O/1053/25

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3946745 BY ROSELAND FURNITURE LIMITED TO REGISTER THE TRADE MARK:

Farrow

IN CLASSES 20, 35 & 42

AND

THE OPPOSITION THERETO UNDER NO. 444358 BY FARROW & BALL HOLDINGS LIMITED

BACKGROUND & PLEADINGS

1. Roseland Furniture Limited ("the applicant") applied to register the word trade mark shown on the front page of this decision in the United Kingdom on 17 August 2023. It was accepted and published in the Trade Marks Journal on 8 September 2023 in respect of the following goods and services:

> **Class 20:** Furniture; Furniture and furnishings; Upholstered furniture; Metal furniture and furniture for camping; Dressers [furniture]; Cushions [furniture]; Credenzas [furniture]; Wooden furniture; Furniture cabinets; Cabinets [furniture]; Patio furniture; Recliners [furniture]; Kitchen furniture; Bentwood furniture; Washstands [furniture]; Bedroom furniture; Pouffes [furniture]; Cupboards being furniture; Outdoor furniture; Drawers for furniture; Nursery furniture; Household furniture; Benches [furniture]; Bathroom furniture; Garden furniture; Lawn furniture; Desks [furniture]; Furniture shelves; Shelves [furniture]; Furniture for kitchens; Panelling for furniture; Kitchen dressers [furniture]; Wooden shelving [furniture]; Leather furniture; Stationery cabinets [furniture]; Slatted furniture; Chairs being office furniture; Shop furniture; Tables [furniture]; Seating furniture; Office furniture; Furniture (Office -); Furniture moldings; Indoor furniture; Furniture for bathrooms; Consignment shelving [furniture]; Lounge furniture; Furniture for storage; Storage furniture; Racks [furniture]; Furniture racks; Bamboo furniture; Furniture of metal; Metal furniture; Trolleys [furniture]; Furniture parts; Furniture partitions; Furniture frames; Arbours [furniture]; Pet furniture; Furniture chests; Pedestals [furniture]; Lockers [furniture]; Consoles [furniture]; Furniture for offices; Furniture partitions of wood; Partitions of wood for furniture; Furniture (Partitions of wood for -); Furniture for shops; Doors for furniture; Furniture doors; Antique style furniture; Furniture for vivariums; Furniture for washrooms; Transformable furniture; Stackable furniture; Mirrors [furniture]; Glass furniture; Furniture for

conservatories; Trestles [furniture]; Metal cabinets [furniture]; Inflatable furniture; Furniture (Inflatable-); Fireguards [furniture]; Garden furniture manufactured from wood; Seats [furniture]; Metal shelving [furniture]; Furniture for caravans; Wooden racks [furniture]; Furniture for children; Modular bathroom furniture; Joints for furniture; Shelves being nursery furniture; Computer furniture; Furniture for saunas; Camping furniture; Furniture for camping; Legs for furniture; Drawers [furniture parts]; Drawers as furniture parts; Cane furniture; Screens [furniture]; Furniture screens; Domestic furniture; Furniture for babies.

Class 35: Retail services relating to furniture.

Class 42: Design of furniture; Furniture design; Designing of furniture.

2. On 28 November 2023, Farrow & Ball Holdings Limited ("the opponent") opposed the application on the basis of Section 5(3) of the Trade Marks Act 1994 ("the Act")[1]. The opponent relies upon the following registered (comparable)[2] mark:

Trade Mark no.	UK00905018502
Trade Mark	Farrow & Ball
Registered Goods & Services	Classes 2, 11, 16, 19, 20, 24, 27 & 35
Dates	Filing date: 27 March 2006
	Date of entry in register: 20 August 2007

[1] 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.

[2] Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EU trade mark ("EUTM"). As a result, the opponent's earlier EUTM was automatically converted into a comparable UK trade mark. Comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

3. The opponent claims reputation for the following goods:

> **Class 2:** Paints, varnishes, lacquers, preservatives against rust and deterioration of wood.
>
> **Class 27:** Wallpaper.

4. Under Section 6(1) of the Act, the opponent's trade mark clearly qualifies as an earlier trade mark. The opponent's mark had completed its registration procedure more than five years before the date of the application for the contested mark ("the relevant date"). The applicant requested that the opponent prove it had made genuine use of the earlier mark for "*paints, varnishes, lacquers, preservatives against rust and deterioration of wood, and wallpaper*". The relevant provisions are those in Section 6A of the Act. These require the mark to have been genuinely used in the five-year period ending with the relevant date.

5. The opponent claims a reputation in its mark for the above listed goods as a result of the extensive marketing of its mark since 1946. The opponent claims that even though the competing goods are not necessarily similar, due to the earlier mark's reputation and the similarity between the competing marks "*alongside design and colour being pivotal aspects of furniture products, consumers are likely to form a link between them and believe that the goods and services, provided under the sign, emanate from the Opponent or an economically linked undertaking*". It also asserts that it has spent "*a significant amount of time and money over the years building its name and maintaining a level of recognition and goodwill amongst consumers.*"

6. The opponent submits that damage would occur in one or more of the following ways:

   (i) Unfair advantage, as the applicant would benefit from the reputation of the earlier mark without having to have made the same

investment and achieve sales of goods and services because of the earlier mark's reputation;

(ii) Dilution of the distinctive character of the earlier mark, as the ability of the earlier mark immediately and exclusively to identify goods as originating from the opponent would be weakened; and/or

(iii) Detriment to the reputation of the earlier mark, if the goods and services supplied by the applicant under the contested sign were of an inferior quality.

7. The applicant filed a defence and counterstatement denying the claims made and putting the opponent to proof of use of the earlier mark.

Papers Filed and Representation

8. The opponent filed evidence in chief in these proceedings. This comes in the form of a witness statement ("the first witness statement") from Neil Andrew Spreadbury, the finance director of the opponent in these proceedings. His witness statement is dated 12 April 2024 and is accompanied by 24 exhibits (NAS1- NAS24). The purpose of the evidence is to prove goodwill, recognition and reputation in the opponent's mark.

9. The applicant also filed evidence in these proceedings. This comes in the form of a witness statement from Tristan Lynch, the director of the applicant in these proceedings. His witness statement is dated 10 June 2024 and is accompanied by six exhibits (TL1-TL6). The evidence focuses on the meaning of the competing marks, the parties' trade activities, and the size of the UK furniture market. I note that the witness statement also contains submissions; however, I do not consider it too onerous a task to separate the opinions of Mr Lynch from his statements of fact. Therefore, I will adopt a pragmatic approach, treating the submissions as legal arguments and/or opinions rather than factual statements, even though they are nevertheless conveyed in a witness statement accompanied by a statement of truth.

10. In addition, the opponent filed evidence in reply which also comes in the form of a witness statements from Mr Spreadbury ("the second witness statement"). The second witness statement is dated 12 August 2024 and is accompanied by seven exhibits (NAS1A- NAS7A). The evidence aims to address the applicant's points raised in Mr Lynch's witness statement.

11. Neither side requested to be heard, and the opponent filed written submissions in lieu of a hearing on 15 October 2024.

12. I have taken this decision following a careful consideration of the papers and shall refer to the evidence and submissions where appropriate.

13. In these proceedings, the opponent is represented by Haseltine Lake Kempner LLP and the applicant by Asserson Law Offices.

Preferred Approach

14. The only ground in this opposition is Section 5(3), which requires the opponent to prove that the earlier mark has a reputation. This is a higher bar for the opponent to get over than genuine use. I shall therefore go straight to the assessment of reputation.

DECISION

Section 5(3) of the Act

15. Section 5(3) of the Act states:

> "(3) A trade mark which-
>
> (a) is identical with or similar to an earlier trade mark,
>
> […]
>
> shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or

be detrimental to, the distinctive character or the repute of the earlier trade mark."

