

BL O/1169/25

CONSOLIDATED PROCEEDINGS UNDER THE TRADE MARKS ACT 1994

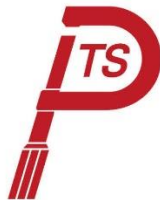
**IN THE MATTER OF APPLICATION NO 3785869
BY PRECISION TECHNOLOGY SUPPLIES LTD
TO REGISTER THE TRADE MARK**

PTS Precision Technology Supplies

IN CLASSES 35 AND 39

**AND THE OPPOSITION THERETO UNDER NO 437183
BY CITY PLUMBING SUPPLIES HOLDINGS LIMITED**

**AND IN THE MATTER OF APPLICATION NO 3785878
BY PRECISION TECHNOLOGY SUPPLIES LTD
TO REGISTER THE TRADE MARK**



IN CLASSES 35 AND 39

**AND THE OPPOSITION THERETO UNDER NO 437184
BY CITY PLUMBING SUPPLIES HOLDINGS LIMITED**

BACKGROUND AND PLEADINGS

1. On 9 May 2022, Precision Technology Supplies Ltd (“the applicant”) applied to register the above trade marks in classes 35 and 39.¹ The specifications are identical and are as follows:

Class 35

Import of Stainless Steel Industrial Fasteners and Precision Turned Parts;
Export of Stainless Steel Industrial Fasteners and Precision Turned Parts.

Class 39

Storage and Distribution of Stainless Steel Industrial Fasteners and Precision Turned Parts.

2. The applications were published on 29 July 2022, following which City Plumbing Supplies Holdings Limited (“the opponent”) filed notices of opposition against both applications for all of the services in the respective applications.

3. Both oppositions are based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”).

4. The opponent relies on the following marks, goods and services:

First mark details:

904333704:



Applied for on 4 March 2005

Registered on 17 January 2007

¹ International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

Goods relied on for 5(2)(b):

Class 6

Pipe support systems and parts and fittings therefor; valves; drain taps; pressure gauge cocks; automatic air vents; pressure/temperature test points; solder wire; pipes, tube and ducting; hoses; pipe couplings; hose couplings; metal coils; bellows expansion joints; joint rings; steam and air traps; taps and cocks; wood screws; manually operated valves; hanging brackets; flanges; parts, fittings and accessories.

Class 7

Heat exchangers, taps and cocks; steam traps; bellows (machines); condensate sets; pumps; pressurisation units; pressure switch kits; fuel oil transfer sets; pump starters; automatic changeover panels; connecting rods; couplings other than for land vehicles; liquid filters; filters; strainers; valves; control panels; hose kits; float switches; booster sets; high temperature pumps; power operated valves; sealed system pressurisation units; parts, fittings and accessories.

Class 9

Electric wire (non-insulated); hand operated pressure test pumps; automatic changeover panels; thermal protection pads; steel tape measures; gauges; valves; mixing valves; electrical and electronic instruments; thermostats, flow meters; welding electrodes; welding rods; electric switches; pump starters; pressure controls; radiator valves; switches; control equipment other than computer hardware; controls for heating apparatus and installations; time switches; programmers; thermostats; thermostatically controlled valves; parts, fittings and accessories.

Goods relied on for 5(3):

The goods listed above for 5(2)(b) and all goods in classes 1,2,3,4,8,16,17,19,20,21 and 22

Second mark details:

902933240:

PTS

Applied for on 14 November 2002

Registered on 13 April 2006

Goods relied on for 5(2)(b) and 5(3)Class 9

Electric wire (non-insulated); hand operated pressure test pumps; automatic changeover panels; thermal protection pads; steel tape measures; gauges; valves; electrical instruments; electronic instruments all in the nature of heating, plumbing, air conditioning or water/sanitary equipment and apparatus; thermostats; flow meters; electric switches; pump starters; pressure controls; radiator valves; switches; control equipment other than computer hardware; controls for heating apparatus and installations; time switches; programmers; thermostats; thermostatically controlled valves; parts, fittings and accessories for the foregoing goods exclusively related to the fields of heating, plumbing and air conditioning and all aimed at builders, contractors, plumbers, heating engineers and air conditioning engineers and all being for the retail or promotion of all of the above listed goods to builders, contractors, plumbers, heating engineers and air conditioning engineers.

Third mark details:

2447728:

PTS

Applied for on 24 February 2007

Registered on 16 November 2007

Services relied on for 5(2)(b) and 5(3)

Class 35

Retail services connected with the sale of plumbing, heating and sanitaryware items and equipment; the bringing together, for the benefit of others, of a variety of plumbing, heating and sanitaryware goods, enabling customers to conveniently view and purchase such goods from retail outlets; mail order, telephone order, electronic shopping and online retailing of plumbing, heating and sanitaryware goods; business information on store locations and information on products in the nature of plumbing, heating and sanitaryware goods provided via a website.

