

O/0025/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003673883

BY BUX & CO LTD

TO REGISTER:



(SERIES OF TWO)

AS TRADE MARKS IN CLASS 39

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 428861 BY

LOK'N STORE LIMITED

## BACKGROUND AND PLEADINGS

1. On 27 July 2021, Bux & Co Ltd (“the applicant”) applied to register the series of trade marks shown on the cover of this decision (“the application”) in the UK for the following services:

Class 39: Providing self-storage facilities for others.

2. The application was published for opposition purposes on 8 October 2021 and, on 7 December 2021, it was opposed by Lok’n Store Limited (“the opponent”). The opposition is based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). Under both grounds, the opponent relies on the following series of marks:

**LOK’nSTORE**

Lok’nStore

LOK’NSTORE

(Series of three)

UK registration no: 2340185

Filing date 8 August 2003; registration date 30 July 2004

Relying on some services, namely:

Class 39: Storage services; rental of storage space; packaging of goods; transportation and delivery of goods; rental of secure storage facilities.

(“the opponent’s registration”)

3. Under its 5(2)(b) ground, the opponent claims that as a result of the high degree of similarity between the marks and the services at issue being identical and highly similar, there exists a likelihood of confusion on the part of the public which includes a likelihood of association.
4. In respect of the 5(3) ground, the opponent claims to have obtained a reputation in only those services underlined above. The opponent argues that the marks are

similar and that the relevant public will consider there to be an economic connection between them. Further, the opponent claims that use of the application will take unfair advantage of, be detrimental to the reputation and distinctive character of its registration.

5. The applicant filed a counterstatement denying the claims made and requested that the opponent provide proof of its reputation and proof of use for its registration.
6. The opponent is represented by Marks & Clerk LLP and the applicant is represented by Wilson Gunn. Both parties filed evidence in chief and the opponent filed further evidence in reply. No hearing was requested and both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.
7. 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 on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

## **EVIDENCE**

8. As above, both parties filed evidence. The opponent's evidence in chief came in the form of the witness statement of Neil Newman-Shepherd dated 19 May 2022. Mr Newman-Shepherd is the Group Managing Director of the opponent. Mr Newman-Shepherd's statement is accompanied by 15 exhibits, being those labelled NS1 to NS15.
9. The applicant's evidence in chief came in the form of the witness statement of Yousuf Ayyub Bux dated 1 August 2022. Mr Bux is the Director of the applicant, a position he has held since its incorporation on 27 February 2012. Mr Bux's statement is accompanied by 16 exhibits, being those labelled Exhibits 1 to 16.

10. The opponent's evidence in reply came in the form of the witness statement of Samantha Collins dated 22 August 2022. Ms Collins is a trade mark attorney and partner at the opponent's representative firm and her statement is accompanied by one exhibit, being that labelled Exhibit SC1.

11. I will refer to points from the evidence or submissions where necessary.

## PRELIMINARY ISSUES

12. I note that the applicant's evidence discusses the history of its business and, in doing so, it has provided a copy of its Companies House information.<sup>1</sup> Further, It has enclosed a copy its trade mark application, print-outs from its website and advertising examples of its application on social media platforms.<sup>2</sup> While I appreciate that evidence of use of an application may be used in support of an argument of there being no actual confusion on the marketplace, this is not something that has been argued here. Further, there is no supporting evidence filed that is capable of giving rise to such an argument. While the evidence filed is noted, it is of no assistance to the applicant in the present proceedings.

13. The applicant also filed evidence of third party businesses that use different spelling variations of the word 'LOCK' and abbreviations of the word 'AND'.<sup>3</sup> I note that this evidence shows use of 'LOCK N GO', 'U LOK' and 'STOCK N LOCK', amongst others. Such evidence was filed to demonstrate that the opponent's term 'LOK'N' does not in itself have any dominant or standalone inherent distinctiveness within the self-storage market. In response to this argument, I note that the opponent's evidence in reply included a print-out from the UK trade mark register showing that all marks with the prefix 'LOK'N' in class 39 actually belonged to the opponent.<sup>4</sup> While the evidence from both parties is noted, none of it is of any relevance to the present proceedings. On this point, I refer to the case of *Zero Industry Srl v OHIM*, Case T-400/06 wherein the General Court ("GC") stated that:

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<sup>1</sup> Exhibit 1

<sup>2</sup> See Exhibits 2 to 4

<sup>3</sup> See Exhibits 5 to 13

<sup>4</sup> Exhibit SC1

“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). “

14. While the applicant has not filed any evidence of the competitors’ marks on the register, it has filed evidence of print-outs from those competitors’ websites and I consider the issues raised in the case law cited above apply here. The issues with the applicant’s evidence on this point is that it is undated and it is, therefore, not clear whether it is reflective of the position as at the date of the application being filed. In addition, I note that there are only a limited number of examples and the evidence is simply website print-outs with nothing further to demonstrate that those businesses are in actual operation and whether they exist in the marketplace. For the avoidance of doubt, the outcome of this opposition will be determined after making a global assessment whilst taking into account all relevant factors and the evidence referred to here is not relevant to that assessment.

15. Lastly, I note that the applicant’s evidence includes a print-out from the website [army.com](http://army.com) that shows a range of logos of third party storage service providers and their use of striking colour schemes.<sup>5</sup> The applicant states that this evidence “demonstrates the use of difference colour schemes to distinguish the different self-

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<sup>5</sup> Exhibit 16

storage solutions of competitors in the UK marketplace” and that “the combination of the unique colour scheme and the word elements and the overall stylisation of the Mark, make the LOK N GO STORAGE Logo easily distinguishable within the context of the self-storage industry.”<sup>6</sup> As I will come to discuss in further detail below, one of the marks in the application is presented in greyscale, so too is the first mark of the opponent’s registration. Additionally, the second and third marks of the opponent’s registration are word only marks presented in black and white. Both parties’ marks can, therefore, be used in any colour scheme so the applicant’s evidence and supporting comments on this point are of no assistance to its argument that the marks are easily distinguishable due to the colour schemes used.

