

O-409-11

IN THE MATTER OF APPLICATION NOS 2453838 AND 2453833
IN THE NAME OF UNITE THE UNION


AND

OPPOSITION THERETO UNDER NOS 96356 AND 96357
BY THE UNITE GROUP PLC

IN THE MATTER OF APPLICATION
Nos. 2453838 AND 2453833
in the name of UNITE THE UNION
and opposition thereto under
Nos 96356 and 96357
by THE UNITE GROUP PLC

Background

1. Application Nos. 2453838 and 2453833 were filed on 26 April 2007 and now stand in the name of Unite the Union (“Union”). The applications are for registration of the following trade marks:

| No. | Mark |
|---------|--|
| 2453838 |  |
| 2453833 | UNITE |

2. Both applications seek registration for a range of goods and services in classes 14, 16, 18, 21, 22, 24, 25, 26, 28, 35, 36, 41, 42, 43, 44 and 45 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, namely:

Class 14

Horological and chronometric instruments; clocks and watches; tie pins; items of jewellery; ornamental pins.

Class 16

Printed matter, publications, newsletters, brochures, instructional and teaching materials, document files, pens and pencils, photographs, leaflets, forms, posters, business cards, calendars, diaries, year wall planners, envelopes, booklets, labels, note pads, sticky notes, erasers, tape measures, staplers, rulers, desk tidies, mug mats (plastic and cardboard), folders (cardboard and ring binder), clipboards.

Class 18

Leather goods; wallets; briefcases; umbrellas; imitation leather goods; travelling bags; handbags; rucksacks; purses.

Class 21

Glassware, porcelain and earthenware; mugs, cups and crockery; decanters.

Class 22

Sacks and bags not included in other classes.

Class 24

Tea towels.

Class 25

Clothing; headgear; T-shirts; sweatshirts; ties; scarves; sweaters; caps; outerclothing; footwear.

Class 26

Badges.

Class 28

Games and playthings.

Class 35

Accountancy advisory services; tax analysis and tax return preparation services; providing advertising space in publications; organising conferences and exhibitions; providing commercial assistance and information; organisation, operation and supervision of loyalty and incentive schemes; opinion polling; provision of business information.

Class 36

Charitable fund raising; financial and insurance consultancy services; credit card services; financial information; financial management and financing services.

Class 41

Education relating to the working environment, employment, the economy and health and safety; providing of training; arranging and conducting conferences, congresses, seminars, symposiums and exhibitions; organising of concerts; organising of lotteries.

Class 42

Industrial and commercial research.

Class 43

Child care services; accommodation services; holiday booking services.

Class 44

Medical assistance; convalescence services.

Class 45

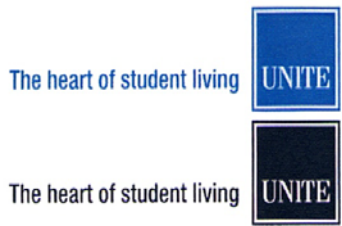
Legal services; legal research; will writing services; representation of

employees and workers; negotiation services for pay and conditions for employees; funeral assistance; health and safety representation and assistance.

3. Both applications were published on 16 November 2007 following which notices of opposition to them were filed by The Unite Group Plc (“Group”). The objections are based on the following grounds:

- Under section 5(2)(a) of the Act. This objection relates only to application no. 2453833 against limited services in classes 36 and 43 and is based on Group’s earlier Community Trade Mark (“CTM”) no. 1328079;
- Under section 5(2)(b) of the Act. In respect of application no. 2453838 the objection is based on CTM no. 1328079 and is against limited services in classes 36 and 43. Additionally, and in respect of both applications, the objection is based on Group’s earlier mark no. 2401561 and is against a limited range of goods and services in classes 16, 35, 36 and 43;
- Under section 5(3) of the Act against all goods and services of both applications and based on CTM no. 1328079 and application no. 2401561;
- Under section 5(4)(a) of the Act against goods and services in classes 16, 35, 36 and 43 of both applications and based on use of the mark UNITE since 1998.

4. Since the filing of the oppositions, Group’s CTM no. 1328079 has been subject to revocation proceedings which have resulted in its specification being amended. Taking that amendment into account, the details of Group’s marks as now registered are as follows:

| No | Mark | Application/ Registration Date | Specification |
|----------------|---|--------------------------------------|--|
| CTM 1328079 | UNITE | 30.9.1999/ 27.5.2002 | Class 36 Real estate management; leasing of real estate; management of residential and commercial properties; leasing of commercial and residential properties; housing agency services |
| 2401561 |  | 14.9.2005/ 29.9.2006 | Class 16 Printed publications relating to real estate, the provision of accommodation, and/or student living; printed city guides Class 36 Provision, leasing and rental |

| | | |
|--|--|--|
| | | <p>of accommodation; provision and leasing of buildings for use as temporary accommodation; leasing and rental of residential and commercial properties; real estate management; the management of residential and commercial properties; arranging accommodation; accommodation management and administration; provision of information relating to real estate and accommodation; accommodation booking and allocation services; capital investment in real estate; financial services; insurance brokerage; insurance services; arrangement of loans; research, consultancy and advisory services relating to real estate and the provision of accommodation including identification of potential sites for new accommodation.</p> <p>Class 37 Real estate development; building construction; repair, refurbishment, conversion and installation services relating to properties; maintenance of buildings and utilities in buildings; advisory services relating to property development; construction of interior accommodation; installation of fixtures, fittings, furniture and furnishings; installation of apparatus for security, lighting, fire detection and alarms, heating, ventilating, refrigerating and drying; installation of electric</p> |
|--|--|--|

| | | | |
|--|--|--|---|
| | | | <p>cabling; installation of apparatus and cabling for data and voice communication; maintenance and repair of utilities in buildings.</p> <p>Class 42 Real estate planning; building design services; architectural services; design services for buildings; interior design services and space planning; design of interior décor; and information, advisory and consultancy services relating to all the aforesaid services.</p> <p>Class 43 Provision of temporary accommodation and rental of temporary accommodation; provision of information relating to the availability of temporary accommodation; temporary accommodation booking and allocation services; providing facilities and accommodation for meetings, conferences, functions, exhibitions and conventions.</p> |
|--|--|--|---|

5. Union filed counter-statements in which it denied each of the grounds of opposition and put Group to proof of use of its mark (where applicable). The two sets of proceedings were consolidated. Both parties filed evidence. Some of Group's evidence has been made subject to an order for confidentiality withholding it from public inspection and I will take this into account when referring to it later in this decision.

6. Matters came before me for hearing on 1st July 2011. At that hearing, Ms Jessie Bowhill of counsel, instructed by Hogan Lovells International LLP, represented Union. Mr Guy Hollingsworth, also of counsel and instructed by Nabarro LLP, represented Group.

The evidence

Group's evidence

7. Amanda Williams is Group's Head of Corporate Communications. She has filed two witness statements, both dated 5 January 2009. Ms Williams states that Group "develops, manages and co-invests in commercial and residential property developments, and provides temporary accommodation services to students." It "develops and owns commercial and residential properties. It leases the commercial property to businesses and retailers, and the residential property to nurses, doctors, teachers and universities (as well as to students directly)."

8. Ms Williams states Group was founded in 1991 and was listed on the London Stock Exchange in 2000. She states Group is one of only seven real estate companies listed on the UK's FTSE 250 index. Between 2002 and 2006 Group invested over £900 million in acquiring and developing property into student accommodation throughout the UK. By 2006 it had a property portfolio under management with an approximate value of £1.435 billion and, at June 2008, that value had grown further to £1.7 billion with sites at 24 major towns and cities throughout the UK including Bristol, Cardiff, Edinburgh, London, Nottingham, Plymouth and Sheffield. Total turnover from Group's rental income is given as follows:

| Year | £m |
|------|------|
| 1999 | 2.8 |
| 2000 | 6.6 |
| 2001 | 15.2 |
| 2002 | 32.4 |
| 2003 | 48.1 |
| 2004 | 66.8 |
| 2005 | 86.1 |
| 2006 | 97.9 |
| 2007 | 82.2 |

9. Ms Williams states Group's commercial properties are either stand alone commercial developments or commercial space within student accommodation buildings. Turnover figures generated from leasing and managing its commercial properties (and generated from the rental income and service charges for those properties) are given as:

| | |
|------|--------|
| 2004 | £1.92m |
| 2005 | £2.37m |
| 2006 | £2.45m |
| 2007 | £2.48m |