The opponent's case under 5(2)(b)

5. Section 5(2)(b) of the Act prevents registration of a mark that is similar to the opponent's earlier marks, for goods and/or services that are the same or similar to those of the opponent, such that there will be a likelihood of confusion.

6. Under the 5(2)(b) ground the opponent claims that both the application PTS PRECISION TECHNOLOGY SUPPLIES (application 3785869) and the figurative mark (application 3785878) contain the letters PTS, which are identical to the opponent's three earlier trade marks.

7. In respect of the word mark application, it says:

"...PTS at the beginning of the Sign is the dominant and distinctive element as it is the element on which consumers will place the most emphasis; the addition of the non-distinctive matter namely the PRECISION TECHNOLOGY SUPPLIES wording to the Sign adds nothing distinguishing".

8. Regarding the figurative application, it says:

“...the PTS letters are the most dominant and distinctive element of the Sign and the stylisation adds nothing distinguishing.”

9. The opponent’s submissions concerning the goods and services for all of the earlier rights against both applications are the same, and read as follows:

“All of the goods (sic) and services of the Application are highly similar to the goods in classes 6, 7 and 9 of the Registration when considering the nature, intended purpose, method of use, complimentary nature and the trade channels through which the respective goods are sold. Due to the similarity of the respective trade marks and the high similarity of the respective goods and services as stated above, there exists a likelihood of confusion which includes a likelihood of association”.

The opponent’s case under the section 5(3) ground

10. The 5(3) ground of opposition requires the opponent to show its earlier mark(s) have a reputation in the United Kingdom (UK) such that the registration of the contested mark(s), without due cause, would allow them to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the opponent’s earlier trade mark(s).

11. With regard to the 5(3) ground, the opponent uses the same wording in respect of all three earlier rights against both applications. It reads as follows:

“If the Applicant is allowed to secure registration of the Sign, the Applicant will benefit financially through use of the Sign because the average consumer will believe that the undertakings are economically linked, given the substantial reputation of the trade mark the subject of the Registration throughout the UK, and the similarity between the mark the subject of the Registration and the Sign respectively. Such confusion as to origin is likely

to take unfair advantage of and be detrimental to the distinctive nature and reputation of the mark the subject of the Registration.”

12. The opponent claims damage will result under all three types of damage available to it. Again, the wording in respect of all of the earlier marks against both of the applications, is the same:

13. Taking unfair advantage of the earlier marks:

“Due to the high degree of similarity between the trade mark the subject of the Registration and the Sign, the use of the Sign in respect of the goods (sic) covered by the Application would take unfair advantage of the reputation held by the mark the subject of the Registration. The business of the Opponent is substantial and the trade mark the subject of the Registration has a substantial reputation throughout the UK in relation to the goods and services covered by the Registration. The Opponent asserts that use of the Sign will "ride on the coat tails" of the reputation held by the mark the subject of the Registration. The Applicant will therefore benefit from the reputation of the mark the subject of the Registration and the marketing effort expended by the Opponent in order to create and maintain the trade marks' image and reputation.”

14. Detriment to the reputation of the earlier marks:

“If the Sign were to be registered, confusion in the minds of the relevant public would be inevitable due to the similarities of the respective marks and the identity and similarity of the goods and services covered by their specifications. This is likely to have a detrimental impact on the reputation of the mark the subject of the Registration as the Opponent will have no control over the quality of the goods (sic) and services sold/provided by the Applicant under the Sign.”

15. Detriment to the distinctive character of the earlier marks:

“Furthermore, due to the high degree of similarity between the mark the subject of the Registration and the Sign respectively the relevant public will associate/call to mind the mark the subject of the Registration when confronted with the Sign. The relevant public is therefore likely to believe that the mark the subject of the Registration and the Sign are in some way connected and/or affiliated with one another which will lead to the Applicant benefiting in sales intended for the Opponent. The distinctiveness of the mark the subject of the Registration will also be significantly diluted, thus impairing the strength of the Registration. The earlier trade marks' function as both a badge of origin (the origin function) and as a repository of goodwill (the investment function) will necessarily be eroded”.

16. The applicant filed a counterstatement in which it denies the grounds of opposition and asks the opponent to prove use of its earlier marks.