## **DECISION**

### **Proof of use**

16. 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, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,

(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.”

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<sup>6</sup> See paragraph 21 and 22 of the witness statement of Yousuf Bux

17. The relevant statutory provisions are as follows:

“Section 6A

“(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),  
(b) 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) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(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.”

18. Section 100 of the Act is also relevant, which reads:

“100. 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.”

19. Given its filing date, the opponent’s registration qualifies as a series of earlier trade marks under the above provisions. The opponent’s registration completed its



registration process over five years prior to the filing date of the application and, as set out above, the applicant requested that the opponent provide proof of use for its registration. As a result, the opponent's registration is subject to a proof of use assessment in respect of all of the services relied upon.

20. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), 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 Bunderversvereinigung 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 Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, 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] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases 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: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

(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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(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] and [76]-[77]; *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].”

21. Pursuant to Section 6A of the Act, the relevant period for assessing whether there has been genuine use of the opponent’s registration is the 5-year period ending with the filing date of the application, being 27 July 2021. Therefore, the relevant period for this assessment is 28 July 2016 to 27 July 2021.

22. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”<sup>7</sup> because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

### Form of the Mark

23. Throughout the opponent’s evidence, there are numerous examples of the first mark of the opponent’s registration on store fronts,<sup>8</sup> storage units<sup>9</sup> and promotional

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<sup>7</sup> *Jumpman* BL O/222/16

<sup>8</sup> See page 2 of Exhibit NS3

<sup>9</sup> See page 5 of Exhibit NS3

materials.<sup>10</sup> I note that the use shown includes use of the first mark in the following way:



24. As per the case of *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, use of a trade mark generally encompasses both its independent use and use as part of another mark taken as a whole or in conjunction with that other mark so long as the mark continues to be perceived as indicative of the origin of the goods or services at issue. This is clearly the case in the above example on the basis that, when it is taken as a whole, it is the words 'LOK'nSTORE' that will remain as the primary indicator of origin of the services at issue. The above use is, therefore, use upon which the opponent can rely.

25. In addition to the above, I wish to address the following uses shown in the evidence:



26. This example of use makes up the majority of the use shown in the evidence and while it adopts a very similar arrangement to that of the first mark in the opponent's registration, it is presented differently with 'LOK'n' being placed above 'STORE' as opposed to the left of it. Further, there are additional elements, namely the horizontal white line under the word 'STORE' and the word 'STORAGE' at the

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<sup>10</sup> See page 2 of Exhibit NS7

bottom of the mark. This is not use of the opponent's registration as it is registered and I must, therefore, consider whether it is an acceptable variant of the same. In doing so, I am reminded of the case of *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22 wherein Mr Phillip Harris, sitting as the Appointed Person, summarised the correct approach for considering marks used in a differing form. He set out that when comparing a mark as registered against how it is used, alterations to or omissions of non-distinctive elements are acceptable. In my view, the alteration to the arrangement of the 'LOK'nSTORE' element so as to present the word 'STORE' beneath 'LOK'n' is not one that alters the distinctive character of the mark. Further, Mr Harris set out that the addition of a descriptive or suggestive word is unlikely to change the distinctive character of the mark and I consider that to be the case in respect of the addition of the word 'STORAGE'. As for the horizontal white line, I consider that its addition is merely a banal division between the 'LOK'nSTORE' element and the word 'STORAGE' and does not alter the distinctive character of the mark as registered.<sup>11</sup> Taking all of this into account, I accept that the above example is acceptable use of a variant mark of the first mark in the opponent's registration. I consider that the same applies for the second and third marks in the opponent's registration on the basis that they are word only marks registered in black and white. They can, therefore, be used in any standard typeface, any customary combination of upper and lower case letters and in any colour. While I do not consider that the use of colour extends to contrived colour splits like the one in the examples above, I do not consider that it alters the distinctive character of the marks to the point where the use is not an acceptable variant. Further, the same points discussed above regarding the arrangement of the word, the addition of a horizontal line and the word 'STORAGE' apply to these marks also.

27. Lastly, I note that the opponent's website features the words 'LOK'nStore' presented in a standard typeface and in white.<sup>12</sup> As the second and third marks in the opponent's registration are word only marks, they are capable of being used in any colour and in any standard typeface which is the case here. I also accept that

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<sup>11</sup> *Hyphen GmbH v EU IPO*, Case T-146/15

<sup>12</sup> See, for example, pages 9 and 11 of Exhibit NS6

this use is an acceptable variant of the first mark in the registration on the basis that the opponent's use of the words 'LOK'nStore' in a word only format does not alter the distinctive character of the first mark in the series. Therefore, this is also use upon which the opponent can rely.

### Sufficient Use

28. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.<sup>13</sup>

29. The opponent's evidence includes a list of stores in its operation and their respective opening dates.<sup>14</sup> Of this list, I note that as at the end of the relevant date the opponent operated 42 stores England and Wales with the first opening on 7 March 1995 and additional branches consistently opening between March 1997 and April 2022 (the last store to open during the relevant period was on 1 April 2021). In addition to the list provided, there is a map taken from the opponent's website that also shows locations.<sup>15</sup> It shows a total of 40 open stores across England and Wales, three of which being new and a further 10 stores listed as 'pipeline stores', presumably meaning stores that the opponent plans to open in the future. This evidence is undated so it is unclear as to whether it accurately reflects the position during the relevant period. On this point, I have reviewed the map against the above list of location and note that one of the 'new stores' is the Stevenage location which the first list shows as having an opening date of 28 April 2022, being after the relevant date. This list is, therefore, not accurate as to the position during the relevant period. Further, there is no explanation as to the inconsistency between the numbers of stores shown on the list and on the map. It may very well be the case that some stores from the first list closed before the production of the second list. In terms of the spread of the stores across England and Wales, I note that the majority of them are spread across the south of England

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<sup>13</sup> *New York SHK Jeans GmbH & Co KG v OHIM*, T-415/09

<sup>14</sup> Exhibit NS1

<sup>15</sup> Exhibit NS2

and span from Dover to Bristol with a number of locations along the south coast. In addition, I note that there is a store in Cardiff, one in the south west of England in Exeter and one in the north west of England. Given what I have discussed above, I am unable to determine the exact amount of locations that the opponent operated during the relevant period. However, the discrepancy between the list and the map is only two locations and I do not consider it to be a significant problem for the opponent on the basis that the number would have been around the 40 location mark.

