O/1214/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004015978
BY VELAHOME CO., LTD. TO REGISTER:

Gökotta

AS A TRADE MARK IN CLASSES 3 & 20

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 447724 BY
JOSEPH ANDREWS

BACKGROUND AND PLEADINGS

1. On 20 February 2024, VELAHOME CO., LTD. (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK (“the applicant’s mark”). The applicant’s mark was published on 10 May 2024 and registration is sought for the following goods:

Class 3: Perfumery, essential oils; shower soap; incense; essential oils for household use; massage oils; lavender oil; moisturising skin lotions [cosmetic]; extracts of flowers [perfumes]; essential oils of lemon; cotton wool for cosmetic purposes; refills for electric room fragrance dispensers; room fragrancing preparations; non-medicated bath salts; bath herbs; cleaning agents for household purposes; bath creams (non-medicated -); massage oils and lotions; cleaning preparations; non-medicated massage preparations; make-up pads of cotton wool.

Class 20: Furniture; beds, bedding, mattresses, pillows and cushions; mattress toppers; sofas; boxes of wood or plastic; clothes hangers [coathangers], not of metal; indoor blinds [roller]; picture frames; tissue holders [fixed] not of metal; sleeping pads; accent pillows; mats for infant playpens; chair pads; children's beds; ottomans; pet furniture; poles, not of metal; work benches; coat hangers.

2. On 28 May 2024, the applicant’s mark was opposed by Joseph Andrews (“the opponent”). The opposition is based on sections 5(2)(a) of the Trade Marks Act 1994 (“the Act”) and is reliant upon the following trade mark:

Gökotta
UK registration no. 3812232

Filing date 22 July 2022; registration date 23 December 2022
Relying on all goods, namely:

Class 21: Glassware.

3. The opposition is based on a claim that the marks at issue are identical and that that the applicant's goods are similar to the opponent's goods. The basis for the opponent's claim as to similarity of goods is because they all within the same category, being 'household goods'. As such, the opponent claims that there exists a likelihood of confusion between the marks.

4. The applicant filed a counterstatement denying the claims against it.

5. The applicant is represented by Pablo Albert Catala and the opponent is unrepresented. Only the opponent filed evidence. No hearing was requested and neither party filed submissions in lieu of the same. This decision is taken after careful consideration of the papers.

6. 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.

PRELIMINARY ISSUE

7. In its counterstatement, the applicant made reference to its own earlier mark for the word 'Gökotta' in classes 9, 21, 24 and 25. It is claimed that the existence of this mark establishes the applicant's prior rights under section 5(1) of the Act and its use of the same solidifies its rightful claim to the trademark, significantly

weakening the opponent's assertion of exclusive rights. For the avoidance of doubt, these comments are of no assistance to the present proceedings and I say so for two reasons, which I will discuss below.

8. Firstly, I am unsure what is meant by the applicant's reference to section 5(1) of the Act, being the ground of opposition relied upon where both the marks and goods/services at issue are claimed to be identical. That being said, while it has not been expressly pleaded in this way, I have given consideration as to whether this was raised as a defence on the basis that the opposition should fail because the applicant owns an earlier mark which identical to the opponent's mark. In short, I note that the applicant owns an earlier identical mark and that this is registered in class 21 (being the class of goods for which the opponent's mark is registered). However, relying on this as a defence to the present proceedings is wrong in law.[1] Secondly, it is possible that the existence of an earlier mark owned by an applicant may give rise to a defence of honest concurrent use as an applicant may be able to diminish a claim of a likelihood of confusion if it has honestly used its mark alongside the opponent's mark for a period of time.[2] However, in order to rely on such a defence, an applicant is required to provide evidence of its own use of its mark. As the applicant has filed no evidence, this defence is not applicable here.[3] In any event, the classes referred to by the applicant in its counterstatement do not cover class 3 goods (being those at issue here) so any use of the applicant's earlier mark would not have been relevant even if evidence was filed.

9. As a result of what I have said above, I will say no more about the comments raised in the counterstatement.

[1] On this point, see paragraphs 4 and 5 of TPN 4/2009
[2] See *Aceites del Sur-Coosur SA v OHIM*, Case C-498/07 P and *Budejovicky Budvar NP v Anheuser-Busch Inc*, Case C-482/0
[3] On this point, I note that a claim of honest concurrent use was not specifically pleaded but I mention it here for the sake of completeness.

EVIDENCE

10. The opponent's evidence came in the form of the witness statement in his own name dated 18 November 2024. The opponent's evidence is accompanied by two exhibits, being JA1 and JA2. The evidence was filed in direct response to the comments in the applicant's counterstatement. I do not intend to summarise the evidence in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

Section 5(2)(a): legislation and case law

11. Section 5(2)(a) of the Act reads as follows:

> "(2) A trade mark shall not be registered if because-
>
> (a) it is identical with an earlier trade mark and is to be registered for goods or services 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 or association with the earlier trade mark."