17. Both sides filed evidence and skeleton arguments. A hearing took place before me at which the opponent was represented by Niamh Herrett of Counsel, instructed by Freeths LLP. The applicant was represented by Roger Lush of Carpmaels & Ransford LLP.

18. I make this decision having taken full account of all the papers before me and the submissions made by both parties at the hearing.

19. Although the UK has left the European Union (EU), section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive and, therefore, this decision continues to refer to the trade mark case law of the EU courts.

EVIDENCE

Opponent's evidence

Witness statement of Russell Alan Deards and exhibits RD1–RD5

20. Mr Deards is the Legal & Compliance Director for Highbourne Group Limited and its subsidiaries, of which the opponent is one. He provides the opponent's evidence of use. His statement is dated 2 January 2024.

Applicant's evidence

Witness statement of Andrew David Edwards and exhibits ADE1–ADE12

21. Mr Edwards is the applicant's managing director, a position he has held since April 2022. He has worked for the applicant since 1993. Mr Edwards' evidence relates to the applicant's trade, including turnover and marketing spend and relates to its claim to honest concurrent use. His statement is dated 13 March 2024.

Submissions

22. The opponent filed submissions on 2 January 2024 and submissions in reply on 15 May 2024. The applicant's response to those submissions is included in its skeleton argument.

Preliminary issue

23. The applicant's evidence concerns the applicant's company history and use of its marks. The opponent's submissions dated 2 January 2024 respond to this evidence and make comments concerning, inter alia, how the applicant uses its marks. These oppositions are filed against new applications for the stylised and word versions of the 'PTS Precision Technology Supplies' marks. The applicant has five years in which to use the marks applied for, so its historic or current use of its PTS marks is irrelevant.

DECISION

24. I will begin by considering the opponent's marks under the 5(2)(b) ground. Section 5(2)(b) of the Act states:

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

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

Proof of use

25. The opponent's marks are earlier marks that are subject to proof of use. This is because, at the date of application of the contested mark, they had been registered for five years and the applicant has put the opponent to proof of use for all three earlier rights relied on.

26. Section 6A of the Act reads as follows:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes -

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

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

(5) - (5A) [Repealed]

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

27. Section 100 of the Act is also relevant. It states:

“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.”

28. The period for which genuine use must be proven is the five years prior to the date of filing of the contested application, namely, 10 May 2017 to 9 May 2022.

29. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023],² Arnold LJ summarised the law relating to genuine use as follows:

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

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

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark:

² EWCA Civ 1247

Ansul at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

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

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered

by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

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

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

107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and *Ferrari* at [73]-[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council* [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

“19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know.

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

Opponent's evidence of use

30. Mr Deards states that the opponent has used the PTS trade marks since at least 2006 and sells, *“over 25,000 heating, bathroom, electrical, tools, spares and plumbing supplies, including a range of PTS branded products”*.

31. He states that the goods and services under the PTS marks are sold throughout the UK and provides the names of 34 towns and cities in England, Scotland, Wales and Northern Ireland, in which the opponent operates.

32. Mr Deards provides the following turnover figures for goods and services sold under the PTS trade marks:

| Year | Amount (£'s) |
|-------------|---------------------|
| 2023 | 307,060,525 |
| 2022 | 331,923,279 |
| 2021 | 354,501,507 |
| 2020 | 282,773,344 |
| 2019 | 337,851,668 |
| 2018 | 329,562,778 |

33. He provides the following advertising expenditure figures, *‘that can be attributed to promotion of the goods and services under the PTS Trade Marks’*:

| Year | Amount (£s) |
|-------------|--------------------|
| 2022 | 1,554,179 |
| 2021 | 1,248,505 |
| 2020 | 1,031,330 |

34. The opponent provides twenty invoices that are said to be a sample of those available.³ Some of these are duplicates for the same order, one being a cash invoice and the other being for collection of the same order, or a branch copy. All of the invoices are dated in 2021 and 2022 and have the following in the top left corner.

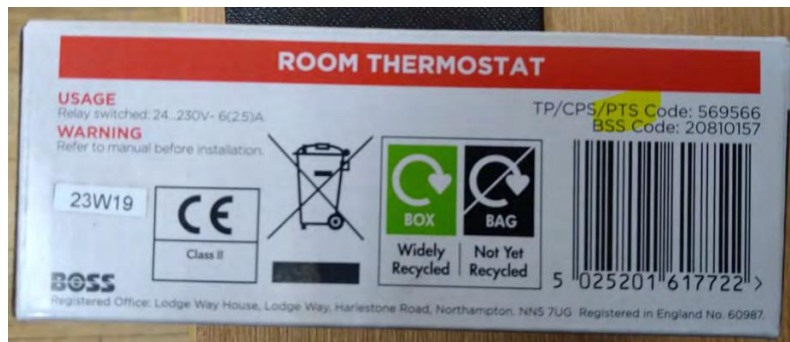


35. Customer details have been redacted, apart from two invoices that relate to delivery of goods from a third party to PTS Portsmouth. The customer is listed as City

³ See exhibit RD1.