30. The bulk of the opponent's business appears to focus on the service of providing customers with flexible storage facilities. This is clear from the content of the opponent's website (which I will discuss in further detail below) and the document that the opponent refers to as its 'Help Guide' that discusses the services that the opponent offers.<sup>16</sup> For example, I note that the 'Help Guide' answers the question of, 'So what is Self storage at Lok'nStore?' by stating:

"Affordable storage space... For anything you need to safely store... In any size you need... For any length of time you want."

While the 'Help Guide' is undated, I am willing to accept that it is relevant to the present proceedings and reflective of the position during the relevant period. This is on the basis that the opponent's reliance upon it has not been challenged by the applicant and its contents as to the nature of the opponent's business are consistent with the information provided on the website. I, therefore, have no reason to doubt that it is reflective of the opponent's business throughout its operations.

31. The opponent's evidence confirms that the first mark of its registration is displayed on the side of its stores and includes a number of photos demonstrating how it appears on those stores.<sup>17</sup> In addition, the opponent sets out that the first mark of its registration has also been continuously used on its own website and in support of such, it has provided a number of print-outs of its '.co.uk' website that were

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<sup>16</sup> Exhibit NS7

<sup>17</sup> Exhibit NS3

obtained from the internet archive facility, The Wayback Machine.<sup>18</sup> I note that these print-outs are dated between 19 February 2016 and 16 January 2021. I note that there is a print-out dated 9 August 2021 but this is after the relevant period and is, therefore, of no assistance to this decision. Additionally, the print-out dated 19 February 2016 is also outside of the relevant period but I have not dismissed it altogether as it may be of some assistance under the issue of distinctiveness and reputation, which I will discuss further below. I note that the earliest print-out includes the first mark of the opponent's registration whereas the majority of the remainder show the second and third marks of the opponent's registration (being the word marks displayed in a standard white typeface).

32. The opponent's evidence also includes a number of online reviews from customers of its various stores across the UK.<sup>19</sup> I note that there are a total of 38 reviews dated between 5 August 2016 and 9 August 2020. There are a further six reviews which are simply dated '36 weeks ago'. Given that the print-outs are undated, I am unable to determine the exact dates of these six reviews.

33. The evidence then goes on to discuss marketing efforts but does not state any information regarding advertising expenditure. It does, however, make reference to a number of articles that mention the opponent's services in publications by financial advisors such as finnCap Group, Arden, Avenir Registrars Ltd and Insider Media. Aside from a claim that Insider Media is a major business to business company, I have nothing to guide me as to the readership or the reach of these publications. The evidence goes on to discuss the opponent's presence in major news providers such as The Daily Mail, the Times as well as local UK news providers such as 'News & Stars'. In support of this, the opponent has provided a non-exhaustive selection of these publications.<sup>20</sup> I note that this selection includes over 100 pages of articles and I do not intend to set them out in full here. However, I note that they range from 5 August 2016 to 26 May 2021. It appears that the majority of the published articles are focused on the stock and growth of the opponent and are focused on its business operations. It is clear that the growth of

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<sup>18</sup> Exhibit NS6

<sup>19</sup> Exhibit NS8

<sup>20</sup> Exhibit NS9



the company stems from its use but in terms of press coverage, I am of the view that the relevance of this evidence is somewhat limited due to its specialist nature. While on the topic of marketing, I note the evidence discussed at paragraph 30 above refers to a 'Help Guide'. While this could be considered as a marketing material and, therefore, reflective of an effort by the opponent to market its registration, I am not willing to consider it in that context. This is on the basis that there is no evidence as to the distribution of this document whatsoever.

34. In terms of turnover, the opponent has provided its revenue figures for 2016 to 2021. They are as follows:

<b>Year</b>	<b>2016</b>	<b>2017</b>	<b>2018</b>	<b>2019</b>	<b>2020</b>	<b>2021</b>
<b>Revenue</b>	£16,06m	£16.65m	£17.75m	£17m	£18m	£21.9m

35. I note that, of the 2016 and 2021 figures, some will inevitably have accrued outside of the relevant period. When it comes to assessing the evidence as a whole, I will bear this in mind.

36. In support of the turnover figures discussed above, I note that a number of invoices have been included that show the rental of units and 'storage services' provided by the opponent.<sup>21</sup> Save for the county in which the customers are located, all address details of the customers have been redacted. From this I can see that all of the invoices are addressed to customers within the UK. While not expressly stated in the evidence, it appears to be me that the invoices relate to various different stores of the opponent. I make this inference on the basis that the invoices include different addresses located in Horsham, Portsmouth and Chichester (for example) that, also appears as locations when cross-referenced to the list of the opponent's stores, being those discussed at paragraph 29 above. There are invoices from after the relevant period but there are ten invoices that fall within it and these are dated between 21 September 2016 and 1 June 2021.

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<sup>21</sup> Exhibit NS10

37. Lastly, I note that the opponent has provided evidence of it being named as a 2018 finalist of the SSA UK Award in the category of 'Best Major Self Storage Facility'.<sup>22</sup> While this is noted, there is no evidence as to how these awards were voted on. For example, were the awards decided by a judging panel or voted on by members of the public. Additionally, there is no evidence as to the reach or awareness of such awards across the average consumer base. As a result, this evidence is of no assistance.

