O-163-14

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION No. 2529011
IN THE NAME OF WINKWORTH OFFICE INTERIORS LIMITED

AND IN THE MATTER OF OPPOSITION THERETO UNDER No. 100638
BY WINKWORTH FRANCHISING LIMITED

AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
BY THE OPPONENT
AGAINST A DECISION OF MRS J. PIKE DATED 15 FEBRUARY 2012

DECISION

Background

1. This is an appeal against a decision of Mrs Judi Pike, acting for the Registrar, dated 15 February 2012, BL O/061/12, in which she partially allowed an opposition brought by Winkworth Franchising Limited ("the Opponent") against Application number 2529011 in the name of Winkworth Office Interiors Limited ("the Applicant").

2. Application number 2529011 was filed by the Applicant on 19 October 2009 seeking registration of the designation WINKWORTH INTERIORS for use as a trade mark in the United Kingdom in respect of the following services:

   Class 37
   Construction services in relation to the fit-out of existing commercial buildings; office fit out services; project management and advisory services in the commercial property sector relating to all of the aforesaid services

   Class 42
   Design and build fit out contractor services in the commercial property sector; planning of offices.

3. On 21 June 2010, the Opponent filed Notice of Opposition against all the services in the Application under Section 5(2)(b), 5(3) and 5(4)(a) of the Act[1].

4. In support of the Section 5(2)(b) and 5(3) grounds, the Opponent relied on 3 earlier UK and CTM registrations owned by the Opponent for the trade mark WINKWORTH.

[1] The services in the Application were amended down during the opposition proceedings to the present specification.

5. The Hearing Officer chose to decide the opposition under Section 5(2)(b) and 5(3) on the basis of United Kingdom Trade Mark number 2407411. This earlier trade mark was not subject to proof of use (whereas the other 2 were) and covered the wider specification of services as follows[2]:

   Class 35
   Auctioneering services; provision of advertising space; information and advisory services relating to the aforesaid services

   Class 36
   Estate agency services; real estate and property management; rental of property and real estate; valuation (financial) services; real estate and property appraisal; house agency services; real estate and property brokerage; insurance and financial services, all relating to estate agency activities; mortgage services; information and advisory services relating to the aforesaid services

   Class 42
   Surveying; surveying of real estate and property; legal services relating to real estate and property; conveyancing services; information and advisory services relating to the aforesaid services.

6. The Opponent's Section 5(4)(a) objection was grounded on the Opponent's claimed earlier unregistered rights in the word WINKWORTH in relation to estate agency services, property management services and "ancillary services".

7. The Hearing Officer said that her summary of the parties' evidence focussed on facts relevant to a determination of the opposition on the basis of United Kingdom Trade Mark number 2407411 and the Opponent's claimed earlier rights under Section 5(4)(a).

8. There was no challenge to any of the above or to the Hearing Officer's assessment that the marks to be compared – WINKWORTH v. WINKWORTH INTERIORS – were visually and phonetically similar to a good degree and conceptually similar.

9. The Hearing Officer decided that the opposition under Section 5(2)(b) was made out but only in relation to the Applicant's services in Class 42, namely: *Design and build fit out contractor services in the commercial property sector; planning of offices*.

10. On appeal, the Opponent contended that that decision should have extended to the entire specification including the Applicant's services in Class 37, namely: *Construction services in relation to the fit-out of existing commercial buildings; office fit out services; project management and advisory services in the commercial property sector relating to all of the aforesaid services*. Instead the Hearing Officer wrongly found that the Applicant's Class 37 services were dissimilar to those of the Opponent and that a requisite condition of Section 5(2)(b) was not met.

[2] The Opponent's CTM 3371101 covered the same services but the Opponent's UK 1276898 covered only services in Class 36. CTM 3371101 and UK 1276898 were both more than 5 years old at the date of publication of the Application.

11. In relation to the grounds of opposition under Section 5(3) and 5(4)(a), the Hearing Officer held that the Opponent's reputation/goodwill in WINKWORTH was limited to residential estate agency. The Opponent could do no better under these grounds than Section 5(2)(b).

12. Although the Opponent appealed the Section 5(3) and 5(4)(a) outcomes, my understanding was that the main focus of the Opponent's appeal was the Hearing Officer's comparison of the parties' services for the purposes of Section 5(2)(b).