Plumbing Supplies. None of the goods listed on any of the invoices is described as PTS goods, though other brands are shown, for example *FireAngel*⁴ and *Bosch*.⁵

36. Mr Deards provides examples said to show the PTS trade mark physically applied to the goods in classes 6, 7 and 9.⁶ The sum total of that evidence is the following two images, that are not dated:



37. Mr Deards provides examples of brochures and leaflets 'promoting the goods and services under the PTS trade marks'. They are dated between 2017 and 2020.

⁴ See exhibit RD1, page 20.

⁵ See exhibit RD1, page 15.

⁶ See exhibit RD2.

38. The first is titled, 'August deals, ends 31 August 2017'.⁷ PTS is shown in the top right corner of the flyer:⁸



39. Products shown include, inter alia, *BOSS* radiator thermostats, *Valliant* boilers and *Bristan* showers. No PTS branded goods are shown.

40. The second promotional item is headed, 'September-December 2017 Plumbers Perks'.⁹ PTS is shown in the top right corner, in white on a red background. Products shown are boilers, oil tanks, fires, radiators, thermostats and other related parts that are branded with third party marks including, inter alia, *Baxi*, *Bristan*, *Adey*, *Worcester*, *Glow Worm* and *Valliant*. None of the goods is branded PTS.

41. The third example is taken from www.cityplumbing.co.uk.¹⁰ The page is dated 22 January 2018 and shows a person in a white shirt branded with PTS. The letters on the shirt are white in red circles. The text below the image reads: '*open an account with Plumbing Trade Supplies today and we will offer you a 5% Credit Note based on your spend in the first three months*'.

42. The following information is shown below the text:



⁷ See exhibit RD3(A).

⁸ On this flyer the background is red, but due to annotations by the opponent, the version shown on a blue background is the only version not otherwise obscured.

⁹ See exhibit RDA(B).

¹⁰ See exhibit RD3(C), page 1.

43. A leaflet is provided that is titled, 'Think we're just a plumbers' merchant, think again'. City Plumbing and PTS logos are shown in the top right of the page:



44. Offers relate to March 2021 and are made in respect of a range of lighting equipment, including downlights and LED panels.¹¹ None of the products is branded with PTS trade marks.

45. Leaflets are provided that are titled, 'January DEALS', 'February DEALS', 'March DEALS', 'April DEALS', 'May/June DEALS', 'Summer DEALS', 'September DEALS', 'October DEALS' and 'Winter DEALS'.¹² They all relate to 2020. City Plumbing and PTS logos are shown in the top right of the page, the same as shown in paragraph 43 above. The offers shown on each of the promotional leaflets are the same for all of the dates, namely, a free Google Mini with selected smart thermostats. Thermostats from *Drayton*, *nest* and *Hive* are shown in the main advertisement. Below it are offers for a *Triton* shower, a *Rothenberger* plumbing set and *Plumb Right* solder wire. None of the products is branded with PTS trade marks. The website at the bottom of the page is www.cityplumbing.co.uk, where customers are informed they can manage their accounts, access 20,000 products online, click and collect in branch or get free next day delivery.

46. Mr Deards provides a Winter 2019 Trade Guide.¹³ The following logos are shown in the top right corner and throughout the guide pages that have been provided in evidence.

¹¹ See exhibit RD3(C), page 2.

¹² See exhibit RD3(C), pages 3-11.

¹³ See exhibit RD3(D), pages 1-3.



47. Product categories are listed on the front cover and include water treatment, air conditioning, plastic plumbing, underfloor heating, kitchens and fires & flues. The bottom of the front page of the trade guide shows the following:



48. A leaflet for 'Plumbers Perks' valid in September–December 2020 is described as 'The trade only reward scheme'. Customers register at www.plumbersperks.co.uk. Discounts are offered on a range of smart controls and thermostats. The same two logos shown in paragraph 46, above, are shown in the top left corner of the page.

49. An historic web page, accessed via waybackmachine, is dated 7 August 2022 (after the relevant date).¹⁴ Under 'Welcome to PTS' the text reads:

"If you're searching for cost effective and high-quality trade plumbing supplies, you'll find everything you need here at City Plumbing. In order to provide you with the best possible service, we've combined the PTS and City Plumbing websites, allowing you to manage your account online, pay invoices and see your trade prices, all in one convenient place."