38. The opponent has not provided any evidence as to the size of the market at issue against which the turnover figures should be compared to. Further, I have no evidence regarding the nature of the services provided (for example, how often they are selected) or the characteristics of the market concerned. Regardless of these issues, I am of the view that the turnover figures provided are somewhat substantial and span the entirety of the relevant period. To me, this demonstrates that there is clearly frequent use of the opponent's registration on a respectable scale. In addition, while the range of locations of the opponent's self-storage stores does not cover the entirety of the UK, it is somewhat widespread across southern England with a store in Wales and another towards the north of England. I accept that this demonstrates that the geographical spread of the opponent's registration is to a respectable extent. Taking all of this into account, I am satisfied that the opponent's use of its registration is warranted in the economic sector concerned such that it has created a share in the market for the services at issue.

#### Fair Specification

39. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

"iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair

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<sup>22</sup> Exhibit NS15

specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

40. At the conclusion of its evidence, the opponent states that it has extensively used its registration in the UK in relation to storage services, rental of storage space, packaging of goods, transportation and delivery of goods and rental of secure storage facilities. As I have set out above the evidence suggests that the main focus of the opponent's business is that it offers personal and business storage facilities. This is confirmed by the content of the opponent's website throughout the relevant period, the presence of the invoices referred to at paragraph 36 above which cover the rental of units, storage services for units and wardrobe boxes and the Help Guide provided. I am, therefore, willing to accept that the opponent has provided evidence of genuine use for "storage services", "rental of storage space" and "rental of secure storage facilities". While I appreciate that "storage services" is a broad term, I am of the view that when confronted with the services provided by the opponent, the average consumer will describe them as simply storage services and will not seek to break it down to a specific sub-category.

41. I turn now to consider "packaging of goods" and "transportation and delivery of goods". I note that the Help Guide provides advice as to packing up and transporting goods for storage, however, there is no indication that it is a service that the opponent actually provides. Further, the evidence refers to the availability of packing boxes, bubble wrap and van hire<sup>23</sup> and while that may be the case, the opponent does not rely on any of these goods or services in the opposition. Outside of the broad statement that it provides these services, there is nothing in the evidence to suggest that it actually does. On balance, I am not willing to accept that the opponent has shown genuine use for "packaging of goods" and "transportation and delivery of goods". For the avoidance of doubt, the opponent may continue to rely on the following specification of services only:

Class 39: Storage services; rental of storage space; rental of secure storage facilities.

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<sup>23</sup> See page 4 of Exhibit NS7

## Section 5(2)(b): legislation and case law

42. Section 5(2)(b) of the Act reads as follows:

“(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,

there exists a likelihood of confusion on the part of the public, which includes the likelihood or association with the earlier trade mark.”

43. 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.”

44. 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.

**Comparison of services**

45. The competing services are as follows:

The opponent’s services	The applicant’s services
<u>Class 39</u> Storage services; rental of storage space; rental of secure storage facilities.	<u>Class 39</u> Providing self-storage facilities for others.

46. I note that the opponent submits that its “storage services” term is identical to the applicant’s service and that its “rental of storage space” and “rental of secure storage facilities” are “near-identical, highly similar and complementary” to the applicant’s service. Regardless of the opponent’s submitted position, I note that the applicant’s submissions state that it does not contest that the services offered by both parties are identical. In light of the admission by the applicant, I am content to proceed on the basis that the services are identical.

**The average consumer and the nature of the purchasing act**

47. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. 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. (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 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.”

48. The opponent submits that the average consumer is a member of the general public who will pay an average degree of attention when selecting the services at issue. While I agree that the average consumer of the services at issue will include members of the general public, I cannot rule out the existence of business users amongst the average consumer base. This is because the services at issue are broad enough to cover those storage services that may be sought by business users in order to have a location to store archived files or stock, for example. Therefore, I conclude that the average consumer base consists of both members of the general public and business users.

49. I consider that the services at issue are most likely to be selected having considered, for example, promotional material (in hard copy or online) and/or signage appearing on the side of roads or in industrial estates (where such services, as far as I understand it, are likely to be located). While visual considerations will be an important part of the selection process, the services are also likely to be the subject of word-of-mouth recommendations or selected after discussions with sales assistants. This means that aural considerations will not be an insignificant feature of the selection process. When selecting these services, the average consumer is likely to consider such things as location of the facility for ease of access (such as opening times or 24-hour access, for example), price, size of units/spaces offered and security presence at the facility. While these factors



are likely to be important to the user, I am in agreement with the opponent that the level of attention paid will not extend to anything beyond average, or medium. I, therefore, conclude that regardless of the identity of the average consumer, they will pay a medium degree of attention during the selection process for the services at issue.

### **Comparison of the marks**

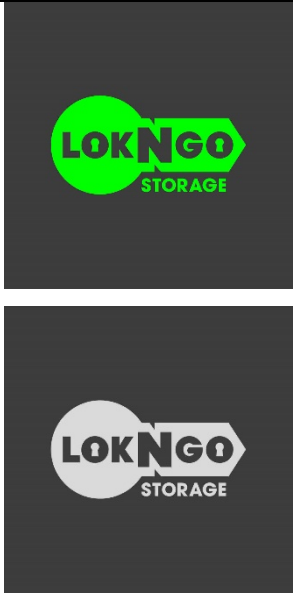
50. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

51. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

53. The respective trade marks are shown below:

The opponent's registration	The application
<p style="text-align: center;"><b>LOK'nSTORE</b></p> <p style="text-align: center;">Lok'nStore</p> <p style="text-align: center;">LOK'NSTORE</p> <p style="text-align: center;">(Series of three)</p>	<div style="text-align: center;">  </div> <p style="text-align: center;">(Series of two)</p>

54. I note that I have submissions from both parties in respect of the comparison of the marks at issue. I have considered these submissions; however, I do not intend to reproduce them in full here. I will, if necessary, refer to them below.

