

BL O/0870/25

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3989501
BY WOOLWORTH GMBH
TO REGISTER THE TRADE MARK:**



IN CLASS 35

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 446521
BY LASSIC LTD**

BACKGROUND AND PLEADINGS

1. On 8 December 2023, Woolworth GmbH (“the applicant”) applied to register the trade mark shown on the cover page of this decision (“the contested mark”) in the UK. The application was published for opposition purposes on 15 March 2024, and registration is sought for services in Class 35.¹

2. On 20 March 2024, Lassic Ltd (“the opponent”) filed a notice of opposition. The opposition was brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”),² and was directed against all the services in the application. The opponent relies upon the following UK trade marks (“UKTM”):



UKTM no. 3048009

Filing date: 21 March 2014; registration date: 27 June 2014;

Relying upon all the Class 35 services for which the mark is registered.³
 (“the first earlier mark”)



UKTM no. 3069208

Filing date: 19 August 2014; registration date: 23 January 2015;

Relying upon all the goods and services in Classes 11, 20, 21, 24, 27 and 35 for which the mark is registered.⁴
 (“the second earlier mark”)

¹ See goods and services comparison – paragraph [60].

² 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. See also Tribunal Practice Notice (“TPN”) 2/2020 End of Transition Period – impact on tribunal proceedings.

³ See paragraph [53] of this decision.

⁴ See paragraph [53] of this decision.

3. The earlier marks are subject to use conditions in accordance with section 6A of the Act because they were registered more than five years before the application date of the contested mark. The opponent has made a statement to the effect that it has used the marks in relation to all the goods and services relied upon.

4. The opponent claims that due to the similarities between the marks and the respective goods and services, registration of the application would cause confusion among consumers, potentially leading to unfair competition in the marketplace.

5. The applicant filed a counterstatement admitting that some of the Class 35 services are identical. However, they deny that the marks are sufficiently similar to cause confusion. They request that the opponent provides proof of use of the earlier marks in respect of all the goods and services relied upon.

6. Only the opponent filed evidence and, in doing so, also filed written submissions. Both parties were given the option of an oral hearing but neither requested to be heard on this matter, nor did they file written submissions in lieu of a hearing. This decision is taken following a careful review of the papers.

7. The opponent is represented by McDaniels Law, and the applicant is represented by Handsome I.P. Ltd.

EVIDENCE

8. The opponent's evidence came in the form of the witness statement of Suresh Handa, dated 23 September 2024, together with nine exhibits (Exhibits SH1 to SH9). Mr Handa is the Director of the opponent, a position held since 2014, as well as a Director of Home Discount Limited, a sister company to the opponent, which has traded under the Home Discount brand in the United Kingdom since its incorporation in 2011. The purpose of the evidence is to demonstrate that the earlier marks have been put to genuine use in the UK during the relevant period in relation to the goods and services relied upon.

9. Whilst I do not intend to summarise the evidence here, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary in the course of this decision.

PRELIMINARY ISSUE

10. In its counterstatement, the applicant points to the differing target markets of the respective parties and submits that this will prevent a likelihood of confusion. For the avoidance of doubt, I must carry out a notional assessment based upon the parties' respective marks and the goods and services contained in their specifications. The actual activities carried out by the parties are not relevant to my assessment.⁵

DECISION

Proof of use

11. I will begin by assessing whether there has been genuine use of the earlier marks in relation to the registered goods and services relied upon. Section 6A of the Act states:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

⁵ *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06 at [66]
Compass Publishing BV v Compass Logistics Ltd [2004] RPC 41 at [22]

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

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

(5)-(5A) [Repealed]

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

12. The relevant period for assessing genuine use is the five-year period ending with the filing date of the application, i.e. 9 December 2018 to 8 December 2023.

13. Section 100 of the Act reads:

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

14. Consequently, the onus is upon the opponent to prove that genuine use of the earlier marks was made within the UK in the relevant period, and in respect of the relevant goods and services as registered.

15. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

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

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

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

- i) The scale and frequency of the use shown;
- ii) The nature of the use shown;

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

17. Before assessing the opponent's evidence of use, I remind myself of the comments of Mr Daniel Alexander QC, (as he then was) sitting as the Appointed Person, in *Awareness Limited v Plymouth City Council*, where he stated that:⁶

“22. The burden lies on the registered proprietor to prove use [...]. However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

And further at paragraph 28:

“28. [...] I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has

⁶ Case BL O/230/13

only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

18. I also note Mr Alexander’s comments in *Guccio Gucci SPA v Gerry Weber International AG*.⁷ Although the case concerned revocation proceedings, the principle is the same for proof of use in opposition actions. He stated:

“The Registrar says that it is important that a party puts its best case up front – with the emphasis both on “best case” (properly backed up with credible exhibits, invoices, advertisements and so on) and “up front” (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of a procedural error. [...] The rule is not just “use it or lose it” but (the less catchy, if more reliable) “use it – and file the best evidence first time round – or lose it”.”

19. The comments of Mr Geoffrey Hobbs QC (as he then was) in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, where he sat as the Appointed Person, are also relevant.⁸ He stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

⁷ Case BL O/424/14

⁸ Case BL O/404/13

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not 'show' (per Section 100 of the Act) with regard to the actuality of use in relation to services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

20. Accordingly, following on from the above, whilst there is no requirement to produce any specific form of evidence, I must consider what the evidence as a whole shows me and whether on this basis I can reasonably be satisfied that there has been genuine use of the marks.

Form of the marks

21. Before I move on to assess if the opponent has shown genuine use, I must first consider if I find the use of the marks as shown in the evidence to be use of the marks as registered.

22. The opponent's registrations are in respect of the following figurative mark:



23. Where the opponent has used its registrations as registered, that will clearly be use on which the opponent can rely. For the avoidance of doubt this would also include slight variations to the marks which do not alter their distinctive character. Overall, I find that use of the marks shown in the evidence to be use of the marks in the form as registered.

Use of the marks

24. Whether the use shown of the earlier marks is sufficient will depend on whether there has been real commercial exploitation of the same, in the course of trade, sufficient to create or maintain a market for the goods and services at issue during the relevant five-year period.

25. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.⁹ As indicated in the case law above, use does not need to be quantitatively significant to be genuine.

26. The opponent claims to have used its earlier marks in relation to all the goods and services relied upon.¹⁰

27. In his witness statement, Mr Handa states that as well as being the Director of the opponent, he is also equally a Director of Home Discount Limited, a sister company to the opponent, which has traded under the Home Discount brand in the United

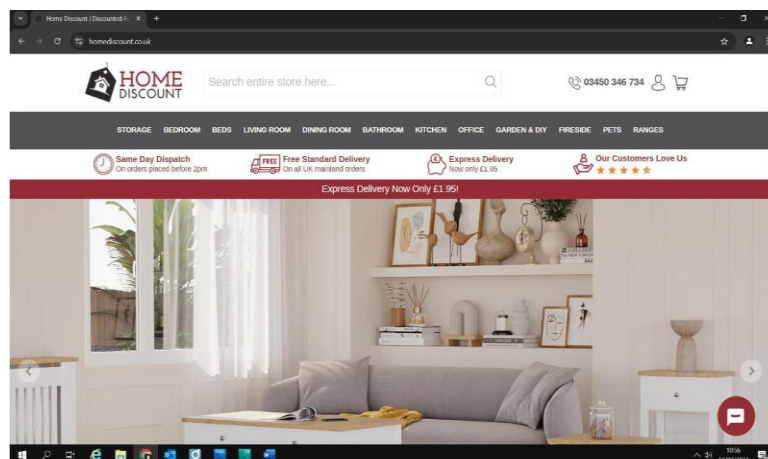
⁹ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, Case T-415/09.