13. At the appeal hearing, the Opponent was represented by Mr. Peter Houlihan of Cleveland, the Opponent's trade mark attorney. The Applicant was represented by Ms. Jacqueline Reid of Counsel, instructed by Williams Powell.

14. Mr. Houlihan invited Ms. Reid to start by addressing me on a preliminary point arising out of the grounds of appeal, which Ms. Reid had identified and briefly discussed with Mr. Houlihan prior to the hearing.

Preliminary point

15. Ms. Reid objected to the Opponent taking the point in its skeleton argument, in brief, that whereas the Hearing Officer compared the Opponent's surveying services in Class 42 with the Applicant's design and build services in Class 42 (and concluded that the services were reasonably similar), she failed to compare the Opponent's surveying services in Class 42 with the Applicant's construction and fit-out services in Class 37 (the implication being that had she done so she would have arrived at the same result).

16. Instead, her only comparison was between the Applicant's construction and fit-out services in Class 37 and the Opponent's property management and rental of property and real estate services in Class 36. This, the Opponent argued, was likely due to a "classification prejudice" on the part of the Hearing Officer, which was unlawful (*TAO ASIAN BISTRO Trade Mark*, BL O/004/11).

17. Ms. Reid contended that the Opponent should be barred from taking that point because it was not stated in the Opponent's Statement of grounds of appeal.

18. Ms. Reid referred me in support to 2 decisions of the Appointed Persons in *COFFEEMIX Trade Mark* [1998] RPC 717 at pages 721 – 724 and *Kurt Geiger Limited's Trade Mark Application*, BL O/075/13, paragraphs 20 - 23.

19. In *COFFEEMIX*, the appellant sought unsuccessfully to raise on the morning of the appeal hearing, a contentious point of legal importance on the relationship between Section 3(1)(a) and 3(1)(b) of the Act that had not been aired either in the case below or in the Statement of grounds of appeal.

20. In *Kurt Geiger* there was only 1 ground of appeal relating to the Hearing Officer's assessment of the similarity in the marks. The appellant was precluded from arguing further grounds relating to the similarity of goods/services, the evidence of fact including as to lack of actual confusion and a number of "wild and baseless" accusations against the Hearing Officer including bias.

21. By contrast in *K THERM Trade Mark*, BL O/085/14, even though the grounds of appeal were only stated in the most general terms, the appellant was not precluded from making arguments in support of its appeal, which were neither inherently startling, nor novel.

22. Turning to the case in hand, the Opponent quite clearly relied on all of its earlier services including those in Class 42, in opposing the *entire* Application below (i.e., the Applicant's services in Class 42 and Class 37).

23. Further the Statement of grounds of appeal listed 3 reasons why the Hearing Officer's decision under Section 5(2)(b) in relation to the Applicant's Class 37 services was wrong:

    (1) The Hearing Officer failed to take into account the respective users of the parties' services as mandated by Jacob J. in *British Sugar plc v. James Robertson & Sons Ltd* [1996] RPC 281 at page 286. The Opponent's skeleton argument expanded on this by pointing out that the respective users of the parties' services influenced the Hearing Officer's finding of similarity of the Applicant's Class 42 services, but played no part in her comparison of the Applicant's Class 37 services. I understood the Opponent to be saying here that the Hearing Officer's reasoning in connection with the Applicant's Class 42 services (i.e., the comparison based on the Opponent's surveying services in Class 42) ought also to have been extended by the Hearing Officer to her consideration of the Applicant's Class 37 services.

    (2) The Hearing Officer was clearly wrong on the Opponent's evidence in finding that the Applicant's services in Class 37 were dissimilar to the Opponent's services. This would encompass the Opponent's surveying services in Class 42.

    (3) As a result of the error in respect of the assessment of similarity of services, the Hearing Officer incorrectly held there was no likelihood of confusion.

24. Ms. Reid argued that even if those listed alleged errors were wide enough to include an argument that the Hearing Officer should have compared under Section 5(2)(b), the Opponent's surveying services in Class 42 with the Applicant's construction and fit out services in Class 37, the remainder of the Statement of grounds of appeal (insofar as it related to Section 5(2)(b)) showed that the Opponent did not intend to rely on its surveying services in Class 42 anyway.

25. Ms. Reid was latterly referring to paragraph 15 of the Statement of grounds of appeal, where under the heading "Correct assessment of the similarity of services" it was stated that the Appellant's earlier services included estate agency services, rental of property and property management, against which were listed the Applicant's services in Class 37.