50. Current examples of PTS information on the www.cityplumbing.co.uk website are also provided by the opponent. They were printed contemporaneously with the witness statement (and are after the relevant date).¹⁵ A map is shown on one of the pages, for an area that cannot be determined from a small image. A radio button to the left of the

¹⁴ See exhibit RD4, page 2.

¹⁵ See exhibit RD4, page 1.

screen reads 'Find your local branch'. There appear to be four stores shown on the example map. Two look to be City Plumbing stores, the other two could be PTS stores, although the text is minute and indistinct. The virtual assistant on the web page is provided under the City Plumbing logo and reads: "Hi, welcome to City Plumbing, I'm your virtual assistant? Do you need any support today?".

51. A Facebook page post, dated 10 June 2019, posted by City Plumbing UK shows the following:¹⁶



52. And on 5 February 2020:¹⁷



¹⁶ See exhibit RD4, page 3.

¹⁷ See exhibit RD4, page 4.

53. A similar price guide is shown in a City Plumbing UK Facebook post, dated 20 May 2021.¹⁸

54. A Facebook page, dated 7 October 2021, and posted by City Plumbing UK, shows the companies under the Highbourne Group, which include City Plumbing and PTS.¹⁹

55. A post by City Plumbing UK, dated 8 April 2022 announces Plumbworld joining the same group of companies.²⁰

56. A post by City Plumbing UK, dated 20 December 2022 announces festive opening hours. It has both City Plumbing and PTS logos at the top of the page.²¹

57. A LinkedIn post for City Plumbing shows a trade stand photograph from '1 yr ago'. This places the date anywhere from 1–2 years before the date the page was accessed. In this case the post is titled, 'From 21st–23rd June at the NEC Birmingham, so likely dates from June 2022 as the page was accessed on 22 December 2023. City Plumbing and PTS logos are displayed on the stand.²²

58. The remaining pages of the LinkedIn exhibits relate to award shortlists. The PTS logo is shown on the page as it is included in the group of companies, though there is no evidence of PTS being shortlisted for any of the awards mentioned in the posts.²³ PTS won the Best Customer Service Award at the 2016 Plumbing and Heating Awards,²⁴ before the relevant date.

59. With regard to market share, Mr Deards states:

“17. The business of CPSHL operating under the PTS Trade Mark occupies a strong position in the plumbing and heating market. Across a market

¹⁸ See exhibit RD4, page 4.

¹⁹ See exhibit RD4, page 5.

²⁰ See exhibit RD4, page 5.

²¹ See exhibit RD4, page 6.

²² See exhibit RD4, page 9.

²³ See exhibit RD4, page 10.

²⁴ See exhibit RD5.

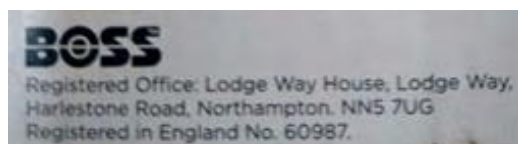
which is estimated to be worth approximately £6bn (as at 2018 estimates), the Goods and Services provided under the PTS Trade Mark have a market share of approximately 5.5%.”

Conclusions from the evidence

60. There is no use shown of the earlier PTS trade marks on goods in classes 6, 7 and 9 in any catalogues or advertising material, or on the opponent’s website. Two examples have been provided that purport to show use on the packaging of a room thermostat and a cylinder thermostat. They appear as follows:²⁵



61. The brand shown on the packaging for each of these items is clearly BOSS, whose logo is displayed in the bottom left corner of packaging, with the company address below it, as follows:



62. BOSS thermostats are shown in the August 2017 deals leaflet from City Plumbing and PTS. The same stylised BOSS logo is shown above each item for sale, for example:²⁶

²⁵ See paragraph x above.

²⁶ See exhibit RD3(A), page 3.

From
£9.19
each

SAVE 20%
for 5 or more

**Supreme 15mm Angled
TRV & Lockshield Pack**

| CODE | SAVE 10% | | SAVE 20% |
|--------|----------|--------|----------|
| | 1 - 2 | 3 - 4 | 5+ |
| 442149 | £11.49 | £10.34 | £9.19 |

COLLECT TODAY

63. The codes shown in paragraph 61 above, which the opponent claims are use of the PTS marks on goods are, when read alongside the opponent's invoices, are simply administrative product codes that are used so that customers can order BOSS thermostats from the opponent's website, catalogue or promotional leaflet. All of the goods shown on the invoices supplied in evidence show that the branded goods of third parties are sold by the opponent by reference to 6-digit product codes.

