

O-374-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2474084
BY HABITAT FOR HUMANITY GREAT BRITAIN
TO REGISTER A SERIES OF TWO TRADE MARKS:**



IN CLASSES 6, 9, 14 16, 19, 20, 21, 25, 35 & 36

AND

**IN THE MATTER OF OPPOSITION NO 97951 BY
HOPE INTERNATIONAL DEVELOPMENT AGENCY**

TRADE MARKS ACT 1994

In the matter of Application No 2474084
by Habitat For Humanity Great Britain
to register a series of two trade mark in classes 6, 9, 14 16, 19, 20, 21, 25, 35
& 36

and

In the matter of opposition No 97951 by
Hope International Development Agency

Background

1. On 5 December 2007 Habitat For Humanity Great Britain (“Habitat”) applied to register the following series of two trade marks:



2. Registration is sought for a wide range of goods and services in classes 6, 9, 14 16, 19, 20, 21, 25, 35 & 36 of the Nice classification system¹. However, given that the opposition is directed at only some of them, I list below only the opposed goods and services:

Class 09: Electronic publications downloadable from the Internet; CD-Roms.

Class 16: Printed matter including newspapers, newsletters, reviews, periodicals and journals and brochures; posters, books, badges, calendars, photographs, collecting boxes made of paper, greetings cards, Christmas cards, diaries; instructional and teaching materials.

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

Class 36: Charitable fundraising; fundraising campaigns; charitable collections; management and monitoring of funds and payment of funds to charity; charitable financing of property development and the building of homes.

3. On 22 September 2008 opposition to the registration of Habitat's application was made by Hope International Development Agency ("International") under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). Under sections 5(2)(b) & 5(3), International rely on its trade mark registration 2402799 in classes 36 & 41. The mark the subject of the registration (hereafter the "logo mark") is depicted below:



**HOPE International
Development Agency**

4. Under section 5(4)(a), International relies on its goodwill associated with a sign corresponding to the above logo mark and, also, goodwill associated with the sign HOPE. It says that these signs were first used in the UK in 2002 and that use by Habitat of its mark would constitute passing-off.

5. International's trade mark registration 2402799 has a date of filing prior to that of Habitat's application² and, therefore, it constitutes an earlier trade mark as defined by section 6(1) of the Act. I also note that International's trade mark completed its registration procedure on 21 April 2006. As this is not before the five year period ending on the date of publication of Habitat's application³, the proof of use provisions contained in section 6A⁴ of the Act do not apply. This means that the earlier mark may be taken into account in these proceedings for its specification as registered, namely:

Class 36: Charitable fundraising services for the operation of relief and development programs in third world countries.

² International's mark was filed on 29 September 2005 and Habitat's on 5 December 2007.

³ Habitat's application was published on 20 June 2008.

⁴ Section 6A of the Act was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

Class 41: Educational services in third world development and conducting training programs for preparing and organising volunteers for participation in international development projects.

6. Habitat filed a counterstatement denying the grounds of opposition. Both sides filed evidence, this is summarised below. Neither side requested a hearing, both opting instead to file written submissions. Habitat filed a revised specification to bear in mind in my determination. This is a conditional amendment, conditional on a finding against it for its current specification. I will, therefore, only consider the conditional amendment in the event that I find against Habitat. The amended specification limits certain of the goods and services to those relating to:

“issues surrounding housing and shelter”

International’s main evidence

Witness statement of Brian Cannon

7. Mr Cannon is International’s “Manager of Administration”, a position he has held for 26 years. He states that International have used the trade marks HOPE and Hope International Development Agency since at least 1975 internationally and since at least 2002 in the UK. The use relates to charitable fundraising services and educational services/conducting training programs for the benefit of third world countries and their peoples. Exhibit BCO1 consists of printouts taken from International’s website. The first is an “about us” print which carries a copyright date of 2006; the following signs are used in it:

HOPE International

The logo mark (albeit with the additional wording “in the UK”)

HOPE International Development Agency (UK)

8. There are also references to “HOPE UK” and “HOPE Ethiopia”. Included in the text is the following:

“HOPE’s work in Addis is channeled through...”

9. The second page of the website printout relates to International’s “mission and goals”. The printout includes the logo mark. The word HOPE is used a number of times on this page in a similar way to that described in paragraph 8 above. The aim of the organisation is to provide assistance and development to developing countries and their peoples.

10. Mr Cannon states that International has acquired a reputation in the UK for its services in relation to which HOPE and HOPE International Development

Agency are used. Its annual turnover figures under HOPE and HOPE International Development Agency are said to be:

year ending January 2005	£20,198;
year ending January 2006	£21,508;
year ending January 2007	£8,972;
year ending March 2008	£9,801;
the next year (to 10 February 2009)	£31,354.

In relation to the above figures, Mr Cannon comments that International is a charitable organisation.

11. Mr Cannon states that International advertises its HOPE charitable services through the distribution of brochures, through fund raising auctions and charity balls, through branded clothing worn by its fundraisers and through its website. An extract from its website is provided at BCO2 which illustrates some of its fundraising activities. A variety of fundraising activities are shown. All of the pages contain the logo mark. Other signs used are:

HOPE (UK)

HOPE International Development Agency (UK)

HOPE [use within other text] e.g.:

“DYNAMIC DUO RUN FOR HOPE”

and

“Trustee, Kirsty Pettit, and HOPE Supporter, Kay Surrey, along with her HUSBAND Andy, successfully completed the Great North Run...”