12. Section 5A of the Act states as follows:

> "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."

13. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

> "(6)(1) In this Act an "earlier trade mark" means –
>
> (a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,
>
> (aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;
>
> (ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.
>
> […]
>
> (2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered."

14. Given its earlier filing date, the opponent's mark qualifies as an earlier trade mark under the above provisions. As the opponent's mark did not complete its

registration process more than five years prior to the filing date of the applicant's mark, it is not subject to the use provisions meaning that the opponent is entitled to rely on all of the goods for which its mark is registered.

15. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) ("OHIM")*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

Identity of the marks

16. It is a pre-requisite of section 5(2)(a) of the Act that the marks at issue be identical. In the present case, the applicant's mark is a figurative representation of the word 'Gökotta' in a black standard typeface. The opponent's mark is a word only mark

for the exact same word, inclusive of the umlaut above the first letter ‘o’. The fair and notional use of word only marks covers the use of the words within them in any standard typeface and in any colour. Given the ordinary presentation of the word in the applicant’s mark, I am content to conclude that this is covered by fair and notional use of the opponent’s mark. As a result, I find that the marks at issue are identical.

Comparison of goods

17. The competing goods are as follows:

The opponent’s goods	The applicant’s goods
Class 21 Glassware.	Class 3 Perfumery, essential oils; Shower soap; Incense; Essential oils for household use; Massage oils; Lavender oil; Moisturising skin lotions [cosmetic]; Extracts of flowers [perfumes]; Essential oils of lemon; Cotton wool for cosmetic purposes; Refills for electric room fragrance dispensers; Room fragrancing preparations; Non-medicated bath salts; Bath herbs; Cleaning agents for household purposes; Bath creams (Non-medicated -); Massage oils and lotions; Cleaning preparations; Non-medicated massage preparations; Make-up pads of cotton wool.

	Class 20 Furniture; Beds, bedding, mattresses, pillows and cushions; Mattress toppers; Sofas; Boxes of wood or plastic; Clothes hangers [coathangers], not of metal; Indoor blinds [roller]; Picture frames; Tissue holders [fixed] not of metal; Sleeping pads; Accent pillows; Mats for infant playpens; Chair pads; Children's beds; Ottomans; Pet furniture; Poles, not of metal; Work benches; Coat hangers.

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

> "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".

19. 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.

20. The applicant's counterstatement sets out that its own products such as perfumery, essential oils and furniture are marketed to different consumer segments and sold through separate distribution channels. In response to this, the opponent filed evidence of an Amazon.co.uk printout showing the applicant's bedding goods (being a term within the applicant's specification) and the opponent's glassware goods (being the term in his own specification) side-by-side on a search results page.[4] The opponent claims that this evidence contradicts the applicant's point. While I note that the printout provided shows a listing for a set of cocktail glasses next to bedding, this does not have the impact that the opponent appears to believe it does. I say this for two reasons. Firstly, Amazon is a very large retailer that produces and sells such a vast array of goods and the simple fact that Amazon may sell different types of goods is not sufficient to give rise to a finding that it is common in the trade for any and all such goods to overlap in trade channels. If it were, then relying on Amazon alone would result in an overlap in trade channels between such a wide range of goods. This would, in my view, offer far too broad a scope of protection for anything that is sold via Amazon. Secondly, I have nothing

[4] JA1

to suggest what was actually searched for to yield such results. For example, it is entirely plausible to suggest that the search was for the word 'GOKOTTA' which would inevitably result in matches across different categories of goods, regardless of what they are. Such a search would, therefore, not necessarily point to an overlap in trade channels.

21. It is noted that the applicant's counterstatement makes reference to the distinct market positioning of the parties, which further supports its claim that there is no confusion. In direct response to this, the opponent provided a printout from Amazon.co.uk showing how the applicant uses its mark.[5] While the evidence in response to the applicant's comments is noted, there is nothing in the applicant's point that warranted any response from the opponent. This is because the way in which the parties actually (or intend to) position themselves in the market is not relevant to the assessment I must make. When considering the likelihood of confusion under the present ground, the assessment must be based, in fact, on the concept of 'notional and fair use' which involves carrying out the comparison of the goods based on the specifications before me, not the goods as they are effectively provided by the parties.[6]

Classes 3 and 20

22. I am of the view that I can deal with all of the applicant's terms across its different classes together.[7] In doing so, I remind myself that as per Section 60A of the Act, it is not simply the case that goods are dissimilar because they appear in different classes of the Nice Classification.