64. A product code that uses the three letters PTS somewhere within it, is not use of the PTS trade marks that would operate as a badge of origin for the consumer. In fact, the letters PTS are the third letters in the sequence of letters in the code and would be difficult to identify if not highlighted by the opponent in the two examples given above.

65. The opponent's submissions at the hearing in relation to genuine use included a request from the opponent's counsel for me to conclude that all of the goods shown in evidence, where no obvious brand is shown, are in fact PTS goods. This is not something I am going to do. It is for the opponent to show genuine use of the earlier marks it relies on, for the relevant goods and services for which genuine use is claimed. It is not for the hearing officer to imply it in circumstances where the evidence falls short.

66. In any case, even if I were to imply that unbranded goods were PTS goods, the few examples of unbranded goods shown in evidence would not be sufficient to clear the genuine use threshold. Opponent's counsel took me to a listing in a catalogue for heated towel rails.²⁷ I note there is also an unbranded listing for a bath.

²⁷ Unbranded towel rails are shown in RD3(A), page 4.

67. In addition, I note that the catalogues and advertising promotions in the evidence are co-branded with both City Plumbing and PTS logos at the top and the website given on the promotional material is the City Plumbing website. It is therefore not clear to me why unbranded goods must be PTS products, rather than City Plumbing products.

68. I have considered the evidence as a whole in reaching a conclusion on the use made of the earlier marks and find there is no evidence that supports a finding of genuine use of the PTS marks, in respect of the goods relied on in classes 6, 7 and 9.

69. The opponent has provided turnover figures in excess of £280 million for each year 2018–2023 and advertising expenditure in excess of £1 million for each year 2020–2022. It should have been a very simple matter, given the level of turnover, for the opponent to have provided some evidence of PTS branded goods for sale in the relevant period, given the significant turnover in the period. It has not done so.

70. The oppositions fail in respect of earlier rights 904333704, PTS stylised mark, registered in classes 6, 7 and 9 and the PTS word mark 902933240, registered in class 9, due to no use being shown of either mark for the goods relied on.

71. The oppositions continue under section 5(2)(b) of the Act in respect of trade mark number 2447728, for the word mark PTS, registered in class 35.

72. The opponent's specification in class 35 is as follows:

Retail services connected with the sale of plumbing, heating and sanitaryware items and equipment; the bringing together, for the benefit of others, of a variety of plumbing, heating and sanitaryware goods, enabling customers to conveniently view and purchase such goods from retail outlets; mail order, telephone order, electronic shopping and online retailing of plumbing, heating and sanitaryware goods; business information on store locations and information on products in the nature of plumbing, heating and sanitaryware goods provided via a website.

73. The opponent's evidence showing trade under the PTS mark is very limited. There are two leaflets from August and September 2017 that show the PTS stylised mark on its own on the top right corner of the page.²⁸ A page dated 22 January 2018 shows an exclusive offer on the www.cityplumbing.co.uk website, for a 5% credit note when customers open an account with Plumbing Trade Supplies. Invoices suggest that there is a PTS Portsmouth where customers collect orders, although it is not clear if this is a store or collection depot. A map of an undefined area looks to have two PTS stores located on it, although it is very difficult to read. The Facebook page, LinkedIn account and website are all City Plumbing accounts, rather than PTS accounts. The trade guides, dated 2019, have www.cityplumbing.co.uk as the website where customers can buy goods, manage their accounts and organise collection or delivery of purchased items. The website evidence provided by the opponent is dated after the relevant date. Even the waybackmachine pages are dated three months after the end of the relevant five-year period.

74. At best, the evidence shows, within the relevant period, co-branding with City Plumbing and PTS for the retail of a range of, primarily, plumbing products including, inter alia, radiators, boilers, thermostats, heating controls, baths, pipes and taps. However, for reasons that will become apparent, I will proceed on the basis that the opponent has shown use of the PTS mark for its full specification in class 35.

The average consumer and the nature of the purchasing act

75. 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*²⁹, Birss J. (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that

²⁸ RD3(A) and RD3(B).

²⁹ [2014] EWHC 439 (Ch).

the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

76. Neither party has made submissions concerning the average consumer for their respective services. The average consumer for the opponent’s retail services for plumbing and heating goods, in class 35, will be traders in the plumbing and heating industries and members of the general public buying for a trader to fit or to use in a DIY context. The purchase is likely to be primarily visual, though there may be a verbal element where advice is sought prior to purchase. The goods being retailed will vary in price from fairly cheap items such as washers and pipes, to fairly expensive items such as boilers and heat pumps. The level of attention paid by the average consumer is likely to vary accordingly, though given the nature of the goods being retailed, the level of attention paid to the purchase will be at least medium as the purchaser will need to consider the availability and lead time for the goods, the range stocked, and the suitability for the particular plumbing or heating job being carried out.