16. As the earlier mark is a comparable mark, paragraph 10 of Part 1, Schedule 2A of the Act is relevant. It reads:

> "10.— (1) Sections 5 and 10 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.
>
> (2) Where the reputation of a comparable trade mark (EU) falls to be considered in respect of any time before IP completion day, references in sections 5(3) and 10(3) to—
>
> (a) the reputation of the mark are to be treated as references to the reputation of the corresponding EUTM; and
>
> (b) the United Kingdom include the European Union".

17. The relevant case law can be found in the following judgments of the European Court of Justice ("CJEU"): Case C-375/97, *General Motors,* Case 252/07, *Intel,* Case C-408/01, *Adidas-Salomon,* Case C-487/07, *L'Oréal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows:

> (a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24.*
>
> (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; G*eneral Motors, paragraph 26.*
>
> (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon, paragraph 29* and *Intel, paragraph 63.*

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42.*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68;* whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79.*

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34.*

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74.*

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oréal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oréal v Bellure).*

18. Section 100 of the Act stipulates that:

"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.

Reputation

19. In *General Motors*, Case C-375/97, the CJEU held that:

"25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity,

geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

20. The relevant date on which the opponent must show a reputation is the date of application for the contested mark, i.e. 17 August 2023. For the period up to 31 December 2020, the relevant territory is the EU (which then included the UK), and for the period after that date, it is the UK alone.

Preliminary point

21. I note that the exhibits accompanying the applicant's witness statement postdate the relevant date. Further, the opponent's evidence-in-reply also contain materials within Exhibits NAS1A and Exhibits NAS5A which are either undated or outside the relevant date. In addition, Exhibits NAS1 and Exhibit NAS8 postdate the relevant date in these proceedings. I accept that evidence dated after the relevant date may shed light on the position at the relevant date,[3] but I do not see that this applies here.

The opponent's evidence

22. With his witness statement, Mr Spreadbury provides a historical account for the opponent stating that "*the Opponent is a British manufacturer of paints and wallpapers, largely based upon historic colour palettes and archives. Having been established in 1946 by local entrepreneurs John Farrow and Richard Ball, the Opponent has been operating for nearly 80 years. The Opponent has used the Mark since this date*." Mr Spreadbury also mentions that the opponent has experienced a significant and rapid

[3] *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11.

growth since the 90s, focusing on restoring heritage properties with period-appropriate colours, appealing to those wanting a traditional British aesthetic by using the opponent's paints and wallpapers. According to Mr Spreadbury, the opponent opened its first store in 1996 in London using the earlier mark as its name.

23. Mr Spreadbury explains that the goods are sold either online or through physical stores in approximately 40 countries, including the UK, EU, USA, Australia, New Zealand, and Japan, through over 1,800 distribution points/retail outlets globally and 59 showrooms (globally). In the UK, distribution points increased from over 715 in 2012 to over 860 by 2021, and over 950 by the time of Mr Spreadbury's statement, including large retailers, e.g. B&Q, and smaller businesses. The number of showrooms in the UK has increased from 25 in 2012 to around 30 at the time of his statement. **Exhibit NAS2** contains two maps showing all the Opponent's stockists and showrooms in 2021 in Europe, including the UK.

24. Mr Spreadbury provides a list of examples with a wide range of branded goods, such as paint tins, wallpaper packaging, colour cards, and finishes boards at stockists, as well as in colour books and product brochures where the earlier mark was used. **Exhibit NAS3** consists of:

    (i) a set of images demonstrating products, including "BAMBOOZLE No. 304 - durable silk finish for exterior wood & metal", "DEAD FLAT – matt, durable finish for interior walls, woodwork and metal", colour cards, a book titled "RECIPES FOR DECORATING", and cardboard boxes, bearing the earlier mark along with the computer information panel that displays the creation dates of these image files, ranging from 2019 to 2023. An example is reproduced below.

(ii) four product advice sheets for goods bearing the earlier mark, namely "*masonry & plaster stabilising primer, interior wood primer & undercoat, metal primer & undercoat, wall & ceiling primer & undercoat, dragged papers*" all dated between 2018 and 2019.

25. The opponent's UK turnover figures between April 2018 and December 2022 (inclusive) are large:[4]

Period	**Approximate Turnover**
01.04.2017 to 31.03.2018	£73,451,000.00
01.04.2018 to 31.04.2019	£73,915,000.00
01.04.2019 to 29.03.2020	£76,574,000.00
01.04.2020 to 31.03.2021	£107,363,000.00
01.04.2021 to 31.12.2021	£77,977,000.00
01.01.2022 to 31.12.2022	£100,904,000.00
Total	£510,184,000.00

Although the turnover figures are very significant, they do not distinguish between the goods. Nevertheless, Mr Spreadbury highlights that the

[4] These are reproduced as they appeared in the witness statement.

opponent "*held around 6% of the UK market share for decorative paint in 2023*."

26. In addition to the above figures, **Exhibit NAS4** includes 11 sample invoices dated from 7 December 2018 to 2 January 2023, illustrating sales of goods under the earlier mark. Although the delivery details are redacted, the invoices are all addressed to customers in the UK, demonstrating signifcant invoiced amounts. For example, the smallest invoiced amount is £3,425, while the largest reaches £103,543. The mark is visible at the top of the invoices, and the invoiced products are within the range of the goods listed above.

27. Further, Mr Spreadbury presents the following table with the annual marketing spend of the opponent in the UK under the registered mark and goods:

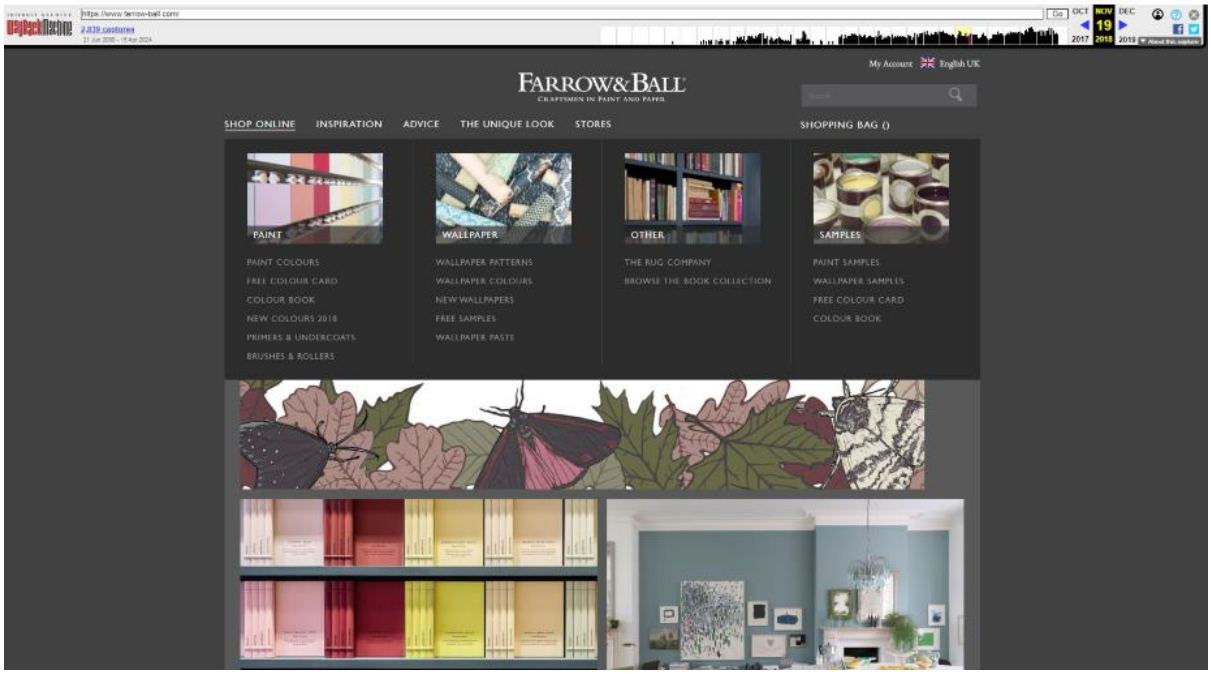
Year	Estimated Marketing Spend
2014	£5.2 million
2015	£6.7 million
2016	£8 million
2017	£7 million
2018	£7 million
2019	£6.3 million
2020	£7.5 million
2021	£6.2 million
2022	£7.4 million
2023	£9 million

28. Mr Spreadbury notes that the majority of this marketing expenditure was directed towards online and print advertising, as well as press campaigns and social media initiatives. He also states that stockists advertise the opponent's goods.

