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TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3007939
BY TRADING PLACES (STRETFORD) LIMITED
TO REGISTER THE MARK 'TRADING PLACES' IN CLASSES 35 AND 36**

AND

OPPOSITION 401085 THERETO BY GEORGE BUTLER

Background and pleadings

1. The Applicant, Trading Places (Stretford) Limited, applied to register the trade mark 'TRADING PLACES' in the UK on 22 May 2013. The application was accepted and the mark published in the Trade Marks Journal on 19 July 2013 in respect of the following services:

Class 35

Advertising, marketing and promotional services; auctioneering services; advertising of real estate property for sale or to let in electronic and printed format; advertising of financial, loan and mortgage services; compilation of information into computer databases; searching services for computer databases; providing an on-line commercial information directory on the internet; consultancy, information, advisory services and the preparation of reports all relating to the aforesaid services.

Class 36

Estate agency services, including the provision of access to real estate information and analysis over a global computer network or the Internet; real estate and property management; real estate appraisal; leasing of real estate; rental of commercial and domestic property; rent collection; financial evaluation of real estate; mortgage advisory and administration services; consultancy, information, advisory services and the preparation of reports all relating to the aforesaid services.

2. Mr George Butler (the Opponent) opposes the application under Sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (the Act), on the basis of his trade mark 2169882 'TRADING PLACES', filed on 18 June 1998 and registered on 1 September 2000 in respect of the following services:

Class 36

Estate agency services; estate management services; real estate management, real estate brokerage services, real estate leasing, real estate valuations; property leasing, leasing of real estate; mortgage broking, housing agency services; information, advisory and consultancy services all relating to the aforesaid services.

3. Given its filing date, the Opponent's mark is an earlier mark within the meaning of section 6(1)(a) of the Act. As the registration procedure was completed before the start of the period of five years ending with the date of publication of the Applicant's mark, in accordance with section 6A the proof of use conditions will apply.
4. Section 6A(3)(a) of the Act provides that the relevant period in which genuine use must be established is the period of five years ending with the date of publication of the application. That being 19 July 2013, the relevant period is 20 July 2008 to 19 July 2013.
5. The opponent argued in his statement of case that:

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i. *“The mark of the application is identical to the Opponent’s earlier mark and it is applied for in respect of services in class 36 which are identical to those covered by the Opponent’s earlier mark.”*

ii. *“The mark of the application is identical to the Opponent’s earlier mark and it is applied for in respect of services in class 35 which are similar to those covered by the opponent’s earlier mark.”*

iii. *“As a consequence of the identity of the marks and the identity/similarity of the respective services they cover, there is a strong likelihood that the average consumer will believe that the Applicant’s services originate from the Opponent (or from an undertaking economically linked to the Opponent).”*

6. The applicant filed a counterstatement denying that the marks are identical, and denying that they relate to services which are identical or similar. The applicant requested that the opponent provide proof of use of the earlier trade mark, and raised a claim to prior or concurrent use.
7. The applicant also questioned the validity of the earlier mark, but advanced no evidence in support of this claim. Section 72 of the Act provides that registration is prima facie evidence of validity, and in any case, as the applicant accepts, such a claim may not be considered under opposition proceedings. It is worth noting that no invalidation proceedings have been brought by the applicant against the earlier mark. Consequently, the earlier mark must be taken as a valid registration.
8. Neither party filed written submissions and no hearing was requested. Accordingly, this decision is taken on the basis of the papers filed. Only the opponent filed evidence in these proceedings. This is summarised to the extent that it is considered appropriate.

Evidence

9. The Opponent’s evidence comprises a witness statement in the name of George Cyril John Butler, alongside a number of exhibits. By a written application dated 12 January 2015 the Opponent requested that certain parts of, and exhibits to, the witness statement be kept confidential save as between the parties and the Registry. By Order dated 16 March 2015 the Registry allowed the request, and such evidence as is covered by the Order does not appear in the following summary.
 - The Opponent began trading as a sole trader under the name of ‘TRADING PLACES’ in early 1998, incorporating as a limited company (‘the Opponent’s company’) in October 1998, whereupon he became and served as Managing Director and Majority Shareholder until his retirement on 31 March 2012 when he was succeeded by his son, Gary Butler.
 - The use of the mark is by the company, and not by the Opponent himself. Nevertheless, use with the Opponent’s consent qualifies as relevant use, and such consent can in certain circumstances be inferred (see Case C-324/08

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Makro Zelfbedieningsgroothandel CV and others v Diesel SpA). In the present case, the earlier mark was registered on 1 September 2000 with George Butler as proprietor, after which the mark remained in his name. I accept the Opponent's evidence in his witness statement that any subsequent use by the company was either under licence or otherwise with his consent.