77. The applicant’s services are import and export services for stainless steel industrial fasteners and precision turned parts in class 35 and storage and distribution of the same, in class 39. The average consumer for these services will be businesses. The purchase is likely primarily visual, being made from a website, trade catalogue or via trade shows. The commissioning of the services will likely be fairly expensive and will require considerable logistics, meaning that the level of attention paid will be high.

Comparison of services

78. The services to be compared are as follows:

| The opponent’s services | The applicant’s services |
|----------------------------------------------------------------------------------------------------------|-------------------------------------------------------------------------------------------------------|
| <p><u>Class 35</u> Retail services connected with the sale of plumbing, heating and sanitaryware</p> | <p><u>Class 35</u> Import of Stainless Steel Industrial Fasteners and Precision Turned Parts;</p> |

| | |
|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <p>items and equipment; the bringing together, for the benefit of others, of a variety of plumbing, heating and sanitaryware goods, enabling customers to conveniently view and purchase such goods from retail outlets; mail order, telephone order, electronic shopping and online retailing of plumbing, heating and sanitaryware goods; business information on store locations and information on products in the nature of plumbing, heating and sanitaryware goods provided via a website.</p> | <p>Export of Stainless Steel Industrial Fasteners and Precision Turned Parts.</p> <p><u>Class 39</u></p> <p>Storage and Distribution of Stainless Steel Industrial Fasteners and Precision Turned Parts.</p> |
|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|

79. When making the comparison, all relevant factors relating to the services in the specification should be taken into account. In *Canon*,³⁰ the CJEU stated at paragraph 23 of its judgment:

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

80. The relevant factors identified by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case) for assessing similarity were:³¹

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

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

³⁰ Case C-39/97.

³¹ [1996] R.P.C. 281.

(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.”

81. The services must be given their ordinary and natural meanings. In *YouView Ltd v Total Ltd*,³² Floyd J. stated:

“...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. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. 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”.

³² [2012] EWHC 3158 (Ch) at [12].

82. The applicant provided a table with its skeleton argument in which it submits that the opponent's class 35 services are different from the applicant's services in classes 35 and 39. I note that the applicant also provided two decisions from the EUIPO between the same parties and sought to rely on the findings that the opponent's goods were different from the applicant's services. I must make this decision based on the material before me. I have already found that the opponent has failed to show genuine use for its PTS marks in respect of goods, so the EUIPO cases are not relevant to the matter to be determined.

83. The opponent submits the following:

“30. The Applicant's Services share a high level of similarity with the Opponent's Services (for which only the Earlier Word Mark (Class 35) is registered for):

...

b. Further, 'retail services ... enabling customers to conveniently view and purchase such goods from retail outlets; mail order, telephone order, electronic shopping and online retailing' is highly similar, if not identical, to the 'distribution' aspect of the Applicant's Services when with respect to the same goods. In particular:

i. The uses of the of the respective services are the same – purchasing/procuring hardware items and equipment (such as screws, nuts, bolts etc.).

ii. The users of the of the respective services are likely to be similar – such as trades people, manufacturers, wholesalers and retailers.

iii. The physical nature of 'distribution', and the respective trade channel through which those services reach the market, will be the same as one or more of purchasing from retail outlets, mail order, telephone order, electronic shopping and/or online retailing.”

The applicant's services in class 35

84. The opponent submits the uses of the respective services are the same, being the purchase and procurement of hardware items. I disagree. The opponent's services are retail services for the sale of, primarily, plumbing and heating goods. With regard to what a retail service is, I bear in mind the comments of Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person in *Tony Van Gulck v Wasabi Frog Ltd* ("*Miss Boo*")³³ in which he cautioned that "selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35". The objective of retail services as set out in *Oakley, Inc v OHIM*,³⁴ "*includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction*" and "*those services play, from the point of view of the relevant consumer, an important role when he comes to buy the goods offered for sale.*"

85. The applicant's services are import and export services that relate to the import and export of stainless-steel industrial fasteners and precision turned parts. Import and export services are services that move goods between countries and may involve considerable paperwork with customs authorities, tariffs and quotas. The users of the respective services are clearly different.

