

BL O/739/22

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NUMBER 3597300
BY QVC, INC.
TO REGISTER THE TRADE MARK:**

TIDY & CO.

IN CLASSES 6, 16, 20, 21 and 22

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 425820
BY TIDY BEDROOMS LIMITED**

Background and Pleadings

1. On 18 February 2021, QVC, Inc. (“the applicant”) applied to register in the UK the trade mark shown on the cover page of this decision, under number 3597300 (“the contested mark”). The contested mark was published in the Trade Marks Journal for opposition purposes on 30 April 2021, in respect of goods in Classes 6, 16, 20, 21 and 22.¹

2. On 28 July 2021, Tidy Bedrooms Limited (“the opponent”) filed a notice of opposition. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Within its Form TM7, the opponent indicated that the opposition is directed against all the goods in the application.

3. On 01 April 2022, the applicant filed a TM21B requesting a limitation to all the goods claimed in the application. On 20 April 2022, having reviewed the limitation the opponent confirmed its intention to continue with the opposition.

4. The opponent relies upon its UK trade mark number 917949419,² “TIDY” (“the earlier mark”). The earlier mark was filed on 31 August 2018. The mark became registered on 04 October 2019. For the purpose of these proceedings, the opponent relies on all goods and services in Classes 6, 11, 18, 20, 24, 35, 39 and 40.³

5. The opponent claims that the marks at issue are highly similar and the respective goods and services are identical, similar, or complementary. In its counterstatement the applicant denies that a likelihood of confusion or association exists between the marks on the basis that its goods are not sufficiently similar to the goods and services of the earlier mark.

¹ These will be listed in the goods comparison

² On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM. As a result of the opponent’s EUTM number 017949419 being registered as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and the original EUTM filing date remains.

³ These will be listed in the goods and services comparison

6. Given the respective filing dates, the opponent's mark is an earlier mark, in accordance with section 6 of the Act. However, as it had not been registered for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified within section 6A of the Act. As a consequence, the opponent may rely upon all of the goods and services for which the earlier mark is registered without having to establish genuine use.

7. Only the opponent filed evidence and submissions. I do not consider it necessary to summarise the evidence but have taken it into account and will refer to it where necessary, throughout this decision. The opponent is professionally represented by Inbrandgible Limited; The applicant is professionally represented by Potter Clarkson LLP. Both parties were given the option of an oral hearing but neither requested to be heard on this matter, nor did they file written submissions in lieu. This decision is taken following a careful review of the papers before me, keeping all submissions in mind.

8. Although the UK has left the 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. That is why this decision continues to refer to EU trade mark case law.

PRELIMINARY ISSUES

9. In its counterstatement the applicant made comments regarding the state of the register. Before going any further into the merits of this opposition it is necessary to explain why, as a matter of law, this issue will have no bearing on the outcome of this opposition.

State of the register

- The applicant states that the earlier mark possesses a low distinctive character in relation to the goods and services, adding that this is evident given the

number of third-party TIDY-formative marks registered in classes 6, 16, 20, 21, 22 (among others), that co-exist both on the UK Trade Marks register as well as in the marketplace. The applicant submits that the common usage in the marketplace and the co-existence on the register for the relevant goods and services demonstrates that confusion or association with their mark will not occur.

10. In *Zero Industry Srl v OHIM*, Case T-400/06, the General Court (“GC”) stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71).”

11. Accordingly, the state of the register is not evidence of how many of such trade marks are effectively used in the market, nor does it establish that the distinctive character of the element in question has been weakened because of its frequent use. However, unrelated to the marketplace or the register, I will make a finding as to the distinctive character of the mark later in the decision.

DECISION

Section 5(2)(b)

12. Sections 5(2)(b) and 5A of the Act read 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.

[...]

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.”

13. I am guided by the following principles which are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well

informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

Comparison of goods and services

14. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

15. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where 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.”

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

“82 ... there is a close connection between [the goods], 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...”.

17. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

18. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

“... 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.”

19. In *Gérard Meric v Office for Harmonisation in the Internal Market (‘Meric’)*, 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”.