¹⁰ See paragraph [53] of this decision.

Kingdom since its incorporation in 2011. He adds that the Home Discount brand also has a growing presence across Europe. Mr Handa states that the Home Discount brand has an established reputation in the UK and Europe as one of the largest online retailers of furniture and home goods, adding that Home Discount has the benefit of the opponent's earlier marks at issue, by way of a licence.

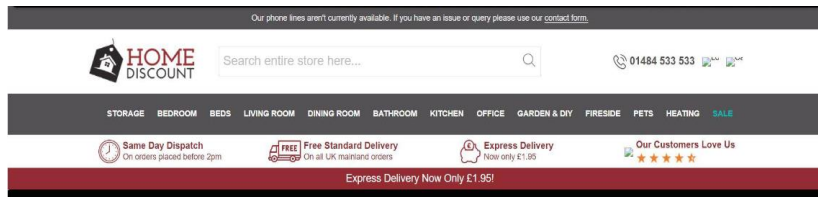
28. Mr Handa explains that in 2011, he and the other directors conceived and launched the Home Discount brand. He adds that Home Discount mainly, but not exclusively, sells products that have been imported by the opponent, Lassic Ltd, explaining that both companies are in fact owned by him and his brother, Mr Rajesh Handa.

29. Mr Handa states that whilst Home Discount initially only had an online presence (www.homediscount.co.uk), this was subsequently followed by the establishment of a physical retail store in 2019, situated adjacent to the opponent's warehouse, which unfortunately, due to the COVID-19 pandemic, closed in March 2020. I note that Exhibit SH2 comprises of webpage screenshots retrieved from 'www.homediscount.co.uk', as well as five screenshots taken from the internet archive website 'Wayback Machine'. The home discount webpage screenshot is dated 18 September 2024, (which is presumably the date on which the page was printed from the website), and simply features, what appears to be a living room scene, namely:

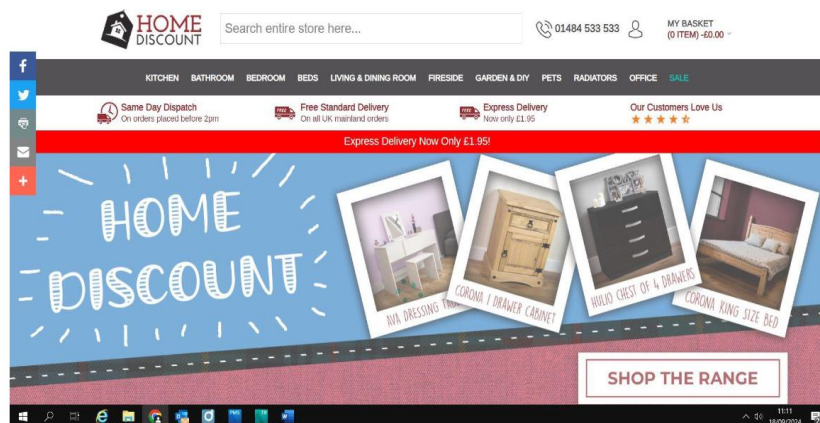


- This image is repeated in the first of the 'Wayback Machine' screenshots, dated 7 May 2023. The second and third 'Wayback Machine' screenshots taken from

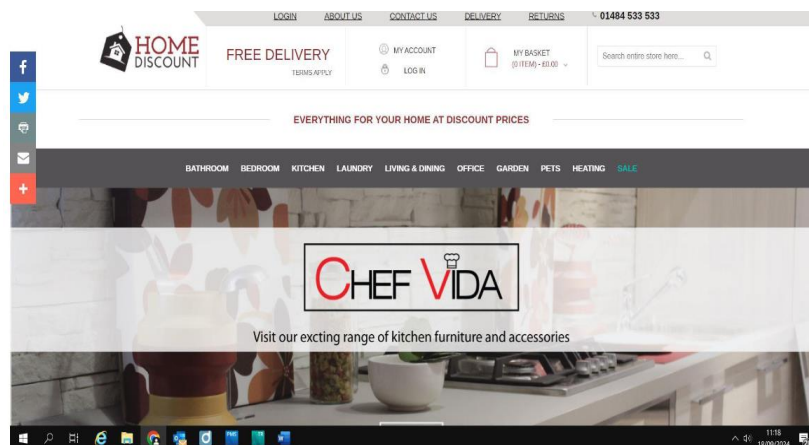
'www.homediscount.co.uk' are dated 15 May 2021 and 29 June 2022 and feature the following information only:



- The fourth 'Wayback Machine' screenshot taken from 'www.homediscount.co.uk' is dated 24 July 2020 and features the following information:



- The final 'Wayback Machine' screenshot (from 'www.homediscount.co.uk') is dated 14 February 2019, and features the following information:



30. As can be seen from the above, some of the screenshots demonstrate use of the marks in relation to various furniture items.

31. In his witness statement, Mr Handa states that the 'Home Discount' website and physical store (while it was open), offered for sale furniture and home goods, namely all those included in the specifications of the earlier marks. He adds that in general, the 'Home Discount' services are targeted at trade customers as well as average retail customers seeking discounted, quality home goods.

32. Exhibit SH3 contains 30 screenshots taken from 'www.homediscount.co.uk', which feature various items of furniture and home accessories. The screenshots are dated 18 September 2024, which is outside the relevant period, though this presumably is the date on which the pages were printed from the website. However, I am unable to ascertain from the exhibits alone, what the pages looked like within the relevant period and what the volume of customers were that were exposed to the earlier marks when visiting the opponent's website.

33. The furniture and home accessory items featured in Exhibit SH3 are as follows:

Wall cabinets, beds, bedside chests, bookcases, storage units, fireside companion set (containing a small shovel, brush, poker, tongs and a stand), hearth shovel and brush sets, chests of drawers, clothes airers, garden rattan sets, desks, dining chairs, dining sets (chairs and tables), dining tables, dressing tables, garden benches, garment racks, wardrobes, kitchen trollies (storage), mattresses, mirrors, office chairs, radiator covers, tiered shelving, sideboards, ottomans, toy boxes and TV units.

34. Mr Handa explains that the 'Home Discount' brand has been in use since 2011, with the opponent adopting the earlier marks as logos from 2014 onwards, resulting in the brand building up a significant customer base and reputation, along with a substantial revenue. Mr Handa has provided turnover figures relating to the revenue generated under the 'Home Discount' brand between 2019 and 2023. However, it is unclear if the turnover figures relate to revenue solely generated in the UK. The figures are as follows:

Year	£
2019	11,172,436.84
2020	16,794,006.92
2021	16,732,595.57
2022	13,415,235.65
2023	15,949,630.65

35. Mr Handa states that his company was actively trading under the earlier marks, throughout the relevant period, as demonstrated by Home Discount's annual accounts from 2019 to 2023.¹¹

36. With regards to Exhibit SH5, Mr Handa states that the evidence contains several invoices provided to customers following the purchase of goods via the opponent's retail services. The seven invoices all prominently display the earlier marks and are dated between October 2019 and June 2023. However, whilst four of the invoices feature redacted addresses in the UK, two of the invoices are for redacted addresses in France, being outside the relevant territory, and one invoice features a redacted address in Ireland, and it is unclear if the address is in Northern Ireland (which would count towards genuine use) or Southern Ireland (which would not count towards genuine use).