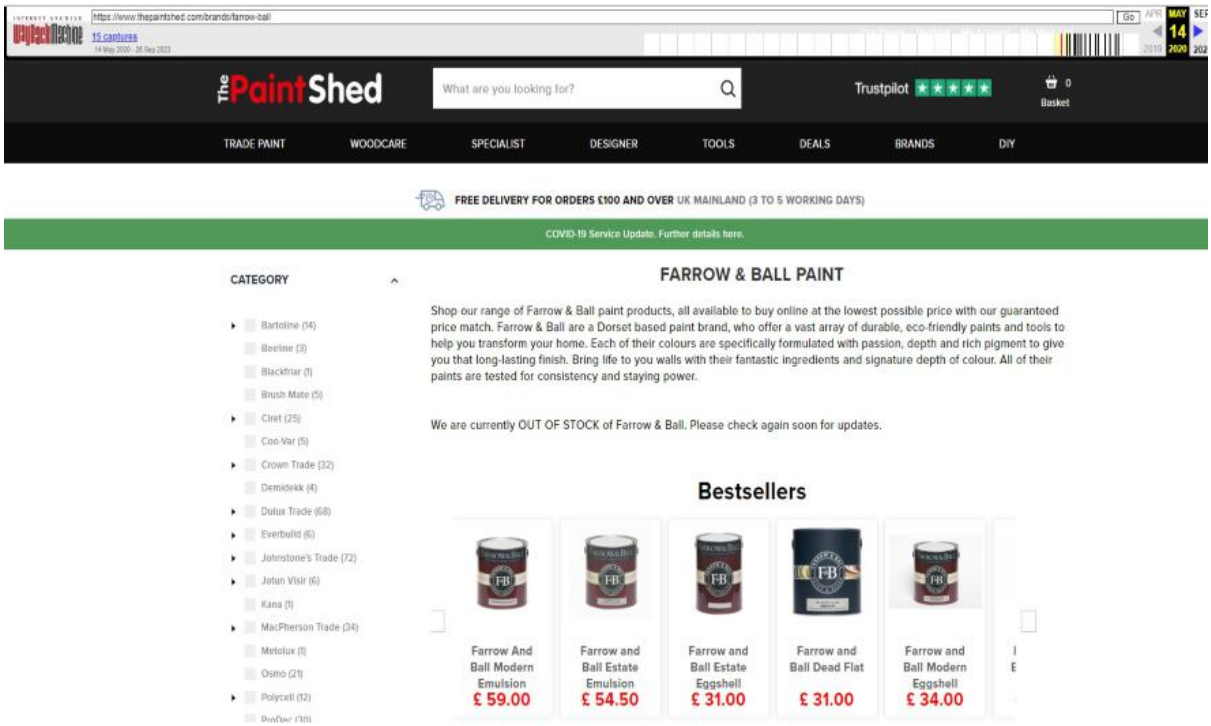
29. Mr Spreadbury provides a detailed account of marketing and advertising activities that the opponent has undertaken in the UK. He explains that the opponent's website *farrow-ball.com*, which the opponent's owned since 19 February 1997 (**Exhibit NAS5**), has over 1.5 million visits each and every

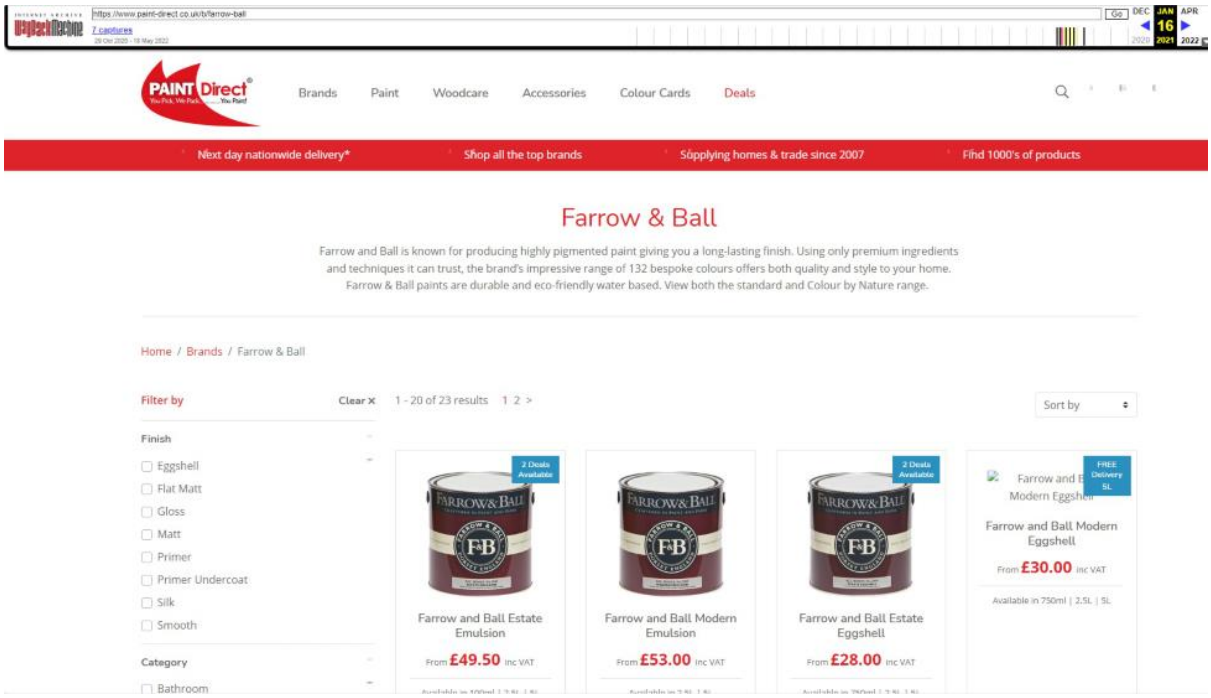
month, and the number of the UK visits amounts to approximately 15 million in 2021, and 10 million in 2022 and 2023.

30. **Exhibit NAS6** contains screenshots from the opponent's website between November 2018 and January 2023 taken from the WayBack Machine Internet archive, demonstrating the landing page of the opponent's website across different years and the 'SHOP ONLINE' drop down menu from 2018.



31. **Exhibit NAS7** contains screenshots dated between May 2020 and July 2023 taken from the WayBack Machine Internet archive. These showcase the websites of the opponent's distributors, namely the *paintshed.com* and *paint-direct.co.uk*, offering the opponent's goods, such as modern emulsion, estate emulsion, and estate eggshell paints.