12. Examples of brochures and other printed material that International has issued are shown in BC03. A mixture of signs are, again, used, namely the logo mark, HOPE International Development Agency and HOPE (used within text). Examples of the use of HOPE are:

“Nearly £125 million has been raised since HOPE was established in 1975.”

“HOPE is the only development agency ...”

13. In relation to promotional expenditure, it is stated that between the years 2002 and 2005 brochures and printed material were supplied free of charge by International’s Canadian branch. No value is accorded to their worth. In 2007 £1384 was spent on promotion and £1205 in 2008.

14. Mr Cannon states that HOPE is used on its letterheads and business cards. Samples are provided in BC04. They do not use the word HOPE on its own. They use the logo mark and “HOPE International UK”.

15. Mr Cannon makes some submissions about Habitat’s mark and its similarity to that of International’s mark. He also makes submissions on confusion. I will not summarise these here but will take them into account in reaching my decision. Further written submissions were also filed by International at the same time as its evidence; I will treat these in the same way.

Habitat’s evidence

Witness statement of Ian Pearce

16. Mr Pearce is Habitat’s Operations Manager, a position he has held since 2006. He states that Habitat is a UK-registered charity which is part of the Habitat for Humanity group of charities. The vision of the charity is based on a world where everyone has a safe, decent and appropriate place to live. He states that since 1976 it has enabled over 300,000 homes to be built or renovated in over 90 countries, providing 1.5 million people with safe, decent and affordable shelter.

17. Figures from the website of the Charity Commission for England and Wales are then provided. The figures relate to the year ending 30 June 2008. In terms of income, Habitat received £4,848,143. Most of this comes from voluntary income (presumably fund raising). Spending was £4,730,383 most relating to charitable activities. To assist with context, the website gives the combined figures for all registered charities. In terms of income, this was £49.3 billion.

18. Mr Pearce states that Habitat’s trade mark and the name HOPE BUILDERS have been used since May 2005. He states that people are encouraged to become “Hopebuilders” in order to raise funds for the charity. Hopebuilders are provided with resources to assist them such as a personalised website, advice and assistance, they are also provided with a newsletter. Exhibit IP2 provides printed material in support of this. It carries a copyright date of 2006. It uses the logo the subject of the application. Reference is made to HopeBuilders and the HopeBuilders Campaign. The fundraising tool for use by HopeBuilders is called HopeRaiser.

19. Mr Pearce says that the name HOPE BUILDERS was chosen because of the double meaning in terms of building people’s hopes in life by helping to build homes. The nail device in its logo is said to signify building and Mr Pearce says that it is a play on the ribbon device that is used by many other charities. He states that the key element of its mark is the device element and the word HOPE BUILDERS, not HOPE alone.

20. Mr Pearce states that the word HOPE is a common word, based on its descriptive meaning, in relation to charities. He states that charities should not be prevented from using this word. He provides at Exhibit IP3 copies of printouts from the Charity Commission website showing over 250 UK charities whose names consist of or contain the word HOPE. Exhibit IP4 shows UK and Community trade marks in class 36 (which cover charitable services) showing marks containing the word HOPE e.g. FOOTBALL FOR HOPE, HOPE HIV, DOGS TRUST HOPE PROJECT. At Exhibit IP5 is a *Google* report for *Hope Charity* which returned just under 15 million hits. The search was not limited to UK pages. Mr Pearce says that this is further evidence of the common use of the word in the everyday context of charities.

International's reply evidence

21. No evidence was filed, but I note that International filed some written submissions instead of factual reply evidence. I will not summarise these here, but take them into account.

The section 5(2)(b) ground of opposition

22. Section 5(2)(b) states:

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

(a)

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

23. In reaching my decision I have taken into account the guidance provided by the European Court of Justice (“ECJ”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

The average consumer and the purchasing act

24. As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) I will begin with an assessment of who this is.

25. Both sets of services include services for charitable fundraising and collection. The end user to whom charitable fundraising and collection is directed is the person that is being asked to donate, this is the average consumer. This consumer will come from the general public, but could also include businesses. In its submissions (albeit in relation to passing-off), International highlights that charitable giving can be the result of an impulsive gesture. This may be true for some members of the general public, however, the case-law talks of an average consumer being reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). Whilst this general presumption can change depending on the particular goods or services in question (see, for example, the decision of the CFI⁵ in *Inter-Ikea Systems BV v OHIM* (Case T-112/06), it seems to me that a member of the general public giving to charity, even if acting on impulse, will still display at least a reasonable degree of care and attention as the aims and goals of the charity are important and he or she would not want to give to a charity in whose cause he or she does

⁵ The Court of First Instance of the European Communities

not believe. In relation to the business average consumer, impulse is less likely to be relevant and, also, given that a business is likely to be giving larger sums of money, and given that a business would not wish to be associated with a cause with which it does not agree, a higher degree of care and attention than the norm will be displayed.

26. There are other charitable based services in class 36 of Habitat's application, namely "management and monitoring of funds and payment of funds to charity; charitable financing of property development and the building of homes". To the extent that such services are not simply being undertaken by the charity itself, it is possible that the management of funds etc. could be undertaken for others (other charities). If this is the case then other charitable organisations would be the end user/consumer. This is what Habitat argues when making a comparison of the relevant services and this seems a reasonable position to adopt. In terms of the degree of care and attention, this is likely to be reasonably high because the choice of organisation to perform such a role, an important and financial-centric role, is likely to be a carefully considered decision.

