, Case C-3/03, Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.

The principles

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

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

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

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

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

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

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

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

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

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

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

Comparison of the goods

11. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the 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.”

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

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

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

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

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

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

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

13. In *Gérard Meric v OHIM*, 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 für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

14. The goods to be compared are shown in the table below:

The opponent’s goods	The applicant’s goods
Class 19 Non-metallic building, construction and civil and structural engineering materials; road making, road marking, road coating	Class 19 Wall and floor tiles; handmade floor and wall tiles; porcelain, ceramic, stone or mosaic tiles; marble, granite, tumbled

<p>and road repair materials; road, airport runway, race-track, playground and all weather sports surfacing materials; blocks, bricks, tiles, slates, lintels, flags, slabs, paving sets, posts, dense concrete masonry and non-metallic cladding for walls and roofs; non-metallic building blocks; concrete blocks; masonry blocks; paving blocks; paving flags; aggregates for concrete, filling, foundations and road making; rock, stone, crushed stone, fine stone powder, pebbles, sand, gravel and slag; asphalt, tarmacadam, pitch and bitumen; natural stone, artificial and reconstituted stone; porous asphalt; polymer modified binders; concrete, ready mixed concrete, mortar, plaster, gypsum, cement and wall rendering and lining materials; non-metallic rigid pipes; swimming pools [structures, not of metal].</p>	<p>marble, travertine marble, limestone, natural stones, terracotta, glass, Jerusalem stone, slate; building products in the nature of slate, slate tiles, quartzite.</p>
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15. In its statement of grounds, the opponent says that “the goods applied for in Class 19 are identical and similar to the Opponent's protected goods in Class 19.”

16. In its counterstatement, the applicant says that “it is admitted that the goods are similar.” Following the applicant’s admission, I consider the goods at hand to have at least a low level of similarity. Since the applicant did not specify the level of similarity for the respective goods, for the purposes of this opposition I will proceed to assess it myself as set out below.

17. The applicant's "wall and floor tiles", "handmade floor and wall tiles", "porcelain, ceramic, stone or mosaic tiles" and "building products in the nature of ... slate tiles ..." are *Meric* identical to the opponent's "... tiles ...".
18. The applicant's "marble, granite, tumbled marble, travertine marble, limestone, natural stones, ... Jerusalem stone" and "building products in the nature of ... quartzite" are *Meric* identical to the opponent's "rock ...".
19. The applicant's "... terracotta, glass, ...", "slate" and "building products in the nature of slate" are *Meric* identical to the opponent's "non-metallic building ... materials" in that terracotta and slate are used in roof tiles and glass is used in windows.

The average consumer and the purchasing act

20. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods 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 word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

21. The typical consumer of the goods at issue is likely to be a building contractor who will buy building materials in relatively large quantities and who will consider

the quality and practical utility of such materials. Price will be a factor, but the purchase of such goods will be within an expected range. Overall, I find that a medium level of attention will be paid during the purchasing process.

22. The purchasing process will be primarily a visual one, whether conducted online or at a builders' merchant. Verbal considerations will be secondary, coming into play if a query about the building materials in question needs to be voiced.


Comparison of trade marks

23. It is clear from *Sabel* 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 states 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 relevant 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.”

24. 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 trade 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.

25. The marks to be compared are as follows:

The opponent's mark	The applicant's mark
<p>VERONA</p>	

26. In its statement of grounds, the opponent says that “The Applicant's Mark is similar to the Opponent's Mark visually, aurally, and conceptually. The Applicant's Mark contains the word "Verona", which is virtually identical to the sole element of the Opponent's Mark. Although the Applicant's Mark is stylised, this has minimal value in differentiating the marks.”

27. In its counterstatement, the applicant says that “The Applicant denies the Opponent is entitled to exclusive rights in the sign VERONA in respect of class 19 goods ... In any event the Applicant denies the respective marks are similar visually, aurally, or conceptually. The Applicant's Mark contains stylisation and other distinctive elements and therefor [sic] there is no likelihood of confusion on the part of the public.”

Overall impression

28. The opponent's mark consists of the plain word “VERONA”, the overall impression made by the mark residing in the word alone.