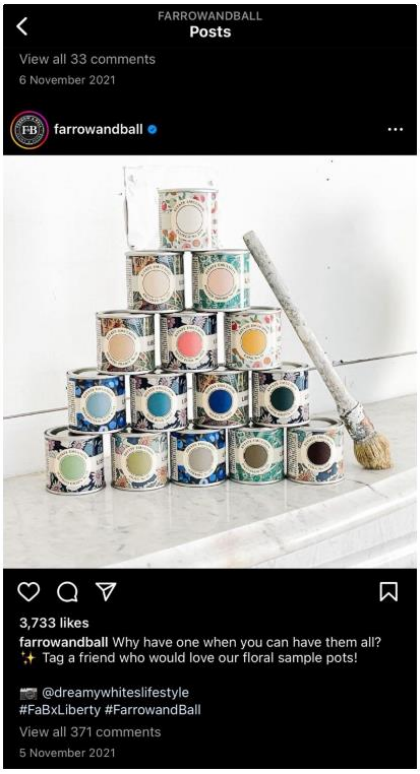




32. Mr Spreadbury presents a table (shown below) that outlines the creation dates of the opponent's social media pages, along with the follower counts recorded around the time of the statement.

Platform	Creation Date	Number of Followers/ Subscribers
Facebook: https://www.facebook.com/farrowball/	25 October 2010	915,000
Twitter / X: https://twitter.com/FarrowandBall	April 2010	50,000
Instagram: https://www.instagram.com/farrowandball/	July 2012	1.7 million
Pinterest: https://www.pinterest.co.uk/farrowball/	-	200,000
YouTube: https://www.youtube.com/user/farrowandballtv	October 2011	13,000

33. **Exhibit NAS9** contains Instagram posts from 19 November 2018 to 13 July 2023. I note that the number of likes and comments is significant, and the posts demonstrate the opponent's goods, such as paint pots and wallpaper, with the use of the hashtag "#FarrowandBall".



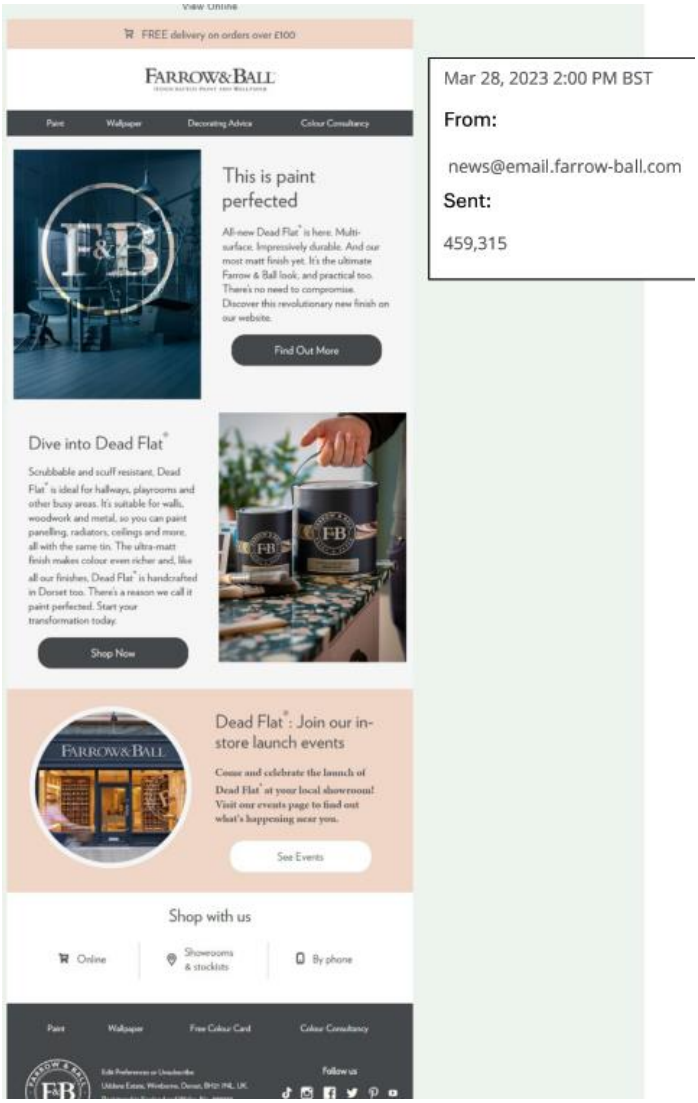
34. In addition to the above, Mr Spreadbury provides social media analytics for 2022 and 2023 with **Exhibit NAS10**. I note that the reports refer to the social media users as 'fans'. In 2022, the UK ranked first, with a fanbase exceeding 947K, which increased to 998K in 2023. Notably, these figures are double those of the second-ranking country.

35. Mr Spreadbury states that the opponent has promoted the mark and the goods extensively in the UK. **Exhibit NAS11** contains three examples of UK advertisements, which are as follows:

    (i) two printouts dated 2021 and 2022, demonstrating the collaboration between the opponent and Liberty. In the 2021 advertisement, the earlier mark features at the centre of the advert followed by the "Curated by LIBERTY" with the strapline stating, "*Colour and print in timeless combinations Discover the edit in-store or online at farrow-ball.com #FaBxLiberty.*" The 2022 advertisement has a strapline that reads "*Iconic British Style in 15 Archive Colours Discover the edit in-store or online at farrow-ball.com #FaBxLiberty*"

(ii) a screenshot dated 26 April 2023 taken from the opponent's YouTube account, showcasing a video titled "*Discover all-new Dead Flat* | *Farrow & Ball*", which has over 3,000 views.

In addition to the above, Mr Spreadbury states that the opponent advertises its goods via promotional emails. In this regard, **Exhibit NAS12** contains four examples of such email campaigns, dated from 13 March 2023 to 28 June 2023. This exhibit also includes details such as the date, the sender's email address, and number of recipients (exceeding 450K in each case).



36. Further, **Exhibit NAS13** provides 19 examples of articles in UK publications as follows:

(i) '*Farrow & Ball launch nine new paint colours",* dated 21 September 2018, from *housebeautiful.com/uk*;

(ii) '*These are Farrow & Ball's must-have colours for 2019*', dated 9 January 2019 from *housebeautiful.com/uk*;

(iii) '*Farrow & Ball embraces bold colours for 2019, releasing its must-have shades for interiors*' dated 14 January 2019 from *materialsource.co.uk*;

(iv) '*Farrow & Ball have just revealed their colours of the year for 2021*' dated 11 September 2020 from *redonline.co.uk*;

(v) Scotland Home, '*Seductive shades – The Sex Education chalet has had a Farrow & Ball makeover*' dated 20 December 2020 from the Sunday Times;

(vi) '*Colour queen - FARROW & BALL'S PAINT EXPERT ON GLOSSY CEILINGS, FEATURE WINDOWS AND HOW TO CLASH STYLISHLY*' dated 26 March 2021 from The Times;

(vii) '*Its official this is the UK's most Instagrammable paint colour*' dated 12 July 2021 from *hoodmagazine.co.uk;*

(viii) '*BEAUTIFULLY MATCHED - This October sees the collaboration between two iconic British brands: Farrow & Ball and Liberty'* dated 1 November 2021 from Homes & Gardens;

(ix) 'NIFTY SHADE OF GREY - Elephant's Breath, the game-changing hue from Farrow & Ball, has returned as the colour of contentment. Here's why it's the smart choice for 2022, says Katrina Burroughs' dated 16 January 2022 from The Sunday Times;

(x) *'Farrow & Ball make over a teenager's bedroom in rhubarb and custard shades'* dated 22 May 2022 from The Sunday Times;

(xi) *'LAURA JACKSON ON - The best ways to make an entrance'* dated 1 July 2022 from Elle Decoration;

(xii) *'colour insight: in the pink - THIS HUE HAS BEEN CLIMBING THE PAINT CHARTS SO IT'S TIME TO LEAVE ANY PRECONCEIVED NOTIONS ABOUT IT AT THE DOOR'* dated 1 August 2022 from Living etc;

(xiii) an excerpt from The Guardian dated 15 April 2023 which appears to include a guide how to upcycle pre-owned furniture by making a reference to Vinterior's collaboration with Farrow & Ball;

(xiv) '*Farrow and Ball launches Dead Flat, its most matt paint ever'* dated 15 April 2023 from Homes & Interiors Scotland;

(xv) an excerpt from The Sunday Times dated 16 April 2023 where the author recommends the Farrow & Ball's new matt Dead Flat finish.

