

O/1008/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003998334

BY R K WHOLESALE LIMITED

TO REGISTER THE FOLLOWING TRADE MARK:

DUST MASTER

IN CLASS 7

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 446486

BY RVT GROUP LIMITED

BACKGROUND AND PLEADINGS

1. On 04 January 2024, R K Wholesale Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 19 January 2024. The applicant seeks registration for the following goods – this is the specification as it now stands after the applicant applied to amend the original specification by way of a Form TM21B filed on 25 March 2024:

Class 7: *Domestic vacuum cleaners; hand-held domestic vacuum cleaners; wet and dry domestic vacuum cleaners; domestic bagless vacuum cleaners; domestic floor cleaning apparatus; domestic floor polishing machines; carpet washingmachines for domestic use; nozzles, brushes and containers for domestic vacuum cleaners.*

2. On 18 March 2024, the application was opposed in full by RVT Group Limited (“the opponent”) under Sections 5(1), 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).¹

3. Under Section 5(1) and 5(2)(b), the opponent relies upon the following trade mark and the goods covered by the same as shown below:

UK00002506428

DUSTMASTER

Filing date: 14 January 2009

Registration date: 24 April 2009

Class 7: *Portable dust filtration unit for building works, mobile dust filtration unit for building works.*

¹ The opposition under Section 5(1) is partial being directed against some of the applied-for goods, whilst it is directed against all of the goods in the specification under Section 5(2)(b) and 5(4)(a).

4. The trade mark relied upon by the opponent qualifies as an “earlier trade mark” in accordance with Section 6 of the Act because it was applied for at an earlier date than the filing date of the applicant’s mark. Having been registered for more than five years at the date the applicant’s mark was filed for registration, the opponent’s earlier mark is subject to the use conditions contained in Section 6A(3) of the Act.

5. Under Section 5(1), the opponent claims that the marks are identical and that some of the goods in the original specification are identical. The goods identified by the opponent as being identical are those highlighted in bold below:²

Class 7: *vacuum cleaners; hand-held vacuum cleaners; wet and dry vacuum cleaners; bagless vacuum cleaners; floor cleaning apparatus; nozzles, brushes, containers all for vacuum cleaners.*

6. In relation to the identity of the goods, the opponent states as follows:

“With reference to the goods under the Application, the Opponent contends these are identical in terms of their nature, purpose, trade channels and end users. The Application covers a range of cleaning apparatus mainly vacuum cleaners. Such goods are identical in their nature to the Opponent's 'Portable dust filtration unit for building works, mobile dust filtration unit for building works' goods. Vacuum cleaners are essentially dust filtration units as they are used to pick up dust and dirt in both commercial and domestic settings. Notably the Application covers the term 'Electric apparatus for the cleaning and care of surfaces of all kinds' which would wholly encompass the Opponent's dust filtering unit goods, thus the goods are identical.

² The original specification was as follows: Class 7: *Electric apparatus for the cleaning and care of surfaces of all kinds; electric apparatus for the cleaning and care of floors, carpets, upholstery, vehicle interiors, hard surfaces, windows and mirrors; vacuum cleaners; hand-held vacuum cleaners; wet and dry vacuum cleaners; water filtration vacuum cleaners; mini and light weight vacuum cleaners; bagless vacuum cleaners; window vacuum cleaners; floor cleaning apparatus; floor polishing machines; carpet washing machines; hard floor mopping machines; steam cleaning machines and apparatus, steam jet machines, high-pressure washers and cleaners; cleaning brushes, brush attachments, dust cleaning tools, nozzles, crevice nozzles, carpet nozzles, hard surface nozzles, beating rollers, electric brushes, articulated brushes, filters, hoses, dust containers all for vacuum cleaners.* In reproducing the terms which were originally opposed, I have removed the goods that are no longer included in the new limited specification.

In addition the Opponent contends that the terms 'dust cleaning tools, nozzles, crevice nozzles, carpet nozzles, hard surface nozzles, beating rollers, electric brushes, articulated brushes, filters, hoses, dust containers all for vacuum cleaners' are identical to the Opponent's 'dust filtration unit' goods."