### Overall Impression

#### *The application*

55. The application consists of two marks that, save for their use of colour, are identical. They are made up of several elements, the first being the word 'LOKNGO' that sits inside what appears to be a figurative key element and above the word 'STORAGE'. All of these elements sit on a dark grey background. The word 'LOKNGO' is displayed in the same dark grey as the background and in a bold standard typeface and is presented in such a way that the two 'O's' have a figurative keyhole in their middles. Further, the 'N' is presented slightly larger than 'LOK' and 'GO'. The key element is displayed in light grey in the first mark and bright green in the second. As for the word 'STORAGE', this is present in a standard typeface and is in the same colour as the key (be that light grey or bright green depending on the mark). On the basis that the eye of average consumer

tends to be drawn to the elements of marks that can be read, I am of the view that the word 'LOKNGO' dominates the overall impression of the mark. As for the remaining elements, namely the key and keyhole elements and the word 'STORAGE', I am of the view that these will play lesser roles.

56. I consider that the use of the light grey in the second mark in the application is such that it constitutes a mark applied for in greyscale. Marks applied for or registered in greyscale are capable of use in any colour. As a result, I will focus the remainder of the 5(2)(b) ground on this mark within the application. Going forward, I will refer to this mark as simply the applicant's mark.

#### *The opponent's registration*

57. The first mark in the opponent's registration consists of a figurative word element, being 'LOK'nSTORE' presented in a bold but standard typeface. I note that the apostrophe is presented as a small triangle and is presented in light grey, as is the first 'O'. The remaining letters are displayed in a dark grey. The word 'LOK'nSTORE' dominates the overall impression of this mark and while the stylisation is not particularly remarkable, it will be noticed. It, therefore, plays a lesser role. As I have set out at paragraph 56 above, a mark registered in greyscale is capable of being used in any colour.

58. The second and third marks in the opponent's registration are word only marks. They are the same word presented in different cases namely 'Lok'nStore' in the second mark and 'LOK'NSTORE' in the third. There are no other elements in either of these marks that contribute to their overall impressions, which lies in these words themselves. Given that word marks may be used in either upper case, lower case or any customary combination of the two, I am of the view that these two marks are identical and will, therefore, be considered together.

## Visual Comparison

59. I will begin by comparing the first mark in the opponent's registration and the applicant's mark. While the marks are presented differently, their figurative word elements are both displayed in a very similar bold typeface and layout (in that they both consist of no spacing between their words). Further, the marks' dominant elements both start with the letters 'L-O-K-N'. In each mark, these letters are presented in such a way so as to distinguish 'LOK' and 'N'. For example, the 'N' is presented in lower case in the opponent's mark and slightly larger than 'LOK' in the applicant's mark. As this point of similarity sits at the beginning of the marks, it is a point of particular importance because average consumers tends to focus on the beginning of marks.<sup>24</sup> Another point of similarity is the shared use of the letters 'S-T-O-R' which appears at the end of the first mark of the opponent's registration and within the word 'STORAGE' in the applicant's mark. While they may be similar, the fact that they form part of different words and are placed in different locations across the marks limits their visual similarity significantly. The marks differ further in the presence of the apostrophe in the first mark of the opponent's registration, the use of the word 'GO' in the applicant's mark and the presence of the key elements in the applicant's mark. While the figurative elements of the applicant's mark plays a lesser role in that mark, they will still contribute as points of visual difference. Taking all of this into account, I am of the view that the marks are visually similar to between a low and medium degree.

60. I will now consider the applicant's mark against second and third marks of the opponent's registration. These marks share the same similarities and differences as those discussed at paragraph 59 above. However, I consider that their presentational differences are lessened somewhat on the basis that the opponent's second and third marks are word only marks and may be displayed in highly similar ways to how 'LOKNGO' is in the applicant's mark. While this does not extend to the use of a keyhole in the 'O's' and the use of a key background element, I

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<sup>24</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

consider that it raises the level of similarity to a degree. Overall, I consider that these marks are visually similar to a medium degree.

### Aural Comparison

61. The marks in the opponent's registration contain identical verbal elements and can, therefore, be considered together. As for the applicant's mark, I refer to the case of *Purity Hemp Company Improving Life as Nature Intended*<sup>25</sup> wherein Mr Phillip Harris, sitting as the Appointed Person, stated that descriptiveness does not of itself render an element negligible or aurally invisible. Therefore, I am of the view that, regardless of their roles, all of the applicant's mark's verbal elements will be pronounced. This leaves me with a comparison on the basis of the words 'LOK'NSTORE' and 'LOKNGO STORAGE'.

62. The opponent's registration consists of three syllables that will be pronounced 'LOK-NN-STAW' whereas the applicant's mark consists of five syllables that will be pronounced as 'LOK-NN-GO-STAW-RIJ'. The first two syllables of the marks are identical and I note that the third syllable of the opponent's registration is identical to the fourth syllable of the applicant's mark. The remaining two syllables of the application have no counterpart in the opponent's registration. Taking into account the identity of the beginnings, the fact that the marks are not particularly of differing lengths and the shared pronunciation of the 'STAW' syllables (albeit found in a different location of the marks), I find that the marks are aurally similar to between a medium and high degree.

### Conceptual Comparison

63. The letter 'N' in the context of both parties' marks is something that will, in my view, be immediately graspable by average consumers in the UK as being an abbreviation for the word 'AND'. I note that this is something that was accepted by both parties in their respective submissions. Further, I find that 'LOK' in both

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<sup>25</sup> Case BL O/115/22

parties' marks will be understood as being an abbreviation for 'lock' which, in the context of the services at issue, will be readily understood by the average consumer.