37. The UK invoices are in relation to various goods and amounts, namely:

Date	Goods	Unit Price (£)
08/10/2019	1 x Home Vida Steel Post Box, Red	13.50
11/08/2021	1 x Vida Designs Dorset Bet 4ft6 Double, Black	54.95
15/07/2022	1 x Garden Vida Belgrave 9 Seater Rattan Set, Black	493.99
12/06/2023	2 x Bath Vida Priano 2 Door Wall Cabinet, white	28.99

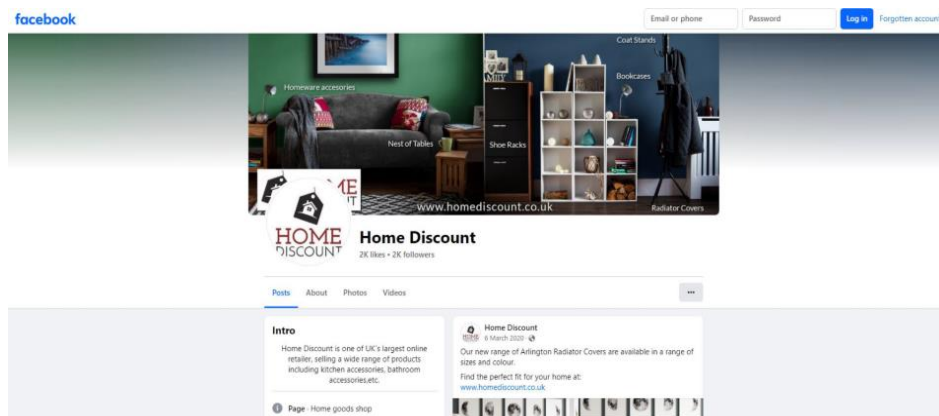
38. Mr Handa explains that as well as the earlier marks being used to advertise the goods and services at issue on the 'Home Discount' website, they have also been used on numerous other online marketplaces, namely, eBay, OnBuy, ManoMano,

¹¹ Exhibit SH4

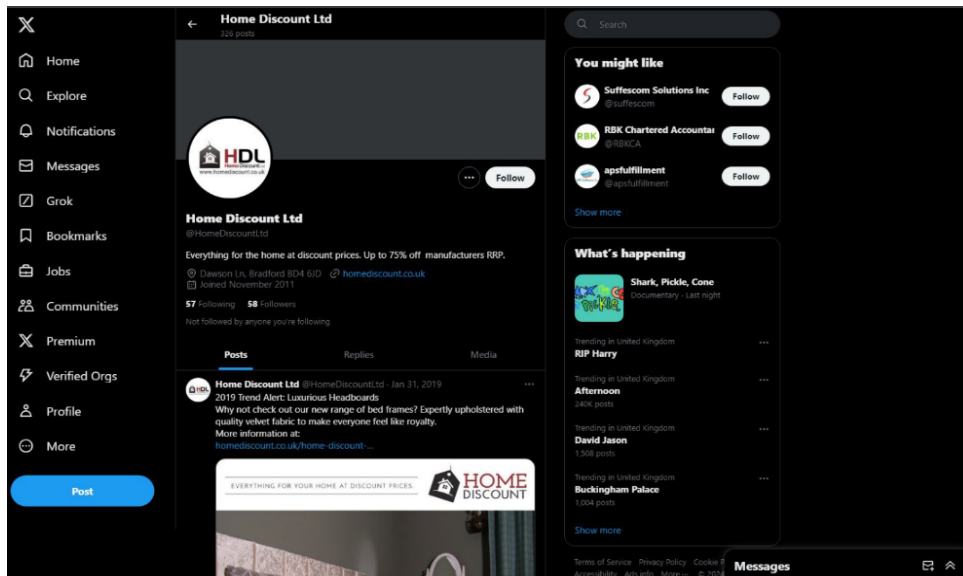
Debenhams, B&Q and Amazon. In this regard, Exhibit SH6 contains six screenshots from the stated marketplaces which feature the opponent's earlier marks. The screenshots are all dated 18 September 2024, which is outside the relevant period, though I presume that this is the date the screenshots were retrieved from the individual websites. Only the screenshots from Debenhams, OnBuy and ManoMano feature goods being offered for sale. These goods are *shoe cabinets, a radiator cover, a coffee table, chest of drawers, a bedside table, console tables, a radiator cover and wardrobes*. However, it is not clear from the exhibits whether goods offered under the earlier marks were available on these marketplaces during the relevant period, the volume of UK customers generated, or the extent to which the relevant consumer had been exposed to the earlier marks by visiting these various online marketplaces.

39. In his witness statement, Mr Handa explains that in order to advertise the 'Home Discount brand', the earlier marks have been used on various social media platforms, namely Facebook, X (formerly Twitter), Instagram, YouTube and Pinterest. In this regard, Exhibit SH7 contains various screenshots showing use of the marks on those social media accounts.

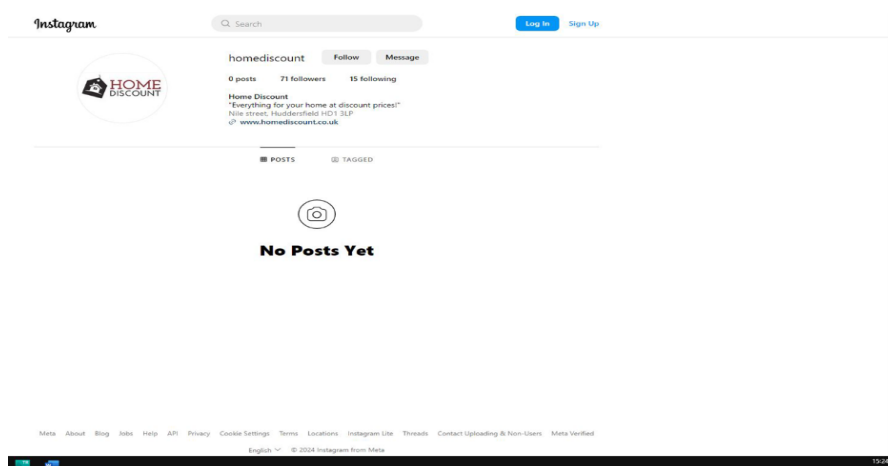
40. The Facebook screenshot taken from the 'Home Discount' account, shows that it has received 2K 'likes' and has 2K 'followers'. The earlier mark is prominently displayed. The screenshot features a post from 'Home Discount' dated 6 March 2020, relating to 'radiator covers'. It also includes a picture of what appears to be a living room, containing various items of labeled furniture, namely coat stands, bookcases, radiator covers, shoe racks, nest of tables and homeware accessories, as can be seen from the following:



41. The X (formerly Twitter) screenshot, taken from the 'Home Discount Ltd' account, shows that the account was created in November 2011 and that it has 58 'followers'. The earlier mark is prominently displayed. The screenshot features a post from 'Home Discount Ltd' dated 31 January 2019, relating to a new range of 'bed frames', as can be seen from the following:



42. The Instagram screenshot, taken from the 'Home Discount' account, shows that it has 71 'followers'. As can be seen from below, the earlier mark is prominently displayed. The screenshot does not feature any posts, and the only date present is 18 September 2024, which is outside the relevant period, though it is presumed that this is the date that the screenshot was retrieved for evidential purposes.