7. Under Section 5(2)(b), the opponent claims that the marks are similar and that the goods are identical or similar, leading to a likelihood of confusion. As regards the goods which are not identified as being identical under Section 5(1) namely "*floor polishing machines; carpet washing machines; hard floor mopping machines; steam cleaning machines and apparatus, steam jet machines, high-pressure washers and cleaners*" (as set out in the original specification – see footnote 2), the opponent states that they are, nonetheless, similar because they share the same purpose in terms of electrical cleaning apparatus which can be used on floors in both commercial and domestic settings, thus making them highly similar to the goods as covered by the earlier registration. Alternatively, the opponent states that in the event the goods are not deemed identical to the opponent's dust filtration goods, they are highly similar because "*vacuum cleaners are designed to pick up, collect and filter dust from surfaces in both commercial and domestic settings. All such goods share the same nature, purpose, end users and trade channels. Vacuum cleaners and dust filtration devices are present in both commercial and domestic settings, either as a vacuum cleaner or a more heavy-duty vacuum cleaner used by the general public and professionals*".

8. Under Section 5(4)(a), the opponent relies upon the sign 'DUSTMASTER' which it claims to have used throughout the UK since 14 January 2014 in relation to *Portable dust filtration unit for building works, mobile dust filtration unit for building works*. The opponent states that given the identity of the opponent's earlier sign and the applicant's mark, and the identity and high similarity of the goods at issue, any use of the applicant's mark in relation to the applied-for goods will amount to a misrepresentation of these goods as being those of, or being associated with, the opponent which is likely to result in the opponent suffering a damage.

9. The applicant filed a counterstatement denying the claims with the exception of the similarity of the marks which is admitted. Further the applicant put the opponent to proof of use.

10. The opponent is represented by RVT Group Limited, and the applicant is represented by Sonder & Clay. Only the opponent filed evidence, along with written submissions dated 29 July 2024. No hearing was requested, and only the applicant filed written submissions in lieu. This decision is taken after careful consideration of the papers.

EU Law

11. 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.

The evidence

12. The opponent's evidence came in the form of two witness statements one from Timothy Dupont and one from Rachel Platts.

13. Mr Dupont is the director of the opponent's company, a position he has held since 2012. His witness statement is dated 25 July 2024 and is accompanied by 16 exhibits, being those labelled TD1 - TD16. The purpose of Mr Dupont's witness statement is to prove use of the opponent's mark and goodwill in the corresponding sign.

14. Ms Platts is a chartered trade mark attorney employed by the opponent's representative in these proceedings. Her witness statement is dated 29 July 2024 and is accompanied by 4 exhibits, being those labelled RP1 - RP4. The purpose of her witness statement is to demonstrate that the goods at issue are similar.

15. I do not intend to summarise the evidence filed in full here (or the submissions of the parties, for that matter). However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

PROOF OF USE

16. 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.

(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.”

17. Section 100 is also relevant, which 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.”

18. 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 Merken 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 goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation

has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

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

19. The relevant period in which genuine use must be established is the five-year period ending with the filing date of the application for registration: 5 January 2019 to 4 January 2024.

The evidence of use

20. Mr Dupont’s evidence focuses entirely on one product which he calls “*the DUSTMASTER*” product. Mr Dupont says that the ‘DUSTMASTER’ product is a self-contained mobile dust extraction unit designed to capture and filter dust from a wide range of applications. The product was first launched in 2009 with the Pro version being released in 2020 and is available directly from the opponent’s company and through selected third parties. Mr Dupont says that the ‘DUSTMASTER’ product bears the ‘DUSTMASTER’ trade mark on the front control panel and that the trade mark has been in continuous use from its launch up until the date of the witness statement.