10. Ms Williams states leases have been granted to a range of tenants including Tesco, Sainsbury's and The Camden Society. Sample leases granted between December 2003 and July 2007 are exhibited at AW3 which is subject to an order for confidentiality from the public but are extracts said to be from lease agreements

made between Group's licensed subsidiaries, each of whom contain the word UNITE within their name, and commercial enterprises. Ms Williams goes on to state that commercial properties are marketed through agents with expertise in the local market. At AW1 are exhibited copies of (dated) brochures issued in 2006. The first relates to retail units in Bristol which are described as forming part of a new student accommodation and which is "immediately adjacent to one of UNITE's existing student accommodation buildings". The leaflet bears several references to UNITE in the text and also shows trade mark no. 2401561. The second brochure advertises two self contained office suites in Edinburgh. The text explains that "UNITE have recently purchased this site" which will benefit from "the security measures implemented by UNITE". The word UNITE is also shown within a squared, blue border. At AW4 are exhibited a number of invoices said to have been issued by Group or its licensed subsidiaries. Each invoice has been issued by a company containing the word UNITE within its name. The invoices bear dates between 20 February 2004 and 23 November 2006 and relate to properties in Liverpool, Bristol and Manchester with some listed as being shop or restaurant premises. The invoices issued in 2004 and 2005 bear the word UNITE within a square border at their top right hand corner. In the same position on those issued in 2006, is trade mark no. 2401561,

11. As indicated above, Group's residential properties are said to be leased to universities, direct to students and to key workers (said to be doctors, nurses and teachers). In 2007 Group leased 19 properties to universities, raising a rental income of some £13.1m. Previous years are said to have raised just under £13m. Copies of leases agreed with two universities in Sept 2004 and July 2005 by companies containing the word UNITE within their names, and again subject to an order for confidentiality from public inspection, are exhibited at AW7. Key worker properties are marketed and leased direct to these workers as well as through NHS Health Trust nomination schemes. At AW10 are exhibited extracts from two nomination agreements. Again, these documents have been made subject to an order for confidentiality from public inspection but they relate to properties in London and Bristol and show agreements entered into by companies with UNITE within their names. They date from February 2000 and July 2001 but Ms Williams indicates that both are still effective and in force.

12. Turnover figures from the leasing and management of residential properties to key workers for 2004 to 2007 are given as follows:

| | |
|------|--------|
| 2004 | £6.51m |
| 2005 | £6.30m |
| 2006 | £6.27m |
| 2007 | £6.18m |

13. In relation to property for students, the evidence shows that the market in such accommodation is measured by reference to the number of 'bed spaces' or 'student beds' (see AW16-AW19). Ms Williams states that Group is the largest provider of student accommodation in the UK, managing accommodation for some 37,000 students with some 35,446 bed spaces in the UK at the relevant date. At AW16 she exhibits a report from the property consultants King Sturge. The report is entitled 'UK Student Accommodation Market 2008' and reports on the position of the market at

September 2007. The report indicates that there were 123,536 student beds in the market at that time with Group the leading player with a market share of just over 28%. This is a higher percentage than the total of its two nearest competitors put together. It is also more than double that of its nearest competitor as can be seen from the following explanatory table taken from the report:

| Name | Completed Beds | Beds in pipeline | Total |
|---------------------|----------------|------------------|-------|
| 'Group' | 34930 | 11204 | 46134 |
| UPP | 15682 | 3554 | 19236 |
| Opal Property Group | 13157 | 5740 | 18897 |

14. At AW17 is exhibited a report from Frank Knight entitled 'The student Accommodation Review 2008'. It estimates there were a total of around 130,000 bed spaces at that time and describes Group as having "by far the greatest number of them in the market". It provides the following table of the number of bed spaces:

| Name | Current (April 2008) | Pipeline |
|---------|----------------------|----------|
| 'Group' | 38522 | 10164 |
| UPP | 16000 | 3550 |
| Opal | 15500 | 5800 |

15. At AW18 is exhibited the CB Richard Ellis Hamptons International UK Student Accommodation market report for September 2007. It also provides a table showing the top providers of student bed spaces, the top three of which are as follows:

| Name | No of Beds | No of locations |
|---------|------------|-----------------|
| 'Group' | 35005 | 29 |
| UPP | 17193 | 8 |
| Opal | 16000 | 18 |

16. Whilst these reports refer to dates slightly after the relevant date, I have no reason to doubt that the position had changed markedly in the intervening period. I am supported in my view by the Savills Student Housing Report from summer 2007 exhibited at AW19. The report states that Group "remains dominant in the sector" and owns nearly 30% of all privately owned bed spaces with another 4500 in the pipeline. It includes the following table showing the position in 2005 and 2007 of the then top three providers:

| Name | Beds 2005 | Beds 2007 |
|---------|-----------|-----------|
| 'Group' | 31000 | 33944 |
| Opal | 8500 | 16000 |
| UPP | 14679 | 16000 |

17. Ms Williams states Group also provides real estate management services to third parties, either direct or through licensed subsidiaries. The third parties are said to be entities in which Group has a joint venture or other interest and include Lehman Brothers and GIC Real Estate. Ms Williams states that Group remains responsible for the management of the properties once they have been completed.

18. Group's management services are said to include services such as providing (or the procurement of) cleaning, maintaining and lighting common parts, providing and maintaining signage and plant displays. Reference to the provision of management services are shown in the leases and nomination agreements exhibited at AW3, AW7 and AW10. Invoices showing service charges (which are typically charged for as a separate item to rent) are shown on two of the invoices included within Exhibit AW4 which both date from 2006. Revenue from real estate services for the years 2005-2007 are given as follows:

| | |
|------|-------|
| 2005 | £0.6m |
| 2006 | £1.5m |
| 2007 | £3.9m |

19. Ms Williams states Group has used a variety of media to promote and market its services. It has used outdoor advertising on billboards and hoardings as well as on buses, vans and 'pedicabs'. It has produced flyers which have been handed out by uniformed 'hit squads' of marketing teams in town centres as well as at university events such as freshers' fairs. It has advertised by direct mailing, in magazines and newsletters and in publications produced by universities. Group also has a number of websites (unite-group.co.uk, unite-keyworkers.co.uk, unite-students.com and unite.students.co.uk) which have been in continuous operation since their respective launches in 2000 or 2001. It also advertises on the Student Television Network. Material relating to this use is exhibited at AW23-60 which shows within the text of use of the word UNITE as well as the word UNITE within a squared border and mark no. 2401561.

20. At AW14 are extracts from Group's annual reports for 2004 to 2007. Extracts from the 2004 edition comprise of a copy of the front cover and one internal page. The cover bears the word UNITE within a squared background. The text refers to Group's property management services and 'beds in development'. The 2005 report bears the earlier mark no. 2401561 and is entitled "Students come home to UNITE". The text mentions Group's "non-rental activities, including the provision of management, consultancy and modular construction services to its joint ventures" but makes clear that its main focus is to "continue to build on its strong foundations, its expertise and the opportunities present in our market to capitalise on our position as the UK's leading provider of student hospitality". The 2006 report also bears mark 2401561 and is entitled "Class of 2006". The text makes multiple references to student accommodation and indicates that Group is testing "a stronger presence on the high street" by opening a "dedicated student shop in a prime student location. It has become a one-stop destination for London students and their parents looking for a UNITE place to live" The 2007 report again shows earlier mark no. 2401561 and is entitled "Shaping the student landscape". The text contains "An introduction to UNITE" and describes "UNITE [as being] the pioneer and specialist in the student accommodation sector".

21. Marketing spend under the marks is given as follows:

| | |
|------|---------------|
| 2003 | £80,000 (est) |
| 2004 | £89,650 |
| 2005 | £41,910 |
| 2006 | £67,252 |
| 2007 | £234,167 |

22. Ms Williams explains that the increase in marketing expenditure in 2007 is due to the extra costs involved in the creation and development of the mark as shown in earlier mark no 2401561 which was launched in 2006 (In fact some exhibits show it to have been used in 2005 see e.g. annual reports at AW14 and invoices at AW15).

23. Ms Williams states that Group's core service is known best by students, parents and universities but that its reputation extends to the wider higher education sector. At AW61-70 she exhibits a number of reports and publications which Group has commissioned, supported, produced or otherwise been involved in. These include copies of the annual Student Experience Report, first published in 2000. The 2005 edition shows it to have been "commissioned by UNITE in association with HEPI and conducted by MORI". At AW66 are three editions of Campus Life, which appears to be Group's newsletter for students. None of the three are dated but, from information included within them, they appear to have been published in early, mid and late 2007 respectively.

24. Ms Williams states Group has won a number of industry awards and accreditations and gives details of those relevant to 2005 and 2006. In 2006, for example, Group won the 'Management Today/Unisys Service Excellence Award' (Retail category). It was granted Investors in People accreditation in 2005. The other awards she lists relate to Group's performance (or that of individual members of its staff) in the customer service, HR practice, communication and training areas (see AW71-77).