43. The YouTube screenshot, taken from the 'Home Discount' account, shows that it has 1 'subscriber'. The earlier mark is prominently displayed. However, the screenshot shows that the channel doesn't have any content. The only date present is 18 September 2024, which is outside the relevant period. However, again it is presumed that this reflects the date that the screenshot was retrieved from the website.

44. The Pinterest screenshot, taken from the 'Home Discount' account, shows that it has 16 'followers'. The earlier mark is prominently displayed. The screenshot includes the following words, '*HOME DISCOUNT is one of the UK's largest online retailer, selling a wide range of products including chests of drawers, radiator covers, rattan furniture, shoe cabinets, and much much more.*' Furthermore, several pictures are displayed featuring various furniture and home accessory items, namely *side tables, chests of drawers, nest of tables, radiator covers, beds, tables, chairs, shoe racks, dressing tables, wardrobes and rattan furniture.* The only date present is 18 September 2024, which is outside the relevant period. However, it is presumed that this reflects the date that the screenshot was retrieved from the website.

45. However, it is not possible to establish from the above screenshots who viewed these platforms, when they were viewed, the volume of UK custom generated from these platforms or the extent that the relevant consumer had been exposed to the marks by visiting the social media pages.

46. Mr Handa states that the earlier marks have had further visibility as a result of Home Discount's additional brand exposure via various newspaper articles and award ceremonies, which have further enhanced the brand's reputation amongst the general public as well as trade customers. In this regard Exhibit SH8 contains screenshots taken from the online newspaper, 'The Telegraph & Argus'. The screenshots feature an article titled '*Furniture firm Home Discount creating 20 new jobs in move to Bradford*', dated 28 March 2018; and an article titled '*Lord Mayor of Bradford opens new factory store Home discount*', dated 21 August 2018.

47. In addition, Exhibit SH8 contains two photographs relating to ‘*The Best Newcomer award at the 2024 B&Q Seller Conference*’. As can be seen from the following, ‘Home Discount’ were the winners of this award. However, it is noted that the date of the award ceremony is outside the relevant period, though I acknowledge that the award was likely to be in respect of Home Discount’s performance during 2023:



48. Additionally, Mr Handa explains that the earlier marks are used on signage, in and around the Home Discount Head Office and warehouse, on roadside signage, and on business cards circulated by the opponent’s employees. In support of this statement Exhibit SH9 contains the following five, undated photographs:



Genuine use

49. I remind myself that I must evaluate all the evidence submitted in an overall assessment, and that although pieces of evidence may be insufficient by themselves, they may contribute to proving use in combination.

50. It is apparent from the evidence that the opponent has used its mark in the UK, during the relevant period. However, as indicated in my analysis above, the evidence is not without its limitations. For example, some of the evidence is not dated, or is dated outside the relevant period. Additionally, the evidence only relates to certain furniture items and home accessories, whereas the specifications of the earlier rights contain a much broader selection of goods and services. Nor do I have any figures before me outlining the marketing budget or spend for the brand. Furthermore, I have no evidence before me relating to the size of the corresponding market or the percentage of market share enjoyed by the opponent for the goods and services at issue, nor is it clear from the revenue/turnover figures submitted whether the revenue relates solely to goods in the UK, bearing in mind that Mr Handa states in his witness statement that the Home Discount brand has an established reputation in both the UK and Europe as one of the largest online retailers of furniture and home goods, and that some of the invoices submitted in the evidence relate to goods sold outside the UK.¹²

¹² Exhibit SH5

51. That being said, taking the evidential picture as a whole, I remind myself that use does not have to be quantitatively significant to be genuine. The turnover figures are impressive and demonstrate that sales have been consistent over the relevant period. Accordingly, from the overall evidential picture, including the supportive narrative evidence provided in Mr Handa's witness statement, whilst there are gaps in the evidence, as discussed above, I am satisfied that the opponent has attempted to create and maintain a market under the 'HOME DISCOUNT' marks at issue, and has done enough to demonstrate commercial exploitation of the marks in relation to some of the goods and services at issue. Accordingly, I am satisfied that the opponent has demonstrated genuine use of its mark.

Fair specification

52. I must now consider whether, or the extent to which, the evidence shows use of the registered marks in relation to the goods and services relied upon. I must bear in mind that fair protection is not to be achieved by identifying and defining particular examples of goods and services for which there has been genuine use, but, rather, the particular categories of goods and services they should realistically be taken to exemplify. For that purpose, the terminology of the resulting specification should accord with the perceptions of the average consumer for the goods and services concerned.¹³ In arriving at a fair specification, I must consider how the average consumer would fairly describe the goods and services shown in evidence; the task is not to describe the use made of the registered marks in the narrowest possible terms, unless that is what an average consumer would do. I remind myself that a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods and services covered by the registrations.¹⁴

53. The opponent relies upon the following goods and services:

The first earlier mark

¹³ *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10

¹⁴ *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch)

Class 35 Administration of businesses; Administration of the business affairs of franchises; Administration of the business affairs of retail stores; Administration relating to marketing; Administration relating to sales methods; Administrative processing and organising of mail order services; Advertising and marketing services; Advertising and promotion services; Advertising by mail order; Advertising by transmission of on-line publicity for third parties through electronic communications networks; Advertising, marketing and promotion services; Advertising, marketing and promotional services; Advertising on the Internet for others; Advertising, promotional and marketing services; Banner advertising; Business services relating to the establishment of businesses; Online advertisements; On-line advertising on a computer network; On-line auctioneering services via the Internet; On-line promotion of computer networks and websites; Operation of businesses [for others]; Ordering services [for others]; Ordering services for third parties; Organisation of exhibitions for business or commerce; Outdoor advertising; Retail services connected with the sale of furniture; Television advertising; Trade information; Trade marketing [other than selling]; Trade promotional services.

The second earlier mark

Class 11 Fabric lantern covers and shades, apparatus and installations for lighting; ceiling lights; chandeliers; chinese lanterns; electric lights for Christmas trees; light diffusers; electric lamps; fairy lights; hangings for lamps; lamp casings; lamp glasses; lamp globes; lamp shades; lamps; lampshade holders; lanterns; light bulbs; standard lamps; parts and fittings for all the aforesaid goods.

Class 20 Furniture, mirrors, picture frames; mattresses; bedding bale; beds; bedsteads; headboards; cots; nappy stackers for use with cots; cot tidies and cot organisers; cushions and bolsters (upholstery); divans; couches; mirrors; blinds; household ornaments and containers; bedding and bedding articles; bedding for cots; furniture and nursery furniture; moses basket stands; cot bumpers; curtain poles; bean bags; parts and fittings for all the aforesaid.