- The Opponent is also the proprietor of the following series of six device marks comprised in UK trade mark 2182645, registered on 17 November 2000. These shall be referred to hereafter as 'the logo'. Although mentioned in evidence, these marks are not relied upon by the Opponent for the purposes of these proceedings.



- Activities of the Opponent's company are said to include valuation services offered to potential vendors; the advertising of properties to prospective purchasers and related matters; lettings and property management services including tenant finding, reference checking, deposits and so on; and ongoing property management services. The company is also involved in mortgage broking. Turnover between 2008 and 2013 ranged from £291,021 to £439,101.
- The Opponent states that use of the mark by the company is carried out in a number of settings, including on invoices as provided at exhibit GCJB15.

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GCJB15 comprises eleven invoices relating to sales of properties in postcodes E10 – E12 between 2008 and 2013. The invoices are addressed to the solicitor of the vendor, seeking payment of commission due for the sale of the property. They are headed with the logo mark in one of the forms shown in numbers 4 – 6 of the series above. The words “trading places” also appear in the web address “www.tradingplacesproperty.com” in the top right of the page, and in the tear off payment advice slip at the bottom of the page, which lists the company’s address as “Trading Places Estate and Letting Agents”, followed by the note “Trading Places Estate and Letting Agents is the trading name of Trading Places (G.B.) Limited”.

- Exhibit GCJB2 relates to internet search results purporting to show use of the earlier mark on the website of the Opponent’s company and others. It is clear from this evidence that properties marketed by the Opponent’s company can be found by the search term ‘trading places’, as the term is used to denote the Opponent’s company on property aggregate websites such as rightmove.co.uk. The search results date between March 2011 and May 2013.
- There is also at page 5 of GCJB2 biographical material listed on the rightmove website which begins ‘Trading Places is an established and highly recommended estate and letting agency...’ However it cannot be determined whether this occurred during the relevant period for the proof of use assessment, as the search is dated 31/03/2014 and there is no indication of when the material was first published online.
- Exhibit GCJB3 comprises screenshots from the Opponent’s company website in the period July 2012 to May 2013 advertising property sales, lettings, valuation services and mortgage services. The words ‘trading places’ appear as the title of the page in the web browser tab, and in the URL ‘http://tradingplacesproperty.com’. The logo mark appears in the bottom right corner of the page.
- Exhibit GCJB4 shows an image of the physical shop window of the Opponent’s company in a Google street view image dating to August 2012. Only the logo mark is present.
- Exhibits GCJB5 and GCJB6 indicate via invoices the times and places where sales and lettings boards belonging to the company were displayed outside of properties offered for sale or letting by them between 2008 and 2013. Additionally GCJB6 includes photographs of such a board in situ, indicating by use of the phrase ‘LET BY’ upon the board that a transaction has taken place in respect of the property. The words ‘trading places’ appear in the address of the company on invoices for the sign used by the company, as well as in the letter sent by the council regarding the display of boards for longer than the permitted time. It also appears in the form ‘www.tradingplacesproperty.com’ on the boards themselves. The logo mark takes up the majority of the board.
- Exhibit GCJB7 comprises invoices showing that the company was paying for advertising space within a property magazine between 2010 and 2013, but

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does not show the nature of that advertising in the form received by the public.