20. For the purposes of considering the issue of similarity of goods or services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10), Mr Geoffrey Hobbs QC, sitting as the Appointed Person, and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

21. The competing goods and services are as follows:

Opponent's goods and services	Applicant's goods (as opposed)
<p>Class 6 Metal building materials; ironmongery, small items of metal hardware; door locks; padlocks; metal locks for windows; metal latches, being fittings for doors and windows; window and door handles of metal; metallic windows; metallic doors; parts and fittings for all the aforesaid goods.</p> <p>Class 11 Lighting apparatus and installations; room air fans; decorative lighting; display lighting; security lighting; outdoor lighting; electric lamps; emergency lighting; fibre optic lighting fixtures; light emitting diodes (LED) lighting apparatus; lights and lamps for vehicles; torches for lighting; lamp holders; light bulbs; electric light bulbs; light fittings; electric blankets; heat pads; electrical fans; parts and fittings for all the aforesaid goods.</p>	<p>Class 6 General purpose metal storage units; general purpose metal storage containers and bins; metal storage boxes for general use; all the aforesaid for brooms, brushes, mops, dusters, dustpans, buckets, tools, stands, stools, chairs, utensils, cooking utensils, eating utensils, cords, wires, electronics, lights, and lamps; none of the aforesaid being bespoke or customisable items or features of furniture.</p> <p>Class 16 Boxes, cartons, storage containers and packaging containers made of paper or cardboard; non-metal photo storage boxes; paper for wrapping and packaging; photo storage boxes of metal; photo storage boxes; none of the aforesaid being bespoke or customisable items of or features of furniture.</p> <p>Class 20 Organizational products, namely, storage racks, metal and non-metal storage racks, expandable storage racks,</p>

<p>Class 18 Leather and imitations of leather; trunks and travelling bags; bags; luggage; holdalls; handbags; rucksacks; purses; wallets; umbrellas, parasols and walking sticks; saddlery, harness; polyurethane leather; leather cloth; synthetic leather; leather for furniture; furniture coverings of leather; leather trimmings for furniture; chamois leather, other than for cleaning purposes; sheets of imitation leather for use in manufacture; parts and fittings for the aforesaid goods.</p> <p>Class 20 Furniture, mirrors, picture frames; picture frames, mirrors, trays, screens, flower stands, umbrella stands; pillows; curtain tie backs; curtain rings; beds; cushions and pillows; bedding except linen; curtain rods; chests for toys; bottle racks; settees; brush mountings; cushions; mattresses; chests of drawers; key boards for hanging keys; statues, figurines, works of art and decorations, made of materials such as wood, wax, plastics or plaster, included in the class; parts and fittings for all the aforesaid goods</p> <p>Class 24 Textiles and substitutes for textile goods; bed and table covers; household textile articles; travellers' rugs; textile goods for use as bedding; duvets; quilts; covers for pillows, cushions or duvets; household linen; linen cloth; bed linen; bath linen; table linen; curtains of textile or plastic; pillow shams; pillow cases; sheets; towels; eiderdowns; covers for eiderdowns; mattress covers; napery; napkins; serviettes; table mats (not of paper); face towels; face flannels of textile; textile tissues; traced cloth for embroidery; tapestry (wall hangings)</p>	<p>shoe racks, non-metal hanging closet organizers for shoes, clothes hangers, garment storage racks; organizational products for household goods, namely, storage racks and shelves for brooms, brushes, mops, dusters, dustpans, buckets, tools, stands, stools, chairs, utensils, cooking utensils, eating utensils, cords, wires, electronics, lights, and lamps; drawer organizers; storage and organization systems comprising shelves, drawers, cupboards, baskets and clothes rods, sold as a unit; furniture with built-in storage; none of the aforesaid being bespoke or customisable items of or features of furniture.</p> <p>Class 21 Plastic storage containers for household and domestic use; collapsible storage containers for household and domestic use; none of the aforesaid being bespoke or customisable items of or features of furniture.</p> <p>Class 22 Cloth bags for storage of garments, shoes and personal items; multi-purpose cloth bags for storage; fabric and polyester mesh net used for storing household items; none of the aforesaid being bespoke or customisable items of or features of furniture.</p>
--	---

of textile; furniture coverings; parts and fittings for the aforesaid goods.