25. Ms Williams states that Group has received widespread publicity through newspaper reports in national and local press as well as in the real estate trade press. A selection of articles is exhibited at AW78. The articles refer to Group, date from 2002 to 2007 and include, for example, those published in the Evening Standard, Aberdeen Press & Journal, South Wales Echo, Birmingham Post, Sunday Times, Daily Telegraph and the Guardian. The extract from the Evening Standard dated 13 September 2002 refers to "UNITE, the specialist developer of student accommodation...". Citywire Funds Insider October 2002 refers to "Unite [providing] accommodation for key workers-such as nurses-and students and has a strong position in the market". The Bristol Evening Post extract from 23 September 2005 tells how "Developers Unite Group wanted to turn the offices into 159 self-contained flats and studios for students and low income workers...". The article in Finance of 11 August 2006 states "Unite's business model could hardly be simpler. It develops, manages and lets accommodation for students".

Union's evidence

26. This takes the form of a witness statement by Shubha Banerjee who has been employed as Union's solicitor since October 2007.

27. Ms Banerjee states that Union started using "the brand" in May 2007 when Union was created through the merger of two other unions (Amicus (the original applicant for the two marks now under consideration) and the T&G Union). She states that Union is the largest trade union in the UK with "approximately 1.5 million members employed in over twenty industrial, occupational and professional sectors including local government, the NHS, retail, transport, manufacturing, aviation, agriculture and food, construction and the services sector". Union's business activities are said to "have grown such that [it] is now active at a national, European and international level in the campaign to protect the rights, health, safety and wellbeing of members in their workplaces".

28. Ms Banerjee exhibits a number of news articles at SB3 to SB6 to show the range of activities Union has been involved in. They relate to such matters as e.g. potential strike action by its members, its relationship with various Labour Party officials, its response to news of job cuts and pay freezes and its sponsorship of anti-racism events and support for migrant workers including those facing deportation because of their legal status. All of this material dates from well after the relevant date in these proceedings.

29. At SB7 are exhibited printouts from Union's website. Whilst there are some said to show the website in 2008, most show them to have been downloaded on 21 December 2010. All are after the relevant date. The exhibit also includes some archive pages of the website as it appeared in an unspecified date in 2007. The printout is incomplete but does state that the website is under construction.

30. At SB8 are results of a Google search said to show the results of searches for UNITE and UNITE THE UNION. The printouts show the searches to have been carried out in December 2010, well after the relevant date.

31. The remainder of Ms Banerjee's witness statement consists, essentially, of submissions which I do not summarise here but will take into account as appropriate.

32. That completes my summary of the evidence to the extent I consider it necessary.

Decision

33. Sections 5(2) and 5(3) of the Act state:

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

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

- (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.

(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 a Community trade mark or international trade mark (EC) 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”.

34. 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,
- (b)
- (c)

(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.”

35. In respect of its opposition under sections 5(2) and 5(3) of the Act, Group is relying on two trade marks, each of which has an application date prior to that of the application for registration. Each therefore qualifies as an earlier trade mark under the above provisions. The applications for registration were published for opposition purposes on 16 November 2007, whilst the earlier marks were registered on the dates shown in paragraph 4 above. As CTM no. 1328079 completed its registration procedure more than five years before the publication date of the marks for which registration has been applied, the provisions of section 6A of The Trade Marks (Proof of Use, etc) Regulations 2004 are relevant to this mark. Section 6A states:

“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 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 period of five years ending with the date of publication.

(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 period of five years ending with the date of publication of the application 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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)

(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.

(7)....”

36. Also of relevance is section 100 of the Act which states:

“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.”

37. As the proof of use requirements apply only to Group's earlier CTM no. 1328079, I go on to consider whether, and if so to what extent, use has been made of it. The relevant period within which use is to be shown is 17 November 2002 to 16 November 2007.

38. The guiding principles to be applied in determining whether there has been genuine use of a mark are set out in *Ansul BV v Ajax Brandbeveiliging BV* [2003] RPC 40 and *Laboratoire de la Mer Trade Mark* [2006] FSR 5. From these cases it is clear that:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);
- the use must be 'on the market' and not just internal to the undertaking concerned (*Ansul*, paragraph 37);
- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);

- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

39. The use relates to use of a Community trade mark. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 the GC stated:

“32 To examine whether an earlier trade mark has been put to genuine use, an overall assessment must be carried out, which takes into account all the relevant factors of the particular case. That assessment entails a degree of interdependence between the factors taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or very regular, and vice versa. In addition, the turnover and the volume of sales of the product under the earlier trade mark cannot be assessed in absolute terms but must be looked at in relation to other relevant factors, such as the volume of business, production or marketing capacity or the degree of diversification of the undertaking using the trade mark and the characteristics of the products or services on the relevant market. As a result, the Court has stated that use of the earlier mark need not always be quantitatively significant in order to be deemed genuine. Even minimal use can therefore be sufficient to be deemed genuine, provided that it is viewed as warranted in the economic sector concerned in order to maintain or create a share in the market for the goods or services protected by the mark (*VITAFRUIT*, paragraph 27 above, paragraph 42, and *LA MER*, paragraph 26 above, paragraph 57; see, by analogy, *Ansul*, paragraph 24 above, paragraph 39, and the order in Case C-259/02 *La Mer Technology* [2004] ECR I-1159, paragraph 21).”

40. Ms Williams’ evidence shows Group to have been founded in 1991. Her evidence shows Group to have used a number of marks since its inception. In the earlier dated evidence the word UNITE appears on its own and throughout the text in upper case form. The brochure at AW1, for example, dates from 2006 and refers to ‘the UNITE Phoenix Court development at Market Gate’ and says the property:

“...will be immediately adjacent to one of UNITE’s existing student accommodation buildings...”

41. In other evidence (e.g. AW4 and AW6 which date from 2004 onwards) the word UNITE is presented within a squared border (i.e. as the word itself appears in earlier mark no 2401561). It is established case law that to qualify as genuine, use of a mark must be in the form registered or in a form which does not alter the distinctive character of the mark in the form in which it is registered. In *Budejovicky Budvar Narodni Podnik v Anheuser-Busch Inc (BUD)* [2003] RPC 25 the Court of Appeal dealt with this issue. Lord Walker stated:

“43....The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?”

44 The distinctive character of a trade mark (what makes it in some degree striking and memorable) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis. The same is true of any striking and memorable line of poetry:

“Bare ruin’d choirs, where late the sweet birds sang”

is effective whether or not the reader is familiar with Empson’s commentary pointing out its rich associations (including early music, vaultlike trees in winter, and the dissolution of the monasteries.

45 Because distinctive character is seldom analysed by the average consumer but is capable of analysis, I do not think that the issue of “whose eyes? –registrar or ordinary consumer?” is a direct conflict. It is for the registrar, through the hearing officer’s specialised experience and judgment, to analyse the “visual, aural and conceptual” qualities of a mark and make a “global appreciation” of its likely impact on the average consumer, who “normally perceives a mark as a whole and does not proceed to analyse its various details.”

42. In *Boura v Nirvana Spa & Leisure Ltd* BL O/262/06 Mr Richard Arnold QC, sitting as the appointed person, stated:

“15. It is clear from BUD and BUDWEISER BUDBRÄU and the four Court of First Instance cases that the normal approach to the assessment of distinctive character applies in this context. As the European Court of Justice has reiterated in numerous cases, the distinctive character of a trade mark must be assessed (i) in relation to the goods or services in question and (ii) according to the perception of the average consumer of those goods or services, who is deemed to be reasonably well-informed and reasonably observant and circumspect.”

He went on to say::

“33... The first question is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether the sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down into the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does

not depend upon the average consumer not registering the differences at all...”

43. Whilst some of the use shown places the word UNITE within a square, there is nothing particularly unusual about that square. It acts merely as a background to the word within it. I do not consider that the squared background alters the distinctive character of the earlier mark which remains firmly with the word UNITE. As set out above, many exhibits, which comprise a variety of documents, show the word UNITE consistently presented in plain block capitals within the text. This gives the word trade mark presence as it stands out from the words around it. When considered as a whole, I am satisfied the evidence shows that genuine use has been made of the earlier mark. I therefore go on to consider the question of on which services such use has been made.

44. In doing so, I must keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, in relation to determining what constitutes a fair specification, namely:

“Pumfrey J in *Decon* suggested that the court’s task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view the task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use”.

45. In *Animal Trade Mark* [2004] FSR 19, Jacob J held:

“The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White’s brilliant and memorable example of a narrow specification) “three-holed razor blades imported from Venezuela” is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say “razor blades” or just “razors”. Thus the “fair description” is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection (“the umbra”) for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods (“the penumbra”). A lot depends on the nature of the goods—are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

46. Also of relevance are the comments of the Court of First Instance in *Reckitt Benckiser (España) SL v OHIM*, Case T-126/03 where it said:

“45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of ‘part of the goods or services’ cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.”

...

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category.”