21. According to Mr Dupont, the ‘DUSTMASTER’ product has been created in house by the opponent and is then hired to third parties for the duration of the contract – this suggests that any revenue generated by the opponent derives from the hire of the product, rather than from its sale. This is further confirmed by copies of webpages from a third party’s website which shows the ‘DUSTMASTER’ product being available for hire but not for sale.³

22. Mr Dupont says that the opponent has invested heavily in the development and design of the product and has obtained trade mark protection as well as design and patent protection in several countries including the UK, the EU, Canada, Australia,

³ TD8

New Zealand, and the USA (with a pending design application in the USA at the date of the witness statement). Copies of registration certificates for registered designs for a product described as “dust extractor” are provided from Canada (2023), New Zealand (2020), EUIPO (2020), Australia (2021).⁴

23. Mr Dupont provides undated screenshots of the opponent’s website showing the ‘DUSTMASTER’ product at www.rtgroup.co.uk/hire-equipment/dust/dustex-ustmaster-pro.⁵ The screenshots include case studies about projects whereby the opponent’s ‘DUSTMASTER’ products have been used, all of which are construction projects which required dust control. In addition, the screenshots show that the ‘DUSTMASTER’ product is recommended for extracting dust from “*drilling, cutting, sawing, wall chasing, stone cutting, concrete breaking*” etc. Similar pages showing the ‘DUSTMASTER’ product as they appeared on various dates in 2020 and 2021 (within the relevant period) are provided by way of archive screenshots, obtained using the Wayback Machine.⁶ The ‘DUSTMASTER’ product also appears (as shown below) in a product catalogue which Mr Dupont says is from 2022, although I cannot see the year:⁷

 **DUSTEX®**

Protected by
Patent and
Registered
Design

DUSTEX® Dustmaster Pro



- A self-contained mobile dust filtration unit with an integral fan delivering up to 2,500 m³/hr of free air when used with 3 stages of filter media.
- Capable of creating negative pressure, designed with a 100% reliable seal for minimal dust migration and zero pressure loss.
- Offers washable filters included in the kit hire price with optional filters up to HEPA standard, making it suitable for ultra-sensitive work environments.
- Castor wheels allow easy movement throughout work progression with a reduced noise level of 70dB at 1 metre and audible warning when filters are full.