26. To my mind 2 points were *inter alia* relevant here:

    (a) By mentioning estate agency services the Opponent was impliedly challenging the Hearing Officer's assessment that the Opponent's property management

and rental of property and real estate services were the closest to the Applicant's Class 37 services and that this would be the only basis of her comparison.

(b) Estate agents sometimes are, or incorporate surveyors as was borne out by the Opponent's evidence.

27. A statement of grounds of appeal need not contain the totality of an appellant's arguments, which is the role of the skeleton argument on appeal.

28. For this and the above reasons, I have decided not to preclude the Opponent from relying in this appeal on the argument that the Hearing Officer should have extended her comparison of the Opponent's surveying services in Class 42 not only to the Applicant's design and build services in Class 42 but also to the Applicant's construction and fit-out services in Class 37.

Section 5(2)(b)

29. As I have said, the crux of this appeal was the Hearing Officer's comparison of the parties' services.

30. The Hearing Officer's determination in relation to the Applicant's Class 42 services was as follows:

> "27. Firstly, I will consider the similarity of the opponent's services with the applicant's Class 42 services, which are:
>
> *Design and build fit out contractor services in the commercial property sector; planning of offices*;
>
> The opponent has cover for surveying services, also in Class 42. To survey is defined in Collins English Dictionary (2000) as:
>
> > "4. *Brit* to inspect a building to determine its condition and value.
>
> and *surveying* is defined as:
>
> > "2. the setting out on the ground of the positions of proposed construction or engineering works."
>
> 28. Bearing in mind the authorities cited above, there will be an element of surveying involved in planning of offices, their design and their fit out, in order, firstly, to assess the building's condition and, secondly, to set out the proposed construction/engineering works (I note that Mr Winkworth says in his evidence that he conducts feasibility studies). All these services would be sought by a client wanting conversion of a commercial space and so the users are the same and the survey, planning, design and build services could be procured from the same channel of trade. A survey will be an important element of the process of planning and design and build services of proposed construction works, so they are complementary in the sense that the customer

may think that the responsibility lies with the same undertaking. Although they do not share nature or purpose, the applicant's services *Design and build fit out contractor services in the commercial property sector; planning of offices* share a reasonable level of similarity with the opponent's surveying services in view of the other similarities between them."

31. Given the good level of similarity between WINKWORTH and WINKWORTH INTERIORS, the reasonable degree of similarity between the Opponent's services and the Applicant's services in Class 42 and the good degree of inherent distinctiveness in the earlier WINKWORTH trade mark[3], the Hearing Officer concluded that there was a likelihood of confusion and that under Section 5(2)(b), registration must be refused to the Application in Class 42.

32. By contrast, the Hearing Officer's determination in relation to the Applicant's Class 37 services was that they were dissimilar to the Opponent's services:

> "29. Next, I will consider the opponent's services and the applicant's class 37 services.
>
> *Construction services in relation to the fit-out of existing commercial buildings; office fit out services;*
>
> I consider the closest of the opponent's services to these terms to be *property management and rental of property and real estate*. Property management and rental of property services do not share the same nature or purpose as construction services for fitting out existing commercial buildings or office fit out services. They are not in competition with each other and are not complementary in the sense of one being important or indispensible for the other. Construction services are not accessed via the same channels of trade as property management or property rental services. Although I have considered the evidence provided by the opponent, it does not persuade me that it is the norm in trade for property management agents, letting agents or estate agents to provide construction services in relation to fit-out, and the evidence relating to "white label" provision is inconclusive and somewhat vague; it appears to be opinion rather than fact from third party 'experts'. I am unconvinced that it would be right to depart from a prima facie finding based on the core meanings of the terms. Although the services are all buildings related, applying the case law cited above, I conclude that property management and rental of property services are not similar to *Construction services in relation to the fit-out of existing commercial buildings; office fit out services*.
>
> 30. *Project management and advisory services in the commercial property sector relating to all of the aforesaid services* [i.e. to construction services in relation to the fit-out of existing commercial buildings; office fit out services].
>
> This is a further step away from the closest of the opponent's services which are, *property management* and [sic]. Property management is the management

3 The Hearing Officer was not prepared on the Opponent's evidence to find enhanced distinctiveness through use of the earlier WINKWORTH trade mark, which finding was not appealed.

of property on behalf of a landlord and rental of property is the provision to a third party of property for (usually) a consideration: the rent. Neither of these share nature, purpose, channel of trade and are not complementary to or in competition with project management and advice relating to construction services for office fit outs. Again, although both parties' services relate to aspects of services connected with buildings, this is similarity at too general a level to be caught by the process of comparison required by with the case law cited above."