Class 35 Advertising; marketing; provision of business information via a website; online ordering services; business information; business introductory services; retail services connected with the sale of metal building materials, ironmongery, small items of metal hardware, door locks, padlocks, metal locks for windows, metal latches, being fittings for doors and windows, window and door handles of metal, metallic windows, parts and fittings for all the aforesaid goods; retail services connected with the sale of metallic doors, lighting apparatus and installations, room air fans, decorative lighting, display lighting, security lighting, outdoor lighting, electric lamps, emergency lighting, fibre optic lighting fixtures, light emitting diodes (LED) lighting apparatus, lights and lamps for vehicles, torches for lighting, lamp holders, light bulbs, electric light bulbs, light fittings, electric blankets, parts and fittings for all the aforesaid goods; retail services connected with the sale of heat pads, electrical fans, leather and imitations of leather, trunks and travelling bags, bags, luggage, holdalls, handbags, rucksacks, purses, wallets, umbrellas, parasols and walking sticks, saddlery, harness, polyurethane leather, leather cloth, synthetic leather, leather for furniture, furniture coverings of leather, leather trimmings for furniture, parts and fittings for all the aforesaid goods; retail services connected with the sale of chamois leather, other than for cleaning purposes, sheets of imitation leather for use in manufacture, furniture, mirrors, picture frames, picture frames, mirrors, trays, screens,

flower stands, umbrella stands, pillows, curtain tie backs, curtain rings, beds, cushions and pillows, bedding except linen, curtain rods, chests for toys, bottle racks, beds, settees, parts and fittings for all the aforesaid goods; retail services connected with the sale of brush mountings, cushions, mattresses, chests of drawers, key boards for hanging keys, statues, figurines, works of art and decorations, made of materials such as wood, wax, plastics or plaster, textiles and substitutes for textile goods, bed and table covers, household textile articles, travellers' rugs, textile goods for use as bedding, duvets, quilts, covers for pillows, cushions or duvets, parts and fittings for all the aforesaid goods; retail services connected with the sale of household linen, linen cloth, bed linen, bath linen, table linen, curtains of textile or plastic, pillow shams, pillow cases, sheets, towels, eiderdowns, covers for eiderdowns, mattress covers, napery, napkins, serviettes, table mats (not of paper), face towels, face flannels of textile, textile tissues, traced cloth for embroidery, tapestry (wall hangings) of textile, furniture coverings, parts and fittings for all the aforesaid goods; information, consultancy and advisory services relating to all the aforesaid services.

Class 39 Transport services; transportation and delivery of goods; distribution services; storage services; packaging and storage of goods; organisation of the transportation of goods and property by sea, river, air and land; transport of goods and property by ship, rail, road, air; delivery of mail-order goods; consultancy, information and advisory services relating to all the aforesaid services.

<p>Class 40 Joinery (custom manufacture); custom manufacture of furniture and kitchens; custom assembly of materials for others; manufacture of furniture to order and specification of others; curtain making; consultancy, information and advisory services relating to all the aforesaid services.</p>	
--	--

22. With regard to the similarity of the goods and services the opponent states the following:⁴

“We submit that the goods are identical /similar/ complementary. This is because the Opponent’s furniture, covers all different kinds of furniture and therefore many of the Applicant’s goods could be deemed identical to the Opponent’s furniture. This is because furniture includes items that are used to store things, including boxes such as blanket boxes, glory boxes and many different multipurpose boxes, especially made of wood or plastic. Shelves for storage, cushions are various types of furniture and furnishings. The goods under comparison satisfy the needs of the same consumers seeking to equip a room, which leads to the conclusion that these goods target the same relevant public. They may be produced by the same type of undertakings specialising in furniture and furnishings for rooms, and they are usually sold together at the same channels of distribution. Furthermore, some of the goods, such as organisational racks, shoe racks and clothing racks and beds share the same purpose as wardrobes, to store things, and are complementary.