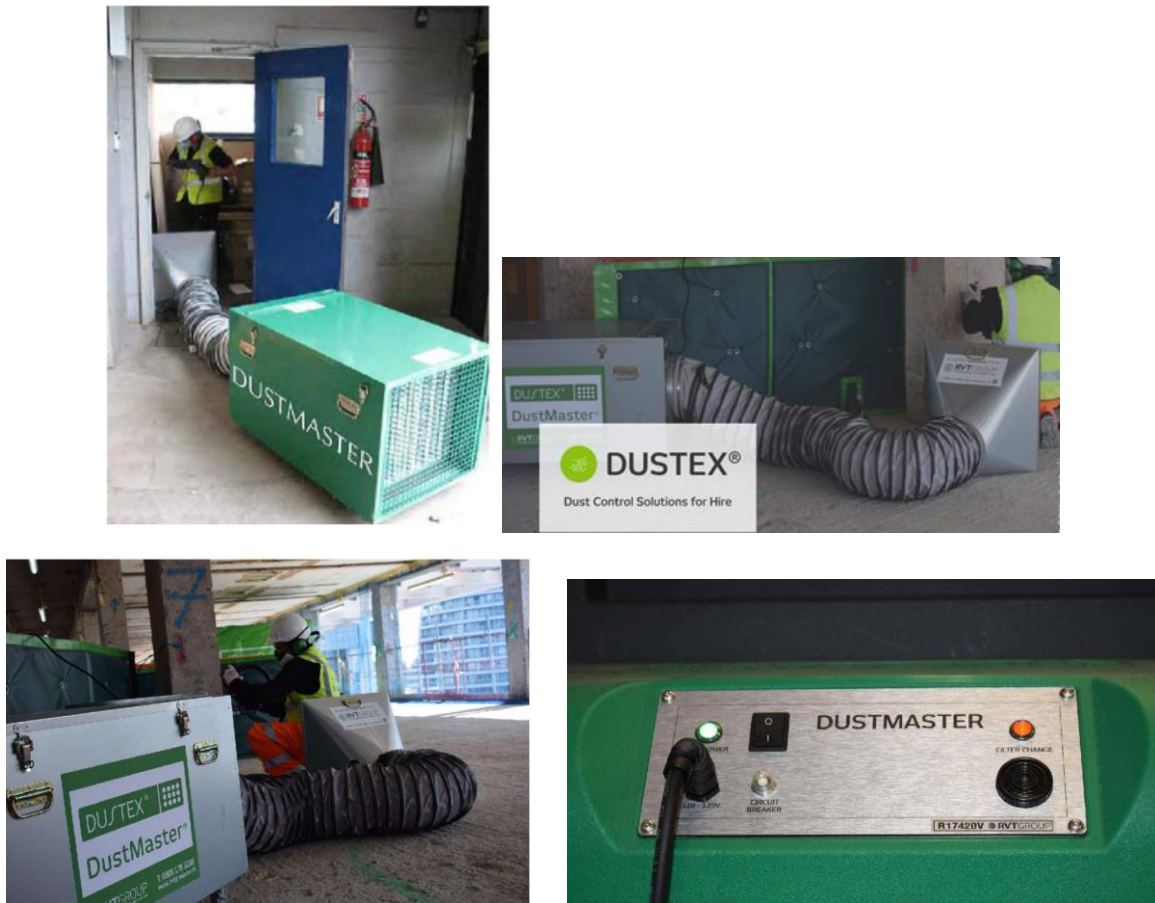
⁴ TD1

⁵ TD2

⁶ TD3

⁷ TD5

24. In addition, copies of pages from documents showing the product specification and images showing the products in use demonstrate that the mark 'DUSTMASTER' features on the goods themselves as shown below:⁸



25. Copies of pages from the opponent's company overview brochure for 2017 also confirm that the sector in which the opponent operates is that of construction.⁹ One of the pages states: *"For over 20 years RVT Group (formerly Rentavent) has provided support in controlling on-site health hazards. Now boasting a large hire fleet of specialist equipment for controlling dust, noise fumes and air quality RVT is established as the UK expert in on-site environmental control"*.

26. Mr Dupont provides the following UK turnover figures which, he says, relate to the 'DUSTMASTER' products:

⁸ DT6 and DT11

⁹ TD4

| Year | Turnover (£) |
|----------------------|-------------------|
| 2017 | £484,939 |
| 2018 | £492,595 |
| 2019 | £440,288 |
| 2020 | £310,952 |
| 2021 | £520,199 |
| 2022 | £651,114 |
| 2023 | £632,226 |
| 2024- to 31 May 2024 | £223,197 |
| Total | £3,755,510 |

27. Sample invoices are provided in support of the above figures.¹⁰ They confirm that the 'DUSTMASTER' product is provided through a hiring contract, the price being measured in weeks.

28. The rest of the evidence include marketing material, copies of photos showing the opponent's attendance at trade shows and products in use, extracts showing posts published on Facebook (from 2019) and LinkedIn (undated) from the opponent's social media accounts, as well as copies of online articles from www.industryupdate.co.uk (October 2021), www.alanguthrieonhire.com, www.refurbandrestore.co.uk, www.speedyservices.com and www.szerelmey.com¹¹ (these are all undated save for the printing date of 23 July 2024). However, these articles are mostly about the opponent rather than the brand 'DUSTMASTER'.¹² Mr Dupont states that all this material is dated between 2014 and 2024; whilst the date is not visible on the actual pages, some of the material and images shows a creation date prior to the relevant period (e.g. 2015) or within it.

Genuine use

29. The opponent's evidence is very clear and concise in relation to the points it covers. It shows that the opponent has designed and developed a type of product which falls within the registered specification, namely a portable/mobile dust filtration unit for building works. It also shows that the earlier mark 'DUSTMASTER' has been used only in relation to such product. The turnover for the relevant period is

¹⁰ DT16

¹¹ www.speedyservices.com and www.szerelmey.com

¹² TD7, TD9, TD10, TD11, TD12

approximately £2.5 million, all of which has been generated by the hiring of the 'DUSTMASTER' product; given that the turnover relates to one type of goods only, it is in my view, a healthy turnover. Admittedly, there are no marketing figures and no market share, however, there is evidence of some marketing efforts being carried out by the opponent to promote the goods during the relevant period.