- Exhibit GCJB8 duplicates evidence appearing in exhibits GCJB2 and GCJB14.
- Exhibit GCJB9 comprises invoices from property websites showing that the company also paid for web space between 2011 and 2013. This evidence suffers from the same shortcomings as GCJB7.
- Exhibits GCJB10 and 11 contain screenshots showing properties advertised by the company dating between 2011 and 2013 taken from property websites zoopla.com and primelocation.com respectively. The words 'Trading Places' appear at the top of the page in the form of the agency name, and also in the address of the company. The logo mark appears above the address.
- Exhibits GCJB12 and 13 show subscription and service invoices paid by the Opponent's company to other property marketing websites between 2008 and 2013.
- Exhibit GCJB14 comprises screenshots from the website agent-tracker.co.uk including reviews of services (including property lettings and valuation) which the Opponent's company offers. Reviewers are identified as buyers, sellers and landlords, and expressly name the company as 'Trading Places'. These are dated 2013. Some refer to the company having been used by or otherwise known to the reviewer for the preceding 5 to 8 years.
- Exhibit GCJB16 comprises screenshots of the Opponent's company's Facebook account relating to sales and lettings. The logo mark appears as the company's 'profile picture', whilst the account name is listed as 'Trading Places GB'. The URL is 'www.facebook.com/TradingPlacesUk'. Their earliest post showing properties for sale is 17 July 2013.
- Exhibit GCJB17 comprises invoices showing the subcontracting by the company of inventory and related services to a third party company. GCJB18 comprises invoices showing the purchase of leaflet printing and other services. These are dated between 2008 and 2013. They show the company was contracting for business services under the name 'Trading Places', but do not show how the company presented themselves to the public.

Proof of use

10. The earlier mark must meet the use conditions in respect of the services upon which the Opponent relies. The use conditions are set out in section 6A of the Act as follows:

“(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

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the United Kingdom by the proprietor or with his consent in relation to the [...] 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) [...]

(5) [...]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the [...] 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 [...] services.”

11. Section 100 of the Act is also relevant:

“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.”

12. In *Stichting BDO v BDO Unibank, Inc.*, [2013] EWHC 418 (Ch), Arnold J. stated as follows:

“51. Genuine use. In *Pasticceria e Confetteria Sant Ambroeus Srl v G & D Restaurant Associates Ltd* (SANT AMBROEUS Trade Mark) [2010] R.P.C. 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439; [2003] R.P.C. 40 ; *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159; [2004] F.S.R. 38 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759; [2009] E.T.M.R. 28 (to which I have added references to *Sunrider v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (C-416/04 P) [2006] E.C.R. I-4237):

(1) Genuine use means actual use of the mark by the proprietor or third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely token, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

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(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider* [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] -[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]".

13. Although minimal use may qualify as genuine use, the CJEU stated in Case C-141/13 P, *Reber Holding GmbH & Co. KG v OHIM* (in paragraph 32 of its judgment), that "not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question". The factors identified in point (5) above must therefore be applied in order to assess whether minimal use of the mark qualifies as genuine use.

Forms of Use

14. Use of the mark in the form as registered (TRADING PLACES) (which I will call “form 1”) clearly has potential to constitute genuine use. Evidence was also put forward of the use of the words ‘trading places’ but accompanied by additional words, such as ‘Trading Places GB’, ‘Trading Places Estate and Lettings Agents’, ‘tradingplacesproperty.com’ (which I will call form(s) 2); and thirdly in the stylised form incorporated into the logo mark (which I will call form 3).
15. Forms 2 and 3 constitute use in a form differing in elements from the form in which the earlier mark was registered, so the question arises as to whether use in these forms constitutes an acceptable variant under section 6A(4)(a) of the Act.
16. I will begin by considering whether the use of the logo (form 3) can constitute use of the word mark, given that the words ‘trading places’ are incorporated into the logo in a stylised form. The question under 6A(4)(a) of the Act is whether the use in the form of the logo is 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. If so, it may qualify as use of the earlier mark for the purposes of these proceedings.
17. The correct approach is set out in *Bud/Budweiser Budbrau* [2003] RPC 25, in which Lord Walker of Gestinhorpe stated:

“43. [...] The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark 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?”

18. Also of relevance are the decisions in the cases of *NIRVANA* (BL O/262/06) and *REMUS* (BL0/061/08) by Richard Arnold QC as he then was, sitting as Appointed Person. In the latter case he stated:

“I do not consider that the subsequent developments discussed above undermine the correctness of the view which I articulated in *NIRVANA* as follows:

“33. [...] The first question [in a case of this kind] 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 that 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 in 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.”

