O/1101/25

TRADE MARKS ACT 1994

IN THE MATTER OF UK APPLICATION NO. 3834790
IN THE NAME OF ELITE GSS LTD
IN RESPECT OF THE TRADE MARK

DuraMatt

IN CLASSES 17 & 43

AND

THE OPPOSITION THERETO UNDER NO. 438411
BY DURAMAT LIMITED

Background and pleadings

1. Elite GSS Ltd ("the applicant") applied to register the trade mark **DuraMatt** in the UK on 30 September 2022. It was accepted and published in the Trade Marks Journal on 14 October 2022 in respect of the following goods and services:

   Class 17: *Plastic sheeting for agricultural purposes; Plastic sheet for agricultural purposes; Plastic sheeting for use in forestry; Semi-processed plastic in sheet form; Plastics materials in the form of sheets [semi-finished products]; Plastics in the form of sheets, films, blocks, rods and tubes; Extruded plastics in the form of sheets for use in manufacture.*

   Class 43: *Hiring of mats.*

2. On 5 January 2023, Duramat Limited ("the opponent") opposed the trade mark on the basis of section 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). The section 5(2)(b) and 5(3) grounds rely on its earlier UK trade mark no. 3450444 for the mark **Duramat**. The following goods are relied upon under these grounds:

   Class 19: *Vinyl Flooring; Flooring non-metallic; Flooring Tiles (non-metallic).*

   Class 27: *Vinyl (and non-vinyl) Floor Covering (for existing floors); Vinyl Floor Coverings; Protective Floor Covering; Puzzle Mats.*

3. The above mark was filed on 10 December 2019 and was registered on 6 March 2020. By virtue of its earlier filing date, it constitutes an earlier mark in accordance with section 6 of the Act. As it had not been registered for a period of five years or more at the date on which the application was filed, it is not subject to the use provisions set out under section 6A of the Act.

4. In respect of the opposition based on section 5(4)(a), the opponent relies on the same sign, that being **Duramat,** and the same goods as under the 5(2) and 5(3) grounds.

5. Under section 5(2)(b), the opponent argues that the respective goods and services are identical or similar and that the marks are similar, and as such there will be a likelihood of confusion between the marks.

6. Under section 5(3), the opponent argues that the earlier mark holds a reputation for the goods relied upon, and that use of the contested mark will result in consumers mistakenly believing that there is an economic connection between the marks. It argues this in turn will result in an unfair advantage for the applicant, who will derive sales and profits based on the opponent's reputation. The opponent also argues the applicant's use will result in the opponent losing its individual identity in the marketplace, damage its reputation and dilute its mark's distinctive character.

7. Under section 5(4)(a) of the Act, the opponent claims that by virtue of its use of the sign throughout the UK since 2017 for the goods previously set out, its business holds substantial goodwill as distinguished by the sign. It argues that use of the applicant's mark will "cause confusion in the minds of the public as to [the] goods provenance and origin". The opponent states that use of the contested mark will therefore misrepresent the origin of the applicant's goods, and result in the opponent's business being diverted to the applicant.

8. The applicant filed a counterstatement denying the claims made. Whilst it admits to there being a moderate level of similarity between the marks, it denies there is similarity between the goods and services and claims the earlier mark holds only a low level of distinctive character. It therefore denies there exists a likelihood of confusion under section 5(2)(b). The applicant put the opponent to proof of its reputation, but denies in any case there will be a link between the marks or any resulting damage in respect of the section 5(3) claim. The applicant also put the opponent to proof of its claim to hold goodwill in its

business under the mark, but also in any case denies misrepresentation or damage will occur under section 5(4)(a).

9. Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. The applicant filed written submissions during the evidence rounds.[1]

10. A shortform Hearing took place before me via video conference on 30 September 2025. The opponent is represented in these proceedings by Mr Stephen John Williams of Williams Solicitors LLP, and was represented at the hearing by Mr Williams. The applicant is represented in these proceedings by Fowler de Pledge Solicitors, and opted to elect counsel to represent it at the hearing. The applicant was represented at the hearing by Mr Chris Pearson of Lamb Chambers.

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.

Evidence

12. The opponent filed its evidence in the form of a witness statement in the name of Mr John Walker Brierley, Director of the opponent. The statement is dated 22 April 2024. It introduces a single exhibit, that being Exhibit JWB, which comprises a number of different documents. The evidence goes to the opponent's use of the mark/sign, in addition to previous correspondence it has

[1] The "submissions" filed by the applicant were filed in the form of a witness statement. However, in a letter dated 17 October 2024, the Tribunal wrote to the parties to confirm that as the applicant's statement did not appear to provide evidence of fact, the witness statement would be treated as submissions and the evidence rounds would conclude. No objection was raised to this, and I intend to proceed on this basis.

had with the applicant and the applicant's own activities under its mark. Further, the evidence provides what Mr Brierley describes as "examples of confusion caused by the activities of the Applicant using the name "DuraMatt" as against our own trademark Duramat."