30. The only point which I think is worth observing is that the goods are not sold but leased to the end consumers, which are mostly building companies; this is confirmed by an online article which defines the opponent as a "*specialist hiring company*" with a team of consultants that work with the clients to understand the full scope of the client's activities on site before recommending "*a fully compliant health hazard control solution*". However, I do not think this is a real problem. I say this because leasing goods to a company can be a legitimate business practice, especially when the goods are used for business purposes, such as in this case. Lastly, it is well established that a trade mark is considered to have been used "*in relation to*" goods/services if an average consumer would perceive the user of the mark/sign to have some responsibility for the quality of the goods/services – in this case, the mark being affixed to the goods, the average consumer seeking a portable/mobile dust filtration unit for building works to hire would perceive the sign 'DUSTMASTER' as a badge of origin in relation to the dust filtration units offered for hire by the opponent.¹³ Accordingly, I am satisfied that the opponent has made genuine use of the earlier mark for the goods relied upon.

Section 5(1) and 5(2)(b) of the Act

31. Sections 5(1) and 5(2)(b) are as follows:

¹³ easyGroup Ltd v Nuclei Ltd & Ors [2023] EWCA Civ 1247, paragraph 68

“Relative grounds for refusal of registration.

5. (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

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

(a) ...

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

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

32. Section 5A states:

“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.”¹⁴

33. The following principles for determining whether there is a likelihood of confusion under section 5(2)(b) of the Act are taken 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-

¹⁴ This section also applies to the ground raised under sections 5(3).

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

34. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

35. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

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

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

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

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

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

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

36. 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:

“[...] 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.”

37. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that responsibility for the goods and services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13:

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

38. Whilst on the other hand:

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

39. In *Gérard Meric v OHIM*, Case T- 133/05, the GC stated that:

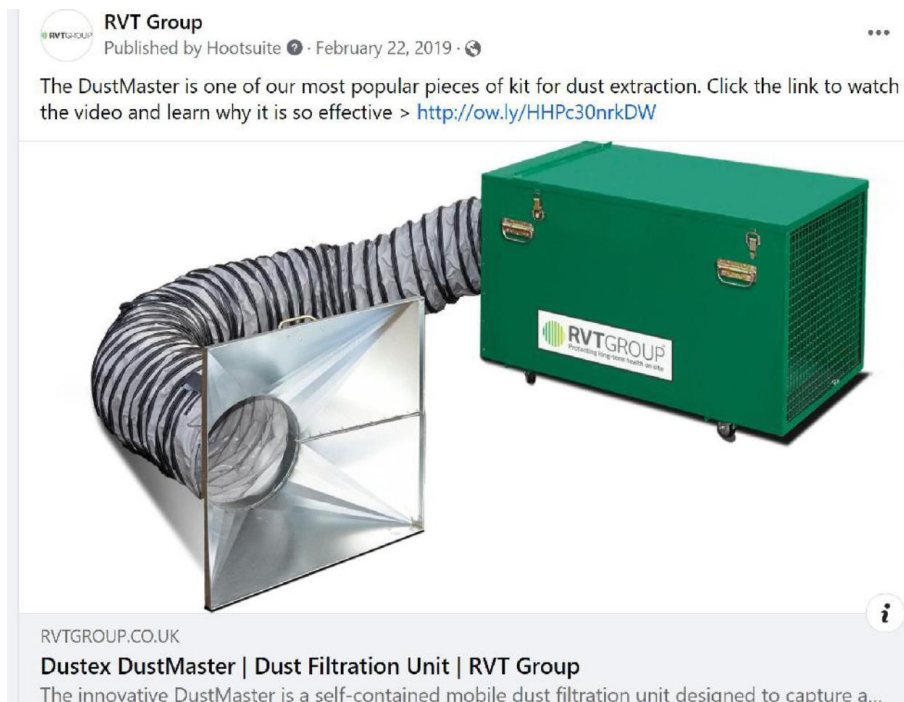
“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where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