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19. I first examine the distinctive character of the earlier mark in its registered form. As is the case with all word-only marks, the distinctiveness of the mark TRADING PLACES lies in the words themselves, in this case the phrase itself. The phrase 'trading places' in its ordinary meaning refers to the swapping of roles, situations or positions, as occurs between the main characters in the 1983 movie 'Trading Places'. There is an element of wordplay with regard to the services of the company, in that they are engaged by clients to facilitate the exchange of physical locations in the form of real estate. Although the phrase does allude to the services of the company, it is by no means a common way of describing the sale or letting of property and related services. The suggestiveness is fairly mild, and the wordplay element is sufficient to afford the mark a medium to low degree of distinctive character.
20. Next I turn to determine the differences between the mark as used and the mark as registered.

EARLIER MARK

TRADING PLACES

LOGO MARK



21. The words trading places are subject to the same spelling in each mark, but thereafter there are a number of differences. In the logo marks as used the word 'Trading' appears above the word 'Places', each in a different typeface, and a triangular shape representing a roof appears above the letters 'din' of 'Trading', evoking the idea of a house. The effect is completed by the 's' of 'Places' representing a road or path approaching the letter 'i', which forms the door of the house. The word 'places' is followed by periods of ellipsis. There is also the device of two intersecting chevrons with contrasting levels of shading, (though none of the evidence is presented in colour so the hue cannot be determined).
22. There is aural and conceptual identity between the two, but visually there is a marked difference not just in the typeface but in the overall appearance of the logo mark, taking account of the additions of devices, stylisation and shading. I conclude that the use of the logo mark is in a form which alters the distinctive character of the word mark as registered.
23. Having reached this conclusion it follows that use of the logo mark cannot stand as use of the earlier mark.
24. Turning next to the second type of use (form 2), the addition of the words 'GB', 'UK', and 'Estate and Letting Agents' to the mark 'Trading Places' do not alter the distinctive character of the mark. Such terms are merely descriptive, indicating the geographic origin and nature of the services offered by the company. I therefore consider these to be acceptable variants of the earlier mark.

Consideration of use

25. As discussed in *Ansul*, for use to be genuine it must be consistent with the essential function of a trade mark, in enabling users to distinguish the services of the company from those of other undertakings. The evidence must be assessed as a whole not just piece by piece. Accordingly, even a collection of individually deficient pieces of evidence may be sufficient if together they paint a picture which, on the balance of probabilities, shows that there was genuine use of the mark in the relevant period.
26. The Opponent cites specific examples of purported use of the earlier mark by the company during the relevant period. Several such exhibits are insufficient to demonstrate genuine use, as some relate solely to the Logo mark, some exceed the relevant period, and some represent dealings with suppliers to the company, rather than outward use and therefore cannot be said to be for the purpose of establishing or maintaining a market share.
27. However, I am content that exhibits GCJB3 and GCJB14 in particular show use of the earlier mark (either in form 1 or form 2) in the context of advertising property sales services, services for landlords, and property valuations. The company's website is shown to feature the tab 'mortgages', which taken with the Opponent's statement that a small proportion of revenue is made up of Mortgage Brokering commission supports the conclusion that the mark is used in respect of sales and letting, valuation, property management and mortgage services within the relevant period.
28. The matrix of evidence does paint a picture of real commercial exploitation of the mark on a scale that is more than minimal, and on balance I am satisfied.
29. I note that much of this use is alongside or secondary to the logo mark, which is clearly the primary mark used by the company and by which it identifies itself foremost online, on paper and on its shop frontage. However this does not impact upon my finding of genuine use of the word mark in its own right, or of an acceptable variant as in form of use 2.

Fair specification

30. In terms of deciding upon a fair specification, Geoffrey Hobbs Q.C., sitting as the Appointed Person, when deciding case *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, summed up the law as being:

"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."

31. More recently, in *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) set out the correct approach for

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devising a fair specification where the mark has not been used for all the goods/services for which it is registered; he said:

“63. The task of the court is to arrive, in the end, at a fair specification and this in turn involves ascertaining how the average consumer would describe the goods or services in relation to which the mark has been used, and considering the purpose and intended use of those goods or services. This I understand to be the approach adopted by this court in the earlier cases of Thomson Holidays Ltd v Norwegian Cruise Lines Ltd [2002] EWCA Civ 1828, [2003] RPC 32; and in West v Fuller Smith & Turner plc [2003] EWCA Civ 48, [2003] FSR 44. To my mind a very helpful exposition was provided by Jacob J (as he then was) in ANIMAL Trade Mark [2003] EWHC 1589 (Ch); [2004] FSR 19. He said at paragraph [20]:

“... I do not think there is anything technical about this: the consumer is not expected to think in a pernickety 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 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.”