The contested goods including *plastic tubs and metal storage units, bins, boxes and storage containers* are containers used as furniture, for example for storing small objects, toys, towels, laundry etc. These goods are commonly produced by furniture manufacturers. The goods under comparison belong to the same market sector and can be found in the same sales outlets and are purchased by the same consumers who wish to furnish their home. Furthermore *storage containers of wood or plastics or paper*

⁴ Written submissions.

and the contested *goods are* used for carrying object or storing objects, are included in the Opponent's broad category of *furniture*.

It is common for furniture stores to offer for sale various types of articles for home decoration, to enable purchasers of furniture to buy them at the same time to achieve an accomplished and harmonious decorative outfit. In addition, these goods are commonly advertised together in the same catalogues and specialist interior design magazines. Therefore, consumers may believe that the responsibility for the production of these goods lies with the same undertaking. Moreover, they are directed at the same public and often have the same distribution channels. Therefore, these goods could overlap with the Opponent's goods."

Class 6 of the contested application

General purpose metal storage units; general purpose metal storage containers and bins; metal storage boxes for general use; all the aforesaid for brooms, brushes, mops, dusters, dustpans, buckets, tools, stands, stools, chairs, utensils, cooking utensils, eating utensils, cords, wires, electronics, lights, and lamps; none of the aforesaid being bespoke or customisable items or features of furniture

23. The above contested goods are all general-purpose metal storage containers, units, bins and boxes used for storing those items listed in the specification. Therefore, the primary purpose of the contested goods is storage. Conversely, the opponent's Class 6 goods are building materials, small items or ironmongery, locks, and fixtures and fittings for doors and windows. Accordingly, although the competing goods coincide in their nature insofar as they are all made of metal, I find that their purposes are totally different. The goods at issue are used in different fields and target different consumers. Furthermore, they are not in competition with each other, nor are they complementary. Therefore, absent any specific submissions from the opponent as to the parties' class 6 goods, I find that these goods are dissimilar.

24. Broadly speaking, the function of the contested units, containers, bins and boxes is to provide storage solutions for an array of household products. The opponent's furniture in Class 20 is a broad term covering items such as chairs, tables, desks and beds. However, the term would also cover *storage* furniture, that is, furniture that provides storage solutions, such as dressers, wardrobes, and shelving units, etc. Furthermore, it is common for furniture manufacturers to incorporate racks and hangers, etc., as moveable and non-moveable parts within furniture, to facilitate and organise the storage of products placed therein. Accordingly, I find that the above contested goods and the opponent's furniture belong to the same homogeneous market sector and will at least share users and may be sold in the same places. Furthermore, the consumer may choose one product over the other so may also involve a degree of competition. Consequently, I find that the above contested goods are similar to a medium degree to the opponent's *furniture*.

Class 16 of the contested application

Boxes, cartons, storage containers and packaging containers made of paper or cardboard; non-metal photo storage boxes; paper for wrapping and packaging; photo storage boxes of metal; photo storage boxes; none of the aforesaid being bespoke or customisable items of or features of furniture

25. The primary purpose of the above contested goods is the storage, wrapping and packaging of goods. The opponent's storage services and packaging and storage of goods in Class 39 refers to, inter alia, services whereby goods are packaged and stored in a particular place for a fee. In most cases, providers of such services will also supply the boxes and packaging materials required to ensure the safe and secure transit and/or storage of goods. Therefore, bearing in mind that the users of such services will usually require the appropriate packaging goods, I find that the competing goods and services will share users and will be offered and sold in the same places, as such consumers are likely to believe that they originate from the same undertaking. Furthermore, the competing goods and services can be considered complementary. Consequently, I find that the above contested goods are

similar to a low degree to the opponent's *storage services* and *packaging and storage of goods*.

Class 20 of the contested application

Organizational products, namely, storage racks, metal and non-metal storage racks, expandable storage racks; none of the aforesaid being bespoke or customisable

26. The opponent's *bottle racks* are used to store and organise bottles and therefore fall within the applicant's *organizational products, namely storage racks*. These goods are identical in line with the principle set out in *Meric*.

Furniture with built-in storage; none of the aforesaid being bespoke or customisable items of or features of furniture

27. The opponent's *furniture* refers to items such as chairs, tables, beds, drawers and wardrobes, etc., that can be placed in areas within houses and other types of buildings in order to make the area more comfortable for living or working in, etc. The above contested *furniture with built-in storage* falls within the broad term *furniture*, whether it is bespoke or customisable or not. Accordingly, these goods are identical in line with the principle set out in *Meric*.