40. The competing goods are as follows:

| The applicant’s goods | The opponent’s goods |
|--|---|
| <p>Class 7: <i>Domestic vacuum cleaners; hand-held domestic vacuum cleaners; wet and dry domestic vacuum cleaners; domestic bagless vacuum cleaners; domestic floor cleaning apparatus; domestic floor polishing machines; carpet washingmachines for domestic use; nozzles, brushes and containers for domestic vacuum cleaners.</i></p> | <p>Class 7: <i>Portable dust filtration unit for building works, mobile dust filtration unit for building works.</i></p> |

41. Clearly, the competing goods target different consumers. The opponent’s goods are dust filtration units for building works; these goods are used to control construction

dust which can be a real risk to construction workers. The goods are also referred to in the evidence as “*extraction units*”¹⁵ which reflects the terminology used in the designs certificates as “*dust extractors*”. In this connection, the evidence below proves that the terms “*dust filtration*” and “*dust extraction*” are used interchangeably in relation to the ‘DUSTMASTER’ products:¹⁶



42. In addition, the opponent’s evidence indicates that the ‘DUSTMASTER’ products are marketed as being designed to eliminate dust migration and being ideal for protecting workers against Silica Dust¹⁷ and controlling health hazards. The opponent’s own marketing material refers also to dust control on site as being “*essential to protect workers from the danger of respiratory and lung disease later in life which can be fatal*”, as shown below:

¹⁵ TD13 page 51

¹⁶ TD12

¹⁷ TD2, Page 38-39

Using suitable dust extraction and filtration equipment is just one of the steps you can take to adequately protect yourself against Silicosis and other lung diseases.



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Dust control

Effective dust control on site is essential to protect workers from the danger of respiratory and lung disease later in life, which can be fatal.

Dust management on site is critical for the long-term happiness and health of those working there. Our wide range of specialist equipment ensures that your workers are protected to the highest standards, and your sites enjoy significantly reduced dust migration and associated clean-up costs.

43. Although I bear in mind that the comparison between the goods ought to be carried out based on the ordinary and natural, or core, meaning¹⁸ of the terms as they are registered and applied-for, in this case the opponent's goods *Portable dust filtration unit for building works, mobile dust filtration unit for building works* belong to a niche and highly specialised market, namely that of solutions to the problem of on-site dust in the construction sector. In addition, I consider that the evidence filed by the opponent as to the nature of the goods fairly reflects (and tally with) what the terms in the earlier mark's specification cover. Consequently, I consider that the evidence filed by the opponent about the use of the earlier mark can be properly used as an aid to the interpretation of the registered terms.

44. Accordingly, based on the language of the earlier specification and the evidence produced by the opponent, the registered *Portable dust filtration unit for building*

¹⁸ YouView TV Ltd v Total Ltd [2012] EWHC 3158 (Ch)

works, mobile dust filtration unit for building works are large pieces of dust filtration and extraction equipment which help improve air quality on construction sites. In this connection, Collins online dictionary defines “building works” as being a formal expression meaning “construction projects”; the latter are carried out by developers and contractors and would not cover, in my view, DIY repairs carried out by homeowners.

45. Conversely, the applied for goods are all for domestic use and include domestic vacuum cleaners, domestic floor cleaning apparatus, domestic floor polishing machines, carpet washing machines and accessories for vacuum cleaners.

46. I agree with the applicant that the users of the respective goods are entirely different, as the opponent’s goods will be used by construction workers/construction companies, whereas the applied-for goods will be used by the general public, purchasing vacuum cleaners for use at home.

47. Conversely, the opponent argues that the goods are identical or highly similar, relying on Ms Platts’ evidence consisting of a dictionary definition of the word “*vacuum cleaner*” which is defined as “*a machine that cleans floors and other surfaces by sucking up dust and dirt*”. Ms Platts also says that from her research, it is evident that dust filters are common in vacuum cleaners and that “*such parts are often bought as spares or replacement parts for a vacuum cleaner and thus there is a wide range of these dust filters available on the market*”. She also provides printouts from various brands of vacuum cleaners, showing the spare parts for dust filters.