(xvi) an undated online article titled '*Best eco paints: Add colour with environmentally friendly and non-toxic paints - Go green with these environmentally friendly paint options*' from The Standard mentioning Farrow & Ball paints;

(xvii) an excerpt from Modern Gardens dated May 2023 where Farrow & Ball's is mentioned in an article titled "TART UP TERRACOTTA POTS";

(xviii) '*Good luck trying to stop me ripping off your colours, Farrow & Ball'* dated 5 May 2023 from *inews.co.uk*; and

(xix) '*Farrow & Ball is launching a new decorating book and it will make you want to get painting'* dated 8 June 2023 from *redonline.co.uk*.

37. It is clear from the above materials that the opponent has strived to educate and expose the public to its products which are known for their distinctive

hues and their unique names, such as Stiffkey Blue, Elephant's Breath, Dead Salmon, Dead Flat, etc. In addition, I note that some publications refer to the opponent as the "*the posh paint company*".[5]

38. Moreover, Mr Spreadbury highlights that the opponent featured in two television programmes:

    (i) The first was a one-episode documentary on UK's Channel 5 titled "Farrow & Ball: Inside the Posh Paint Factory" which originally aired on 8 July 2021 and replayed in 2022 and remains available online. Following the documentary's debut, Mr Spreadbury states that several news articles were published by various media outlets. **Exhibit NAS14** includes two examples of these articles: one from *broadcastnow.co.uk,* which is dated 9 July 2021 and titled "*Farrow & Ball: Inside the Posh Paint Factory; Diana's Decades*"; and another from The Telegraph dated 8 July 2021 and titled "*Farrow & Ball: Inside the Posh Paint Factory, review - Do you know your Dead Salmon from your Salon Drab?*"

    (ii) The second was an episode of the "Inside the Factory" on BBC2 aired on Sunday 25 February 2024 at 8pm, which Mr Spreadbury characterises as a peak viewing time. Mr Spreadbury expounds that the producers approached the opponent in 2022 to film an episode at their Dorset factory, which took place over four days in August 2022. The Opponent reviewed the episode in December 2022. Mr Spreadbury states that "*whilst the episode aired after the filing date of the Application, the fact that the producers and BBC approached the Opponent for filming demonstrates the Opponent's reputation in the Mark prior to the filing date of the Application*."

39. Mr Spreadbury submitted that the opponent attended the National Painting and Decorating Show in 2017, 2018 and 2019 to promote its goods under the mark, noting that each show attracted approximately 3,5K visitors. In

[5] See Exhibit NAS13 page 54 and Exhibit NAS14.

this respect, **Exhibit NAS16** contains undated photographs of the opponent's stand, colour cards and finishes boards.

40. Further, Mr Spreadbury emphasises that the opponent has received a significant amount of industry recognition and awards providing a list of eight example awards and accolades and articles and announcements with **Exhibit NAS17**. For example, the opponent's Instagram account featured as one of Forbes' '*12 Of The Best Instagram Accounts to Follow Right Now for Colourful Interior Design Inspiration'* in 2020, and the opponent was the winner of '*Best Brand Licensed Home Decor Product or Range for the Natural History Museum Colour By Nature Campaign*' at the 2020 Brand and Lifestyle Licensing Awards.

41. In addition, Mr Spreadbury refers to the collaborations between the opponent and third parties, namely Vinterior and Liberty, as a result of the opponent's reputation. In particular, he states that:

> "44. In early 2023, and prior to the filing date of the Application, the Opponent announced a collaboration with Vinterior, the online pre-owned furniture marketplace. The Opponent and Vinterior partnered up to create a capsule collection of freshly painted, pre-owned furniture. Pieces of furniture from Vinterior were elected by three sellers who then reimagined them using paint supplied by the Opponent. […]
>
> 45. In 2021 the Opponent announced a collaboration with Liberty, the iconic luxury London department store, to create an edit of richly pigmented paint colours and interiors fabrics. The edit reintroduced 15 retired paint colours from the Opponent's archive and paired them with complementary patterned fabrics for Liberty's collection. […]"

Exhibit NAS18 and **Exhibit NAS19** contain screenshots from six online articles and blogposts illustrating the collaborations between the opponent and Vinterior and Liberty. Examples of these are the following:

(i) '*Farrow & Ball X Vinterior: Upcycling at its Finest*' dated 13 February 2023 from the opponent's website; and

(ii) *Discover 15 New Farrow & Ball Colours: Curated by Liberty'* dated 13 October 2021 from *pavilionbroadway.co.uk*.

42. Mr Spreadbury also notes that the opponent's competitors formed partnerships with businesses in the furniture, home, and lifestyle industries, and in particular, Marks and Spencer joined forces with Fired Earth (**Exhibit NAS20**) and Barker and Stonehouse partnered with paint manufacturer Lick (**Exhibit NAS21**).

43. **Exhibit NAS22** contains a selection of reviews from the opponent's Trustpilot account dated with multiple dates from 2021, where users mention in their reviews that they used the opponent's products to paint furniture.

44. **Exhibit NAS23** consists of a printout of an online article from the opponent's website dated 13 February 2022 and titled '*How To Paint Furniture'*. Lastly, **Exhibit NAS24** contains news articles and social media posts from X (former Twitter) dated from 2014 to 2023.

45. Further, I have considered the opponent's evidence-in-reply which contains the following relevant exhibits that are of evidential value for the purposes of Section 5(3):

(i) **Exhibit NAS2A** consists of screenshots of the opponent's book '*Find It, Paint It, Love It'* which Mr Spreadbury mentions it was produced in 2014 providing advice on how to paint furniture.

(ii) **Exhibit NAS3A**: page 3 consists of a screenshot dated 15 June 2017 (taken from the WayBack Machine Internet archive) from the opponent's website demonstrating the opponent's products 'estate eggshell'.

(iii) **Exhibit NAS4A** consists of an image of the opponent's stand which is said to relate to the Cumbria Life Home & Garden Show 2016.

46. I note that the relevant public for the earlier goods is the general public as well as users in the interior design and decorating trades. Further, the evidence appears to focus exclusively on the UK market. However, I have already noted that the earlier mark relied on under this ground is a comparable mark based on an EUTM, which means that the relevant territory is the European Community, and the trade mark must have a reputation in a substantial part of that territory for the period up to 31 December 2020. That said, I remind myself that the CJEU held in *Pago International GmbH v Tirolmilch registrierte GmbH*, Case 301/07, that "*the territory of the Member State in question may be considered to constitute a substantial part of the territory of the Community*".[6] Thus, it is my view that at the relevant date, the UK constituted a substantial part of the territory of the European Community.

47. As outlined above, the opponent's UK turnover figures are very large, and notably, the spend on UK advertising up to the relevant date is also very significant. Despite the lack of breakdown regarding the UK figures in relation to the registered goods, the picture created by the evidence as a whole supports the assertion that the opponent had a significant business in relation to the goods relied upon and the respective market. There is extensive UK specific press coverage, including social media posts, online and printed publications, and televised episodes, provided from prior to the relevant date. With consideration to the sum of the evidence and the picture this creates, including the market share the opponent possesses in the market, I am satisfied that the earlier mark had a strong reputation in the UK for *paints, varnishes, lacquers, preservatives against rust and deterioration of wood* in Class 2 at the relevant date, and that the reputation was one of high quality.

[6] See [20]-[30].

Link

48. In assessing whether the public will make the required mental link between the marks, I must take account of all relevant factors, which were identified by the CJEU in *Intel* at paragraph 42 of its judgment. I shall consider each of them in turn.

The degree of similarity between the conflicting marks

49. In *Intra-Presse SAS v OHIM*, joined cases C-581/13P & C-582/13P, the CJEU stated that:

> "72…The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited)."