64. Turning to the marks as wholes, I first consider that the opponent's registration carries the concept of something that the user can 'lock and store', alluding to the fact that the user may store something securely on the basis that it can be locked away. I also consider that this same concept is shared by the applicant's mark and find that this is somewhat reinforced by the presence of the figurative key and keyholes within the letters 'O'. In addition, I note that the applicant's mark also carries the concept that the user can simply 'lock and go', thereby alluding to a more express type of storage service. Overall, both marks are dominated by the concept of locking and storing something away and while the addition of the concept of 'go' creates a point of conceptual difference, it is only a slight one and does not take away from the overall concept of the mark. Overall, I consider the marks to be conceptually similar to a high degree.

### **Distinctive character of the opponent's registration**

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

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in *Joined Cases C-108/97 and C-109/97 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).”

66. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods or services, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. The opponent has filed evidence of use of its registration and submits that its registration has:

“a distinctive character that has been deeply enhanced to a high degree due to the effort and expense expended by the opponent to create a well-respected brand which is associated by the UK consumer with excellent and reliable self storage services.”

67. Before moving to consider the position in respect of enhanced distinctiveness, I will first consider the inherent position. I note that throughout its submissions, the applicant argues that the words element of the opponent’s registration are of little, if any, distinctiveness in relation to the services at issue and that the stylisation elements are the standalone dominant and distinctive element of the opponent’s registration. Firstly, I am reminded of the case of *Formula One Licensing BV v OHIM*, Case C-196/11P wherein the CJEU found that a registered trade mark must be assumed to have at least some distinctive character. It, therefore, cannot be the case that the words ‘LOK’NSTORE’ have no distinctive character on the basis that this element forms the entirety of both the second and third marks within the registration. Secondly, when considering the overall impression of the first mark of the opponent’s registration above, I set out that the average consumer will be

drawn to the elements of the mark that can be read. I, therefore, disagree with the applicant's position that the stylisation is the dominant and distinctive element of the first mark in the opponent's registration.

68. I am of the view that the 'LOK'NSTORE' element in the opponent's registration will clearly be understood as 'LOCK AND STORE'. I consider that this will be understood as being descriptive of the services at issue, in that the user can lock something away in storage. While that may be the case, I consider that the way in which the words are presented is somewhat unusual in that it is presented as 'LOK'NSTORE' (or 'LOK'nSTORE' in the first mark of the opponent's registration) and not simply 'LOCK AND STORE'. While I accept that this is not particularly remarkable, it does impart some distinctive character on the registration to the point that it is inherently distinctive to a low degree. As the second and third marks in the opponent's registration are word only marks consisting solely of this word, it follows that they are inherently distinctive to a low degree. As for the first mark in the opponent's registration, I am of the view that the stylisation, while fairly standard, is enough to enhance the distinctive character of the mark, but only very slightly to between a low and medium degree of distinctive character.

69. Moving now to consider enhanced distinctiveness, I refer to my summary of the evidence as set out at paragraphs 29 to 38 above. It is not my intention to repeat that evidence here but I will mention, for the avoidance of doubt, that my summary was made when considering the issue of genuine use meaning that it was focused on the relevant period of 28 July 2016 and 27 July 2021. I note that my present assessment must take into account the entirety of the evidence up to the date of the application at issue, being 27 July 2021. While the bulk of the evidence filed was focused on the relevant period, there was additional relevant evidence from prior to 28 July 2021 provided. Such evidence was included in my summary above in anticipation of it being relevant to the assessment of enhanced distinctiveness and reputation under the 5(3) ground. For example, I discussed above the opening of the opponent's additional locations between 1997 and 2020, the print-outs prior to 28 July 2016 and the general turnover figures for 2016 as a whole. While the



evidence prior to 28 July 2016 did not form any basis for my genuine use assessment, it is relevant here.

70. Having reviewed the evidence, it is clear that the opponent operates a large storage business with turnover starting at £16.06 million in 2016 and increasing to £21.9 million in 2021. For the most part, the turnover figures increased on a year by year basis during this time. While I bear in mind that the 2021 figure includes turnover from after the relevant period, the nature of the increasing turnover over this time period is indicative of a business that continued to grow up until the relevant date. Further, I appreciate that the opponent's business began in 1995 and continued to expand by opening additional branches at a consistent rate between 1997 and 2020. This is a clear indicator of an ever increasing business operation over 25 years. While there is no additional evidence from prior to 2016, such as turnover figures, it is clear from the expansion of the company from one location in 1995 to around 40 as at the relevant date that opponent operated a successful business operation in the field of storage services and rental of storage spaces/facilities. I am also willing to make such a finding on the basis that I consider it reasonable to infer that the turnover prior to 2016 would have, for some time, been in the multiple millions of pounds on the basis that the opponent's 2016 turnover of £16.06 million would not have simply accrued overnight and would have, instead, steadily built to such an amount over a number of years.

71. Taking all of the above into account, I am satisfied that the opponent's ongoing business operations are sufficient to warrant a finding that the distinctiveness of its registration has been enhanced through the use made of it. This finding applies to all of the services at issue, namely those for which genuine use was found (being the services listed at paragraph 41 above). While that may be the case, I do not agree with the opponent that the evidence points to the opponent's registration having a high degree of distinctiveness. Instead, I find that the degree of distinctive character of the registration has been enhanced to a medium degree.

## Likelihood of confusion

72. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. 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. The first 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 marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive 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 he has retained in his mind.