33. Since in her view, the Applicant's services in Class 37 were dissimilar, the Hearing Officer held that there was no likelihood of confusion (in fact 1 of the cumulative conditions was missing) and the opposition in Class 37 was unsuccessful under Section 5(2)(b).

Merits of the appeal

34. I agree with the Opponent that it seems illogical that the Hearing Officer did not continue/extend her reasoning as regards the Opponent's Class 42 surveying services versus the Applicant's Class 42 design and build services, also to the Applicant's construction and fit-out services in Class 37.

35. In the same way as she held that surveying services go hand in hand with proposed construction works, so they can also accompany actual construction works and the users can be the same. Surveyors may be involved not only at the planning stage, but also the execution and end stages of construction, build or fit-out projects, whether in the commercial or residential sectors. They may also provide management and advisory services in relation to such projects[4].

36. It is certainly true that services may not be considered dissimilar simply because they appear in different classes (likewise they cannot be considered similar on the ground that they appear in the same class) (*TAO ASIAN BISTRO*, paras. 36 – 39).

37. Nevertheless it is not clear to me that the Hearing Officer's decision in relation to the Applicant's services in Class 37 was motivated by "classification prejudice" (as the Opponent argued), rather than oversight of the Opponent's surveying services on her part.

38. Whatever the reason, I find that the Hearing Officer erred in this regard and that it is appropriate for me to reconsider the issue (*GALATOPOLY Trade Mark*, BL O/382/13, paras. 3 – 6).

39. I also accept the Opponent's criticisms that the Hearing Officer failed to give due regard to the Opponent's evidence, in particular, as to the involvement of larger firms of estate agents (incorporating surveyors) like Knight Frank and Savills and indeed the Opponent in building, construction and refurbishment projects including in the commercial sector.

[4] Again, borne out in the evidence.

40. The Hearing Officer said that the evidence relating to “white label” provision of such services was inconclusive. If by this, she meant that Knight Frank etc. do not actually do the construction work, I cannot see what difference this makes. The public are used to sub-contracting (and sub-sub-contracting) in this area but this does not prevent the public attributing responsibility to the principal or main contractor under that principal or main contractor’s brand.

Reconsideration

41. I have reconsidered the opposition case in Class 37 including the materials on file.

42. For the reasons stated above and as an extension of the Hearing Officer’s findings in relation to the Applicant’s design and build services in Class 42, I find that there is some degree of similarity between the Opponent’s surveying services (which would include building/construction surveying services and project management) and the Applicant’s: *Construction services in relation to the fit-out of existing commercial buildings; office fit out services; project management and advisory services in the commercial property sector relating to all of the aforesaid services* in Class 37.

43. In view of the strong similarity in this context of the trade marks WINKWORTH and WINKWORTH INTERIORS (“interiors” being descriptive; decision paras. 34, 43) and the good degree of inherent distinctiveness of the earlier trade mark for the registered services (decision para. 40), and despite the reasonably high level of attention the average consumer will pay in choosing the respective services (decision para. 43), in my judgment there is a risk that the public will mistakenly believe that the respective services emanate from the same or a linked source.

44. I find therefore that the opposition under Section 5(2)(b) succeeds also in relation to the Applicant’s services in Class 37 and that the Application must be refused in its totality.

Conclusion and costs

45. In the event, the appeal under Section 5(2)(b) was successful and there was no need for me to consider the grounds of appeal under Section 5(3) or 5(4)(a).

46. As the successful party, the Opponent is entitled to a contribution towards its costs of the opposition, which I have calculated on the Registrar’s scale in the sum of £2,100 (allowing for the grounds that were unsuccessful). The Opponent is also entitled to a contribution towards its costs of this appeal, which I will order in the sum of £800. The Applicant is ordered to pay to the Opponent a total costs contribution of £2, 900 within 28 days of the date of this decision.

Professor Ruth Annand, 10 April 2014

Mr. Peter Houlihan, Cleveland LLP, appeared on behalf of the Opponent/Appellant

Ms. Jacqueline Reid of Counsel, instructed by Williams Powell LLP, appeared for the Applicant/Respondent