23. The only term in the opponent's specification is "glassware" in class 21. Clearly, the goods of the applicant (being in class 3 and 20) differ in nature, method of use

[5] JA2
[6] *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06 at [66] and *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at [22]
[7] It is permissible to do so in accordance with the case of *Separode Trade Mark* (Case BL O/399/10)

and purpose with the opponent's goods.[8] Further, they are not complementary and neither are they in competition. In the opponent's notice of opposition, he appeared to play up the fact that the parties' goods are household goods that would be found adjacent to each other in homes and in department store sections. Such a pleading appears in support of a claim that the goods overlap in trade channels. In considering the former point of the opponent, I will say that is no merit whatsoever to the claim that the goods are placed in close proximity in the home. I say this because where goods are placed in homes is not a relevant factor when comparing goods. For example, plainly it is possible for glassware (such as a vase) to be placed on a shelf next to a speaker for playing music. However, such goods would clearly be dissimilar in a comparison in proceedings before the Tribunal and their placement in the home would have no bearing on this. As for the claim that the goods are sold in close proximity in department store sections, I will address this in detail below.

24. I appreciate that large department stores or supermarkets will sell both the applicant's goods and those of the opponent. Further, I accept that some of the applicant's goods (such as room fragrancing preparations in class 3 and the beddings goods in class 20) will likely be found in the same 'home' sections of stores as those where the opponent's goods are found. While this may be the case, I am not convinced that they would be placed in close proximity within those sections as I see no reason why fragrance goods or bedding, for example, would be placed next to glassware. On this point, I note that I have nothing before me in evidence to suggest that it is common in the trade for such goods to be found next to one another within these sections of stores. Overall, I am not convinced that there is a sufficiently pronounced overlap in trade channels between these goods simply because large retailers may sell them. This applies even where some of the goods may be found in the same sections of said stores. Turning finally to user, I appreciate that there is an overlap in user between all of the above and the

[8] In respect of purpose, I will say here that goods being for use in the home does not equate to an overlap in purpose.

opponent's term as they will all be sought by members of the general public at large. However, this is, again, not a sufficiently pronounced overlap due to the fact that the user base for both parties' goods is so broad. As a result, I do not consider that there exists any meaningful degree of similarity between these goods. They are, therefore, dissimilar.

25. Lastly, in respect of the comparison of the goods, I wish to discuss the case of *Unicorn Studio Inc v Veronese* [2024] EWHC 1098 (Ch) wherein Mr Iain Purvis K.C., sitting as deputy High Court judge, set out at paragraph 24 of his judgement that:

> "[A]ny finding of similarity in the end requires the exercise of common sense and requires the hearing officer to stand back and consider the overall question. It strikes me that here the hearing officer was engaging essentially in a box-ticking exercise, asking how many of the factors identified in *TREAT* or in *Canon* could be said to have been satisfied. Had the hearing officer stood back and considered the overall question of similarity, I believe she would have considered and certainly ought to have considered that the idea that figurines and works of art were similar to electric lamps, chandeliers or mirrors was nonsensical and it hardly needed a careful consideration of the *Canon* or *TREAT* factors to come to that conclusion. I therefore agree with the appellant that this category of goods should have been found dissimilar, and certainly it could not have reasonably been found similar to more than 'a very low degree'."

26. While the above case involved a comparison of entirely different goods than those that are at issue here, I find that the same principle applies. Even if I was wrong in what I have said above and there were sufficiently pronounced overlaps in trade channels and user between the parties' goods, I am of the view that upon taking a step back and looking at the terms of the parties as they appear before me, any finding of similarity between them would be non-sensical. To suggest otherwise would result in an argument that any and all household goods are similar to one

another simply because they may be found in the same sections of larger stores and selected by the same users. This cannot be the case as it would, in my view, offer far too broad a level of protection to household goods.

Conclusion of the goods and services comparison

27. A likelihood of confusion under the present ground may only exist where goods are found to be identical or similar.[9] Given what I have said above in that the goods at issue are dissimilar, the opposition must fail at this stage, regardless of the identity between the marks.

CONCLUSION

28. The opposition fails and the applicant's mark may, subject to any successful appeal against my decision, proceed to registration for all of the goods for which protection was sought.

COSTS

29. The applicant has succeeded in defending its mark. It is, therefore, entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. While the applicant did not file evidence, I consider that costs should still be awarded in respect of this task as the applicant would have been required to consider the opponent's evidence. That being said, the evidence was very short and of no real assistance to these proceedings so any costs award in respect of the same should be reduced.

30. In the circumstances, I award the applicant the sum of £450 as a contribution towards its costs. The sum is calculated as follows:

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

Considering the notice of opposition and preparing a counterstatement:	£250
Considering the opponent's evidence:	£200
Total:	**£450**

31. I hereby order Joseph Andrews to pay VELAHOME CO., LTD. the sum of £450. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 23rd day of December 2025

A COOPER
For the Registrar