73. I have found the parties' services to be identical. I have found the average consumer for the goods to be members of the general public and business users who will select the goods at issue via primarily visual means, although I do not discount an aural component playing a part. I have concluded that the average consumer will pay a medium degree of attention when selecting the services at issue. I have found the first mark in the opponent's registration to be visually similar to between a low and medium degree, aurally similar to between a medium and high degree and conceptually similar to a high degree with the applicant's mark. In respect of the second and third marks in the opponent's registration, I have found these to be visually similar to a medium degree, aurally similar to between a medium and high degree and conceptually similar to a high degree with the applicant's mark. I have found that the first mark in the opponent's registration is inherently distinctive to between a low and medium degree and the second and third marks are inherently distinctive to a low degree. In respect of enhanced distinctiveness, I have found that the evidence filed is sufficient to find that the

distinctiveness of all of the marks in the opponent's registration have been enhanced to a medium degree.

74. I will focus first on the word only marks in the opponent's registration on the basis that they can be presented in a typeface similar to that used by the applicant. The following findings are made whilst bearing in mind that, as I have set out above, consumers rarely have 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 minds. Both parties' marks begin with the same letters, being 'LOKN', that will be understood as meaning 'LOCK AND' and I remind myself that the average consumer tends to focus on the beginnings of marks. This means that the differences towards the ends of the dominant elements of both marks, being the words 'STORE' and 'GO', are likely to be overlooked. Even taking into account the presence of the word 'STORAGE' in the applicant's mark, I consider that it will contribute to the issue of confusion regardless of its role in the applicant's mark. This is on the basis that (1) it will be noticed and (2) it is so visually, aurally and conceptually similar to the word 'STORE' (that forms part of the dominant element of the opponent's marks) to the point that the differences will be overlooked.

75. I appreciate that the inherent position regarding the word 'LOK'NSTORE' is that it is of low distinctiveness, however, this does not preclude a finding of confusion.<sup>26</sup> I consider that this is particularly the case here on the basis that, while the reference to 'LOCK AND STORE' or 'LOCK AND GO STORAGE' are not remarkable on the services at issue, I consider that the average consumer will focus on the shared use of 'LOK' and 'N' in both parties' marks. Further, while I accept that (as the applicant submits) the enhanced distinctiveness of the opponent's mark does not lie in the 'LOK'N' element alone, I refer to the findings I have made above in that it is the first element of both parties' marks meaning that it will be a particular point of focus by the average consumer. In this instance, I find the opponent's use of 'LOK'N' is such that the average consumer will not consider its use in the applicant's mark to be coincidental. As for the figurative elements of

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<sup>26</sup> *L'Oréal SA v OHIM*, Case C-235/05 P

the applicant's mark, they will simply be seen as reinforcing the concept of secure storage and will not be sufficient to assist the consumer in accurately recalling the marks for one another. I make the same finding in respect of the apostrophe in the opponent's marks on the basis that it will be overlooked when the consumer is trying to recollect the marks.

76. Taking all of the above into account and bearing in mind the principle of imperfect recollection, I consider that, as a result of the similarities between the marks, the average consumer will be unable to accurately remember or recall the marks at issue. Consequently, I find that there is a likelihood of direct confusion.

77. As for the first mark in the opponent's registration, I do not consider the differences in presentation between the marks will result in a different conclusion from the one I have reached above. The presentation elements are not sufficient enough, in my view, to take away from the fact that the average consumer will focus on the 'LOKN' element of the parties' marks and, therefore, will still inaccurately recall and/or misremember them for one another, particularly given that consumers rarely have the opportunity to consider marks side by side.

78. Turning now to consider a likelihood of indirect confusion, I am reminded of the case of *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

"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)”.

79. In the present case, I am of the view that if the differences between the marks are noticed, the average consumer will consider that they belong to the same or economically connected undertakings. I make this finding on the basis that the average consumer will note the shared use of the ‘LOKN’ element (regardless of its presentation) at the beginning of the marks and believe that this is the element that alludes to the undertaking responsible. While I appreciate the inherent distinctiveness of the opponent’s registration, the reference to ‘LOCK AND’, being abbreviated to ‘LOK’N’ is such that the consumer will consider it unusual and not coincidental. In any event, the enhanced distinctiveness of the opponent’s registration is such that the average consumer will further connect the shared use of ‘LOKN’ to the opponent itself. As for the differences, being ‘STORE’ in the

opponent's registration and 'GO STORAGE' in the applicant's mark, I consider that they are such that the consumer will consider them to be brand extensions or sub-brands of one another. The reference to 'STORE' and 'STORAGE' is descriptive of the type of services offered so very little weight will be attributed to them. The addition of 'GO' will indicate that the 'LOKN' entity has expanded into offering more express type of storage service. For example, this could include storage units more readily available/easily accessed with 24-hour access or services with more ad-hoc and flexible agreement terms. In the event that the presentational differences between the marks are noticed, I do not consider that this changes the position. The additional elements in the applicant's mark, being the figurative key and keyholes are, on the services at issue, unremarkable. If noticed, I consider it likely that the average consumer will see them as just stylistic additions that allude further to what services are being offered. Together with the fact that the differences between 'LOK'NSTORE' and LOKNGO' will be understood as brand extension/sub-brands of one another, I find that the average consumer will consider the presentational differences as being merely examples of alternative marks used by the same or economically linked undertakings. Consequently, I consider there to be a likelihood of indirect confusion between the parties' marks.

### **Final remarks on 5(2)(b)**

80. I appreciate that the above assessment focused on the second mark in the application only. For the avoidance of doubt, I am of the view that the same conclusion applies to the first mark in the application also. This is on the basis that the only difference between the marks in the application is their use of colour. I do not consider that the difference in colour will result in a finding that differs from the one made above.

81. While the opposition succeeds on the 5(2)(b) ground, I will proceed to consider the 5(3) ground for the sake of completeness.

## Section 5(3)

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

“5(3) A trade mark which –

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

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

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks

and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

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

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

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

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

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial



compensation, the marketing effort expended by the holder of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

84. The conditions of section 5(3) are cumulative. There must be similarity between the marks, the opponent must also show that its registration has achieved a level of knowledge, or reputation, amongst a significant part of the public. The opponent must also establish that the public will make a link between the marks, in the sense of the earlier mark being brought to mind by the later mark. Assuming that these conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the opponent will occur. It is unnecessary for the purposes of section 5(3) that the services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

85. The relevant date for the assessment under section 5(3) is the filing date of the application at issue, being 27 July 2021.