Preliminary issues

Request to admit oral evidence into the proceedings

13. At the hearing, Mr Williams for the opponent began by asking to turn to Mr Brierley for the opponent to submit oral evidence. At the hearing, I explained that the evidence rounds had been closed, and I had not received an application for late evidence and would not be taking oral evidence at this stage. Mr Williams stated that he requested the hearing on the basis that they were able to offer oral evidence to explain previous use. I asked if an application had been made, and Mr Williams stated that it was, for Mr Brierley to explain some of the issues at the hearing. At the hearing, I explained that it is not common practice for oral evidence to be taken at a hearing, and we have specific evidence rounds for filing evidence (during which, I note a witness statement and evidence of use was filed by Mr Brierley). Mr Williams reiterated that the point was that his request had been made months ago, but in any case, moved on at that stage.

14. Having now had the opportunity to review the correspondence from when the hearing request was made, I note that the following email was received by the Tribunal from Mr Williams on 20 October 2024:

> "**Hearing**
>
> The Opponent Duramat Ltd requests a hearing to fully explain the confusion caused by this application and the damage to its business.
>
> Mr Brierley wishes to give live evidence."

15. It does not appear that the statement “Mr Brierley wishes to give live evidence” was ever responded to directly. Following this email, the parties were both sent a letter on 23 March 2025, stating that the case had been identified as suitable for a shortform hearing. The structure of such a hearing was explained to the parties in the letter as follows (my emphasis):

> “Parties should be aware that the proposed allocation of two hours will be strictly adhered to. Submissions-in-chief will be limited to forty minutes, with twenty-five minutes for submissions-in-reply. Any remaining time will be allocated to introductions and submissions on costs at the conclusion of the hearing. The following should also be noted:
>
> - The Hearing Officer will expect parties to place a greater degree of reliance on skeleton arguments filed prior to the hearing than they would at a standard- format hearing;
> - Due to the volume of hearings work being undertaken as a result of this initiative, the Hearing Officer allocated to your case may not have had opportunity to fully familiarise themselves by way of a detailed review of the papers. That being said, parties can still expect the Hearing Officer to have a degree of familiarity with the case and the issues at hand;
> - References to additional case law relied upon in skeleton arguments may only be read and considered by the Hearing Officer in full after the hearing. However, parties will be free to refer to these (and the relevant paragraphs) within the hearing itself;
> - Where appropriate - for example, in respect of multiple earlier marks or reliance upon wide specifications - the opponent will be expected to highlight its best case (although it is not expected to expressly limit its case by doing so, as reliance upon additional points may still be made via e.g. the skeleton).

- While the proposed hearing time slot has been shortened, the Tribunal does not consider that the proposal interferes with the parties' right to be heard."

16. Agreement to a shortform hearing was optional, and both parties provided their express agreement to the same. There was no further correspondence relating to Mr Brierley's intention to give oral evidence at the hearing, or to request that there be time allocated for the same. I first became aware of this intention at the hearing itself, and there was no mention of the this in the skeleton arguments provided by Mr Williams in advance of the hearing.

17. I note firstly, that it is unfortunate that this aspect of Mr Williams' email of 20 October 2024 was never responded to. It is my view this should have been addressed upon the receipt of the same. However, it is also my view that neither this sentence, nor the email as a whole, constitutes a formal request for the admission of oral evidence at a hearing (which is also in my view a request to enter late or "additional" evidence), and parties wishing for oral evidence to be given at the hearing after the evidence rounds are closed should set out, as a minimum, the full reasons for the request, including why oral evidence is necessary. I note that at the hearing, Mr William's noted this was for the purpose of explaining previous use.

18. The Manual of trade marks practice clearly sets out (in accordance with Rule 20 of the Trade Marks Rules 2008) the usual evidence rounds and establishes these will generally be considered complete either upon completion of the period for the applicant to file evidence (if none is filed) or alternatively upon receipt of the opponent's evidence in reply.[2] It also sets out that evidence will normally be filed in the form of a witness statement,[3] and that in most cases evidence in inter partes proceedings before the Tribunal will be in writing, but the Tribunal may allow oral evidence to be given, for example, if a witness is unable to read or write or it has not been possible to obtain written evidence

[2] See section 4.2.2.1
[3] See section 4.8.3

within the relevant period.[4] It further sets out that the request to give oral evidence must be received with at least one months' notice prior to the hearing, and the other party will be invited to comment on the same.[5] In respect of additional evidence, it sets out that the reasons for the request will be considered in accordance with the factors set out in *Property Renaissance Ltd v Stanley Dock Hotel & Ors* (2016) EWHC 3103 (CH), which include materiality, the justice and fairness to the other party including reasons why it could not be filed earlier, whether it would cause prejudice to the other side that cannot be compensated for in costs (such as excessive delays); and the fairness and prejudice of excluding the evidence.[6]

19. I sympathise with Mr Williams' on the basis that his original statement regarding live evidence was never responded to. However, I note that no proper application for additional oral evidence, complete with reasons for the same, was ever made. Should the opponent have wished to pursue this further, it is my view that a full request for the same should have been made at the earliest possible opportunity (and at least one month prior to the hearing), explaining what exactly the evidence was, why it was necessary, why the evidence could not be filed in writing and why it had not/could not have been filed earlier. Certainly, the proposal of a shortform hearing should have been refused on that basis. Further, and in any case, I note that Mr Brierley was clearly capable of providing written evidence, considering a coherent witness statement (going to both evidence of use and referring to the emails relating to actual confusion) was filed during the evidence rounds, and it seems unlikely the provision of oral evidence would have been appropriate in this instance. Instead, this evidence should have been provided in a witness statement at the opponent's earliest opportunity, not only giving the Tribunal time to consider its admission into the proceedings in accordance with the factors set out in *Property Renaissance*, but if it were to be admitted, giving the applicant time to review this and, if required, provide a response. In addition, regarding the fact that the evidence the opponent wished to introduce orally would have been "additional" evidence