Storage and organization systems comprising shelves, drawers, cupboards, baskets and clothes rods, sold as a unit; none of the aforesaid being bespoke or customisable items of or features of furniture

28. In general, the above contested goods are units of furniture. Accordingly, I find that the opponent's broad term *furniture*, encompasses the above contested goods and therefore, although worded differently, the goods at issue can be considered identical in line with the principle set out in *Meric*.

Shoe racks, non-metal hanging closet organizers for shoes, clothes hangers, garment storage racks; organizational products for household goods, namely, storage racks and shelves for brooms, brushes, mops, dusters, dustpans, buckets, tools, stands, stools, chairs, utensils, cooking utensils, eating utensils, cords, wires, electronics, lights, and lamps; drawer organizers; none of the aforesaid being bespoke or customisable items of or features of furniture

29. Broadly speaking, the above contested goods are types of furniture, components, parts or accessories. It is common for furniture manufacturers to incorporate racks and clothes hangers, etc., as moveable and non-moveable parts within furniture, such as, cupboards, wardrobes, and storage systems sold as a unit of furniture, comprising shelves, drawers, cupboards, baskets and clothes rods, etc. Accordingly, I find that the above listed goods and the opponent's *furniture* belong to the same homogeneous market sector and will at least target the same relevant consumer and share the same distribution channels. Moreover, the goods at issue are complementary in that they are important for one another, resulting in the consumer seeing a connection between the two and believing that the responsibility for both lies with the same undertaking, likewise, they may also be in competition. Consequently, I find that the above contested goods are similar to a medium degree to the opponent's *furniture*.

Class 21 of the contested application

Plastic storage containers for household and domestic use; collapsible storage containers for household and domestic use; none of the aforesaid being bespoke or customisable items of or features of furniture

30. The primary purpose of the above contested goods is to provide storage solutions. I find that the contested *plastic* and *collapsible storage containers* have nothing relevant in common with the opponent's goods or services and therefore share no obvious similarity, differing in their nature, method of use, intended purpose and trade channels. In addition, the above contested goods will not be in competition with any of the opponent's goods and services, nor will they be complementary.

While it is acknowledged that the opponent's goods include the broad term *furniture* in Class 20, which can share a similar purpose to the contested goods, insofar as they can all be used to store goods, I find this to be a very general overlap and I do not consider it sufficient for a finding of similarity. While I note that consumers purchasing the opponent's *furniture* may, for example, also be interested in purchasing the contested goods since all of them can be used in the same home environment, this factor is not sufficient to find the competing goods similar to each other. The ordinary and natural meaning of *furniture* would not ordinarily include the contested *plastic* and *collapsible storage containers* keeping in mind the nature of the goods, trade channels, methods of use and the fact that they are neither in competition nor complementary. Accordingly, I find that the contested Class 21 goods are dissimilar to the opponent's *furniture* in Class 20. The same conclusion also applies to the opponent's remaining goods and services in Classes 6, 11, 18, 20, 24, 35, 39 and 40, which share no similarities with the above contested goods.

31. Bearing in mind the above, it is important to keep in mind the guidance in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12], where Floyd J (as he was then) 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. 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."

Class 22 of the contested application

Cloth bags for storage of garments, shoes and personal items; multi-purpose cloth bags for storage; fabric and polyester mesh net used for storing household items; none of the aforesaid being bespoke or customisable items of or features of furniture

32. Primarily, the above cloth, fabric and mesh bags are a type of flexible storage container with an opening at one end that provides storage solutions for household items such as garments and shoes, etc. These products do not have anything in common with any of the opponent's goods and services. In particular, they have clearly different purposes, methods of use, distribution channels and consumers. Furthermore, they are not complementary or in competition. While I note the opponent's *bags* in Class 18, I am unable to find similarity between these goods and the above contested *bags and nets for storage of household items* on the basis that these products belong to completely different markets, i.e. fashion v storage of household goods. While it is acknowledged that the opponent's broad term *bags* in Class 18, can share a similar purpose to the contested goods, insofar as they can all be used to store things, this is a very general overlap and I do not consider it sufficient for a finding of similarity. The ordinary and natural meaning of *bags* in Class 18 would not ordinarily include the contested *cloth and mesh bags for the storage of garments, shoes and household items*, keeping in mind the nature of the goods, trade channels, methods of use and the fact that they are neither in competition nor complementary. Accordingly, I find that the contested Class 22 goods are dissimilar to all the opponent's goods and services in Classes 6,11,18, 20, 24, 35, 39 and 40.