47. Finally, I take into account the comments of Mr Geoffrey Hobbs QC, sitting as the appointed person in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10, where he stated:

“...I adhere to the view that I have expressed in a number of previous decisions. In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

48. In its notices of opposition, Group claims to have used the mark on the following services:

Real estate management; leasing of real estate; management of residential and commercial properties; leasing of commercial and residential properties; consultancy and advisory services relating to all the aforesaid services

however, as Mr Hollingsworth accepted at the hearing, ‘consultancy and advisory services’ are not specified in the registration and cannot therefore form part of my consideration of whether genuine use has been made of the mark in relation to the services for which it is registered. Whilst the evidence filed supports Union’s view that Group’s primary concern is its involvement in the student accommodation market, that same evidence also shows use of the mark in the relevant period, and which is not token, in relation to the commercial market including such services to restaurants, shops and supermarkets (e.g. AW3 and AW4 which date from 2003-2007). There is also some, much more limited, evidence of the advertising and provision of office accommodation and residential premises to keyworkers, described as nurses, doctors and teachers (e.g. AW8 and 9 which cover the period from 2001 to 2008 and AW10, accommodation agreements which date from before the relevant period but which are said to still be in force). The evidence also shows that Group is responsible for the management of various properties, e.g. undertaking the maintenance of common areas of student accommodation blocks for which it imposes service charges.

49. The use shown relates to both commercial and residential properties. Whilst turnover relating to the lease and management of commercial properties (which has been shown to include restaurants, shops and offices) is not extensive (particularly in view of the likely size of the market) it has been consistently around £2 million per annum. In terms of residential properties, the evidence shows a much greater turnover with that use being in relation to the provision of accommodation to a range of people seeking accommodation in which to live. Taking all of the above into account and in light of the evidence filed, I am satisfied that genuine use has been shown of earlier mark no 1328079 in respect of the services set out in paragraph 48 above with the exception of *consultancy and advisory services relating to all the aforesaid services*..

50. I therefore go on to consider the objections raised under sections 5(2)(a) and (b) of the Act. In determining whether there is a likelihood of confusion, I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [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* [2000] E.T.M.R.723, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di Laudato & C. Sas v OHIM* C-334/05 (Limoncello). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors: *Sabel BV v Puma AG*, paragraph 22;

- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question: *Sabel BV v Puma AG*, paragraph 23, 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 he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen B. V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel BV v Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki v Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma Ag*, paragraph 24;
- (g) in determining whether similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer inc*; mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*, paragraph 26;
- (h) further, 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; *Marca Mode CV v Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 29;
- (j) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its

components; *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*;

- (k) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L Laudato & C. Sas v OHIM*.

The objection under section 5(2)(a) of the Act

51. The objection under this ground is directed at application no 2453833 only and is based on the earlier CTM 1328079.

Comparison of marks

52. Both marks are for the word UNITE presented in plain block capitals. In each case, the mark has no dominant elements; its distinctiveness rests in its totality. Self evidently the respective marks are identical.

The services to be compared

53. For ease of reference, the services to be compared under this ground are as follows:

| Group's earlier mark | Union's application |
|---|--|
| Class 36: Real estate management; leasing of real estate; management of residential and commercial properties; leasing of commercial and residential properties. | Class 36: Financial and insurance consultancy services; financial information; financial management and financing services. Class 43: Accommodation services. |

The average consumer and the nature of the purchasing process

54. I have to assess who the average consumer is for the services at issue (*Sabel*). Group's management services will be used by property owners looking for someone to manage that property. Consumers of its other services will include those seeking to lease a property, whether that is an individual looking for a place to live, an organisation wishing to enter into agreements for the provision of accommodation for those who use or provide its services (such as the staff of a hospital or students of a university) or a commercial enterprise looking to lease a property to house its business. Union's services in class 36 all relate either to finance or insurance for which the average consumer will be somebody (whether an individual or corporation) seeking advice and information on such matters or seeking to finance or insure e.g. an asset. Its services in class 43 are the provision of accommodation for which the average consumer is described above. All of these services are such as will be purchased with a fair degree of care. They are services which are likely to involve consideration and completion of forms or other paperwork and, most likely, will

involve relatively detailed discussions. Both visual and aural considerations are therefore likely to play important roles in the overall comparison of the respective marks.

Comparison of the respective services

55. The significance of classification and the relevance of class numbers have been considered by the courts in *Altecnic Ltd's Trade Mark Application (CAREMIX)* [2002] RPC 639 and *Avnet Incorporated v Isoact Limited* [1998] FSR 16. In *Proctor & Gamble Company v Simon Grogan*, O-176-08, Anna Carboni, sitting as the appointed person, referred to *Altecnic* and said:

“34.....The Court of Appeal has held that, although the purpose of classifying goods and services is primarily administrative, that does not mean that the class numbers in an application have to be totally ignored in deciding, as a matter of construction, what is covered by the specification: *Altecnic Ltd's Trade Mark Application (CAREMIX)* [2001] EWCA Civ 1928, [2002] RPC 639. But neither the Court of Appeal, nor the ECJ, nor any other court or tribunal in the United Kingdom, has gone so far as to state that class numbers are determinative of the question of similarity of goods in the case of national trade marks. On the contrary, they are frequently ignored.”

56. In *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 280 (“TREAT”), Jacob J said (at 289):

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all, a trade mark specification is concerned with use in trade.”

He went on (at 295) to set out the following factors as being relevant to the question of similarity of services without reference to the classes in which they may fall:

- (a) the respective uses of the respective services;
- (b) the respective users of the respective services;
- (c) the nature of the services;
- (d) the respective trade channels through which the services are marketed;
- (e) the extent to which the respective services are competitive. This inquiry may take into account how those in trade classify the services, for instance whether market research companies put them into the same or different sectors.

57. Subsequently, in *Canon Kabushiki Kaisha v MGM Inc* the ECJ stated:

“23. In assessing the similarity of the goods or services concerned.....all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.”

58. In Case T-420/03 – *El Corte Inglés v OHIM- Abril Sanchez and Ricote Sauger* (Boomerang TV) the CFI commented:

“96.....Goods or services which are complementary are those where 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 the production of those goods or provision of those services lies with the same undertaking (Case T14169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, and judgment of 15 March 2006 in Case T-31/04 *Eurodrive Services and Distribution v OHIM – Gomez Frias* (euroMASTER), not published in the ECR, paragraph 35).”

59. I also take into account Jacob J's comment in *Avnet* (supra) where he said:

“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 meaning attributable to the rather general phrase.”

60. As far as concerns the comparison between the services of Group's earlier mark with those of Union's application in class 43, Union accepts these are similar services despite them being recorded in different classes. In my view they are highly similar.

61. As for its services applied for in class 36, Union denies there is any similarity with the services of Group's earlier mark. For its part Group submitted at the hearing that whilst it agrees that the similarity between its services and Union's services in class 36 is less high than those covered by Union's services in class 43, they are nevertheless still similar on the basis that they are complementary services.

62. All of Group's services relate to the leasing and management of real estate or property. The users of these services will be those individuals and businesses seeking a property in which to live or from which to run a business or those who have property already and who seek to engage the services of someone to manage or let that property. Union's services relate to finance and insurance and will be used by those seeking help with financial or insurance matters (who may or may not be property seekers/owners). The natures of the respective services differ as do the uses. Whilst I accept that some people or businesses will need financial advice when arranging the acquisition of property and may well seek advice on insuring that property, this does not, in my view, make them complementary services. Financial advice may be needed for many types of purchases (e.g. when buying a vehicle or setting up in business) and careful purchasers may seek information on insuring the purchase or venture but that does not mean that one is essential for the other or that consumers would think that responsibility for the respective services lies with the same provider. In my view the respective services in class 36 are not similar. Likelihood of confusion can only occur where the services are similar and thus, the likelihood of confusion cannot occur in relation to those services in class 36 of the application.

Distinctiveness of the earlier mark

63. I also have to take into account the distinctive character of the earlier trade mark having regard to its inherent characteristics and the reputation it enjoys with the public. Union contend that, at best, Group's mark is known only by a small proportion of the UK population, that being a small number of students when considering the size of the overall student market. Whilst Group may provide accommodation to a minority of students when compared with the overall number of students there may be at any given point in time, it is likely, given e.g. its marketing activities and presence in areas of student population, that a greater number of students are aware of its services. In any event, the evidence, which comes from a variety of sources, shows Group consistently to have been the leading provider, by number of student beds, within its sector of the student accommodation market for a number of years. I have found that the use shown extends wider than the student market and encompasses the wider residential and commercial markets. I have set out above the turnover figures achieved through use of the mark over a number of years across the range of services for which the earlier mark is registered. Whilst it is a leading provider of accommodation for students, I have no evidence which allows me to put the use of the mark into any sort of context in relation to the wider property market (a market which must be of immense size). I have no doubt that the distinctive character of the mark has been enhanced through its use, particularly in relation to its use in the student property market. Even if I am wrong in this, the mark has a reasonably high degree of inherent distinctive character.