[4] See section 4.8.3.4
[5] As above
[6] See section 4.8.5

to explain previous use of the mark and/or the effect of the actual confusion between the parties on its business, it would not in my view meet the criteria for admission at the hearing (even in writing), particularly considering there is no apparent reason that evidence relating to events which took place prior to or shortly after the relevant date in 2022 could not have been filed during the original evidence rounds set, or at the very least nearly a year prior to the hearing when Mr Williams' original email was received. I therefore intend to proceed with my decision at this stage based on the evidence filed during the evidence rounds.

Request to treat the evidence of "actual confusion" with caution

20. In his skeleton arguments, Mr Pearson for the applicant made a number of comments relating the opponent's evidence of actual confusion. These were made to draw my attention to things such as the format of each email being the same, that fact that each "purported" email enquiry is signed with an "unverifiable name" and no logos or signatures, that they all come from a generic email address, and that they were all made within a six-week period. Mr Pearson went on to submit that the "purported email enquiries are highly suspicious at the very least".

21. At the hearing, I explained to Mr Pearson that I considered the comments made to be at least an indirect challenge to the veracity of the evidence filed by the opponent. I explained that in the interest of fairness, challenges to the veracity of evidence should be made as early as possible in the proceedings.[7] I explained that in the absence of submissions either highlighting where these challenges were made earlier on in the proceedings, or providing a reason they were not made earlier, I was unlikely to give much consideration to the criticisms made. Mr Pearson addressed me on this point during his submissions, confirming that no challenge to the documents had been made previously and that he had no evidence confirming that these emails are fake.

[7] At the hearing, I highlighted these principles were set out in *TUI v Griffiths* [2023] UKSC 48 and before that, *Extreme Trade Mark*, BL O/161/07.

However, he invited me to nonetheless treat the documents with caution and submitted that considering all the problems with them and the lack of witness evidence explaining them[8] that it was a question of weight. He submitted that in his view, they should be wholly disregarded and to rely on them would be dangerous.

22. Whilst I have considered the submissions from Mr Pearson at the hearing, alongside the comments made within his skeleton arguments, it remains my view that it was not appropriate for these challenges to the evidence filed by the opponent to be raised for the first time at the close of the proceedings. Had they been raised earlier, the opponent would have been provided with an opportunity to address the same. I do not consider any of the factors highlighted by Mr Pearson to be overly suspicious or to be such that I am inclined to believe the emails provided in the evidence are fabricated, particularly without the opponent being provided with an opportunity to explain or provide further evidence in response to this challenge. I intend to take this evidence into account where appropriate and give it the weight I deem relevant in the course of my decision below.

Section 5(2)(b)

23. Section 5(2)(b) of the Act is as follows:

> "5(2) A trade mark shall not be registered if because-
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

24. Section 5A of the Act is as follows:

[8] I note for completeness these emails were introduced by Mr Brierley as "…examples of the confusion caused by the activities of the Applicant using the name "DuraMatt" …" in this witness statement, but little else was said in relation to the same.

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

The Principles

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

The principles

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing

in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

Comparison of goods and services

26. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment 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".

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

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

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

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

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

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

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

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

"… Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU

in Case C-307/10 The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

29. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)***,** Case T-325/06, the General Court ("GC") stated that there is complementarity where:

> "...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".

30. In *Gérard Meric v Office for Harmonisation in the Internal Market,* 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".

31. With this in mind, the goods and services for comparison are as follows:

Earlier goods	**Contested goods**

Class 19: *Vinyl Flooring; Flooring non-metallic; Flooring Tiles (non-metallic).* Class 27: *Vinyl (and non-vinyl) Floor Covering (for existing floors); Vinyl Floor Coverings; Protective Floor Covering; Puzzle Mats.*	Class 17: *Plastic sheeting for agricultural purposes; Plastic sheet for agricultural purposes; Plastic sheeting for use in forestry; Semi-processed plastic in sheet form; Plastics materials in the form of sheets [semi-finished products]; Plastics in the form of sheets, films, blocks, rods and tubes; Extruded plastics in the form of sheets for use in manufacture.* Class 43: *Hiring of mats.*

Class 17

32. I note firstly, and in brief at this stage, that whilst I have considered the evidence of actual confusion I have been provided with, I do not consider this provides me with any particular information on the contested goods and services outlined above, or the similarity of these and the earlier goods relied upon. I note I must at this stage conduct a notional assessment of the goods and services as they feature within the specifications above.

33. In respect of the goods in class 17, I firstly consider those outlined below:

Plastic sheeting for agricultural purposes; Plastic sheet for agricultural purposes; Plastic sheeting for use in forestry.