27. Habitat also seeks registration for goods in classes 9 & 16. They are general consumer items. An average, reasonable degree of care and attention is likely to be used here. They are not completely casual purchases though, but neither are they particularly considered ones.

28. International also provide educational services relating to third world development and for preparing and organising volunteers for participation in international development projects. This is targeted at individuals who wish to do more towards a particular cause than just raising money. In terms of third world development education, this is less clear, but could include both individuals and businesses. The use of such a service is unlikely to be regular occurrence and the choice of provider will be fairly well considered. I consider that the degree of care and attention will be higher than the norm but not of the highest degree.

29. In terms of the manner of purchase/use, there is no evidence directed specifically at this point. The raising of charitable funds could be effected physically by the use of collecting boxes, through on-line payment on a web-site, through regular payments directly from a bank account, or by donating over the telephone. This means that both visual and aural considerations have an equal role to play. Physical goods, though, are more likely to be purchased after visual inspection, visual similarity will have more significance than aural similarity; aural similarity should not, though, be completely ignored.

30. In relation to educational services, a service provider is likely to be identified through research on the Internet or by looking at brochures/leaflets of prospective organisations. This is also likely to be similar in relation to the services provided to other charitable organisations. Visual similarity will be of more significance than aural similarity; aural similarity should not, though, be completely ignored.

Comparison of the goods and services

31. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ 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.”

32. Guidance on this issue also comes from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant in the assessment of similarity of goods and/or services:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

33. If a term in Habitat’s specification falls within the ambit of a broader term in International’s specification then there must be a finding of identity. Furthermore, if a term in International’s specification could include within its ambit a specific term in Habitat’s specification then this will also be sufficient for a finding of identity even though there may be other goods/services within that broader term that are, potentially, only similar (or even not similar at all)⁶. In construing a word used in a trade mark specification, one is concerned with how

⁶ See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-133/05

the product is, as a practical matter, regarded for the purposes of the trade⁷. I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning⁸. I must also be conscious not to give a listed service too broad an interpretation; in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 Jacob J stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

34. The opposed goods and services of Habitat are:

Class 09: Electronic publications downloadable from the Internet; CD-Roms.

Class 16: Printed matter including newspapers, newsletters, reviews, periodicals and journals and brochures; posters, books, badges, calendars, photographs, collecting boxes made of paper, greetings cards, Christmas cards, diaries; instructional and teaching materials.

Class 36: Charitable fundraising; fundraising campaigns; charitable collections; management and monitoring of funds and payment of funds to charity; charitable financing of property development and the building of homes.

35. International relies on all of its services, namely:

Class 36: Charitable fundraising services for the operation of relief and development programs in third world countries.

Class 41: Educational services in third world development and conducting training programs for preparing and organising volunteers for participation in international development projects.

36. Habitat seeks registration for “charitable fundraising”. International’s specification also includes charitable fundraising, albeit for the operation of relief and development in third world countries. Although Habitat’s mark is the later mark, the services of International fall within its ambit and, thus, must be

⁷ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

⁸ See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

considered to be identical⁹. This finding also applies to Habitat's "fundraising campaigns; charitable collections" as these are simply alternative ways of referring to fundraising services. There is no real dispute between the parties in relation to this.

37. Habitat's class 36 specification also covers the management and monitoring of charitable funds and charitable financing (of property development). These terms are clearly related to charitable activities (as argued by International), but I agree with Habitat's submission that the specific purpose and nature of these activities is not the same as the fundraising itself. There is, though, an overriding similarity in that both have the same overall objective of providing help and assistance to others in a charitable context. Habitat argues that the end user is not the same. I decided earlier that the average consumer is likely to be different (the general public as opposed to other charitable organisations) as fundraising and the subsequent management and payment of funds (and financing of property development) are at either end of the charitable activity. However, there will be a degree of overlap in that end users of the management and payment services will also form part of the group to whom fundraising is aimed as they are also members of the general public. It is not as though the two groups are separate and distinct, with never the twain meeting. There is also a degree of complementarity here. Without fundraising, the subsequent charitable management/payment/financing will not take place. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 the CFI stated:

"It is true that goods are complementary if there is a close connection between them, in the *sense that one is indispensable or important for the use of the other in such a way that* customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48)."

38. In view of the above, I consider that the remaining services in class 36 (the management and monitoring of charitable funds and charitable financing (of property development)) are complementary to charitable fundraising services because charitable fundraising is important or indispensable for the subsequent charitable management/payment/financing in such a way that consumers may think that the same undertaking is responsible for both. There is a moderate degree of similarity.

⁹ *Gérard Meric v OHIM*

39. The goods in classes 9 & 16 include electronic publications and printed matter (and specific items of such) and instructional and teaching materials. The primary submission from International is that such goods could relate to charitable activities. Habitat says that such goods are fundamentally different in character and are not the same or similar.

40. The goods (such as printed matter/electronic publications) and the service (for example fundraising in class 36) are clearly different in nature. However, I agree with International that such material may be about charitable activities as its subject matter and, therefore, there may be a degree of similarity in terms that both are aimed at raising funds or promoting a particular cause. The end users are also likely to be the same. The other factors that inform on similarity set out in the above case-law do not advance International's case. It could be argued that printed matter could relate to anything and everything and this should not create similarity with goods/services that could potentially be related to it. However, the degree of similarity here is not simply hypothetical because, as can be seen from Habitat's fall-back position, its material is likely to be about charitable activities and fundraising. In view of this, I consider there to be some, albeit only a moderate degree of similarity. I should add that there is also a degree of similarity between International's educational services and goods such as instructional and teaching materials (and broad terms that could cover such material) for similar reasons.