Class 21 Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making

materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.

Class 24 Textiles and textile goods, not included in other classes; bed and table covers, textiles and textile goods; curtains; curtain tiebacks; household textile articles; bed linen; mattress covers, protectors and toppers; duvet covers; bed sheets, fitted bed sheets, flat bed sheets; cushion covers; blankets and baby blankets; bed blankets; bed spreads and throws, pillow cases, quilts, quilt covers, bed covers, valances for beds and for pillow cases, pillow shams; table linen; table cloths, table napkins, table covers and table mats; bath linen, towels and towel sets; tea towels; kitchen linen; shower curtains; bunting.

Class 27 Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile); carpets, rugs, mats, floor coverings, wall hangings; bath mats, bath mats sold in sets, bathroom mats, bathroom rugs, bathroom tiles [carpet], external bath mats, mats for bathroom use.

Class 35 Retail services connected with the sale of beauty products, cosmetics, toiletries, substances for bleaching, cleaning, scouring and laundry use, machines for household use, hand tools, optical goods, cameras, domestic electrical and electronic equipment, including white goods, jewellery, clocks, watches, stationery, office requisites, publications, luggage, furniture, including garden furniture, household containers and utensils, furnishings, textiles, clothing, footwear, headgear, decorator's materials, wall coverings, paints, floor coverings, haberdashery, toys and games, sports equipment, food, foodstuffs, food ingredients, drinks (alcoholic and non-alcoholic), tobacco products and smokers' articles; administration of businesses; administration of the business affairs of franchises; administration of the business affairs of retail stores; administration relating to marketing; administration relating to sales methods; administrative processing and organising of mail order services; advertising and marketing services; advertising and promotion services; advertising by mail order; advertising by transmission of on-line publicity for third parties through electronic communications networks; advertising, marketing and promotion services; advertising, marketing and promotional services; advertising on the internet for others;

advertising, promotional and marketing services; banner advertising; business services relating to the establishment of businesses; online advertisements; on-line advertising on a computer network; on-line auctioneering services via the internet; on-line promotion of computer networks and websites; operation of businesses [for others]; ordering services [for others]; ordering services for third parties; organisation of exhibitions for business or commerce; outdoor advertising; retail services connected with the sale of furniture; television advertising; trade information; trade marketing [other than selling]; trade promotional services; information and advisory services related to the aforesaid services.

54. From the evidence before me, the use shown by the opponent of the earlier marks in the UK, during the relevant period, overwhelmingly relates to furniture items, some very limited home accessory items, and retail services connected with the same. The goods and services shown in the evidence are as follows:

Wall cabinets, beds, bedside chests, bookcases, storage units, chests of drawers, garden rattan sets, desks, dining chairs, dining sets (chairs and tables), dining tables, coffee tables, console tables, side tables, bedside tables, dressing tables, garden benches, wardrobes, mattresses, mirrors, office chairs, sideboards, ottomans, toy boxes and TV units, shoe cabinets, bookcases, clothes airers, garment racks, kitchen trollies (storage), radiator covers, tiered shelving, steel post boxes; and retail services connected with the sale of the forgoing.

55. There is no evidence of use of the marks being used in relation to the remaining goods and retail services contained in the specifications of the earlier marks. Furthermore, for the avoidance of doubt, the same can be said in relation to the provision of the various business services contained in the Class 35 specifications of the opponent's earlier marks.

56. Accordingly, from the evidence I have before me, keeping in mind the parameters of the goods and services contained in the earlier marks, I find that the use shown by the opponent of the earlier marks in the UK, during the relevant period, would be fairly described by the average consumer as relating to *furniture, including garden furniture;*

mattresses; storage units; mirrors; and household utensils, namely clothes airers; and fittings for all the aforesaid, along with retail services connected with the same.

57. Accordingly, fair specifications for the earlier marks are:

First earlier mark

Class 35 Retail services connected with the sale of furniture, including garden furniture.

Second earlier mark

Class 20 Furniture, including garden furniture; mirrors; mattresses; beds; bedsteads; parts and fittings for all the aforesaid.

Class 21 Household utensils, namely clothes airers.

Class 35 Retail services connected with the sale of furniture, including garden furniture, mirrors, mattresses, beds, bedsteads, household utensils, namely clothes airers.

Section 5(2)(b)

58. Sections 5(2)(b) and 5A of the Act read as follows:

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

[...]

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

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

[...]

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

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

(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 goods and services

60. As per my earlier findings, the opponent may rely upon the following goods and services:

First earlier mark

Class 35 Retail services connected with the sale of furniture, including garden furniture.

Second earlier mark

Class 20 Furniture, including garden furniture; mirrors; mattresses; beds; bedsteads; parts and fittings for all the aforesaid.

Class 21 Household utensils, namely clothes airers.

Class 35 Retail services connected with the sale of furniture, including garden furniture, mirrors, mattresses, beds, bedsteads, household utensils, namely clothes airers.

61. The applicant's opposed services are as follows:

Class 35 Retail services connected with the sale of tobacco, heating equipment, food cooking equipment, refrigeration equipment, automobile parts, car accessories, baked goods, batteries, construction machinery, building materials, clothing, clothing accessories, clothing, lighting, cutlery, beers, flowers, floor coverings, fuels, tanning apparatus, computer hardware, computer software, desserts, printed matter, fragrance preparations, furnishings, animal bedding materials, disposable paper products, ice cream, bicycle accessories, vehicles, paints, delicatessen goods, meat, fruit ices, fruits, animal feed, threads, yarn, garden articles, horticultural equipment, horticultural products, freezers, hearing protection devices, luggage, apparatus for human hygiene purposes, devices for hygiene purposes for animals, devices for human beauty purposes, beauty devices for animals, navigation devices, food preparation equipment, physical therapy equipment, tableware, fabrics, hair products, pet products, home textiles, heating appliances, coffee, cocoa, small hardware goods, cooking appliances, confectionery, headgear, motor vehicle accessories, works of art, art materials, artificial fur, kitchen appliances, kitchen knives, refrigeration appliances, foodstuffs, seafood, dairy products, mobile telephones, fashion accessories, musical

instruments, preparations for veterinary purposes, furniture, nutritional supplements, foodstuffs, sewing articles, paper and stationery, preparations for making beverages, preparations for making alcoholic beverages, umbrellas, cleaning supplies, cleaning products, saddlery, lubricants, jewellery, chocolate, stationery, footwear, smartphones, smart watches, games, toys, sporting goods, sports equipment, strollers and buggies, sporting goods, animal litter, sweets, tobacco, bags, cups and glasses, diving equipment, tea, carpets, animal care products, toiletries, teaching materials, weapons, wall coverings, water supply facilities, timekeeping instruments, non-alcoholic beverages, alcoholic beverages, alcoholic beverages (other than beers), audiovisual equipment, pre-recorded content, chemical products for horticultural purposes, chemical products for agricultural purposes, dietetic products, household electrical appliances, electronic household appliances, festive decoration items, horticultural products, horticultural equipment, frozen yoghurt, hand-operated equipment for construction purposes, hand-operated tools for construction purposes, downloadable music files, downloadable electronic publications, information technology equipment, medical apparatus, medical instruments, pharmaceutical, medical and veterinary articles and sanitary preparations, sexual aids, sanitary installations, portable computers, multimedia content; The bringing together, for the benefit of others, of telecommunications services and entertainment services, enabling customers to conveniently view and purchase those services.