33. Bearing in mind the above, again it is important to keep in mind the guidance in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12], as previously detailed.

The average consumer and the nature of the purchasing act

34. 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 (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

35. 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.”

36. The average consumer of the parties’ goods and services will mainly be members of the general public. However, some of the goods in Class 6 and services in Classes 39 and 40 can be aimed at both ordinary members of the public as well as a more specialised commercial customer or business. For example, *metal building materials* in Class 6 and *custom manufacture of furniture and kitchens* in Class 40 are likely to be aimed at members of the general public as well as businesses, whereas *organisation of the transportation of goods and property by sea, river, air and land* in Class 39 and *custom assembly of materials for others* in Class 40 are more likely to be aimed at a specialised commercial customer.

37. The relevant goods and services at issue broadly consist of household storage and furniture. The purchasing act will not require an overly considered thought process as, overall, the goods and services at issue are relatively inexpensive. The average consumer will nevertheless consider factors, for example, suitability, etc., when purchasing the goods and services. Taking these factors into account, I find that the level of attention of the relevant public would be medium. The goods are typically sold in brick-and-mortar retail establishments or their online equivalents, where the goods are likely to be purchased after perusing the shelves or viewing

information on the internet. In these circumstances, the purchasing process will be predominantly visual in nature, though I do not exclude aural considerations entirely as consumers may receive word of mouth recommendations or discuss the products with a sales assistant.

Comparison of the marks

38. It is clear from *Sabel BV v. Puma AG* that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, that:

“34. [...] 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.”

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

40. The trade marks to be compared are as follows:

Opponent's mark	Applicant's mark
TIDY	TIDY & CO.

41. With regard to the similarity of the marks, in its counterstatement the applicant states the following:

“The Applicant denies that the Contested Mark and the mark of the Earlier Mark are highly similar, or indeed similar.”

42. With regard to the similarity of the marks the opponent states the following:⁵

“The signs in conflict are visually, aurally and conceptually identical for the first word and as result of the identical first verbal element, “TIDY” and the non distinctiveness of in the Applicant’s mark, the second and third words & CO.

[...]

Consumers generally tend to focus on the first element of a sign when being confronted with a trade mark. This is justified by the fact that the public reads from left to right, which makes the part placed at the left of the sign (the initial part) the one that first catches the attention of the reader. The second ‘&’ and third word ‘Co.’ are absent from the Opponent’s mark, however they are non distinctive and will either be dismissed by the consumer or will form a link with the TIDY and an association to the brand ‘TIDY’ that company is part of the TIDY company.”

Overall impression

43. The opponent’s mark comprises the word ‘TIDY’ presented in standard upper-case letters without any stylisation. The overall impression resides in this single element.

44. The applicant’s mark starts with the word ‘TIDY’ followed by the components ‘& CO.’, presented in standard upper-case letters without any stylisation. I find that the word ‘TIDY’ is the dominant and distinctive element of the mark, whereas the ‘& CO.’

⁵ Written submissions.

element will be perceived as reference to a company status and therefore plays a secondary role within the mark.

Visual comparison

45. With regard to the visual similarity of the marks the opponent states the following:

“Visually, the signs are similar to the extent that they coincide in the first word ‘TIDY’. Both the Opponent’s mark and the Applicant’s mark consist of the first word which is identical with the same number of letters. We admit that the Applicant has additional words of & Co but we respectfully submit that visually the marks look the same with the first word. Therefore, as [sic] the signs differ only in irrelevant aspects, which will have a small impact on the visually impression created by the marks.”

46. Visually the marks coincide insofar as they identically share the same word in the same position, namely ‘TIDY’. This similarity appears at the beginning of the respective marks, being where consumers tend to focus⁶ as this position is generally considered to have more impact due to consumers in the UK reading from left to right.