## **Reputation**

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

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

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

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

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

87. Under its 5(3) ground, the opponent relies on the same registration as it did under its 5(2)(b) ground and claims to have obtained a reputation in only some goods, namely the following:

Class 39: Storage services; rental of storage space; rental of secure storage facilities.

88. When assessing whether there had been genuine use of the opponent's registration, I undertook a detailed assessment of the evidence filed. This same evidence is relied upon for the basis of the opponent's 5(3) claim. A summary of the evidence can be found at paragraphs 29 to 38 above and while I do not intend to reproduce that evidence here, I remind myself that the opponent's UK turnover was approximately £107.36 million between 2016 and 2021 in respect of the services at issue (although I bear in mind that the 2021 figure includes turnover that inevitably accrued after the relevant date). While I do not have any evidence or submissions as to the size of the market at issue, I am of the view that it is a sizable market with a turnover in the region of hundreds of millions of pounds per annum in the UK. The turnover provided is not necessarily large in comparison to the market at issue, however, I am content to conclude that it does represent a fair proportion of the same. In addition to the above, I refer to my comments at paragraphs 70 and 71 above wherein I considered the position in regard to the

enhanced distinctiveness of the opponent's registration. In that assessment, I discussed the position prior to 2016 and how the evidence points to expansion of the opponent's business from just one branch in 1995 to around 40 in 2020. I found the evidence sufficient to conclude that the opponent has been carrying on a substantial business for a prolonged period of time and I echo that finding here, thereby pointing to sufficient longevity of the opponent's business.

89. Taking all of the evidence into account, I am satisfied that the opponent enjoys a moderate reputation in the UK in its registration and that reputation extends to all of the services for which reputation is claimed, which, for the avoidance of doubt, are identical to those that I found there to be genuine use under the 5(2)(b) assessment above.

### **Link**

90. In my assessment under the 5(2)(b) grounds, I focused on the first mark in the application and referred to it simply as the applicant's mark. For the same reasons discussed at paragraph 56 above, I will focus on that mark under the present ground and will, again, refer to it simply as the applicant's mark.

91. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

### The degree of similarity between the conflicting marks.

92. I have found the first mark in the opponent's registration to be visually similar to between a low and medium degree, aurally similar to between a medium and high degree and conceptually similar to a high degree with the applicant's mark. In respect of the second and third marks in the opponent's registration, I have found these to be visually similar to a medium degree, aurally similar to between a medium and high degree and conceptually similar to a high degree with the applicant's mark.

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

93. The services at issue are identical.

The strength of the earlier mark's reputation

94. The opponent's registration enjoys a moderate reputation in the UK.

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

95. I have found that the first mark in the opponent's registration is inherently distinctive to between a low and medium degree and the second and third marks to be inherently distinctive to a low degree. In respect of enhanced distinctiveness, I have found that the evidence filed is sufficient to find that the distinctiveness of all of the marks in the opponent's registration have been enhanced to a medium degree.

Whether there is a likelihood of confusion

96. I have found there to be a likelihood of confusion between the parties' marks.

Conclusion on link

97. I am now required to determine whether, in this particular case, the relevant public would bring the opponent's registration to mind when confronted with the applicant's mark, thereby creating the necessary link. Taking all of the above into account, I am of the view that a section of the relevant public concerned with the services at issue will make a link between the parties' marks. Even if the differences between the marks are noticed, I consider that consumers will be caused to wonder if they are linked.

## **Damage**

98. The opponent has pleaded that use of the application would, without due cause, take unfair advantage of the reputation of the opponent's registration and/or be detrimental to the distinctive character or reputation of the opponent's registration. I will deal with each head of damage in turn below.

## Unfair Advantage

99. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch), Arnold J. (as he then was) considered the earlier case law and concluded that:

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

100. Given the moderate reputation of the opponent's registration for identical services, it is my view that it is quite clear that there is potential for the applicant to gain an unfair advantage by using its mark. The applicant's mark consists of the prefix 'LOCKN' with the 'N' displayed larger, therefore indicating it is to be read as 'LOK N', being an abbreviation of 'LOCK AND'. This is identical to the meaning that

will be taken away from the prefix in the opponent's registration (albeit presented as 'LOK'N') and would, in my view, achieve instant familiarity in the eyes of the average consumers, be that by way of the consumer being caused to wonder if they are linked or if they believe there to be an economic connection between them. This would result in the applicant securing a commercial advantage and benefitting from the opponent's reputation without paying financial compensation. Such commercial advantage would not exist were it not for the reputation of the opponent's registration. Therefore, I find it likely that the applicant's mark takes unfair advantage of the opponent's registration. For the avoidance of doubt, the same conclusion applies to the second mark in the application on the basis that the only difference between those marks is their use of colour. This will not, in my view, result in a different finding from the one made above.

101. As damage is made out on the basis of unfair advantage, I do not consider it necessary to go on to consider the opponent's other heads of damage. Therefore, the opposition based upon section 5(3) succeeds in its entirety.

## **CONCLUSION**

102. The opposition succeeds in its entirety and the application is, therefore, refused.

## **COSTS**

103. As the opponent has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£1,300** as a contribution towards its costs. The sum is calculated as follows:

Preparing a notice of opposition:	£200
Preparing evidence and considering the applicant's evidence:	£600
Preparing written submissions in lieu:	£300

Official fees: £200

**Total** **£1,300**

104. I hereby order Bux & Co Ltd to pay Lok'n Store Limited the sum of £1,300. 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 11<sup>th</sup> day of January 2023**

**A COOPER**  
**For the Registrar**