62. In *Canon*, Case C-39/97, the Court of Justice of the European Union (“CJEU”) stated that:

“23. In assessing the similarity of the goods or services concerned, ... 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”.

63. Additionally, the factors for assessing similarity between goods and services identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] R.P.C. 281 include an assessment of the users and the channels of trade of the respective goods or services.

64. 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 OHIM*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

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

65. For the purposes of considering the issue of similarity of the goods and services, it is permissible to consider groups of terms collectively where appropriate: *Separode Trade Mark*, BL O-399-10.¹⁵

66. In the case of services, the terms used should not be interpreted widely but confined to the core of the possible meanings attributable to the terms: *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1) [2024] UKSC 36*, at [365].

67. Pursuant to section 60A of the Act, I am mindful of the fact that the goods and services are not to be automatically regarded as being similar to each other on the ground that they appear in the same class, nor automatically regarded as dissimilar from each other on the ground that they appear in different classes. I also note that in *Unicorn Studio Inc v Veronese* Case CH-2023-000214, Iain Purvis, KC, sitting as deputy High Court judge, stated that any finding of similarity (between goods and services) requires the exercise of common sense. Meanwhile, in *RALEIGH INTERNATIONAL Trade Mark* [2001] RPC 11, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, observed that when goods or services are not identical or self-evidently similar, the opposition should be supported by evidence as to their similarity.

¹⁵ Paragraph 5

68. Both parties have filed submissions regarding the similarity of the goods and services.¹⁶ Whilst I do not propose to reproduce the parties' submissions here, I have taken them all into consideration in reaching my decision.

Class 35 of the contested application

Retail services connected with the sale of furniture

69. The above contested services are present in the specifications of the opponent's earlier marks, therefore the services are identical.

70. With regards to the retail services of specific goods and retail services of other goods, I remind myself that they have the same nature as both are retail services, and that they have the same purpose of allowing consumers to conveniently satisfy different shopping needs, along with the same method of use. However, overall similarity is found between those retail services *where the specific goods concerned are commonly retailed together in the same outlets and they target the same public*. Furthermore, the degree of similarity between the retail of specific goods on the one hand and retail of other goods on the other hand may vary depending on the proximity of the retailed goods and the particularities of the respective market sectors.

71. Accordingly, in view of the above, I find the following in relation to the applicant's remaining Class 35 contested services:

72. The contested retail services connected with the sale of furnishings, home textiles, are similar to a high degree to the opponent's *retail services connected with the sale of furniture, including garden furniture*, present in Class 35 of the opponent's earlier marks.

73. The contested retail services connected with the sale of floor coverings, carpets, tableware, cutlery, kitchen knives, cups and glasses, garden articles, lighting, are similar to a medium degree to the opponent's *retail services connected with the sale*

¹⁶ Via the applicant's counterstatement and the opponent's written submissions filed on 23 September 2024.

of furniture, including garden furniture, present in Class 35 of the opponent's first earlier mark, and retail services connected with the sale of furniture, including garden furniture, mirrors, mattresses, beds, bedsteads, household utensils, namely clothes airers, in the opponent's second earlier mark.

74. The contested retail services connected with the sale of wall coverings, works of art, festive decoration items, threads, yarn, fabrics, sewing articles, food preparation equipment, food cooking equipment, refrigeration equipment, paints, cooking appliances, kitchen appliances, refrigeration appliances, household electrical appliances, electronic household appliances, heating equipment, batteries, building materials, flowers, horticultural equipment, horticultural products, freezers, apparatus for human hygiene purposes, heating appliances, small hardware goods, water supply facilities, chemical products for horticultural purposes, chemical products for agricultural purposes, horticultural products, horticultural equipment, hand-operated equipment for construction purposes, hand-operated tools for construction purposes, hearing protection devices, sanitary installations, are similar to a low degree to the opponent's *retail services connected with the sale of furniture, including garden furniture, present in Class 35 of the opponent's first earlier mark, and retail services connected with the sale of furniture, including garden furniture, mirrors, mattresses, beds, bedsteads, household utensils, namely clothes airers* in the opponent's second earlier mark.

75. The applicant's remaining contested services are:

Retail services connected with the sale of tobacco, automobile parts, car accessories, baked goods, construction machinery, clothing, clothing accessories, clothing, beers, fuels, tanning apparatus, computer hardware, computer software, desserts, printed matter, fragrance preparations, animal bedding materials, disposable paper products, ice cream, bicycle accessories, vehicles, delicatessen goods, meat, fruit ices, fruits, animal feed, luggage, devices for hygiene purposes for animals, devices for human beauty purposes, beauty devices for animals, navigation devices, physical therapy equipment, hair products, pet products, coffee, cocoa, confectionery, headgear, motor vehicle accessories, art materials, artificial fur, foodstuffs, seafood, dairy products, mobile telephones, fashion accessories, musical instruments, preparations for

veterinary purposes, nutritional supplements, foodstuffs, paper and stationery, preparations for making beverages, preparations for making alcoholic beverages, umbrellas, cleaning supplies, cleaning products, saddlery, lubricants, jewellery, chocolate, stationery, footwear, smartphones, smart watches, games, toys, sporting goods, sports equipment, strollers and buggies, sporting goods, animal litter, sweets, tobacco, bags, diving equipment, tea, animal care products, toiletries, teaching materials, weapons, timekeeping instruments, non-alcoholic beverages, alcoholic beverages, alcoholic beverages (other than beers), audiovisual equipment, pre-recorded content, dietetic products, frozen yoghurt, downloadable music files, downloadable electronic publications, information technology equipment, medical apparatus, medical instruments, pharmaceutical, medical and veterinary articles and sanitary preparations, sexual aids, portable computers, multimedia content; The bringing together, for the benefit of others, of telecommunications services and entertainment services, enabling customers to conveniently view and purchase those services

76. I am of the view that none of the contested retailed goods listed above appear to be the same as the retailed goods present in the opponent's earlier marks, nor do they appear to be goods that are likely to be marketed by the same kind of retailer. In this regard, I keep in mind that it is necessary to construe the meanings of the descriptions of goods forming part of the retail services specifications at issue by reference to their ordinary natural meaning. However, in doing so it is again necessary to keep in mind that specifications of services should be interpreted as covering the core of the possible meanings of the words used.¹⁷ Accordingly, in the absence of any submissions to assist me, I see no similarity between the above contested retail services and the opponent's retail services contained in its two earlier marks. These services are dissimilar.

77. The same conclusion also applies to the opponent's goods in Classes 20 and 21 which cover the same goods as those covered by the opponent's retail services and are one step removed from the applicant's services which I found to be dissimilar.

¹⁷ *Sky v Skykick* [2020] EWHC 990 (Ch)

78. Accordingly, as some degree of similarity is required for there to be a likelihood of confusion under section 5(2)(b), the opposition must fail in respect of these services.¹⁸

The average consumer and the nature of the purchasing act

79. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

80. 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. (as he then was) 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.”