34. I note in his skeleton arguments, Mr Williams submitted "…plastic sheets can be and are often used for floor and ground coverings". These arguments were reiterated at the hearing. Whilst I note that to an extent this may be true in some circumstances, for example, a plastic sheet such as a tarpaulin may be used as temporary flooring when camping, I have no evidence relating to the use of plastic sheeting as a floor covering as such in the agricultural or forestry industry. To my knowledge, whilst I accept they may possibly be used to cover

the ground in the sense that they may be laid on the ground to cover and protect crops or to assist with the decomposition of plant life beneath them, I have no knowledge that they will be used as an actual flooring product. I also acknowledge the applicant's position in its counterstatement regarding the products, and that they may also be used as "hoarding and as a sheet product within livestock pens and other agricultural areas". It is my understanding that a hoarding sheet is a flat barrier of sorts, used to gather and contain animals or guide them from one area to another by blocking their way, but beyond this I have no evidence on what a "sheet product" for use within livestock pens may be.

35. It is my view that these goods will differ to the opponent's flooring products in respect of purpose and method of use, and I do not consider that trade channels are likely to be shared in any meaningful way. Whilst users may overlap, this will likely be at a fairly general level. Whilst I note the goods might both include items that are flat and made of plastic, this is the extent to which the nature will overlap, and I note this will also be the case for many dissimilar items, from pool lining to chopping boards for example. I do not consider the goods to be complementary or in competition. Overall, I find these goods to be dissimilar to the opponent's earlier goods.

36. For completeness, I note here that I have kept in mind the applicant's own submission that its actual goods offered under its mark include those which may be for construction site ground cover, flooring for festivals and industrial flooring. However, I do not consider these goods to be included within the ordinary and natural meaning of the applicant's terms above. The actual use of the mark by the applicant therefore does not alter my view that the goods applied for in this instance are dissimilar to those covered by the opponent's earlier mark.

37. Next, I consider the applicant's goods as follows:

Semi-processed plastic in sheet form; Plastics materials in the form of sheets [semi-finished products]; Extruded plastics in the form of sheets for use in manufacture.

38. All of the above goods are semi-processed or semi-finished products for use in manufacture. Whilst all of the goods may include some form of plastic, it is clear that the nature and purpose of these goods will differ to those finished items covered by the opponent's earlier goods. Further, I do not consider the method of use to be shared, nor do I consider there to be any real overlap in trade channels or users. I do not consider the goods to be complementary or in competition. Overall, I find these goods to be dissimilar to the opponent's earlier goods relied upon.

39. Finally, in respect of class 17, I consider the following goods:

Plastics in the form of sheets, films, blocks, rods and tubes.

40. It is apparent that plastics in the form of blocks, rods and tubes will share no similarity with the earlier goods in terms of purpose or method of use. Again, whilst there may be an element of plastic in all of the goods, I do not consider their nature to be similar to any meaningful extent. I do not consider the goods to be complementary or in competition. I do not consider they will share trade channels or users on any meaningful level. Overall, they are clearly dissimilar to the earlier goods.

41. With respect to *plastics in the form of sheets, films.* I note firstly that I do not consider the ordinary and natural meaning of plastics in the form of sheets or films to be flooring, particularly when considered in the context of class 17,[9] which covers mainly goods for use in manufacture and not flooring products as

[9] See *Altecnic Ltd's* Trade Mark Application [2002] RPC 34 (COA) in which the Court of Appeal decided that "the Registrar is entitled to treat the Class number in the application as relevant to the interpretation of the scope of the application, for example, in the case of an ambiguity in the list of the specification of goods."

such.[10] Whilst I note that there may be some overlap in nature, in that both of the goods may be flat and may include an element of plastic, they will also differ in that the contested goods will not be a finished flooring product. I do not consider the purpose or method of use to be shared. Further, I do not consider the goods to be complementary or in competition, and I do not consider the trade channels or users to be shared in any meaningful way. Overall, I find these goods to be dissimilar.

Class 43

42. The contested mark covers the following goods in this class:

Hiring of mats.

43. The earlier goods in classes 19 and 27 both include those that may be considered *mats*, such as, for example, *flooring non-metallic* and *protective floor covering; puzzle mats.* It is my view that mats themselves are essential for the hiring of mats, and that the consumer may well consider that the services for hiring the same come from the same entity which produces or sells the goods. I therefore consider the goods and services to be complementary. There may also be an element of competition, in that the consumer may choose between either hiring mats or purchasing these outright. Trade channels may overlap for the reasons outlined, in addition to users. Further, there is an overlap in purpose, in that hiring a mat may serve the same purpose to the consumer as buying one outright. I do not consider that the nature or method of use will be shared. Overall, I find the earlier goods to be similar to the above services to at least a medium degree.

[10] See the explanatory note from the World Intellectual Property Office [accessed at: https://nclpub.wipo.int/enfr/?basic_numbers=show&class_number=17&explanatory_notes=show&lang=en&menulang=en&mode=flat&pagination=no&version=20220101 on 2 November 2025] which explains:
"**Explanatory Note** Class 17 includes mainly electrical, thermal and acoustic insulating materials and plastics for use in manufacture in the form of sheets, blocks and rods, as well as certain goods made of rubber, gutta-percha, gum, asbestos, mica or substitutes therefor."

44. Where the goods are dissimilar, an opposition based on section 5(2)(b) of the Act cannot succeed.[11] This ground of opposition therefore proceeds only in respect of the contested class 43 services.