47. The competing marks are visually different in that the contested mark contains the additional components ‘& CO.’ This difference appears at the end of the mark and renders the marks different in length. I find the competing marks visually similar to at least a medium degree.

Aural comparison

48. With regard to the aural similarity of the marks the opponent states the following:

“Aurally, the pronunciation of the signs coincides in the sound of the sequence of the letters ‘T-I-D-Y’, present identically in both signs. It is agreed that there

⁶ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

is a difference between the second and third words, namely ‘& CO’ of the Applicant’s mark. However, consumers tend to not say all the words.”

49. Aurally, the opponent’s mark will be articulated in the ordinary English language pronunciation of ‘TIDY’. Likewise, the first element of the applicant’s mark will also be pronounced as ‘TIDY’ but with the addition of the two syllables ‘AND CO’ which merely indicate that the mark designates a company. Accordingly, the ‘& CO.’ element of the applicant’s mark is less likely to be always spoken. Overall, considering the consumer’s attention is usually directed to the beginnings of marks, I find the competing marks aurally similar to at least a medium degree.

Conceptual comparison

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

51. With regard to the conceptual similarity of the marks the opponent states the following:

“Conceptually, both ‘TIDY’ give the perception of being organised. We respectfully submit that conceptually the marks are identical for ‘TIDY’ and having a meaningful element in common could approximate the signs conceptually.”

52. Conceptually, the opponent’s mark ‘TIDY’ will be given its ordinary dictionary meaning, namely *neat and orderly in appearance*. As the competing marks both contain the word ‘TIDY’ they convey the same concept despite the added concept of ‘& CO.’ present in the applicant’s mark, which will be perceived as a company identifier. Therefore, I find that there is a high degree of similarity between the marks.

Distinctive character of the earlier trade mark

53. The distinctive character of a trade mark can be measured only, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, 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 *Windsurfing Chiemsee 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).”

54. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

55. In its counterstatement the applicant submits that the earlier mark 'TIDY' possesses, at best, a low distinctive character in relation to the goods and services at issue. Conversely, in their submissions, the opponent states that the earlier mark has a meaning for the relevant public that is not related to the goods and services in question and therefore is distinctive. Although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the opponent has not filed any evidence of use. Consequently, I have only the inherent position to consider.

56. The earlier mark comprises the word "TIDY". As previously discussed, this word will likely be given its ordinary dictionary meaning, namely *neat and orderly in appearance*. Furniture and storage goods are used to store and organise items, keeping them neat and orderly, and the same goes for related services. Accordingly, "TIDY" is highly allusive for the relevant goods and services. However, as registered marks are assumed to have "at least some distinctive character",⁷ I find the earlier mark to have a low degree of inherent distinctive character.

Likelihood of confusion

57. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. One such factor is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be mindful to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

⁷ *Formula One Licensing BV v OHIM*, Case C-196/11P

58. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods and services down to the responsible undertakings being the same or related.

59. Earlier in the decision I concluded that the marks are visually and aurally similar to at least a medium degree and conceptually similar to a high degree. I have found that the earlier mark has a low degree of inherent distinctive character for the goods and services at issue. Furthermore, I found the similarity between the goods and services to range from dissimilar to identical. I have identified the average consumer for the relevant goods and services to be in the main members of the general public who will pay a medium degree of attention during the purchasing process. I have found that the purchasing process will largely be visual, however, I have not discounted aural considerations.

60. I acknowledge that the word 'TIDY' is identically present in the competing marks and generally the beginnings of marks tend to make more impact than the endings.⁸ Nevertheless, the contested mark also contains the components '& CO.', which will be perceived as a company identifier and have no counterpart in the earlier mark. However, I am of the view that these additional elements may go unnoticed, be overlooked, or be forgotten especially considering their low level of distinctiveness. Accordingly, with all things considered, given the similarities of the marks and the similarity or identity between some of the goods and services, I find that the average consumer is unlikely to recall the differences between the marks resulting in the consumer confusing the marks for one another and therefore, there is a likelihood of direct confusion.