81. The average consumer for the services at issue is likely to be both members of the general public, as well as business users. When selecting the services the consumer will take a number of factors into account, such as price, quality, stock availability and location. The services are likely to be purchased from retail shops (or their online equivalents) following inspection of the premises' frontage, websites or advertisements (such as flyers, posters or online adverts). Generally, the purchasing process is likely to be dominated by visual considerations. However, given that word-of-mouth recommendations may also play a part, and consumers may seek advice from sales assistants, I do not discount that there will be an aural component to the

¹⁸ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

selection of the services. Overall, given the nature of the services at issue, I would expect the average consumer to pay a medium degree of attention.



Comparison of the marks

82. It is clear from *Sabel BV v. Puma AG* 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 them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, that:

“34. [...] 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.”

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

84. The trade marks to be compared are as follows:

Opponent's marks	Applicant's mark
 <p>(the first and second earlier marks)</p>	

85. Both parties have filed submissions regarding the similarity of the marks. Whilst I do not propose to reproduce the parties' submissions here, I have taken them all into consideration in reaching my decision.¹⁹

Overall impression

86. The first and second earlier marks are identical composite marks consisting of words and a figurative device element. The words 'HOME DISCOUNT' are presented in large uppercase letters, and are placed in order, one on the top of the other. 'HOME' is presented in a slightly stylised red font, whereas 'DISCOUNT' is presented in a slightly smaller plain black font. Positioned directly below 'DISCOUNT' in a much smaller font, is the email address 'www.homediscount.co.uk'. Directly to the left of the words is a large device element, resembling a black 'swing tag', featuring a stylised, white house. On balance, whilst I find that both the device and words dominate the overall impression, I find that the eye is naturally drawn to the elements of the marks that can be easily read, namely 'HOME DISCOUNT', keeping in mind *MigrosGenossenschafts-Bund v EUIPO*, T-68/17, where it was stated that:

“...in the case of a mark consisting of both word and figurative elements, the word elements must generally be regarded as more distinctive than the figurative elements, or even as dominant, since the relevant public will keep in mind the word elements to identify the mark concerned, the figurative elements being perceived more as decorative elements...”

87. The applicant's mark is also a composite mark consisting of the words 'HOME OF DISCOUNT SINCE 1879' along with a figurative device element. The words are presented in a white standard bold font and are placed in order, one on the top of the other, upon a red irregular geometric shaped background, which is outlined in white. The words 'HOME' and 'DISCOUNT' are presented in large uppercase letters, though the word 'DISCOUNT' is slightly smaller than the word 'HOME'. The word 'OF' and the phrase 'SINCE 1879' are presented in significantly smaller fonts. As for the phrase

¹⁹ Via the applicant's counterstatement and the opponent's written submissions filed on 23 September 2024.

'SINCE 1879', this will likely be understood as the date on which the business behind the mark was established, and as such, is likely to be seen as having little distinctiveness and, as a consequence, lower relative weight in the overall impression conveyed by the mark.

88. Accordingly, by virtue of their size and positioning, I find that the words 'HOME' and 'DISCOUNT' have greater visual impact, with a weaker role being played by the red figurative background, and the words 'OF' and 'SINCE 1887', due to their size and positioning within the mark. Accordingly, whilst these elements are not negligible, they will likely have little impact on the consumer.

Visual comparison

89. Visually, the marks overlap in that they all contain the dominant words 'HOME' and 'DISCOUNT' presented in a similar manner, i.e. with the word 'HOME' presented in a larger size and placed above the word 'DISCOUNT' presented in a slightly smaller size. They differ in the presence of the website address 'www.homediscount.co.uk' in the earlier marks and the words 'OF' and 'SINCE 1879' in the applicant's mark, as well as the presentational/device elements that make up the marks at issue. Taking all of this into account, I consider the marks to be visually similar to a medium to high degree.

Aural comparison

90. The words 'HOME' and 'DISCOUNT' will be pronounced identically in all three marks. The word 'OF' in the applicant's mark will be given its ordinary English pronunciation and will act as a point of aural difference. As for the website address in the opponent's marks and the words 'SINCE 1879' in the applicant's mark, it is unlikely that these elements will be articulated. Furthermore, the device elements in the marks will not be articulated. Accordingly, I find the marks to be aurally similar to a high degree.

Conceptual comparison

91. In my view the word 'HOME' will likely be recognised as reference to *a house or dwelling, or a place where something or someone originates from*; and 'DISCOUNT' will likely be recognised as reference to *a reduction in the usual price of something*.

92. The element 'www.homediscount.co.uk' present in the opponent's marks will be perceived as a website address. The word 'OF' in the applicant's mark will be given its ordinary dictionary meaning, used for example, to indicate the origin of something; and the phrase 'SINCE 1879' will be perceived as the date in which the business behind the mark was established. Whilst these elements all act as points of conceptual difference between the marks, I am of the view that they are not particularly distinctive.

93. The device element in the earlier marks brings to mind the concept of a 'swing tag' featuring a house/home, creating a degree of conceptual difference. However, this element is very low in distinctiveness bearing in mind the retail services at issue, on the basis that it will merely be understood as reference to a price tag for the retailed goods. The red irregular geometric shaped background in the applicant's mark fails to convey any particular conceptual message.

94. Whilst not directly descriptive, I am of the view that when considered as a whole, the words 'HOME DISCOUNT' in the opponent's marks convey an allusive message, namely, *a reduction in the usual price of something that is intended for the home*. With regards to the applicant's mark, I am of the view that due to its overall size and position in the mark, the word 'OF' will likely be overlooked, and as such, the mark will also be perceived as 'HOME DISCOUNT'. However, if 'OF' is not overlooked, whilst not directly descriptive, I find that the words 'HOME OF DISCOUNT' convey an allusive message, namely *a place where reductions in the usual price of something can be found*. Overall, if the word 'OF' in the applicant's mark is overlooked, the concept conveyed by the dominant words 'HOME DISCOUNT' is identical in both marks. In the event that the word 'OF' is not overlooked, I find that the marks are conceptually similar to a medium to high degree.

Distinctive character of the earlier trade mark

95. The distinctive character of a trade mark can be measured only, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, 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).”

96. 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 or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the

more distinctive the earlier mark, the greater the likelihood of confusion. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

97. The earlier marks contain the words 'HOME DISCOUNT', which whilst not directly descriptive, in the context of the retail services at issue, allude to characteristics of the services, namely that they provide *a reduction in the usual price of something intended for the home*. With regard to the figurative element present in the mark, this will likely be perceived as representing a 'swing tag' featuring a figurative home/house device. Broadly speaking, a swing tag comprises a small cardboard label, commonly attached to retail products such as clothing, etc. The 'www.homediscount.co.uk' will be perceived as a website address. Keeping in mind their overall presentation, I find that the earlier marks have between a low to medium degree of inherent distinctive character.

98. I note that in his witness statement, Mr Handa states that the Home Discount brand has an established reputation in the UK and Europe as one of the largest online retailers of furniture and home goods. However, the opponent has not specifically pleaded that its marks have acquired enhanced distinctive character through use. Nevertheless, as the opponent has filed evidence of use, as summarised above, I will make a finding in relation to enhanced distinctiveness for the sake of completeness.