50. In other words, the level of similarity required for the public to make a link between the marks for the purposes of 5(3) may be less than the level of similarity required to create a likelihood of confusion. That said, I shall assess the visual, aural and conceptual similarities of the marks by reference to their overall impressions, as I would do under Section 5(2)(b). The competing marks are as follows:

Earlier Mark	Contested Mark
Farrow & Ball	Farrow

51. The opponent submits that the first word "Farrow" will be the most distinctive element in the earlier mark as the ampersand will be seen as connecting the two words, and the word "Ball" could play a lesser or secondary role due to its position at the end of the mark. It also claims that the consumers tend to abbreviate marks, and they may refer to the earlier mark as "Farrow" or "Farrow" would be perceived as an abbreviation of "Farrow & Ball".

52. The respective marks are word marks. Registration of word marks protects the words themselves.[7] As to the earlier mark, I disagree with the opponent's position. This is because the words "Farrow" and "Ball" are connected by an ampersand. The overall impression is, therefore, contained in the complete phrase, though the words "Farrow" and "Ball" are more distinctive than the ampersand, which nevertheless plays a role, with neither of these two words being more dominant or distinctive than the other.

53. For completeness, in the absence of evidence, I am not satisfied that the earlier mark will be abbreviated as "Farrow", as the evidence shows that the abbreviated form of the earlier mark used on publication materials is "F&B".[8]

Visual Comparison

54. The earlier mark contains eleven letters, whereas the contested has six. I bear in mind, as a rule of thumb, that the beginnings of marks tend to have

[7] See *LA Superquimica v EUIPO*, T-24/17, para 39; and *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

[8] See Exhibit NAS14 page 1.

more impact than the ends.[9] In this regard, the competing marks share the common word "Farrow", while they differ in whether or not they contain additional words. Taking into account the overall impression of the marks and the similarities and differences, I consider that the marks are visually similar to a medium degree.

Aural Comparison

55. Aurally, the competing marks will be pronounced entirely conventionally. The ampersand in the "Farrow & Ball" mark will be articulated as the word "AND". Therefore, the earlier mark has four syllables, namely "FAR-ROW-AND-BALL", while the contested two ("FAR-ROW"). The marks share the first two syllables. The absence of the last two syllables "AND-BALL" in the contested mark will be a point of difference. Consequently, I find a medium degree of aural similarity.

Conceptual Comparison

56. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] ECR I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

57. I note that both parties agree that "Farrow" would be understood to mean "a litter of pigs". As the competing marks share the common word "Farrow", the relevant public is likely to form the same concept of that word when it appears in the other mark. In addition, the earlier mark contains the ampersand, which will be understood as such, and the word "Ball", which could either be viewed as a surname or simply the ordinary and dictionary word 'ball'. Notwithstanding the added concepts introduced by the words "& Ball" in the earlier mark, the competing marks will be conceptually

[9] See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, where the General Court observed that the attention of the consumer is usually directed to the beginning of a mark.

similar to a medium degree based on the shared concept of the common word “Farrow”.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

58. The relevant goods and services are those in the application and those for which I have found the opponent to have a reputation. For the purposes of detriment and/or unfair advantage under section 5(3) of the Act it is not a requirement that there must be identity or similarity between the respective goods and services; however, the issue remains relevant to the overall analysis.

59. In its submissions, the opponent argues that the contested goods and services are similar to the opponent’s goods in the following terms:

> “55. […] Whilst they have different natures, they can coincide in purpose as they are all for decorating, furnishing or refurbishing homes. They may also have the same distribution channels, such as home furniture and interior decoration stores, and they target the same relevant public. They are extremely complementary. This is supported by evidence in the WSNAS, for example in terms of collaborations between parties in the paint and furniture sectors (paras 43 - 47) and in the Second WSNAS which shows the number of companies selling both furniture and paint (paras 6-7).
>
> 56. In the Defence under the section headed Link between the marks, the Applicant admits the respective goods are complementary by stating “whilst it may be the case that a large amount of furniture is manufactured with additional paint, and that the two (i.e. furniture and paint) are, on any normal view, complementary in that sense ...”
>
> 57. It is submitted that the services found in class 35 of the Application are similar to the Opponent's Goods. It is common for furniture stores

to offer for sale various types of furniture in conjunction with other decorative items such as paint and wallpaper, to enable purchasers of these goods to buy them at the same time to achieve an accomplished and harmonious decorative look for the home, office space etc.

58. It is submitted that the services found in class 42 of the Application are similar to the Opponent's Goods. The goods and services can all relate to interior design. In particular, when a producer is designing a piece of furniture, closer attention is paid to the type of paint used as this can effect the condition, colour and final appearance of the furniture." [sic]

60. Although the opponent argues that the applicant has admitted complementarity between the competing goods, I consider that the opponent's submissions do not accurately capture the applicant's position. In order to address this point, I will reproduce the applicant's claim in full, which is as follows:

> "[…] Whilst it may be the case that a large amount of furniture is manufactured with additional paint, and that the two (i.e. furniture and paint) are, on any normal view, complementary in that sense, it does not follow that paint and furniture are similar goods for trade mark purposes and would lead the consumer to associate the two.
>
> The parties' goods and/or services are neither identical nor similar, or if similar, only to a low degree. […]"

61. In my view the applicant sought to establish a distinction between the use of the competing goods within the manufacturing process and their complementarity from a trade mark standpoint. More specifically, the applicant has made a similar point to the one articulated by Mr Daniel Alexander QC (as he then was), who noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited,* BL O/255/13, the following:

> "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."

Therefore, I interpret the applicant's claim as a denial rather than an admission. This is so as the applicant's position is primarily that the competing goods and services are neither identical nor similar, and, alternatively, should any similarity found, it would be of a low degree.

62. In addition to the above, in his witness statement, Mr Lynch states that the parties operate in distinct markets, namely the furniture and decorative paint sectors, with a minimal overlap from a retail perspective. He also mentions that no paint brand in the UK sells furniture in significant volumes or has affiliated manufacturers, and that trade shows for these sectors are held separately. Mr Lynch further highlights that the opponent does not engage in furniture manufacturing, design, or mixed material development. He puts forward that the opponent's collaborations are based on complementary aesthetics rather than collaborative creation. In addition, he argues that any use of the earlier goods for the purposes of upcycling furniture does not mean that the opponent has established that it has a meaningful presence in the applicant's markets.

63. Although I have considered the above points concerning market considerations, I note that no evidence within the relevant date has been provided. Therefore, I am not able to conclude from the relevant evidence whether there is a minimal overlap in the respective markets or to what degree they converge so that the consumers would consider the same entity would be responsible for both. I will now proceed to the comparison of the competing goods and services, taking account of all relevant factors, including those identified in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, at paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296].

Class 20

64. I consider that there is no obvious similarity between the contested terms "*Camping furniture; Furniture for camping; Furniture for vivariums; Pet furniture*" and the earlier goods in Class 2. I find that the competing terms differ in nature, purpose, method of use, and trade channels as they will be sold through different retailers. Further, I do not consider that there is complementarity or competition between the competing terms. Therefore, I find them to be dissimilar.

65. The rest of contested goods in Class 20 contain a wide range of furniture, whereas the opponent's are various types of coating in Class 2. The competing goods differ in nature and method of use. However, it is my view that the competing goods share a secondary purpose, as they may all fulfil an interior design/decorative purpose and be selected together to create a coherent aesthetic. Nevertheless, I do not consider that there is a degree of complementarity. Despite the opponent's position, based on the evidence before me, I consider that the focus of the opponent's collaborations was upcycling[10] or the creation of *"an edit of richly pigmented paint colours and interiors fabrics*."[11] This merely suggests a joint venture or collaborative effort in which consumers would recognise two distinct brands working together. All other things being equal, the consumers are unlikely to believe that the responsibility for pre-owned furniture or interior fabrics and the earlier goods lies with the same undertaking or with economically connected undertakings. Even though the competing goods could be used together, in this present case, this is not enough on its own to lead to complementarity since the respective goods are not indispensable or important for the use of the other in such a way that consumers may think that responsibility for the production of those goods lies with the same undertaking.[12] If I am wrong, I do not

[10] It is mentioned in Exhibit NAS18 that the opponent's goods were used to "*show the potential of pre-owned furniture*" and to "*inspir[e] people to try upcycling themselves*."