Comparison of marks

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

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

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

47. The respective trade marks are shown below:

Earlier trade mark	**Contested trade mark**
Duramat	DuraMatt

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

48. The earlier mark comprises the single word Duramat. Whilst this is presented as a single word, it is my view that due to the element ‘mat’ having a clear meaning, the consumer will likely consider the mark to comprise two identifiable elements, namely ‘dura’ and ‘mat’. In the context of the goods the element ‘Dura’ appears slightly more distinctive than ‘mat’, but it is in the combination of these two elements and the word as a whole that the overall impression resides.

49. The contested mark also comprises a single word, that being DuraMatt. Again, it is my view that this mark may be considered by the consumer to comprise two distinguishable elements, those being Dura and Matt, and this is reinforced by the use of the capital ‘M’ in the middle of the mark. Again, it is in the combination of the two elements and the mark as a whole in which the overall impression resides.

Visual comparison

50. Both marks are filed as word marks, providing them with protection for the words in any ordinary combination of upper- and lower-case lettering. Considering I have found the earlier mark to comprise two distinguishable elements, the second of which is ‘mat’, the use of a capital letter for the ‘M’ in the earlier mark would do little to alter its distinctive character, and as such I find this use would be in accordance with the fair and notional use of the same. The point of this is to say that the use of the capital ‘M’ in the contested mark has little impact visually. Both marks include the same initial 7 letters, and vary by way of the additional ‘t’ placed at the end of the contested mark. They are visually similar to a very high degree.

Aural comparison

51. Phonetically, the marks will both comprise the same three syllables, those being Dur-ah-mat(t). They are aurally identical.

Conceptual comparison

52. At the hearing, Mr Williams for the opponent stated:

> "Had the Applicant, as I said earlier, registered a name DuraSheet, there would be no problem, absolutely no problem at all. But DuraMatt cuts right across my client's earlier mark. The common term also is "dura", meaning, no doubt, durability or resilience."

53. On this point, Mr Pearson submitted as follows:

> "On the marks, it is easy to say, look, they both sound like "duramat" but, as my friend pointed out, "dura" is simply short for durability or durable, and "mat" is mat. It does what it says on the tin, it is highly descriptive, and it certainly has a very low level of inherent distinctiveness, in my submission."

54. I note Mr Pearson went on to submit that the marks are only moderately similar conceptually, based on the descriptiveness of the earlier mark.

55. Whilst I note that the average consumer will not artificially dissect marks, they do tend to break these down into verbal elements which to them suggest a meaning or which resemble known words.[12] I agree with the parties that the element "dura" would be very likely to bring to mind the concept of durability in each of the marks, and I find that the use of both "mat" and "matt" would convey the concept of a mat, that being a floor covering. I do not find that the use of the double 't' in the contested mark takes away from this concept. Overall, I therefore consider both marks to convey the identical concept of a durable mat. I consider the marks to be conceptually identical.

56. For completeness, I have considered Mr Pearson's point that the alleged descriptiveness of the earlier mark means the marks will be conceptually similar only to a moderate degree. However, whilst the level of distinctiveness of the mark will be considered within my overall assessment, whatever the outcome

[12] See *Usinor SA v OHIM,* Case T-189/05

of that assessment, it cannot change the fact that an identical concept is produced by both marks, and it will not detract from the conceptual identity of the marks per se.

Average consumer and the purchasing act

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

58. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

> *"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."*

59. The average consumer of the goods and services still in play under this ground will primarily be members of the general public. In respect of the flooring goods, it is my view that the consumer will consider factors such as cost, durability, practicality and aesthetics prior to making a purchase. With the possible exception of goods such as protective floor coverings and puzzle mats, these are likely to be goods that will remain in the consumers home for a considerable amount of time and will not be replaced frequently, and the consumer may

therefore pay a slightly above medium level of attention to the same, with at least a medium level of attention being paid to the remaining goods.

60. I also consider that there may be a group of professional consumers, including trades as well as those stocking retail stores, who will likely pay a slightly higher level of attention to the flooring goods due to the added liability of purchasing these to install for, or sell on to, customers.

61. The services will be also be engaged by both the general public or professional consumers. I consider that the general public will likely consider factors such as reliability and reputation of the services provider, as well as the selection of products available to hire, and will pay a medium level of attention to the services provided. Professionals looking to hire mats may include those in construction or event planners, who may again pay a slightly higher than medium level of attention due to the increased liability that comes with their position. I note these professionals may also purchase the protective flooring goods, and where this is the case, for the same reasons a slightly above medium level of attention will be paid.

62. The goods and services will most likely be purchased visually, either via websites or by way of physical or online retail or wholesale stores. However, I note that consumers may also seek verbal assistance from retail or wholesale staff, or place orders over the phone, and as such I must also take into account aural considerations.

Distinctive character of the earlier trade mark

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

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming

from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

64. I set out previously in my assessment of conceptual similarity that I find the earlier mark to convey to the consumers the concept of a durable mat. The mark is therefore at least highly allusive of the goods covered by the mark. I therefore consider the earlier mark to hold a relatively low degree of distinctive character inherently.

65. The opponent has filed evidence in these proceedings, and I must therefore consider whether the distinctiveness of the earlier mark has been enhanced through its use. When considering enhanced distinctiveness, it is the perception of the UK consumer at the relevant date, that being the filing date of the applicant on 30 September 2022, that is key.