41. The above findings extend to "badges, Christmas cards, diaries, greetings cards, calendars". It is common knowledge that goods such as these are routinely sold for charitable purposes and there is, therefore, a similarity of purpose to the fundraising itself and also a complementary relationship. The end users are also the same. This also applies to "collecting boxes". Whilst, again, the nature is different, there is a similarity in purpose in that such boxes and charitable fundraising both have fundraising as a purpose. Boxes could of course be purchased by charities but, in turn, the end user could be the fundraiser and such a person is likely to see a complementary relationship as identified earlier. There is some similarity but not a high degree.

42. The only terms for which I can see no similarity are "posters and photographs". These are not goods which, based on common knowledge, are sold for charitable purposes. I cannot, therefore, see any similarity in purpose or complementary relationship.

Comparison of the marks

43. When assessing this factor I must do so with reference to the visual, aural and conceptual similarities between the respective marks bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, paragraph 23). Although Habitat's application contains two marks (one coloured, one not) it is not necessary to make a separate analysis for the coloured version. This is because International's earlier mark is registered without regard to colour, therefore, the presence of colour in one of Habitat's marks cannot create a significant difference – the matter must be assessed on the similarity between the respective words and configurations without regard to colour¹⁰. The marks to be compared are:

Habitat's mark



International's mark



44. Both marks are composite marks. International says that the word HOPE is the dominant and distinctive element of both marks, it says that words always speak louder than devices, it says that the word HOPE in both marks is more prominent than the other textual elements, and it says that the other textual elements in both marks are non-distinctive. Habitat says that the word HOPE is non-distinctive in relation to charitable services, it says that both marks have prominent and distinctive device elements, it says that the words HOPE and BUILDER will not be separated from each other and will not be treated as individual elements, and it says that International's mark also has additional wording.

45. Habitat's mark has three elements. A stylised nail device, the words HOPE BUILDERS (the words being presented one above the other) and the words "Poverty housing – let's nail it". I note that in the HOPE BUILDERS element, the word HOPE is larger than the word BUILDERS. This is a relevant consideration but, although larger, it does not give the word HOPE significantly more prominence. I consider that these words will be perceived as a single combined

¹⁰ See the decision of Mr Hobbs QC (sitting as the Appointed Person) in BL O-246-08 *MARY QUANT COSMETICS JAPAN LTD V ABLE C&C Co LTD*.

element. This is because, as Habitat submits, the words are indicative of the building of hope. I also agree with Habitat that there is a dual meaning, in that the building aspect of its charity is re-enforced by the nail device and the strap line. The dual meaning does not, though, contrary to International's view, mean that the word HOPE indicates the name of the charity with the word BUILDERS simply describing its nature. The first two elements (the nail device and HOPE BUILDERS) strike me as the most dominant and distinctive elements. They have equal degrees of dominance. The third element, the strap line, is the least dominant element, but it is not negligible in the overall context of the mark.

46. International's mark consists of two elements. The first is its own device element which, again, is striking. The second element is the words HOPE International Development Agency. Although these words would be considered as an element as a whole, I note that the word HOPE is capitalised and, therefore, it has slightly more prominence. Furthermore, the words INTERNATIONAL DEVELOPMENT AGENCY seem to me to be non-distinctive, so the word HOPE will be seen as the name of the international development agency responsible for the services it offers. Habitat submits that the word HOPE is non-distinctive in relation to charitable service. However, in the context of International's mark the word HOPE, given that it will be perceived as the name of an international development agency, does play a more dominant and distinctive role (in terms of indicating origin) than the other textual elements of the mark. I will, though, return to the question of the distinctiveness of the word HOPE and its impact on whether there is a likelihood of confusion. As with Habitat's mark, the device and the word element have an equal degree of prominence.

47. In terms of a visual comparison, both marks include the word HOPE. As I have said, this word stands out slightly more than the other textual elements. However, it is undoubtedly true that the eye will also notice a number of differences which include the striking (and quite different) device elements, and the different additional wording. The net result of assessing the single point of visual similarity with the several points of visual difference is that any similarity between the respective marks, on a visual level, is very low.

48. Similar considerations apply to the aural assessment. The one key difference, though, is that the respective device elements will not be spoken. Habitat's mark is likely to be referred to as HOPE BUILDERS (the strap line is unlikely to be spoken in most circumstances) whereas International's mark is likely to be spoken as HOPE INTERNATIONAL DEVELOPMENT AGENCY or even HOPE INTERNATIONAL. Whilst I do not agree with International that all of its additional text will be dropped completely, the fact that the words "international"/"international development agency" are descriptive means that more focus will be placed on the HOPE element when it is spoken/heard. The point of similarity is the same, but the additional wording in the respective

pronunciations still creates a difference. The net result, balancing the similarities and the differences, is that there is a moderate degree of aural similarity.

49. Conceptual similarity and its importance in the overall assessment of a likelihood of confusion has been dealt with in the jurisprudence on a number of occasions. In *Case T-292/01 Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR the CFI stated:

“Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. In this case that is the position in relation to the word mark BASS, as has just been pointed out in the previous paragraph. Contrary to the findings of the Board of Appeal in paragraph 25 of the contested decision, that view is not invalidated by the fact that that word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made. That fact does not prevent the relevant public from immediately grasping the meaning of that word mark. It is also irrelevant that, since the dice game Pasch is not generally known, it is not certain that the word mark PASH has, from the point of view of the relevant public, a clear and specific meaning in the sense referred to above.