[11] See Exhibit NAS19.

[12] See *Boston Scientific Ltd v OHIM*, Case T-325/06.

consider that any complementarity there might be would be sufficiently pronounced.[13] Further, I consider that there might be an overlap in users. It is noted that some of the contested goods (e.g. shop furniture) would be purchased by business users. The trade channels may also coincide as the competing goods will be sold in large outlets or DIY stores. That said I consider that the competing goods will be in different aisles and not in a close proximity to each other. I find that the competing goods are similar to a low to medium degree.

Class 35

66. The contested retail services concerning furniture goods in Class 35 are provided with the aim of selling such goods. The nature of the services differs from the earlier goods in Classes 2 and 27. The contested services are offered by a retail operator for the sale and purchase of goods by the end users, whereas the earlier goods are the physical products as such. Moreover, the method of use and purpose differentiates between the goods and the services in question. The consumers and trade channels may overlap. However, the goods are intended to be used for interior design, whereas the respective services are intended to enable the end users to purchase furniture by interacting with them either online or at physical premises. Bearing in mind the principles set out in *Tony Van Gulck v Wasabi Frog Ltd,*[14] in the case where the goods retailed do not correspond to the goods of the kind of the other mark, it is necessary to consider whether there is the likelihood the same undertaking would provide both goods in question. In the present case, the relationship between "*retail services relating to furniture*" and Class 2 goods is not sufficiently pronounced that the average consumer would consider them on the face of it to be offered by the same undertaking. While there may be some overlap in users, as the competing goods and services could all

[13] See *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, paragraph 22, in which the Appointed Person quoted: *Assembled Investments (Proprietary) Ltd v. OHIM*, T105/05, paragraphs 30 to 35 (which was upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*, C-398/07P, paragraphs 34, 35).

[14] Case BL O/391/14.

be used by members of the general public, this is not a sufficient factor to find similarity. Taking all these factors into consideration, there is no degree of similarity between the respective goods and services.

Class 42

67. The contested services "*Design of furniture; Furniture design; Designing of furniture*" in Class 42 relate to the creative and technical process directed to create furniture. According to the case law, the words used to describe the services "*should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase*."[15] Although I have considered the opponent's submissions, in the absence of evidence, I do not see any obvious overlap between the reputed goods and the contested services. The respective goods and services differ in nature, purpose, method of use, and trade channels. I consider that the relationship between the earlier goods and the contested services is not sufficiently proximate to warrant a finding of complementarity; the contested services may be provided entirely independently from the earlier goods. Thus, I do not consider that, all other things being equal, consumers would think that they are provided by the same undertakings. I find the competing goods and services to be dissimilar.

The strength of the earlier mark's reputation

68. I found that the earlier mark had a strong reputation at the relevant date for *paints, varnishes, lacquers, preservatives against rust and deterioration of wood*. As previously mentioned in this decision, these products were known for their high quality, referred to as "posh paint", and were closely associated with period and heritage decoration aesthetics. Lastly, I also

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

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

note that the goods bearing the mark are marketed as both aspirational and prestigious.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

69. The earlier word mark "Farrow & Ball" will be interpreted in the way delineated earlier in this decision. The mark is not allusive or suggestive of the registered goods. Therefore, I consider that it is inherently distinctive to a medium degree.

70. Given the evidence and the extensive use and media coverage of the mark in relation to the reputed goods, I do consider that the distinctiveness of the mark has been enhanced through use for at least a significant enough subset of the average consumers. Therefore, I find that the earlier mark is distinctive to a high degree overall.

Whether there is a likelihood of confusion

71. Generally, a finding that the respective goods and services are not similar would mean that there could be no likelihood of confusion. That would certainly be the case under Section 5(2)(b) of the Act. However, some marks are so highly distinctive and well-known that there is likely to be some confusion almost irrespective of the goods or services in relation to which they are used. In an earlier decision, Mr Allan James in *Lazard & Co., Holdings Ltd v Lazard Consulting Ltd*[16] gave the example of the use of 'MICROSOFT' for table lights. In those circumstances, he said, the public would probably expect the user to have some economic connection to the software company, such as a licence or the kind of collaboration that the opponent submits that it regularly undertakes.

72. It is important to recall that Section 5(3) of the Act requires me to take account of all the relevant factors, including the distinctiveness and repute

[16] See BL O/359/15, paragraph 55.

of the earlier mark, and to decide whether in this particular case the public may be caused to believe that the use of “Farrow & Ball” for goods in Class 2 is connected to “Farrow” in relation to goods in Class 20 and services in Classes 35 and 42.

73. After considering the above factors and the parties’ submissions and evidence, I find that there is a likelihood of indirect confusion. I consider the marks would be indirectly confused for the respective similar goods. In particular, while the average consumer will identify the difference in the competing marks, they will recognise the shared word element “Farrow”, which has an independent distinctive role and is the first verbal element in the earlier mark, a position which is considered to be more impactful. Bearing in mind my assessment of the overall impression and the conceptual hook stemming from the common word element, when coming across the respective marks, I find that at least a significant proportion of average consumers will interpret the use of the common word “Farrow” as being a sub-brand of the earlier and reputed mark “Farrow & Ball”. As will be outlined in the next section of this decision, there is also evidence that suggests that consumers think there is an economic connection between them. In this respect, I find that the average consumer would assume a commercial association between the parties, believing that the respective goods come from the same or economically linked undertakings. Where there is a likelihood of confusion, there is automatically a link created in the mind of the relevant public.[17] For completeness, I note that my finding is limited to the respective goods for which I found similarity.

Conclusion on link

74. The assessment I am considering here is not whether the relevant public would be confused, but rather would they call to mind the earlier mark upon being confronted by the contested one. I remind myself that to find a link the degree of similarity between the marks may be lower than is required

[17] see *Intel*, paragraph 57.

to find confusion under Section 5(2)(b). In addition, it is not necessary for the goods and services to be similar.

75. In this present case, the opponent's evidence sheds light on whether there would be a link between the marks in the minds of the consumers. In more detail, Exhibit NAS7A contains screenshots[18] dated between 2022 and 2023 demonstrating various user reviews on the applicant's Trustpilot account. In these reviews, customers frequently refer to the opponent's goods, noting how they compare to the colours of the applicant's goods. Some customer reviews highlight how the applicant has suggested which paint colours from the opponent would closely match their own products or advised customers to visit the opponent's website or obtain the opponent's colour chart. Notably, there is one review where the customer believed that the opponent's goods were used in the manufacturing process of a TV unit. By way of example, I reproduce below some of the reviews that illustrate these points.

[18] See pages 1-8.

11 reviews GB

Verified 18 Jul 2022

Don't buy from them

Don't buy from them! All furniture shipped in from Vietnam with sub standard packaging. I bought white painted bedroom furniture, all came with yellow marks from not treating wood knots, spilt in wood, warped wood, dents and chips. I was offered £100 cash back, I asked them for an additional £29 to cover the cost of the Farrow and Ball paint for the touch ups and was told the £100 was intended for me to get the furniture repairs myself and they wouldn't cover the cost of the paint. Poor products and poor customer service. I feel like I've bought second hand furniture at a high price and they don't care. Don't buy from them!

Date of experience: 18 July 2022

EB
8 reviews GB

7 Jul 2022

Had to wait 6 weeks for delivery of...