Likelihood of confusion

64. In reaching a decision of the likelihood of confusion, I have to take into account all relevant factors. I have found the marks to be identical. I have found Union's *accommodation services* in Class 43 to be highly similar to those of Group's earlier mark. In view of this, and on a global appreciation, I consider there is a likelihood of confusion in respect of Union's application as far as it seeks to be registered for services in class 43.


65. As for Union's application for registration of services in class 36, I have found them not to be similar to the services covered by Group's earlier mark and thus I do not consider there to be a likelihood of confusion between the respective services.

66. The objection against Union's application and brought under the provisions of section 5(2)(a) therefore succeeds in respect of *accommodation services* but fails in respect of *Financial and insurance consultancy services; financial information; financial management and financing services*.

The objection under section 5(2)(b) of the Act

67. Union's application no 2453833 also attracts objection by Group under the provisions of section 5(2)(b) of the Act. The objection is founded on earlier mark no 2401561.

68. For ease of reference, I set out below the respective marks along with the relevant goods and services to be compared:

| Group's earlier mark no. 2401561 | Union's application no. 2453833 |
|---|---|
| <div style="text-align: center;">  </div> <p>Class 16 Printed publications relating to real estate, the provision of accommodation, and/or student living; printed city guides</p> <p>Class 36 Provision, leasing and rental of accommodation; provision and leasing of buildings for use as temporary accommodation; leasing and rental of residential and commercial properties; real estate management; the management of residential and commercial properties; arranging accommodation; accommodation management and administration; provision of information relating to real estate and accommodation; accommodation booking and allocation services; financial services; insurance brokerage; insurance services; arrangement of loans; research, consultancy and advisory services relating to real estate and the provision of accommodation including identification of potential sites for new accommodation.</p> <p>Class 43 Provision of temporary accommodation and rental of temporary accommodation; provision of information relating to the availability of temporary accommodation; temporary accommodation booking and allocation services.</p> | <p>UNITE</p> <p>Class 16 Printed matter, publications, newsletters, brochures, instructional and teaching materials, leaflets, booklets.</p> <p>Class 35 Accountancy advisory services; tax analysis and tax return preparation services; providing commercial assistance and information; provision of business information.</p> <p>Class 36 Charitable fund raising; financial and insurance consultancy services; credit card services; financial information; financial management and financing services.</p> <p>Class 43 Accommodation services</p> |

The average consumer and the nature of the purchasing process

69. The respective goods in class 16 are such as would be bought by the general public with printed publications with a specific subject matter being bought by those

members of the public with an interest in that subject. The goods are everyday ones which are widely available and likely to be of relatively low cost.

70. With the exception of *provision of business information*, the services of class 35 are most likely to be purchased by individuals such as self employed traders and other commercial enterprises looking for e.g. assistance in preparing financial and tax records and submitting them, where necessary, to the relevant authorities. That said, I do not exclude the possibility that non-trading individuals may also seek assistance with such matters. The provision of business information is most likely a service to be used by another business. All of the services are such as may be commissioned on a one-off basis to address a particular need or may be subject of an ongoing service provided at regular intervals. The cost of the services will vary depending on the nature and frequency of the service provided. On whichever basis they are provided, they are services which are likely to be bought after a fair degree of consideration.

71. *Charitable fundraising* is a service which identifies, commissions and/or establishes methods of raising funds and will be used by charities to assist it in carrying out its business and are services likely to be bought following a fair degree of consideration and discussion. All of the remaining services in class 36 can be broken down into those relating to accommodation, those of a financial nature and those relating to insurance. These are services which may be bought by an individual (e.g. a homeseeker or someone looking for a loan) or by a business. They are services likely to involve e.g. extensive discussions and, most likely the completion of forms and other documentation and will be purchased with a good degree of care.

72. Earlier in this decision, I considered the average consumer and the nature of the purchasing process in respect of the services in class 43 and consequently there is no need to repeat that consideration here.

Comparison of goods and services

73. With the exception of *instructional and teaching materials* Union accepts that its specification in class 16 involves similar goods to those of Group's earlier mark. In my view the respective goods are identical given that those covered by the earlier mark are included in a wider term of the later mark (see *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) (MERIC)* Case T- 133/05). As *instructional and teaching materials* include materials in the form of printed matter, I consider these to be at least similar goods.

74. Union accepts that *accountancy advisory services* as appears in its specification within class 35 have a degree of similarity with *financial services* as is included within Group's specification within class 36 however it submits that the degree of such similarity is low. Given that accountancy relates to e.g. the monetary and tax affairs of a person or company all of which are financial services, I consider there is a somewhat higher degree of similarity between the respective services. *Tax analysis and tax return preparation services* are all services which relate to a person's fiscal affairs and would be included within, and therefore at least similar to, Group's *financial services* in class 36. That leaves *providing commercial assistance and*

information; provision of business information. These are services which have not been limited in terms of their subject matter and could include assistance with and information about any number of business areas including those areas of trade for which Group's earlier mark is registered. I consider that the respective services are similar.

75. *Charitable fund raising* are services which, as described above, encompass a range of activities. Whilst the ultimate aim of the activities might be to raise money, the core nature of the service itself is e.g. to identify, organise and promote various activities. I do not consider them to be similar services to any of Group's goods or services.

76. Union accept that its remaining goods as appears in class 36 are identical or similar to those which appear in Group's earlier mark. It also accepts that its services in class 43 are identical or similar to those of Group in the same class.

Comparison of marks

77. As I indicated earlier in this decision, Union's application is for the word UNITE presented in plain block capitals. Group's mark is a series of two which differ only as to colour. As far as the colour of the application is concerned, I take note of the comments made by Mr Geoffrey Hobbs QC, sitting as the appointed person in *Mary Quant Cosmetics Japan Ltd v Able C & C Ltd* BL O/246/08:

"10. The present oppositions under Section 5(2)(b) are based on the rights conferred by registration of a device mark recorded in the register in black-and-white. It follows that colouring is immaterial to the distinctiveness of the Opponent's device mark as registered and therefore irrelevant for the purposes of the assessment of similarity in both oppositions."

78. In *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch), Mann J stated:

"119. It is not clear to me that this is a debate which advances the case very much, but the position seems to me to be as follows. As a matter of principle the exercise involves comparing the offending sign with the registered mark and assessing the likelihood of confusion or association. The two things have to be compared. Since we live in a visual world, and signs are visual, some form of appearance has to be considered. If the registered mark is unlimited to colour then it is registered for all colours. This means that the colour of the offending sign becomes irrelevant. It will not be possible to say that its colour prevents there being an infringement. At this point one can take one of two courses, each of which ought to have the same result. The first is to imagine the registered mark in the same colour as the offending sign. The second is to drain the colour from the offending sign,. Either way one then has the material for comparison. One could even imagine them both in a third colour. It does not matter. So in a sense both Mr Purvis and Mr Bloch are right. As a matter of visual convenience it seems to me to be easier to imagine the registered mark in a colour than to imagine the offending sign drained of colour, and I propose to adopt that course."

79. The mark is a composite one. There is the word UNITE within a rectangular background to the left of which are the words 'The heart of student living'. Key guidance on how to approach issues of similarity involving composite signs was issued in *Medion AG v Thomson multimedia Sales Germany & Austria GmbH*, Case 120/04 as follows:

“29. In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32).

30. However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case and earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31. In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32. The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33. If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.

34. This would be the case where, for example, the owner of a widely-known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known. It would also be the case if the composite sign was made up of the earlier mark and a widely-known commercial name. In fact, the overall impression would be, most often, dominated by the widely-known mark or commercial name included in the composite sign.

35. Thus, contrary to the intention of the Community legislator expressed in the 10th recital in the preamble to the directive, the guarantee of the earlier mark as an indication of origin would not be assured, even though it still had an independent distinctive role in the composite sign.

36. It must therefore be accepted that, in order to establish the likelihood of confusion, it suffices that, because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by the composite sign is attributed by the public also to the owner of that mark.”

80. The word UNITE means the formation of an alliance or combined whole but has no particular meaning in relation to the goods and services applied for and so is distinctive of them. As for Group’s earlier mark, in my view the word UNITE is also distinctive element of this mark as it neither describes nor is it non distinctive for the goods or services for which the mark is registered. In my view, it is also the dominant element of the mark. The squared background is not particularly unusual and is simply a background to the word appearing within it. The words ‘The heart of student living’ are unlikely to be given trade mark significance and are not particularly distinctive in relation to goods or services intended for student life.

81. As both marks have the word UNITE within them, there is a degree of similarity from the visual perspective. The inclusion of other words within Group’s mark along with the word UNITE being presented on a squared background also leads to some visual differences between the respective marks. I consider the marks to be similar to a reasonable degree.