The fact that one of the marks at issue has such a meaning is sufficient – where the other mark does not have such a meaning or only a totally different meaning - to counteract to a large extent the visual and aural similarities between the two marks.”

50. The word element of Habitat’s mark conjures up the concept of a charitable body which aims to build hope in people. There is though, as I have already indicated, a dual meaning in that the phrase will also point towards building – this is brought to mind due to the nail device and the strap line. International’s mark conjures up the name of an international development agency which is called HOPE. The word HOPE is a word with a clear meaning and in the context of charitable services will be taken as a reference to the giving of hope to individuals to whom the charity benefits. There is, therefore, a degree (although not high) of conceptual similarity given that both marks, to some extent, allude to the building of or the giving of hope. However, a concept of hope does not strike me as a particularly distinctive concept for charitable organisations. As I have said, I will return to this point later.

Distinctive character of the earlier trade mark

51. The distinctiveness of the earlier mark is a factor to be considered because the more distinctive it is (based either on inherent qualities or because of the use made of it), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). International's earlier mark consists of two key components. The device element is striking. The words, though, are less so in that they simply refer to an international development agency called HOPE and the word hope has a clear and obvious relationship with charitable services. I will bear this in mind, but it is sufficient at this stage to record that the earlier mark has, overall, a reasonable degree of distinctiveness.

52. In terms of the use made of the earlier mark, there is nothing to suggest that International's use on an international scale from 1975 has had any real impact on the average UK consumer. International has, though, used its mark in the UK since 2002. However, the scale of use strikes me as being of an extremely low level. This is true in terms of income and also true in terms of promotional activity. The fact that International is a charitable organisation does not alter this fact. International says that it also relies on free publicity, but there is little to support that the name is known to any significant extent. Some people clearly know of the charity and its trade mark, as shown in its website evidence where people have undertaken fundraising activities, but there is nothing to suggest that this has any real significance for the UK average consumer. There is no enhancement of distinctive character.

Likelihood of confusion

53. It is clear that the relevant factors have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer(s) and determining whether they are likely to be confused.

54. International's best case must lie with its opposition to Habitat's charitable fundraising services. This is because the services involved are identical, which, therefore, has the capacity to off-set a lower degree of similarity between the marks. In relation to these services, I identified two types of average consumer ((1) the general public, (2) businesses). I will make an initial assessment in relation to the general public average consumer because, unlike the business consumer, I did not find that they would display a higher degree of care and attention than the norm (although a reasonable degree of attentiveness will still be displayed). This, again, puts International's case at its highest point because if a higher degree of care and attention was being used then confusion is less likely due to the effects of imperfect recollection being mitigated to a certain degree. In

other words, if International cannot succeed on the basis of identical services, assessed against the general public average consumer, it will be in no better position elsewhere.

55. Whilst I must bear in mind the concept of imperfect recollection (which relates to the fact that consumers rarely have the chance to make direct comparisons between trade marks and must instead rely on the imperfect picture of them he or she may have kept in mind¹¹) it seems to me that the overall degree of similarity between the marks, based on the separate and distinct device elements, and the additional and different wording, mitigates strongly against imperfect recollection resulting in the average consumer directly confusing the two marks. There is, therefore, no likelihood of direct confusion.

56. That is not the end of the matter, though, because confusion can be indirect in the sense that the average consumer considers that the goods and/or services in relation to which the respective marks are used are the responsibility of the same or an economically linked undertaking. This level of confusion, indirect confusion, is sufficient for a finding under section 5(2)(b) of the Act¹².

57. To illustrate the above, the average consumer could see International's mark as indicating the main overriding charitable organisation, with Habitat's mark indicating an arm of that charity which specialises in building and providing shelter and housing for the disadvantaged. The assumption being made on the basis of the common presence of the word HOPE.

58. The key submission from Habitat on this argument is based on the inherent quality of the word HOPE. It submits that this word has no distinctiveness and that the average consumer will not assume shared economic origin on the basis of such a word. Habitat filed three pieces of evidence to support this argument. It provided state of the register evidence, it provided details from the Charity Commission website regarding charities with the word HOPE in its name, and it provided a *Google* print of charities using this word. These pieces of evidence can all, individually, be criticised. State of the register evidence does not show what is happening in the actual marketplace and such evidence has been held, generally speaking, as not being relevant¹³. The Charity Commission evidence could be criticised for the same reason as it only shows charity names registered and not, necessarily, the signs used in actual operation by the charities. The *Google* print was not limited to websites in the UK and, furthermore, the websites that underpin the search results were not disclosed. International also highlight that some of the "evidence" post dates the filing of Habitat's trade mark

¹¹ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B*

¹² *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*

¹³ See *British Sugar Plc v James Robertson & Sons Limited*.

application. However, taken in totality, the evidence is certainly symptomatic of a word which is not particularly distinctive in relation to charitable services. Whilst I do not place any significant weight on the evidence or any particular part of it, it at least confirms my own view that the word HOPE must be one, due to its inherent meaning, that other charities use are likely to use in their publicity material and even in their names. This is a commonsense understanding. The purpose of any charity could easily be described as bringing hope to people. I, therefore, agree with Habitat that the word HOPE is not a particularly distinctive word in relation to charitable services. However, although agreeing with the proposition that the word HOPE is a weak element, I must also bear in mind that confusion may still be likely on the basis of a shared weak element. For example in *L'Oréal SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-235/05 P*, the ECJ stated:

“45 The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

59. And in *Zero Industry Srl v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-400/06* the CFI stated:

“71 In addition, the weak distinctive character of an element of a compound mark does not necessarily imply that that element cannot constitute a dominant element since – because, in particular, of its position in the sign or its size – it may make an impression on consumers and be remembered by them (judgment of 16 May 2007 in Case T-491/04 *Merant v OHIM – Focus Magazine Verlag (FOCUS)*, not published in the ECR, paragraph 49). It should be added that, as regards the earlier marks, in so far as they comprise a single verbal element, the argument that that word has become common is not relevant for the purposes of the comparison of the signs at issue (see, to that effect, *Limoncello della Costiera Amalfitana shaker*, cited in paragraph 44 above, paragraph 37).

74 Third, as regards the applicant's claim that the earlier marks have weak distinctive character, it should be held that accepting that the earlier mark has a weak distinctive character does not prevent the finding in the present case that there is a likelihood of confusion. Although the distinctive character of the earlier mark must be taken into account when assessing the likelihood of confusion (see, by analogy, *Canon*, cited in paragraph 32 above, paragraph 24), it is only one factor among others involved in that assessment. Thus, even in a case involving an earlier mark of weak distinctive character, there may be a likelihood of confusion on account, in particular, of a similarity between the signs and between the goods or services covered (see judgment of 12 November 2008 in Case T-210/05 *Nalocobar v OHIM – Limiñana y Botella (Limoncello di Capri)*, not published in the ECR, paragraph 51 and the case-law cited).

75 In addition, granting excessive importance to the fact that the earlier mark has only a weak distinctive character would have the effect that the factor of the similarity of the marks would be disregarded in favour of the factor based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the signs at issue. Such a result would not, however, be consistent with the very nature of the global assessment which the competent authorities are required to undertake by virtue of Article 8(1)(b) of Regulation No 40/94 (see *Limoncello di Capri*, cited in paragraph 74 above, paragraph 52 and the case-law cited). “

60. International makes reference to the judgment of the ECJ in *Medion AG V Thomson multimedia Sales Germany & Austria GmbH*. The reply the ECJ gave to the question referred to it states:

“37. Accordingly, the reply to the question posed must be that Article 5(1)(b) of the directive is to be interpreted as meaning that where the goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein.”

61. Although the above judgment is important to consider, the facts of the case before me are not particularly analogous. This is because although the word HOPE could be said to play an independent and distinctive role in International's mark (the word HOPE, after all, will be seen as the name of the particular international development agency) it is not a word which, as alluded to earlier,

has a normal degree of distinctiveness. It is a word which, even when used alone, will be regarded as being of low distinctiveness (if distinctive at all) for the reasons I have already identified. Furthermore, the use by Habitat of this word in its mark is not use of an element that is playing an independent and distinctive role. Taking all this into account, and whilst bearing in mind the issues discussed in *L'Oréal SA v OHIM* and *Zero Industry Srl v OHIM*, I do not believe that the average consumer will make an assumption of shared economic origin on the basis of a word which has little distinctiveness when the nature of the respective marks (and their similarity) is considered. The average consumer will, in my view, believe that the two marks are the responsibility of two separate charitable organisations who have chosen to make use of the suggestive word HOPE. In fact, Habitat's use (of the word HOPE) will be seen as descriptive use to create the HOPE BUILDERS message. The average consumer will put any similarity down to co-incidence (and an unsurprising co-incidence at that) and not to economic connection. There is no likelihood of indirect confusion. The ground of opposition under section 5(2)(b) is hereby dismissed.

The section 5(3) ground of opposition

62. Section 5(3)¹⁴ of the Act reads:

“5-(3) A trade mark which-

(a) 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 Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

63. In order to succeed under this ground the earlier mark must have a reputation. In *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572 *Chevy* the ECJ stated:

“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.”

64. Although the question is different under section 5(3) to that posed under section 5(2) in terms of enhanced distinctive character, the analysis and assessment I gave there (paragraph 52) is relevant. It is clear to me from that assessment that whilst some members of the relevant public will know of the mark, such knowledge, on the basis of the evidence presented, is extremely limited. I am far from satisfied that International’s mark is known by a significant part of the relevant public. Without a reputation, this ground of opposition must be dismissed.

¹⁴ Section 5(3) was amended by The Trade Marks (Proof of Use, etc) Regulations 2004 (SI 2004 No. 946) giving effect to the judgments of the ECJ in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* (C- 292/00) and *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* (C-408/01).

The section 5(4)(a) ground of opposition

Legislation and case-law

65. Section 5(4)(a) of the Act reads:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

66. The elements of passing off (often referred to as the classic trinity) can be summarised as: 1) goodwill, 2) misrepresentation and 3) damage. In *Reckitt & Colman Products Ltd v Borden Inc* [1990] R.P.C.341, Lord Oliver summarised the position quite succinctly when he stated:

“The law of passing off can be summarised in one short general proposition--no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff...Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.”

67. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223 as:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first.”