86. The opponent's customers are traders or members of the public, such as, inter alia, plumbers, heating engineers or DIYers looking to buy plumbing and heating goods. The applicant's customers are businesses who require stainless steel industrial fasteners and/or precision turned parts to be moved between countries. The uses of the respective services are different.

87. Import and export services of the type in the application will not be bought by the same consumer as would purchase the opponent's goods from its retail stores. In other words, the services reach the market in different ways and there is no complementary relationship between them. They are not in competition.

³³ BL O/391/14.

³⁴ Case T-116/06, at paragraphs 46-57.

88. In short, there is no similarity between the opponent's services in class 35 and those provided by the applicant, in the same class.

The applicant's services in class 39

89. The applicant's services are storage and distribution services relating to stainless steel industrial fasteners and/or precision turned parts. These services are not sales services, they relate to delivery and storage of goods for a fee and will likely include logistics and warehousing. They will be used by businesses to manage the flow of goods, in this case stainless steel industrial fasteners and/or precision turned parts, from manufacturers to consumers. Clearly, the users, nature and purpose of these services differs from the retail services of the opponent. The opponent submits that the trade channels for distribution services are the same as for its own retail services in class 35. I disagree. The opponent's end consumer, who is, for example, someone seeking to buy plumbing goods, will not, as an alternative, commission the services of a distribution company. The opponent may use the services of storage and delivery companies to move its own goods (not the same goods as those that are the subject of the applicant's retail services) but this is a step removed from its end consumer purchasing goods from its plumbing and heating retail business. The core nature of the services is different, and I would find that to be the case, even if the goods being distributed were identical to those being selected for retail by the opponent, and, they are not. I find the same to be true in respect of the applicant's storage services that have different users, uses, purpose and trade channels to the opponent's retail services. They are not in competition and are not complementary. These are dissimilar services.

90. Some similarity of services is essential to engage the likelihood of confusion assessment.³⁵ In *eSure Insurance v Direct Line Insurance*,³⁶ Lady Justice Arden stated that:

³⁵ See *Waterford Wedgwood plc v OHIM*, C-398/07 P (CJEU).

³⁶ [2008] ETMR 77 CA.

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

91. As I have found no similarity between the respective services, there can be no likelihood of confusion, and the opposition based on trade mark 2447728 for the mark PTS in class 35 fails.

92. As is clear from my conclusions regarding the opponent’s evidence, I accepted that use of the PTS mark for class 35 was shown, in order to go on to consider the similarity of services. In reality, the evidence of use of PTS for retail services is extremely scant, with almost all evidence supporting a finding that the opponent uses City Plumbing for its retail services, rather than its PTS marks. This coupled with the fact that the opponent’s services in class 35 are different to the applicant’s services in classes 35 and 39, means that there can clearly not be a likelihood of confusion between the competing marks.

93. The oppositions fail under section 5(2)(b) of the Act.

94. Given that I have found no likelihood of confusion, I need not consider the applicant’s claim to honest concurrent use of its marks alongside those of the opponent, which becomes relevant only once a conflict, such as a likelihood of confusion, is established. See *Budejovicky Budvar NP v Anheuser-Busch Inc*,³⁷ and *Match Group LLC & Ors v Muzmatch Ltd & Anor*.³⁸

³⁷ Case C-482/09

³⁸ [2023] EWCA Civ 454

The opponent's case under section 5(3) of the Act

95. In order to begin a case under this ground, the opponent must satisfy me that its earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Given my findings regarding the opponent's evidence, it is clear that it falls a long way short of satisfying the requirement that the earlier marks have a reputation.³⁹

96. Accordingly, the opponent's opposition under section 5(3) of the Act fails.

COSTS

97. Precision Technology Supplies Ltd has been successful in both oppositions and is entitled to a contribution towards its costs. The oppositions were filed on 28 October 2022. Tribunal practice notice 2/2016 provides the applicable scale for tribunal cases launched between 1 July 2016 and 1 February 2023 and is relevant here. I award costs on the following basis, bearing in mind there are two oppositions, but with some degree of duplication in the material filed:

| | |
|--------------------------------------------------------------------------------------------------------|--------------|
| Preparing a statement and considering the other side's statement x 2 - | £400 |
| Filing evidence and considering and commenting on the other side's evidence (for two oppositions) - | £1200 |
| Preparing for and attending a hearing - | £800 |
| Total | £2400 |

98. I order City Plumbing Supplies Holdings Limited to pay Precision Technology Supplies Ltd the sum of £2400. This sum is to be paid within 21 days of the expiry of

³⁹ See *General Motors*, Case C-375/97.

the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 16th day of December 2025

**AI Skilton
For the Registrar,
the Comptroller General**