29. The applicant's mark is a figurative one which consists of the word “GRANDE” in block capitals in grey text sitting above the capital letters “XL” in black text and right justified inside a rectangular bar which in turn sits above the capitalised words “By Verona” in grey text, the words and letters (and the rectangular bar)

being inside a larger black rectangle. The word “GRANDE” and the letters “XL” are significantly larger than the words “By Verona”, but they are lowly distinctive and so the dominance of these elements is mitigated by the more distinctive “By Verona”. The stylistic elements of the mark, being a grey bar and a black rectangle, play a very minor role in forming the overall impression.

Visual similarity

30. While both marks contain the words “VERONA”/“... Verona”, these identical words are positioned at different points within the marks and the applicant’s mark has the additional words and letters “GRANDE” and “XL” and the word “By ...” as well as some minor stylisation. I find these marks to be of low visual similarity.

Aural similarity

31. Aurally, the marks are “VE-RO-NA” versus “GRAN-DAY EX-EL Bi Ve-ro-na”. The shared word that is voiced identically “VE-RO-NA”/“Ve-ro-na” is positioned at different points within the marks and the applicant’s mark takes far longer to articulate. Overall, I find the marks to be of low aural similarity.

Conceptual similarity

32. Both marks share an identical concept derived from the word Verona, a city in Italy. However, the applicant’s mark also contains the additional word “GRANDE” and the letters “XL”, both elements giving rise to the concept of largeness. While the word “grande” is a foreign language word, the average UK consumer will understand it to mean “large”. “XL” is a widely recognised abbreviation for “extra-large”. Overall, I find these marks to be of medium conceptual similarity.

Distinctive character of the earlier mark

33. In *Lloyd Schuhfabrik Meyer* 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).”

34. 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 goods, 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.

35. Although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the opponent has not filed any evidence of use and so I have only the inherent position to consider.

36. The earlier mark consists of the word “VERONA”. “VERONA” is a city in Italy, but I do not consider that the average UK consumer will make any particular association between that city and the goods in question, and I have not received any submissions on the matter. Overall, taking account of “VERONA” not being an invented word, I find the earlier mark to have a medium degree of inherent distinctive character.

Likelihood of confusion

37. 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 the goods 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 goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent’s trade mark, the average consumer for the goods 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.

38. I have found the marks to be visually and aurally similar to a low degree and conceptually similar to a medium degree. I have found the earlier mark to possess a medium degree of inherent distinctive character.

39. The typical consumer of the goods at issue, which I have found to be identical, will be a building contractor paying a medium level of attention during the purchasing process. The process will be primarily a visual one, with verbal considerations being secondary.

40. Notwithstanding the goods at issue being identical in this case and the marks sharing the word “VERONA”/“... Verona”, these identical words are positioned at different points within the marks and the applicant’s mark has the additional words and letters “GRANDE” and “XL” and the word “By ...” as well as some minor stylisation. The average consumer will notice these differences and so there is no likelihood of direct confusion.

41. I will now consider the question of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis QC (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:¹

“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 recognised 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’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements

¹ BL O/375/10

of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI”, etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

42. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

43. While I acknowledge that fitting one of the Purvis criteria is not determinative of the likelihood of indirect confusion in and of itself, the marks in this particular case fall within the scenario outlined in criterion (b). The applicant’s mark contains two lowly distinctive elements – “GRANDE” and “XL” – consistent with being a sub-brand of the opponent’s mark.

44. The average consumer will find there to be an economic connection between the two marks. When purchasing building materials, they will regard the opponent’s mark as belonging to a company named after Verona, a city in Italy. They will regard the applicant’s mark as another brand of the Verona building materials company, this brand perhaps being for a service which entails the

purchase and delivery of building materials in bulk, large orders of building materials being furnished “by Verona”.

45. I find there to be a likelihood of indirect confusion in this case.

CONCLUSION

46. The opposition under section 5(2)(b) has been entirely successful.

COSTS

47. The opponent has been entirely successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023 as follows:

Official fee	£100
Preparing a statement and considering the other side’s statement	£250
Total:	£350

48. I therefore order The Mosaic Tile Co. Ltd to pay Roadstone Limited the sum of £350. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

Dated this 10th day of September 2025

John Williams
For the Registrar