68. I also note from the relevant case-law that to qualify for protection under the tort, the goodwill must be of more than a trivial nature¹⁵. However, being a small player does not rule out possession of goodwill¹⁶. An important point in this case is the fact that International (and also Habitat) is a charitable organisation. Goodwill is normally understood in the context of a trader’s custom, but a charity, certainly in relation to its primary fundraising activities, is not a trader as such. However, the law—off passing off has been held to protect the goodwill in a charity against misappropriation by a non-charity¹⁷ and also misappropriation by another charity. The latter can clearly be seen in *British Diabetic Association v The Diabetic Society* [1996] F.S.R. 1 where Mr Justice Walker stated:

“I conclude, therefore, that the scope of a passing off action is wide enough to include deception of the public by one fund-raising charity in a way that tends to appropriate and so damage another fund-raising charity's goodwill-- that is, the other charity's "attractive force" (see Lord Macnaghten in *Inland Revenue Commissioners v. Muller & Co.'s Margarine Ltd* [1901] A.C. 217, 223) in obtaining financial support from the public. That conclusion raises a number of questions which may have to be explored at some future time (though litigation of this sort will, I sincerely hope, be extremely rare). I will make some tentative comments on points which were raised, but not fully examined, in counsel's submissions.”

69. In terms of misrepresentation, this relates to the deception of a substantial number of those persons who are aware of International’s goodwill¹⁸. In the context of the case before me this could take the form of such persons giving funds to Habitat in the belief that it is International’s charity or buying Habitat’s goods in the belief that they are being offered for sale by International for the purpose of its fundraising. Similar considerations apply in relation to the other services offered by Habitat. It is important to also bear in mind use in relation to bequests made in wills. This was a factor made clear in *British Diabetic Association v The Diabetic Society* and a point highlighted was the fact that the degree of accuracy in a named beneficiary may vary. Mr Justice Walker summed

¹⁵ *Hart v Relentless Records* [2002] EWHC 1984

¹⁶ *Stacey v. 2020 Communications Plc* [1991] F.S.R. 49

¹⁷ See, for example, *British Legion v British Legion Club (Street) Ltd* [1931] 48 R.P.C. 555

¹⁸ see the findings of the Court of Appeal in *Neutrogena Corporation and Ant. V. Golden Limited and Anr.* [1996] R.P.C. 473

up the proposition of misrepresentation in *British Diabetic Association v The Diabetic Society* thus:

“I must therefore go on to the second issue, whether the Society's use of its own name would be likely, if not restrained, to lead people to deal with the Society (which includes becoming subscribing members of the Society, and leaving legacies to the Society) on the faith of the Association's reputation.”

70. (The first issue assessed by Mr Justice Walker is not relevant to the case here because it related to whether the plaintiff had a goodwill associated with the same name that the defendant used – this is not the case here.)

71. In relation to damage, it is also useful to consider the comments of Lord Fraser in *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31 where he stated that the claimant must prove:

“That he has suffered, or is really likely to suffer, substantial damage to his property in the goodwill by reason of the defendants selling goods which are falsely described by the trade name to which the goodwill attaches.”

Material date

72. In terms of the material date at which my assessment must be made, I note the judgment of the CFI in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Joined Cases T-114/07 and T-115/07*. In that judgment the CFI stated:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non registered national mark before the date of filing, in this case 11 March 2000.”

73. The date of filing of Habitat's application is, therefore, the material date. However, if Habitat has used its mark prior to this then this must also be taken into account. It could establish that Habitat is the senior user, or that there had been common law acquiescence, or that the status quo should not be disturbed;

any of this could mean that Habitat's use would not be liable to be prevented by the law of passing-off¹⁹.

Goodwill

74. The first matter to address is whether International had a goodwill at the material date, namely 5 December 2007. International's statement of case refers to two signs which it says it has used, namely the logo version that corresponds to its registered trade mark and also the sign HOPE. It is important to bear in mind that goodwill exists in the business and not the individual signs themselves. However, it is relevant to consider the signs or identifying get-up which is associated with the business's goodwill. However, putting the signs to one side, it must firstly be observed that the degree of knowledge of International's business is limited (see my findings in paragraphs 52 & 64). However, it is, at the very least, an active and operative charity in the UK. This is demonstrated by its income and promotional expenditure (although modest) and by the examples of individuals who have undertaken fundraising activities on its behalf. I do not consider that such use should be disregarded as trivial. It is small, but, as I stated earlier, a business with a small goodwill may protect itself under the law of passing-off.

75. In terms of the indentifying get-up, it is clear to me that the primary sign with which International identifies itself to the public is its logo mark as per its registered trade mark. When considering the various pieces of evidence filed by International this is the sign which is used most prominently and is the sign which seems to me to have greatest impact. It is, though, clear that International use a number of signs as part of its indentifying get-up. These all form part of the fabric of International's goodwill. This includes the word HOPE. There is clear evidence that International sometimes abbreviates its full name to simply refer to itself as HOPE. Those members of the public who have encountered International's charitable services may, therefore, recognise the word HOPE on its own as the name of that particular charitable organisation. This, therefore, is also part of the fabric of its goodwill. I must though record that the goodwill is weak and this is particularly so in relation to HOPE alone given not only the limited "custom" in the UK but also due to the inherent qualities of the word HOPE.

¹⁹ See, for instance: *Croom's Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42.

Misrepresentation

76. I will deal firstly with the issue of intent. The following was stated in *British Diabetic Association v The Diabetic Society*:

“For this purpose the defendants' motives are largely irrelevant; it is not necessary for the plaintiff to prove any actual intention to practise deception, although if such an intention is shown then the probability of deception is more easily established.”