Had to wait 6 weeks for delivery of farrow TV unit and matching lamp table. No updates on delay or expected delivery. Whilst customer service staff were pleasant when I rang for updates and reason for delay I found that it was me who had to keep ringing and emailing otherwise they would not have kept me informed.
Whilst I love the furniture when I removed it from the packaging I noted 2 scuff marks on paint work on one of the drawers. Whilst I didn't necessarily want the hassle of asking for a replacement I emailed Roseland to tell them about the issue and I enclosed photos of the defect they didn't even reply or acknowledge the problem. Like I said I didn't want the hassle of repackaging the unit and awaiting possibly another 6 weeks for a replacement but I think they should have at the very least offered to send me a small tin of the farrow and ball paint used in its manufacturing so that I can repair the paint work myself as it is expensive paint for me to buy. Very disappointed with this company

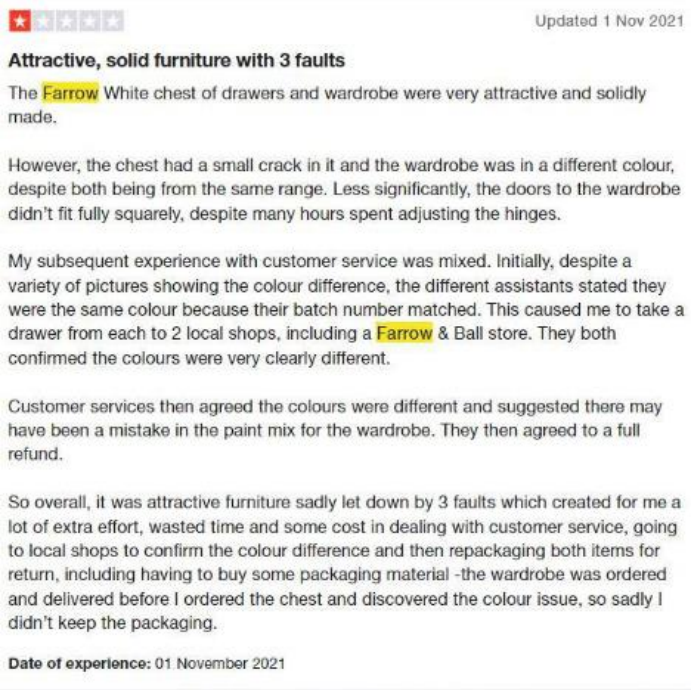
Date of experience: 07 July 2022

4 Apr 2022

Very bad and insensitive company

Roseland furniture are quick to take your money but slow to give you good service. I ordered a tv unit and money was taken quickly and I kept getting emails to rate my experience on Trustpilot, this was before I heard anything from them regarding delivery and before I had seen the goods. My tv unit arrived one evening, Roselands did not give tracking information and the company they use did not get in touch , they merely arrived in the evening and dropped of unit outside my house.Couldn't speak to the driver as he hardly spoke English. After unpacking the unit we positioned it in my bedroom and I noticed straight away that it was not white (as described on the website) but a sort of light cream colour, I was really disappointed because the rest of the furniture is white. I have phoned Roselands today and they dispute the colour although I have sent around 6 photos showing that this is not white. They said I could send it back but it would cost me. They also said that if I would have asked they would have told me to get a colour chart by farrow and ball and that the colour wevet was similar to the colour of the unit. Wevet contains a hint of grey but the unit as I've told them is a light cream colour. They've looked at my photos and they see a hint of grey. I am so annoyed about this , what an awful companiy to deal with. Do not buy from them as they don't understand the meaning of the words 'customer satisfaction', shame on you Roselands for intimating that I am a liar!!!!!!

Date of experience: 04 April 2022



Updated 1 Nov 2021

Attractive, solid furniture with 3 faults

The Farrow White chest of drawers and wardrobe were very attractive and solidly made.

However, the chest had a small crack in it and the wardrobe was in a different colour, despite both being from the same range. Less significantly, the doors to the wardrobe didn't fit fully squarely, despite many hours spent adjusting the hinges.

My subsequent experience with customer service was mixed. Initially, despite a variety of pictures showing the colour difference, the different assistants stated they were the same colour because their batch number matched. This caused me to take a drawer from each to 2 local shops, including a Farrow & Ball store. They both confirmed the colours were very clearly different.

Customer services then agreed the colours were different and suggested there may have been a mistake in the paint mix for the wardrobe. They then agreed to a full refund.

So overall, it was attractive furniture sadly let down by 3 faults which created for me a lot of extra effort, wasted time and some cost in dealing with customer service, going to local shops to confirm the colour difference and then repackaging both items for return, including having to buy some packaging material -the wardrobe was ordered and delivered before I ordered the chest and discovered the colour issue, so sadly I didn't keep the packaging.

Date of experience: 01 November 2021

76. Taking all of the above factors into account and bearing in mind the strength of the reputation, the high degree of distinctive character of the earlier mark, and levels of similarity between the marks at issue, I am of the view that the existence of a link between the marks will be made regardless of the level of similarity or dissimilarity between the goods and services. Whilst I am in no doubt about this conclusion, my finding is reinforced by the fact that the applicant clearly refers its customers to the opponent's goods, strengthening the already inevitable link that would be made between them.

Damage

77. The opponent claims under the three heads of damage available to it under Section 5(3) of the Act, those being unfair advantage, dilution and detriment to repute of the earlier marks. I will deal first with unfair advantage.

78. In *L'Oréal*,[19] the CJEU said:

[19] *L'Oréal SA & Ors v Bellure & Ors*, Case C-487/07, paragraph 50.

> "The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of that mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image."

Earlier in the same decision, the CJEU also said:

> "41. As regards the concept of 'taking unfair advantage of the distinctive character or the repute of the trade mark', also referred to as 'parasitism' or 'free-riding', that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation."

79. The opponent submits that the applicant's mark rides on the coat-tails of the opponent's mark benefiting economically by utilising the opponent's reputed mark for the sales of its own goods and services.

80. It is clear from the decision of Arnold J. (as he then was) in *Jack Wills v House of Fraser (Stores) Limited*,[20] that the claim to unfair advantage does not require proof of subjective intention on the part of the applicant. Paragraph 80 of that decision reads:

> "The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of

[20] [2014] EWHC 110 (Ch).

the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill."

81. Given the opponent's strong reputation in its goods, it is reasonable to infer that the high quality and period/heritage aesthetics attached to the opponent's reputed mark form part of the image that will be transferred to the applicant's mark. Therefore, the success of the earlier mark and its standing amongst users of the earlier goods will make it easier for the attraction of the earlier mark to be projected on to the applicant's mark in relation to the goods (particularly for those that I found that there is a likelihood of confusion) and services in the contested specification. I find that prima facie there is a risk, which is not hypothetical, that use of the contested mark will make it easier for the applicant to offer its goods and services to a section of the relevant public. In addition, it is clear from the evidence that the applicant refers its customers to the opponent's goods. In light of this, I consider that the applicant is unfairly exploiting the opponent's marketing efforts and investment and is free-riding upon the coat-tails of the opponent's considerable reputation in its mark.

82. As I have found for the opponent under the first head of damage, I do not consider it necessary to go on to consider the remaining heads of damage pleaded.

CONCLUSION

83. **The opposition succeeds under Section 5(3)**. Therefore, subject to any successful appeal, the application will be refused.

COSTS

84. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 1/2023. I award costs to the opponent as a contribution towards the cost of the proceedings on the following basis:

Official fee	**£200**
Preparing a statement and considering the other side's statement	**£250**
Preparing evidence and considering and commenting on the other side's evidence	**£900**
Filing submissions	**£450**
Total	**£1,800**

85. I, therefore, order Roseland Furniture Limited to pay to Farrow & Ball Holdings Limited the sum of £1,800. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 12th day of November 2025

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General