66. In his witness statement, Mr Brierley explains that the opponent has been using the mark for its goods since 2016. However, I do also note from the evidence provided via the internet archiving site the Wayback Machine at Exhibit JWB, that it appears the mark was in use on the opponent's website

http://duramat.co.uk as early as August 2015 in respect of goods described as "garage flooring, heavy duty vinyl floor tiles, rubber matting and ground protection mats". Similar products are referred to on further pages from the opponent's website showing the mark from 2016, 2020, 2021 and 2022. Mr Brierley provides turnover figures for sales under the earlier mark as set out below, and confirms that advertising spend equated to approximately 16% of the turnover figures each year:

> 12. Turnover in the relevant period was as follows:
>
> 2016 £222,925
>
> 2017 £457,360
>
> 2018 £819,867
>
> 2019 £1,029,741
>
> 2020 £2,099,807
>
> 2021 £1,672,789
>
> 2022 £1,667,211
>
> 2023 £1,701,875

67. Also provided at Exhibit JWB are some invoices which display the mark, although I note only 3 are from prior to the relevant date. These all appear to reference types of floor tiles and are addressed to consumers in the UK. The amounts on the invoices range from just above £50 to just above £1100, and so give little indication of the amount of the average sale or the number of customers or sales that may have been made prior to the relevant date.

68. I note there is one example of an advertisement for garage flooring under the mark in Suffolk magazine, but this appears to post-date the relevant date. Some figures which are described as "Advertising breakdown by publication" are also provided as below:

	Google		Bing	
2016	£	24,209		
2017	£	49,884		
2018	£	71,921	£	452
2019	£	77,921	£	3,002
2020	£	168,241	£	5,515
2021	£	124,063	£	9,224
2022	£	137,474	£	9,280
2023	£	174,122	£	1,019

Other

2017/18	Practical Classic	£	936
2018	Billboards	£	5,689
2019/20	Bauer	£	2,450
2020	Billboards	£	26,300
2020	Classic car	£	300
2020	Mercedes Benz	£	400
2021	Daily Mail	£	1,600
2022	Billboard	£	6,750

69. Mr Brierley also confirms the opponent aims to attend 4 trade shows a year, with an approximate £7000 spend on each.

70. I have not outlined all of the evidence provided, some of which I note postdates the relevant date in these proceedings and is therefore not relevant. However, this has all been considered. I note from the sum of the evidence, the opponent does appear to have a healthy turnover under the mark, and I consider it appears to use its mark in respect of garage floors and ground protection mats in particular. It also appears to have a reasonable spend on advertising, although I do note that much of the spend appears to be on “Google” which, without further evidence on the point, seems likely to include spend on sponsored search results such as those shown in the evidence provided, rather than necessarily on traditional adverts or promotional material as such. I note I have not been made aware of the size of the market, nor have I been provided with anything notable by way of press coverage or likewise, although I have taken into account the spend listed on these. It is not possible to accurately determine unit sales or customer numbers from the figures provided.

71. Considering the sum of the evidence, whilst I do not discount that the turnover figures appear fairly good in isolation, it is my view that the evidence as a whole

is not sufficient to show that the distinctiveness of the earlier mark has been materially increased through use in the UK.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

72. Prior to reaching a decision under section 5(2), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 25 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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 they have kept in their mind. I must consider the level of attention paid by the average consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive character held by the earlier mark will have an impact on the likelihood of confusion. I must remember that the distinctiveness of the common elements is key.[13] I must keep in mind that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa. I must also consider that how the goods are obtained may have a bearing on how likely the consumer is to be confused.

73. In respect of section 5(2)(b) of the Act, there are two types of confusion that I may find. The first type of confusion is direct confusion. This occurs where the average consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the average consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings.[14]

[13] See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.
[14] *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

74. In *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

75. I found the marks to be similar to a very high degree visually, and to be aurally and conceptually identical. I found the contested services to be similar to at least a medium degree. I found the mark to hold a relatively low level of distinctive character in respect of the goods. I found the average consumers will comprise members of the general public as well as professionals who will pay a medium or above medium degree of attention in respect of the goods and services. Considering all of the relevant factors and noting particularly the very high similarity of the marks overall, it is my view that where there is similarity between the goods and services, the average consumer is likely to fail to notice or misremember the addition or omission of the additional 'T' at the end of the marks. On this basis, I find there to be a likelihood of direct confusion between the same.

76. As I have previously outlined, where the goods are dissimilar, it is well established there can be no likelihood of confusion based on section 5(2)(b) of the Act. Whilst I note the opponent's evidence claiming to show actual confusion between the companies in this instance, as I have already found for the opponent on the basis of all the similar goods, it is not necessary to consider this further within the context of this ground. Whatever this evidence is deemed to show, it cannot take the opponent any further in respect of the dissimilar goods outlined.

77. The opposition has been successful under section 5(2)(b) in respect of the following services:

Class 43: *Hiring of mats.*

78. The opposition on this ground has failed in respect of the following goods:

Class 17: *Plastic sheeting for agricultural purposes; Plastic sheet for agricultural purposes; Plastic sheeting for use in forestry; Semi-processed plastic in sheet form; Plastics materials in the form of sheets [semi-finished products]; Plastics in the form of sheets, films, blocks, rods and tubes; Extruded plastics in the form of sheets for use in manufacture.*

79. I now move on to consider the opposition filed based on section 5(3) of the Act.

Section 5(3)

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

"(3) A trade mark which-

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".

81. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case C-252/07, *Intel,* Case C-408/01, *Adidas-Salomon,* Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12P, *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 Saloman*, 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) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oreal v Bellure NV*, paragraph 44.

(g) 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.

(h) 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.

(i) 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'Oreal v Bellure NV,* paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

(j) 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'Oreal v Bellure).*

82. An opposition based on section 5(3) of the Act can only be successful via the establishment of several individual elements. To be successful on this ground, the opponent must prove it holds a reputation for the earlier mark relied upon amongst a significant portion of the public. It must also be established that the marks are similar. If it is found both that the marks are similar and that the earlier mark holds a qualifying reputation, it must then be shown that this reputation, combined with the similarity between the marks, will result in the relevant public establishing a link between the marks. A link may be found on the basis that the later mark brings the earlier mark to mind. Importantly, if all three of these elements have been established, it must then be shown that the link made by the public will result in, or will be likely to result in, one of the pleaded types of damage.

83. The relevant date for consideration under section 5(3) of the Act is the filing date of the contested mark, that being 30 September 2022. The opponent claims to hold a reputation in the UK for its earlier mark at this date.

Reputation

84. 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."

85. I have previously summarised the key evidence provided by the opponent when considering whether the distinctive character of the earlier mark had been enhanced. I note that an assessment of enhanced distinctive character and reputation are not necessarily identical, however, there is a significant cross over in respect of the factors for consideration when reaching a conclusion on

each. I note that the evidence of reputation provided suffers from the same shortfalls previously outlined. I consider that the high point of the evidence provided is the turnover figures, which I do not consider to be insignificant. I do also note the mark had been in use for at least seven years prior to the relevant date. However, I have not been provided with anything to indicate the size of the market for the goods or the market share held by the opponent for the same. Further, it is not clear how many sales the turnover figures equate to, with the invoices provided being very limited but also showing quite a range of costs. Whilst some fall after the relevant date, I note they show "garage flooring packs" for example, as ranging between (approximately) £330-£930. If I were to assume that the average sale falls between these figures at somewhere around £630, I note this equates to just over 3300 sales made in the opponent's strongest year in 2020. Whilst this is not insignificant, these sorts of numbers (which in any case cannot really be relied upon) are not in my view sufficient *in and of themselves* to prove a reputation under a mark without much additional context. I note the extent of the geographical spread of the use across the UK is also uncertain, although I do note a few different locations in England listed on the sample invoices provided. Whilst I note the advertising spend is again reasonable, little evidence showing press or promotional material is provided, and it is not clear how the spend relating to search engines such as Google or Bing will manifest in terms of active promotion of the mark.

86. It is important to highlight that none of the shortfalls in the evidence that I have highlighted above need be fatal to the opponent's case for proving a reputation under the mark. However, it is my view that the sum of the evidence simply does not establish that it held a reputation for the same in respect of the goods relied upon at the relevant date. I have no doubt that the opponent's evidence is sufficient to establish that it had made reasonable use of its the mark prior to the relevant date, but it is not clear that the earlier mark will have been known by a significant part of the public concerned with its goods at that time. I therefore do not consider the opponent to have shown a reputation for its mark relied upon under section 5(3) of the Act, and the opposition based on this ground must fail on that basis.

87. I now move on to consider the opposition based on section 5(4)(a) of the Act.

Section 5(4)(a)

88. 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,
>
> […]
>
> 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."

89. 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."

<u>The principles</u>

90. 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)."

91. 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

92. 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.'"

93. There is very limited evidence of the applicant using its mark prior to its filing date of 30 September 2022. I note in the claimed 'evidence of actual confusion' provided by the opponent, there is a reference to a phone call referencing the applicant's products dating from August 2022. This in and of itself is very little to go on, however, I note it is in any case only a month prior to the application date of the mark. This additional month will, in view of the evidence provided by the opponent, make no difference to the outcome of this ground, and as such, I will consider the position with reference to both the August 2022 and 30 September 2022 dates in mind below.

Goodwill

94. I have previously outlined the evidence provided in these proceedings when considering enhanced distinctive character and reputation, and I do not intend to repeat this summary in full at this stage. However, whilst I have found that the evidence provided is not sufficient to show enhanced distinctive character or a reputation under the mark at the relevant date, it is my view that considering the use shown of the sign in the UK, in addition to the several years of sales figures provided, the same evidence does establish that the opponent will have held a reasonable level of goodwill in its business under the sign both in August 2022 and on the filing date of 30 September 2022, at least in respect of the slightly limited list of goods outlined below:

> Class 19: *Garage flooring non-metallic; Garage flooring Tiles (non-metallic).*
> Class 27: *Vinyl (and non-vinyl) Floor Covering (for existing garage floors); Protective Floor Coverings for garages; ground protection mats.*[15]

95. I therefore move on to consider misrepresentation.

[15] I consider ground protection mats to be covered by the (now limited) original term *protective floor coverings*, and as such may be relied upon under this ground.

Misrepresentation

96. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchen L.J. concluded:

> "… if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement."

97. Although this was an infringement case, the principles apply equally under 5(2): see *Soulcycle Inc v Matalan Ltd,* [2017] EWHC 496 (Ch). In *Marks and Spencer PLC v Interflora,* [2012] EWCA (Civ) 1501, Lewison L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that *"a substantial number"* of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal's later judgment in *Comic Enterprises,* it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitive assessments.