48. The main issue with Mr Platts’ evidence and arguments is that vacuum cleaner filters are different types of goods compared to the opponent’s dust filtration units for building works. The opponent’s dust filtration units are dust extractors, they are not filters in themselves. Filters are small components of any vacuum cleaner, they are usually made from cloth, foam, or paper, and their function is to capture unwanted particles while a substance passes through them. On the contrary, the opponent’s goods are large pieces of equipment used on construction sites for protecting workers from hazardous airborne contaminants by filtering hazardous dust.

49. Consequently, the filtration properties of the goods are different, the filtration system of the opponent's goods being aimed at filtering the air from contamination on construction sites in order to reduce health hazards for workers, the filtering system of vacuum cleaners for domestic use being aimed at cleaning and collecting dust and small particles from floors and other surfaces in a domestic environment. The fact that both goods might incorporate a filter or filtering system, does not make them similar. Given what I have said earlier about using the evidence as an aid to interpret the terms in the opponent's specification, the opponent's argument (a) ignores the different nature of the goods at issue and the fact that the opponent's goods are meant to be used on construction sites by construction workers, whilst the applied-for goods are meant to be used by the general public at home; (b) stretches the meanings of the word 'FILTERING' in the earlier specification beyond what the goods are, as the filtering properties of the goods are totally different.

50. The goods have different uses, users, nature and purpose. They have different methods of use, target different consumers, do not share distribution channels and are neither complementary nor in competition. These goods are dissimilar.

51. The goods being dissimilar, the Section 5(1) objection fails as one of the requirements of that section is that the goods are identical. As regards the grounds under Section 5(2)(b), in *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

"49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity."

52. Some similarity of goods is therefore essential for a likelihood of confusion to be established. Since I have concluded that the goods are dissimilar, the opposition, insofar as it relies on the Section 5(1) and 5(2)(b) ground, fails at the first hurdle.

Section 5(4)(a)

53. Section 5(4)(a) states:

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

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

(aa) [...]

(b) [...]

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

54. Subsection (4A) of Section 5 states:

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

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

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

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

56. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

"Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

The relevant date for Section 5(4)(a)

57. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the registrar’s assessment of the relevant date for the purposes of Section 5(4)(a) of the Act, as follows:

“43. In *SWORDERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

58. The *prima facie* relevant date is the date the applied-for mark was filed, that is to say 04 January 2024. As there is no evidence of the applicant having used the applied-for mark that is the only relevant date.

Goodwill

59. Having found that there has been genuine use of the earlier mark, I also find that at the relevant date the opponent had a protectable goodwill in the sign and for the goods relied upon.

Misrepresentation

60. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J. made the following findings about the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff’s business. The expression “common field of activity” was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff’s claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd.* (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego* case *Falconer J.* acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

‘...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’:

Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency) [1972] R.P.C. 838 at page 844 per Russell L.J.

In the *Lego case Falconer J.* likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

‘even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely

different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.'

In the same case Stephenson L.J. said at page 547:

'...in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged "passer off" seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.' "

61. Even considering that the marks are nearly identical, and that misrepresentation can occur when the parties operate in different fields of activity, as the case law establishes, what the plaintiff in an action for passing off (in this case the opponent) must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties. As the parties' goods are intended for different publics (i.e. member of the general public who purchase vacuum cleaners or cleaning equipment for domestic use, as opposed to construction companies which purchase dust extractors or filtering units to ensure the construction site is free from dust intended as a health hazard), there cannot be misrepresentation in this case. Lastly, even conceiving that a few members of the public who work in the construction sector and hire the opponent's goods might also purchase the applicant's vacuum cleaners for use at home, that would be a very rare instance and would not pass the test of a significant proportion of the relevant public being confused.

CONCLUSIONS

62. The opposition has failed under all grounds.

63. The application will proceed to registration.

COSTS

64. The applicant has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the applicant the sum of £1,200 as a contribution towards the costs of proceedings. The sum is calculated as follows:

Filing counterstatement and considering the notice of opposition: £400

Considering the other party's evidence: £500

Submissions in lieu: £300

Total: £1,200

65. I therefore order RVT Group Limited to pay R K Wholesale Limited the sum of £1,200. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 30th day of October 2025

TERESA PINTO

For the Registrar