61. However, if I am wrong on this, I will now go on to consider indirect confusion.

62. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

⁸ See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

63. Further, in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a

consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

64. These examples are not exhaustive but provide helpful focus.

65. I acknowledge that a finding of indirect confusion should not be made merely because the two marks share a common element. However, it is not sufficient that a mark merely calls to mind another mark:⁹ this is mere association not indirect confusion.

66. In the circumstances that the average consumer does notice the minor differences between the marks, I am mindful that the dominant and more distinctive element of the marks at issue is the word ‘TIDY’ which forms the sole basis for the opponent’s mark. I find that the average consumer would regard this as the same company presenting its mark in two slightly different ways. It would be reasonable for the average consumer to see ‘TIDY’ as an abbreviated version of the full company name ‘TIDY & CO.’ and as previously stated, the ‘& CO.’ element of the applicant’s mark, though not negligible, does not add distinctiveness to the mark and would be seen merely as an indication of company status. Accordingly, with regard to the parties’ goods and services that are identical and/or similar to a degree, the potential for the marks to be seen as alternative marks from the same or economically linked undertakings is greatly magnified. I am satisfied that consumers would assume a commercial association between the parties, or sponsorship by one of the parties, due to the shared element ‘TIDY’. Consequently, I consider there to be a likelihood of indirect confusion. This is so even bearing in mind the earlier mark’s low level of inherent distinctive character. In reaching this conclusion I note that a degree of caution is required before finding a likelihood of confusion on the basis of common elements which are either descriptive or are low in distinctive character.¹⁰ Nevertheless, I maintain that there is a likelihood of confusion. Furthermore, as ‘&

⁹ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

¹⁰ *Nicoventures Holdings Limited v The London Vape Company Ltd* [2017] EWHC 3393 (Ch) and *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch)

CO.' is weak in distinctive character, their addition to the word 'TIDY' does little to alter the distinctiveness of the mark as a whole to the extent that consumers would see it as an entirely different undertaking. Accordingly, I find that there is a likelihood of indirect confusion.

Conclusion

67. The opposition under section 5(2)(b) is partially successful in respect of the following goods, for which the application is refused:

- Class 6 General purpose metal storage units; general purpose metal storage containers and bins; metal storage boxes for general use; all the aforesaid for brooms, brushes, mops, dusters, dustpans, buckets, tools, stands, stools, chairs, utensils, cooking utensils, eating utensils, cords, wires, electronics, lights, and lamps; none of the aforesaid being bespoke or customisable items or features of furniture.
- Class 16 Boxes, cartons, storage containers and packaging containers made of paper or cardboard; non-metal photo storage boxes; paper for wrapping and packaging; photo storage boxes of metal; photo storage boxes; none of the aforesaid being bespoke or customisable items or features of furniture
- Class 20 Organizational products, namely, storage racks, metal and non-metal storage racks, expandable storage racks; Furniture with built-in storage; Shoe racks, non-metal hanging closet organizers for shoes, clothes hangers, garment storage racks; organizational products for household goods, namely, storage racks and shelves for brooms, brushes, mops, dusters, dustpans, buckets, tools, stands, stools, chairs, utensils, cooking utensils, eating utensils, cords, wires, electronics, lights, and lamps; drawer organizers; storage and organization systems comprising shelves, drawers, cupboards, baskets and clothes rods,

sold as a unit; none of the aforesaid being bespoke or customisable items of or features of furniture.

68. The application can proceed to registration in respect of the following goods for which the opposition has been unsuccessful:

Class 21 Plastic storage containers for household and domestic use; collapsible storage containers for household and domestic use; none of the aforesaid being bespoke or customisable items of or features of furniture.

Class 22 Cloth bags for storage of garments, shoes and personal items; multi-purpose cloth bags for storage; fabric and polyester mesh net used for storing household items; none of the aforesaid being bespoke or customisable items of or features of furniture.

Costs

69. On balance, I consider that both parties have achieved a relatively equal level of success in these proceedings. In the circumstances, I do not consider it appropriate to make a costs award in favour of either party. Therefore, I order both parties to bear their own costs in these proceedings.

Dated this 30th day of August 2022

**Sam Congreve
For the Registrar**