98. I note that under section 5(2)(b) I have already considered and dismissed the possibility of both direct and indirect confusion based on the same marks/signs as I have before me under this ground on the basis that the goods are dissimilar, but I found a likelihood of confusion in respect of the class 43 services filed. Whilst I note that there can be circumstances in which misrepresentation can exist where goods are considered dissimilar, or in the context of 5(4)(a), there is no common field of activity, as the case law sets out, the closeness of the fields of activity remains highly relevant. It further sets out that where this is the

case, this presents the opponent with a heavy burden of proving misrepresentation and damage in those circumstances.[16]

99. With a view to establishing whether the opponent's case under section 5(4)(a) may take them further than that under section 5(2)(b) in this instance, I have also considered again the evidence provide of instances of actual confusion again in the context of this ground. Further, I also consider the statement of Mr Heard, which highlights that the applicant's "core business" is seemingly closer to the opponent's goods than the goods applied for, stating:

> "5. The core business of Elite GSS Ltd is construction and our mats designed principally for outdoor use and are capable of being driven on by heavy weight construction traffic. There is no mention of any such heavy weight use in the documentation filed on behalf of Duramat Ltd or on their website.
>
> 6. Our matting being heavy duty is also suitable for use as spoil boards for construction materials.
>
> 7. It is clear from the website of Duramat Ltd that their products are not designed for the same purposes being smaller and less robust. In emails attached to the Witness Statement of John Walker Brierley, it is stated on behalf of Duramat Limited that their floor tiles "aren't suitable for use outdoor" (see page 52) and their product is "not a ground protection board" (see page 60)."

100. However, whilst I note this information may (or may not) be deemed relevant to a passing off case to be decided in the courts, that being one based on the use of the applicant's mark, I am ultimately required to answer the question of misrepresentation based on the goods and services as filed by the applicant, albeit with consideration to any evidence filed which may help to

[16] See *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), in which Millet L.J. made found there to be no requirement for parties to operate in a common field of activity, but that there is an additional burden of establishing misrepresentation and damage when they do not.

establish or reinforce the opponent's case in respect off the same. In this instance, even if I am to give weight to the evidence of actual confusion (which I note in any case is fairly limited), it is clear that none of this evidence shows any sort of misrepresentation stemming from the sale of the goods that have actually been filed by the applicant under the mark. Further, I note at this stage, that whilst the businesses do, in practice, appear to now operate in a closer field of activity than that represented by the specifications filed in this case, I do not consider an intention to deceive has been established in the evidence, and I therefore do not weigh such an intention into my assessment. Whilst I note the opponent's submissions regarding the timing of the application showing it to be in reaction to the receipt of the opponent's letters requesting use of the applicant cease use of its mark, this does not in my view establish that the applicant had an intention to deceive the consumer.

101. Overall, with reference to the issue I am required to decide at this stage, that being whether the use of the contested application for the goods and services applied for result in misrepresentation, it is my view that with consideration to the circumstances of the case and the evidence filed, the answer does not take the opponent further than its case under section 5(2)(b) of the Act. I find there to be a misrepresentation in respect of the related services in class 43 services, but no misrepresentation in respect of the class 17 goods filed, the fields of activity for which do not, in my view, appear to overlap in any way. I do not consider the opponent to have discharged the heavy burden of proving there will be such a misrepresentation where the fields of activity do not overlap.

Damage

102. Whilst I have not found this ground to take the opponent any further than its case under section 5(2)(b), I will, for completeness, very briefly consider damage. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697, Millett L.J. described the requirements for damage in passing off cases like this:

> “In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.”

103. In this instance, it is my view that where there is a misrepresentation in respect of the similar services, there may easily be damage by way of substitution, with relevant consumers hiring mats from the applicant instead of purchasing these from the opponent. The opposition based on section 5(4)(a) of the Act therefore succeeds in respect of the following contested services:

Class 43: *Hiring of mats.*

104. The opposition based on section 5(4)(a) of the Act fails in respect of all of the contested goods.

Final Remarks

105. The opposition has been partially successful based on sections 5(2)(b) and 5(4)(a) of the Act only. Subject to any successful appeal, the application will be refused in respect of the following services:

Class 43: *Hiring of mats.*

106. The application will proceed to registration in respect of all of the remaining goods, those being:

> Class 17: *Plastic sheeting for agricultural purposes; Plastic sheet for agricultural purposes; Plastic sheeting for use in forestry; Semi-processed plastic in sheet form; Plastics materials in the form of sheets [semi-finished products]; Plastics in the form of sheets, films, blocks, rods and tubes; Extruded plastics in the form of sheets for use in manufacture.*

COSTS

107. Both parties have achieved a measure of success in these proceedings. However, the applicant's success has been somewhat greater than the opponent's, and it is therefore entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £1240 as a contribution towards the cost of the proceedings, in accordance with Tribunal Practice Notice 2/2016. The sum is calculated as follows:

Considering the TM7 and preparing the TM8:	£350
Considering the evidence and preparing and filing evidence:	£500
Preparing for and attending the hearing:	£700
20% reduction to account for the opponent's partial success:	-£310
Total:	**£1240**

108. I therefore order Duramat Limited to pay Elite GSS Ltd the sum of £1240. 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 25th day of November 2025

R. Le Breton

For the Registrar