77. Misrepresentation will more readily be inferred if intent to deceive can be established. The only argument in relation to intent is International's reference to Habitat not being averse to picking out elements used by other charities and adopting them as its own. This is a reference to Habitat's statement that its nail device was chosen as a play on the ribbon devices used by other charities. International says that this is illustrative of Habitat calculating to deceive. In my view, all Habitat was saying was that charities often use ribbon devices in their branding and its nail device is, effectively, its own ribbon device. I therefore reject International's argument here. Furthermore, I can see nothing in the evidence to suggest any improper motive or attempt to pass-off.

78. Regardless of the above, there is still an issue to consider in the absence of intent, a point which was made (and guidance provided) by Parker J. in *Burberrys v. Cording (J.C.) & Co. Ltd* [1909] 26 R.P.C. 693:

“If the use of a word or name be restrained, it can only be on the ground that such use involves a misrepresentation, and that such misrepresentation has injured, or is calculated to injure another in his trade or business. If no case of deception by means of such misrepresentation can be proved, it is sufficient to prove the probability of such deception, and the court will readily infer such probability if it be shown that the word or name has been adopted with any intention to deceive. In the absence of such intention, the degree of readiness with which the court will infer the probability of deception must depend of the circumstances of each particular case, including the nature of the word or name, the use of which is sought to be restrained.”

79. Habitat's key submission focuses, again, on the distinctiveness of the word HOPE. Of relevance here is the judgment in *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* (1946) 63 R.P.C. 39. In this case the differences between "Office Cleaning Services Limited" and "Office Cleaning Association," even though the former was well-known, was held to be enough to avoid passing off. Lord Simmonds stated:

"Where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first

user is allowed unfairly to monopolise the words. The Court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered."

80. The above case was considered to be highly relevant in *British Diabetic Association v The Diabetic Society*. Although, in that case, the difference between the respective signs (the use of society rather than association) was not considered enough due to the long standing and significant use the plaintiff had made of its sign together with the shared root of the words association/society. The dispute in the subject proceedings must, however, be determined on its own merits and facts bearing in mind the guidance in the case-law identified.

81. In terms of the merits of this case, and as I have already stated, although International's full name may be HOPE INTERNATIONAL DEVELOPMENT AGENCY, it may be detailed in wills as HOPE. This is supported by the fact that International abbreviate its name in some of its publicity material to HOPE and this is clearly how some of its supporters will remember its name. This is relevant not only to wills, but also to general fundraising and the purchase of goods for the benefit of a charity.

82. There is, though, still the inherent nature of the word HOPE to consider. Whilst there is no requirement under passing-off for the possession of an exclusive reputation (in this case in relation to the word HOPE)²⁰ the word HOPE is one which other charities are likely to make use of in a descriptive way. This is likely to be known by persons that are aware of International's goodwill. Bearing in mind *Office Cleaning*, this is all indicative of a position that a person who knows of International and its use of the word HOPE as its name will unlikely regard the use of the word HOPE, where such use does not indicate, on its own, the actual name of a charity, as being the same charitable organisation as International.

83. Lord Simmonds referred to small differences being sufficient to avoid confusion. The differences here (even between the sign HOPE and one of the dominant and distinctive elements of the applied for mark - HOPE BUILDERS) are certainly clear enough to avoid a misrepresentation, particularly in circumstances where the word HOPE in Habitat's mark will not be regarded as playing an independent and distinctive role. International's position is no better when considering the issue of bequests in wills. No matter how inaccurately detailed International may be, it will not be so inaccurately detailed so as to refer to HOPE BUILDERS, nor do I consider it a reasonable assumption to make that

²⁰ See, for example, *Associated Newspapers Limited and others v Express Newspapers* [2003] FSR 51

funds which are meant for International (even if HOPE is detailed) would be diverted to Habitat due to its use in its mark of the designation HOPE BUILDERS.

84. International's position is not helped in these proceedings by the fact that its goodwill is not particularly strong. It is not a large and long-standing organisation. This is another relevant factor. Taking all factors into account, I do not consider that any form of misrepresentation will occur.

85. The view I have expressed above is sufficient to determine this ground of opposition in Habitat's favour. This is without even considering the impact of its pre-application use. I will, though, comment on it for the sake of completeness. Habitat cannot claim to be the senior user. Its mark has been used since 2005, whereas International's use goes back to 2002. In terms of whether there has been common law acquiescence or whether the pre-application use means that the status quo should not be disturbed, this is a more difficult issue. This is because, although Habitat has filed evidence of its income in the year ending 2008, this is not only after the material date (or at least part of it is), but it is also not clear what proportion of this relates to the use of the mark at issue here as opposed to other signs that Habitat may use. There is an example of use from 2006 but this is really all there is. In my view, had this issue been determinative, Habitat would likely have failed to persuade me that the status quo should be maintained or that there had been common law acquiescence.

Conclusion

86. All the grounds of opposition have failed. International's opposition to the registration of Habitat's mark must, therefore, be dismissed.

Costs

87. Habitat has been successful and is entitled to a contribution towards its costs. I hereby order Hope International Development Agency to pay Habitat For Humanity Great Britain the sum of £1500. This sum is calculated as follows:

Preparing a statement and considering the other side's statement
£400

Filing evidence and considering the other side's evidence
£700

Written submissions
£400

88. The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 3rd day of December 2009

**Oliver Morris
For the Registrar
The Comptroller-General**