82. Whilst Group’s mark includes a number of words, the average consumer is likely to refer to it by the word UNITE which would make the respective marks aurally identical. Even if all of the words within Group’s mark were articulated, there would still be a reasonable degree of aural similarity between them given the commonality and positioning of the word UNITE.

83. The word UNITE is an ordinary everyday word with a well known meaning of joining or bringing together which is how the average consumer will see the mark. The word UNITE within Group’s mark will bring to mind the same image however the inclusion of the other words within the mark will, as I indicated above, give some context in that it will suggest the goods and services relate to student life.

Distinctiveness of the earlier mark

84. The evidence shows the earlier mark was first used in late 2005/early 2006 and, from the exhibits, it appears that this mark has been used (though not exclusively) on all documentation issued since that time (see e.g. invoices at AW4 and AW15 and the website pages at AW6). Whilst the evidence does not provide any breakdown of Group’s turnover in a way which would allow me to be certain of how to apportion it between Group’s two earlier marks, the figures provided by Ms Williams and set out above at paragraph 21 show that the introduction of earlier mark no. 2401561 now under consideration caused a marked increase in the marketing spend. I have no doubt that the distinctive character of the mark, which, inherently, is reasonably high will have been enhanced through its use particularly in relation to its use in relation to the student property market.

88. As indicated earlier in this decision, the earlier mark is not registered in respect of *consultancy and advisory services relating to all the aforesaid services* and so this cannot be relied upon by Group. I have already found that Group has proved use of its mark in respect of the other services on which it relies and so it is these services that I will take into account when making the comparison. For ease of reference I set out below the respective services to be compared:

| Group's earlier mark | Union's application |
|--|---|
| <p>36 Real estate management; leasing of real estate; management of residential and commercial properties; leasing of commercial and residential properties;</p> | <p>36 Financial and insurance consultancy services; financial information; financial management and financing services</p> <p>43 Accommodation services</p> |

89. I have already carried out a comparison of these services (see paragraphs 55-62 above). I found that the services of Group's earlier mark are highly similar if not identical to those in class 43 of Union's application. I found them not to be similar to Union's services in class 36. Similarly, my earlier comments on the average consumer of these services and the nature of the purchasing process are equally applicable here.



Comparison of marks

90. Group's mark consists of the word UNITE presented in plain block capitals. Its distinctiveness lies in its whole. Union's mark consists of a number of elements: there is the word UNITE written in lower case letters. Above this is a distinctive device element which is somewhat reminiscent of a twisted flag or flame. Underneath the word UNITE are the conjoined words THE UNION (with the words THE written in lower case letters and UNION written in upper case and emboldened font so they are easily identifiable as separate words). In my view, it is the word UNITE that is the dominant element within the mark given its position and size. It is also a distinctive element given that the words THE UNION would be descriptive of services provided by or on behalf of a union. Visually, I consider the marks to be similar to a reasonable degree. From an aural perspective, Union's mark is likely to be referred to as UNITE though I do not rule out that some may also articulate the words THE UNION. In any event, given the position of the word UNITE with the mark, there is a reasonably high degree of aural similarity between the respective marks. As I indicated above, the earlier mark will bring to mind a coming together. The mark applied for will also bring to mind a coming together, particularly so in view of the well known meaning of the words THE UNION and so the respective marks are conceptually similar.

Likelihood of confusion

91. Again, in reaching a decision on the likelihood of confusion between the respective marks, I have to take account of all relevant factors. I have found the respective marks to have a reasonable degree of visual similarity, a reasonably high degree of aural similarity and that they are conceptually similar. I have found the services applied for in class 36 not to be similar but those in class 43 to be highly similar if not identical. **On a global comparison I find there is a likelihood of indirect confusion and thus the opposition to Union’s application no. 2453838 based on Group’s earlier CTM no. 1328079 succeeds with respect to accommodation services in class 43 but fails in respect of the services applied for in class 36.**

92. Finally under the provisions of section 5(2)(b) of the Act, Group raises an opposition to Union’s application no. 2453838 based on its earlier mark no. 2401561. Again for ease of reference, I set out below, the respective marks:

| Group’s earlier marks | Union’s application |
|--|--|
| <p data-bbox="188 857 368 891">No 2401561</p> <div data-bbox="252 902 746 1173" style="text-align: center;">  <p data-bbox="252 976 595 1010">The heart of student living</p> <p data-bbox="252 1117 595 1151">The heart of student living</p> </div> <p data-bbox="188 1229 847 1375">Class 16 Printed publications relating to real estate, the provision of accommodation, and/or student living; printed city guides</p> <p data-bbox="188 1417 874 2029">36 Provision, leasing and rental of accommodation; provision and leasing of buildings for use as temporary accommodation; leasing and rental of residential and commercial properties; real estate management; the management of residential and commercial properties; arranging accommodation; accommodation management and administration; provision of information relating to real estate and accommodation; accommodation booking and allocation services; financial services; insurance brokerage; insurance services; arrangement of loans; research, consultancy and advisory services relating to real estate and the provision of accommodation including identification of</p> | <p data-bbox="898 857 1078 891">No 2453838</p> <div data-bbox="1002 1059 1206 1285" style="text-align: center;">  </div> <p data-bbox="898 1397 1302 1576">16 Printed matter, publications, newsletters, brochures, instructional and teaching materials, leaflets, booklets</p> <p data-bbox="898 1621 1382 1868">35 Accountancy advisory services; tax analysis and tax return preparation services; providing commercial assistance and information; provision of business information</p> <p data-bbox="898 1912 1398 2018">36 charitable fund raising; financial and insurance consultancy services; credit card services;</p> |

| | |
|---|--|
| <p>potential sites for new accommodation</p> <p>43 Provision of temporary accommodation and rental of temporary accommodation; provision of information relating to the availability of temporary accommodation; temporary accommodation booking and allocation services.</p> | <p>financial information; financial management and financing services</p> <p>43 Accommodation services</p> |
|---|--|

93. For reasons already given above, I consider each of the respective goods and services to be identical or similar with the exception of Union’s *charitable fund raising* in class 36 which I consider to be dissimilar to any of the goods or services of Group’s earlier mark.

94. Earlier in this decision I set out my findings as regards the average consumer of the above goods and services, the distinctiveness of the earlier mark and dominant and distinctive elements of both marks and commented on the enhanced distinctiveness of the earlier mark because of the use made of it. I do not consider it necessary to repeat my findings here.

95. The word UNITE is a dominant and distinctive element of both marks. Given the position of this word within each mark, there is a degree of visual similarity between them however, there are also some visual differences given the inclusion of the other words within each mark. It is likely that both marks will be referred to by the word UNITE which would lead them to be aurally identical though I do not rule out the possibility that the other words within the respective marks may be articulated which would highlight the differences between them. Conceptually, there is a high degree of similarity between the respective marks as each suggests a unity.

Likelihood of confusion

96. Again, in reaching a decision on the likelihood of confusion between the respective marks, I have taken into account all relevant factors. Having done so, I find that there is a likelihood of indirect confusion between them. **Group’s opposition to application no. 2453838 based on its earlier mark no. 2401561 therefore succeeds in respect of all goods and services for which it was brought with the exception of *charitable fund raising*.**

The objection under section 5(3) of the Act

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

“ 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 a 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.

98. Union has given no indication it seeks to rely on the defence of due cause and I therefore say no more about it.

99. In order to be successful in an objection based on section 5(3) of the Act, Group must prove each of the earlier marks on which it relies has a reputation. Reputation in this context means that the earlier trade mark is known by a significant part of the public concerned with the goods or services covered by that mark (see paragraph 26 of the CJEU's judgment in *General Motors Corp. v Yplon SA (CHEVY)* [1999] ETMR 122). The Court stated:

“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 promoting it.”

100. To benefit from the provisions of section 5(3) of the Act, the trade marks must be known by a significant part of the public concerned by the products or services covered (see *General Motors Corporation v Yplon SA* Case C-375/97). The CHEU stated

“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 promoting it.”

101. One of the trade marks relied upon by Group under section 5(3) of the Act is a Community trade mark. In *PAGO International GmbH v Tirol Milch registrierte Genossenschaft mbH* Case C-302/07 the CJEU considered the requirements for establishing a reputation in respect of a Community trade mark. It stated:

“30 The answer to the first question referred is therefore that Article 9(1)(c) of the regulation must be interpreted as meaning that, in order to benefit from the protection afforded in that provision, a Community trade mark must be known by a significant part of the public concerned by the products or services covered by that trade mark, in a substantial part of the territory of the Community, and that, in view of facts of the main proceedings, the territory of the Member State in question may be considered to constitute a substantial part of the territory of the Community.”

102. There can be no doubt from the evidence that Group's business under its marks has grown significantly and consistently since its launch in 1991. Whilst advertising spend is modest, turnover for the period 2004 to 2007 rose from £66.8m to £82.2m with trade in towns and cities throughout the UK. Reports by independent third parties over a number of years attest to the strength of the brand. I have no doubt

that both earlier marks relied upon have a reputation for the purposes of section 5(3) of the Act and I go on to determine to what that reputation relates.