99. The overall turnover figures provided by the opponent demonstrate an impressive turnover during the relevant period, taking into account the goods and services at issue. However, I am of the opinion that the sales, supported by the invoices provided, do not represent a particularly significant share of what is undoubtedly an extensive market. Furthermore, whilst I recognise that the use shown has taken place over several years in the UK, advertising expenditure has not been included in the evidence of use and data relating to marketing activities are also absent. Taking all of this into account, I find that there is nothing in the evidence before me to suggest that the opponent's mark has acquired an enhanced degree of distinctiveness in relation to the goods and services at issue. Accordingly, I am of the view, that the opponent's evidence falls short of what would be required to show that the distinctive character of the opponent's marks have been enhanced through use.

Likelihood of confusion

100. 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. One such factor 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 services, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and services, and the nature of the purchasing process. In doing so, I must be mindful 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 they have retained in their mind.

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

102. Earlier in the decision I found that:

- The marks are visually similar to between a medium to high degree, aurally similar to a high degree, and depending on how the marks are perceived, they are either conceptually identical, or conceptually similar to between a medium to high degree;
- I have found the parties' goods and services to range between identical to dissimilar;
- I have found the average consumer to be a member of the general public or a business user, who will select the services at issue through visual means (although I do not discount an aural component). Given the nature of the

services, I would expect the average consumer to pay a medium degree of attention.

- The earlier marks are inherently distinctive to between a low to medium degree. On this point, it is acknowledged that a weaker degree of distinctive character in an earlier mark does not preclude a finding of confusion.²⁰ Furthermore, I have found that the opponent's evidence does not show that the distinctiveness has been enhanced through use.

103. Taking all the above factors into account, I keep in mind that the marks at issue share the same identical dominant words, 'HOME' and 'DISCOUNT', and that the differences between the marks are caused by elements that are not particularly distinctive. Furthermore, due to their size and positioning within the marks, I find that the words 'OF' and 'SINCE 1879' in the applicant's mark, and the website address in the opponent's marks will have a lesser impact on the overall impressions of the marks.

104. Accordingly, given the stated similarities between the marks, I am of the view that the average consumer is likely to remember the marks as 'HOME DISCOUNT' marks, with the additional elements in the marks, including the figurative elements, going unnoticed, being overlooked, or forgotten. Even in the case that the word 'OF' present in the applicant's mark is noticed, due to its size and position in the mark, this does not take away from consumers misremembering 'OF' and focusing their recollection on the dominant words 'HOME DISCOUNT'. On this point, I remind myself that consumers are rarely able to compare marks side by side and, as such, are likely to forget which marks had the letter 'OF' or the particular device elements, etc, and which ones did not. Instead, the average consumer will simply seek to remember the marks by recalling the shared dominant verbal element, being 'HOME DISCOUNT'.

105. Therefore, given the level of similarity across the marks and the similarity or identity between the services at issue, I am of the view that the average consumer is unlikely to recall the differences between the marks resulting in a likelihood of direct

²⁰ See *L'Oréal SA v OHIM*, Case C-235/05 P

confusion. This is so even bearing in mind the earlier marks' low to medium level of inherent distinctive character. In reaching this conclusion I note that a degree of caution is required before finding a likelihood of confusion on the basis of common elements which are either descriptive or are low in distinctive character,²¹ nevertheless, I maintain that there is a likelihood of direct confusion.

106. For the avoidance of doubt, I will proceed to consider indirect confusion. In doing so, I remind myself of the comments of Iain Purvis KC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:²²

“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.”

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

²¹ *Nicoventures Holdings Limited v The London Vape Company Ltd* [2017] EWHC 3393 (Ch) and *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch)

²² BL O/375/10.

(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).”

107. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

108. I have borne in mind that the examples given by Mr Purvis are not exhaustive. Rather, they were intended to be illustrative of the general approach.²³

109. In my view, in the circumstances where consumers do notice the difference between the marks, they will perceive the addition (or removal) of the additional elements, merely as brand variants or sub-brands of the ‘HOME DISCOUNT’ mark. To my mind, consumers will not see ‘HOME DISCOUNT’ used on different marks in relation to similar or identical services and put it down to mere coincidence. Rather, they are far more likely to assume a connection between the two undertakings and will simply consider that the additional elements in the application is an alternative mark being used by the same or economically linked undertaking by virtue of the common use of ‘HOME DISCOUNT’. Therefore, I find that there is a likelihood of indirect confusion.

Conclusion

110. The opposition under section 5(2)(b) is partially successful in respect of the following services, for which the application is refused:

Class 35 Retail services connected with the sale of furniture, furnishings, home textiles, floor coverings, carpets, tableware, cutlery, kitchen knives, cups and glasses, garden articles, lighting, wall coverings, works of art, festive decoration items, threads,

²³ See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17 at paragraphs [81] to [82].

yarn, fabrics, sewing articles, food preparation equipment, food cooking equipment, refrigeration equipment, paints, cooking appliances, kitchen appliances, refrigeration appliances, household electrical appliances, electronic household appliances, heating equipment, batteries, building materials, flowers, horticultural equipment, horticultural products, freezers, apparatus for human hygiene purposes, heating appliances, small hardware goods, water supply facilities, chemical products for horticultural purposes, chemical products for agricultural purposes, horticultural products, horticultural equipment, hand-operated equipment for construction purposes, hand-operated tools for construction purposes, hearing protection devices, sanitary installations.

111. The application can proceed to registration in respect of the following services for which the opposition has been unsuccessful:

Class 35 Retail services connected with the sale of tobacco, automobile parts, car accessories, baked goods, construction machinery, clothing, clothing accessories, clothing, beers, fuels, tanning apparatus, computer hardware, computer software, desserts, printed matter, fragrance preparations, animal bedding materials, disposable paper products, ice cream, bicycle accessories, vehicles, delicatessen goods, meat, fruit ices, fruits, animal feed, luggage, devices for hygiene purposes for animals, devices for human beauty purposes, beauty devices for animals, navigation devices, physical therapy equipment, hair products, pet products, coffee, cocoa, confectionery, headgear, motor vehicle accessories, art materials, artificial fur, foodstuffs, seafood, dairy products, mobile telephones, fashion accessories, musical instruments, preparations for veterinary purposes, nutritional supplements, foodstuffs, paper and stationery, preparations for making beverages, preparations for making alcoholic beverages, umbrellas, cleaning supplies, cleaning products, saddlery, lubricants, jewellery, chocolate, stationery, footwear, smartphones, smart watches, games, toys, sporting goods, sports equipment, strollers and buggies, sporting goods, animal litter, sweets, tobacco, bags, diving equipment, tea, animal care products, toiletries, teaching materials, weapons, timekeeping instruments, non-alcoholic beverages, alcoholic beverages, alcoholic beverages (other than beers), audiovisual equipment, pre-recorded content, dietetic products, frozen yoghurt, downloadable music files, downloadable electronic publications, information technology equipment, medical apparatus, medical instruments, pharmaceutical, medical and veterinary articles and

sanitary preparations, sexual aids, portable computers, multimedia content; The bringing together, for the benefit of others, of telecommunications services and entertainment services, enabling customers to conveniently view and purchase those services.

Costs

112. As both parties have had a measure of success in this opposition, I decline to award costs.

Dated this 22nd day of September 2025

**Sam Congreve
For the Registrar**