103. Group claims to have a reputation in respect of all goods and services for which its earlier marks are registered. Earlier mark no 2401561 is registered, inter alia, in respect of goods in class 16. Whilst there is some evidence of Group having issued a number of what I take to be newsletters, these essentially are in the form of promotional material. There is no evidence of its having been involved in the market of printed publications or printed city guides as is included within the registration. No turnover figures or other information about whatever trade it might have had in these goods have been provided. It has not established that it has a reputation in respect of these goods.

104. Whilst, earlier in this decision, I found that Group's evidence was sufficient to find its earlier CTM no. 1328079 had been used on all services for which it is registered, the issue to be determined here is the extent of its reputation. Group claims to have a reputation in respect of a wide range of services in classes 36, 37, 42 and 43 as set out in paragraph 4 above. Whilst each of the services could be said to relate to real estate in some way, some more directly than others, the evidence does not support its claim to have a reputation in each of these services. Whilst the development of real estate will, no doubt, involve e.g. identifying a suitable location, arranging suitable financing, designing, constructing and fitting out a building before it can be let, the evidence does not show that Group has any reputation in these services. There is some, very limited, evidence that Group works with a number of 'partners' each, presumably with its own area of expertise though the evidence does not show the respective roles within that relationship or who is responsible for what aspect of the resulting business. What is clear from the evidence is that the overwhelming focus of Group's business, as it itself sets out in its most recent annual reports, is as a provider of student accommodation. There is some limited evidence that Group has let and maintained accommodation to a range of businesses such as shops and restaurants however this appears to be ancillary to its student focussed business as the evidence shows them to be located within the student accommodation blocks. Whilst there is some evidence of its providing accommodation to a range of individuals in e.g. the medical profession, this evidence is extremely limited and appears to relate to renewal of more historical leases rather than new business, a finding for which I find support in its most recent annual reports which focus solely on the provision of serviced student accommodation. Taking the evidence as a whole, I find that its reputation is established in relation to the provision of serviced accommodation to students.

105. Group's objections to Union's applications are directed against all of the goods and services of those applications. It puts its claims in the following way:

“ (c) Use of the Applicant's Mark is without due cause and would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the Opponent's Marks.

(d) It is apparent that the Applicant is a trade union. The services of representation of employees and workers and negotiation services for pay and conditions for employees, specified in Class 45 of the Applicant's Mark,

are the most characteristic of a union's activities. The remainder of the specification of the Applicant's mark covers (i) services in Classes 35, 36 and 41-45 that are ancillary to these activities; and (ii) goods in Classes 14, 16, 18, 21, 22, 24-26 and 28 that can be categorised as merchandising.

(e) Trade unions, although primarily concerned with conditions of employment and the workplace, often express broader social and political interests that, although may be representative of certain sections of society, are not aligned with the interests of everyone in society. Trade unions also, due to the nature of their activities, attract substantial publicity. For these reasons, use of the Applicant's Mark in relation to the those services specified in the Application that are most characteristic of a union's activities would have the detrimental effects on the Opponent's Marks noted in paragraph (c) above. Use of the Applicant's Mark in relation to the remainder of the goods and services specified in the Application would also have the effects noted in paragraph (c) above. These claims will be addressed in more detail in evidence."

106. In her witness statement Ms Shah states:

"...whilst it is in the nature of the services provided by the Union that a section of society – and any given consumer group – will applaud the activities of the Union and be positively attracted to the "UNITE" brand, others will inevitably disapprove of the Union's activities and think less well of the brand".

She goes on to say:

"Trade unions are primarily concerned with conditions of employment and the workplace, and as such their activity will of course be supported and applauded by a certain section of society. However, in addition to providing benefits to members and engaging in collective bargaining, trade union activity throughout history has also included industrial action and political activity.

The enforcement of industrial action and strikes in furtherance of particular goals, in particular, is disapproved of by large sections of society, from employers to the general public whose lives are disrupted as a result of strike action (for example, strike action affecting public services such as transport, medical services and so on).Use of the "UNITE" or a "UNITE"-based name in connection with this type of activity, amongst those who hold a negative view of trade union activity, will have an impact on the way in which they perceive the "UNITE" brand. They will no longer be attracted to the brand in a positive way, and this will damage the reputation of [Group's] Trade Marks.

Trade unions also engage in broader social and political struggle, advocating for social policies and legislation favorable to their members or to workers in general. As such, they are often closely aligned with political parties. In the UK, trade unions have been strongly aligned with the Labour Party, and opposed to the Conservative Party. The Union itself is active in voicing its opposition against the Conservative Party....A significant proportion of the UK

population, including students, is likely to hold an unsupportive or contrasting view. Moreover, political convictions tend to be strongly held. As such, campaigns of this nature are likely to stay in the minds of those who hold an unsupportive or contrasting view, and as a result the association created between this type of polemical activity and “UNITE” or a “UNITE”-based name will likely be long lasting.

There is a real risk that those who disapprove of a trade union’s activities in general, or the Union’s activities in particular, or both, will think less well of the “UNITE” brand. This will inevitably have a damaging effect on the brand”.

107. Ms Shah attaches a number of exhibits to her witness statement including newspaper and other articles downloaded from the Internet, most of which date from after the relevant date. The articles refer to a number of trade unions and their background as well as certain activities they have been involved in and provides some reaction to some of these activities

108. In *Intel Corporation Inc v CPM United Kingdom Ltd* Case C-252/07 the CJEU considered Article 4(4)(a) of Directive 2008/95/EC which is the basis of section 5(3) of the Act and stated:

“26 Article 4(4)(a) of the Directive establishes, for the benefit of trade marks with a reputation, a wider form of protection than that provided for in Article 4(1). The specific condition of that protection consists of use of the later mark without due cause which takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark (see, to that effect, in respect of Article 5(2) of the Directive, *Marca Mode*, paragraph 36; *Adidas-Salomon and Adidas Benelux*, paragraph 27, and Case C-102/07 *adidas and adidas Benelux* [2008] ECR-I-0000, paragraph 40).

27 The types of injury against which Article 4(4)(a) of the Directive ensures such protection for the benefit of trade marks with a reputation are, first, detriment to the distinctive character of the earlier mark, secondly, detriment to the repute of that mark and, thirdly, unfair advantage taken of the distinctive character or the repute of that mark.

28 Just one of those three types of injury suffices for that provision to apply.

29 As regards, in particular, detriment to the distinctive character of the earlier mark, also referred to as ‘dilution’, ‘whittling away’ or ‘blurring, such detriment is caused when that mark’s ability to identify the goods or services for which it is registered and used as coming from the proprietor of that mark is weakened, since use of the later mark leads to dispersion of the identity and hold upon the public mind of the earlier mark. That is notably the case when the earlier mark, which used to arouse immediate association with the goods and services for which it is registered, is no longer capable of doing so.

30 The types of injury referred to in Article 4(4)(a) of the Directive, where they occur, are the consequence of a certain degree of similarity between the

earlier and later marks, by virtue of which the relevant section of the public makes a connection between those two marks, that is to say, establishes a link between them even though it does not confuse them (see, in relation to Article 5(2) of the Directive, *General Motors*, paragraph 23; *Adidas-Salomon and Adidas Benelux*, paragraph 29, and *adidas and adidas Benelux*, paragraph 41).

31 In the absence of such a link in the mind of the public, the use of the later mark is not likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark.

32 However, the existence of such a link is not sufficient, in itself, to establish that there is one of the types of injury referred to in Article 4(4)(a) of the Directive, which constitute, as was stated in paragraph 26 of this judgment, the specific condition of the protection of trade marks with a reputation laid down by that provision.

.....

37 In order to benefit from the protection introduced by Article 4(4)(a) of the Directive, the proprietor of the earlier mark must adduce proof that the use of the later mark 'would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark'.

38 The proprietor of the earlier trade mark is not required, for that purpose, to demonstrate actual and present injury to its mark for the purposes of Article 4(4)(a) of the Directive. When it is foreseeable that such injury will ensue from the use which the proprietor of the later mark may be led to make of its mark, the proprietor of the earlier mark cannot be required to wait for it actually to occur in order to be able to prohibit that use. The proprietor of the earlier mark must, however, prove that there is a serious risk that such an injury will occur in the future.....

44 As regards the degree of similarity between the conflicting marks, the more similar they are, the more likely it is that the later mark will bring the earlier mark with a reputation to the mind of the relevant public. That is particularly the case where those marks are identical.

45 However, the fact that the conflicting marks are identical, and even more so if they are merely similar, is not sufficient for it to be concluded that there is a link between those marks.

46 It is possible that the conflicting marks are registered for goods or services in respect of which the relevant sections of the public do not overlap.

47 The reputation of a trade mark must be assessed in relation to the relevant section of the public as regards the goods or services for which that mark was registered. That may be either the public at large or a more specialised public (see *General Motors*, paragraph 24).

48 It is therefore conceivable that the relevant section of the public as regards the goods or services for which the earlier mark was registered is completely distinct from the relevant section of the public as regards the goods or services for which the later mark was registered and that the earlier mark, although it has a reputation, is not known to the public targeted by the later mark. In such a case, the public targeted by each of the two marks may never be confronted with the other mark, so that it will not establish any link between those marks.

49 Furthermore, even if the relevant section of the public as regards the goods or services for which the conflicting marks are registered is the same or overlaps to some extent, those goods or services may be so dissimilar that the later mark is unlikely to bring the earlier mark to the mind of the relevant public.

50 Accordingly, the nature of the goods or services for which the conflicting marks are registered must be taken into consideration for the purposes of assessing whether there is a link between those marks.

51 It must also be pointed out that certain marks may have acquired such a reputation that it goes beyond the relevant public as regards the goods or services for which those marks were registered.

52 In such a case, it is possible that the relevant section of the public as regards the goods or services for which the later mark is registered will make a connection between the conflicting marks, even though that public is wholly distinct from the relevant section of the public as regards goods or services for which the earlier mark was registered.

53 For the purposes of assessing where there is a link between the conflicting marks, it may therefore be necessary to take into account the strength of the earlier mark's reputation in order to determine whether that reputation extends beyond the public targeted by that mark.

54 Likewise, the stronger the distinctive character of the earlier mark, whether inherent or acquired through the use which has been made of it, the more likely it is that, confronted with a later identical or similar mark, the relevant public will call that earlier mark to mind.

55 Accordingly, for the purposes of assessing whether there is a link between the conflicting marks, the degree of the earlier mark's distinctive character must be taken into consideration.

56 In that regard, in so far as the ability of a trade mark to identify the goods or services for which it is registered and used as coming from the proprietor of that mark and, therefore, its distinctive character are all the stronger if that mark is unique—that is to say, as regards a word mark such as INTEL, if the word of which it consists has not been used by anyone for any goods or services other than by the proprietor of the mark for the goods and services it

markets- it must be ascertained whether the earlier mark is unique or essentially unique.

57 Finally, a link between the conflicting marks is necessarily established when there is a likelihood of confusion, that is to say, when the relevant public believes or might believe that the goods or services marketed under the earlier mark and those marketed under the later mark come from the same undertaking or from economically-linked undertakings (see to that effect, inter alia, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 17, and Case C-533/06 *O2 Holdings and O2 (UK)* [2008] ECR I-0000, paragraph 59).

58 However, as is apparent from paragraphs 27 to 31 of the judgment in *Adidas-Salomon and Adidas Benelux*, implementation of the protection introduced by Article 4(4)9a) of the Directive does not require the existence of a likelihood of confusion.

59 The national court asks, in particular, whether the circumstances set out in points (a) to (d) of Question 1 referred for a preliminary ruling are sufficient to establish a link between the conflicting marks.

60 As regards the circumstance referred to in point (d) of that question, the fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark would call the earlier mark to mind is tantamount to the existence of such a link.

61 As regards the circumstances referred to in paragraphs (a) to (c) of that question, as is apparent from paragraph 41 to 58 of this judgment, they do not necessarily imply the existence of a link between the conflicting marks, but they do not exclude one either. It is for the national court to base its analysis on all the facts of the case in the main proceedings.

62 The answer to point (i) of Question 1 and to Question 2 must therefore be that Article 494(a) of the Directive must be interpreted as meaning that whether there is a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the earlier marks with a reputation and the later mark must be assessed globally, taking into account all factors relevant to the circumstance of the case.

63 The fact that for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark with a reputation to mind is tantamount to the existence of such a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the conflicting marks.

64 The fact that:

-the earlier mark has a huge reputation for certain specific types of goods or services, and

-those goods or services and the goods or services for which the later mark is registered are dissimilar or dissimilar to a substantial degree, and

- the earlier mark is unique in respect of any goods or services,

does not necessarily imply that there is a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the conflicting marks.”

109. Earlier in this decision I found that the respective marks are identical or similar. I also found that some of the respective goods and services were also identical or similar and which includes services of the provision of student accommodation in which Group enjoys a reputation. The relevant public for such services are those seeking such accommodation, which may be the student himself or his parent or guardian who may be funding that accommodation. Given the importance of finding a safe, secure, habitable place to live and the likely cost of the overall commitment, the purchasing act is likely to involve a greater level of attention than, for example, the purchase of an everyday, consumable, item. I found that Group’s marks have a reputation and enjoy a reasonably high degree of inherent distinctive character which has been enhanced through use. I found that there was a likelihood of confusion between the respective marks in respect of some goods and services. Taking all this into consideration, I conclude that Union’s marks may bring Group’s mark to mind. Applying the guidance set out in *Intel* such a bringing to mind is tantamount to the existence of the required link as identified in *Adidas-Salomon and Adidas Benelux*.

110. The existence of such a link is not sufficient, of itself, to establish whether damage has or is likely to occur. In order for a claim of detriment to the distinctive character or repute of a mark to be made out, it is necessary that there exists a change in economic behaviour or a serious likelihood that such a change will occur in the future (*Intel*). From the evidence filed, I am unconvinced that the necessary change in economic behaviour of the consumer will, or is likely to, occur.

111. In essence, the claim made under grounds based on section 5(3) of the Act is that the marks applied for will take unfair advantage or be detrimental to the distinctive character or repute of the mark. It is claimed that Trades Unions such as the applicant attract substantial publicity for their activities but not everyone will share those interests and indeed some will positively disapprove of those activities because they include taking strike action which disrupt peoples’ lives. Others disapprove of their political allegiances which, it is claimed, will have “a damaging effect on the brand”.

112. Whilst Group’s evidence includes some newspaper articles (mostly after the relevant date) which give details of various activities which have been or were planned to be undertaken by Union (and which include strike action which would, undoubtedly and by its very nature have an adverse effect on some members of the public), there is no evidence that either Union itself or the services it provides attract disapproval. Even if it did, the evidence fails to demonstrate that for those people who make a link between the respective marks, that link will affect their economic behaviour or that the reputation of the earlier marks will be transposed to the later marks with the result that marketing and selling of Union’s goods and services becomes easier. The fact that the applicant is a trades union is not, of itself, any

reason to find that there is any detriment to the distinctive character of the marks or detriment to repute or that there would be any unfair advantage. Objections to the registration of a mark and founded on the basis of section 5(3) of the Act require consideration of that objection in light of the goods and services for which the application is made rather than the ownership of that application. The objections under section 5(3) of the Act fail.

The objections under section 5(4) of the Act

113. I do not consider the grounds of opposition brought under the provisions of section 5(4)(a) put Group in any stronger position than those brought under section 5(2) of the Act. It would be disproportionate to deal with those grounds in this decision and I decline to do so.

Summary

Application 2453833

114. The opposition under section 5(2)(a) and based on earlier mark no CTM 1328079 succeeds in respect of:

Accommodation services in class 43 .

The opposition under section 5(2)(b) and based on earlier mark no 2401561 succeeds in respect of:

Printed matter, publications, newsletters, brochures, instructional and teaching materials, leaflets, booklets in class 16

Accountancy advisory services; tax analysis and tax return preparation services; providing commercial assistance and information; provision of business information in class 35

Financial and insurance consultancy services; credit card services; financial information; financial management and financing service in class 36

and

Accommodation services in class 43.

Application 2453838

115. The opposition succeeds under section 5(2)(b) in respect of:

Accommodation services in class 43 based on CTM 1328079 and

Printed matter, publications, newsletters, brochures, instructional and teaching materials, leaflets, booklets in class 16

Accountancy advisory services; tax analysis and tax return preparation services; providing commercial assistance and information; provision of business information in class 35

Financial and insurance consultancy services; credit card services; financial information; financial management and financing service in class 36

and

Accommodation services in class 43 based on earlier mark No 2401561.

Costs

116. Group's opposition was brought against all goods and services of the application on grounds founded on sections 5(2)(a) and (b), 5(3) and 5(4) of the Act. Its opposition has largely failed having succeeded on section 5(2) grounds only and in relation to limited goods and services. I find that Union is entitled to an award of costs in its favour. I made the award of the following basis:

| | |
|--|-------------|
| For filing a statement and reviewing the other side's statement: | £200 |
| For reviewing and filing evidence: | £400 |
| For preparation of and attendance at hearing: | £200 |
| Total: | £800 |

117. I order The Unite Group PLC to pay Unite the Union the sum of £800 as a contribution towards its costs. This sum is to be paid within seven days of the 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 21 day of November 2011

**Ann Corbett
For the Registrar
The Comptroller-General**