64. Importantly, Jacob J there explained and I would respectfully agree that the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be adopted is, in essence, a relatively simple one. The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more of those subcategories will not constitute use of the mark in relation to all the other subcategories.

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65. It follows that protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider belong to the same group or category as those for which the mark has been used and which are not in substance different from them. But conversely, if the average consumer would consider that the goods or services for which the mark has been used form a series of coherent categories or sub-categories then the registration must be limited accordingly. In my judgment it also follows that a proprietor cannot derive any real assistance from the, at times, broad terminology of the Nice Classification or from the fact that he may have secured a registration for a wide range of goods or services which are described in general terms. To the contrary, the purpose of the provision is to ensure that protection is only afforded to marks which have actually been used or, put another way, that marks are actually used for the goods or services for which they are registered.”

32. The opponent’s specification reads:

Class 36

Estate agency services; estate management services; real estate management, real estate brokerage services, real estate leasing, real estate valuations; property leasing, leasing of real estate; mortgage broking, housing agency services; information, advisory and consultancy services all relating to the aforesaid services.

33. I have found that the mark has been used in relation to sales and letting, valuation, property management and mortgage services, which matches the specification except in respect of ‘housing agency services’. I have not found evidence that the mark is used in relation to ‘housing agency services’, which I understand to mean specialist accommodation provided to particular groups of people such as those on low incomes. Accordingly I consider a fair specification should read as above, save for the exclusion of this term.

Decision

34. The Opponent relies on Sections 5(1) and 5(2)(a) of the Act.

Section 5(1) of the Act states that:

A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

Section 5(2)(a) of the Act is as follows:

“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 trade mark is protected...there exists a likelihood of confusion on the part of the

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public, which includes the likelihood of association with the earlier trade mark”.

35. The marks are identical, both being the word mark ‘TRADING PLACES’. I therefore proceed to compare the services. For ease of comparison I present the specifications below:

APPLICANT	OPPONENT
Class 35 Advertising, marketing and promotional services; auctioneering services; advertising of real estate property for sale or to let in electronic and printed format; advertising of financial, loan and mortgage services; compilation of information into computer databases; searching services for computer databases; providing an on-line commercial information directory on the internet; consultancy, information, advisory services and the preparation of reports all relating to the aforesaid services.	
Class 36 Estate agency services, including the provision of access to real estate information and analysis over a global computer network or the Internet; real estate and property management; real estate appraisal; leasing of real estate; rental of commercial and domestic property; rent collection; financial evaluation of real estate; mortgage advisory and administration services; consultancy, information, advisory services and the preparation of reports all relating to the aforesaid services.	Class 36 Estate agency services; estate management services; real estate management, real estate brokerage services, real estate leasing, real estate valuations; property leasing, leasing of real estate; mortgage broking; information, advisory and consultancy services all relating to the aforesaid services.

36. The Applicant addresses Class 36 in its counterstatement thusly:

“7. [...] Whilst it is not denied that there are some incidences of overlap between the respective specifications in Class 36, for example estate agency services, there are some services claimed by the Applicant that are arguably different such as “real estate appraisal” and “rent collection.” Accordingly, not all of the services claimed by the Applicant in Class 36 are identical to those of the Opponent’s earlier trade mark as alleged in the Grounds of Opposition.”

37. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court stated that:

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“29. [...] the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM-Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

38. I do not agree that “real estate appraisal” is different from “real estate valuations”, both it and “financial evaluation of real estate” are identical to “real estate valuations” in the Opponent’s specification. I find that “rent collection” is the sort of service that would be covered by the terms “estate management services”, “real estate leasing”, and “property leasing, leasing of real estate” in the opponent’s specification. Whilst it is true that an organisation might source tenants or otherwise facilitate the grant of the lease and that be their sole function, whereupon the landlord might take over collection of the rent, it is equally true that the term “leasing” would ordinarily be understood to include the handling of the monies payable under the lease, not just the initial formation of the contract.
39. Of the other terms claimed, “Real estate and property management” is identical to “estate management services” and “real estate management”. “Leasing of real estate” and “rental of commercial and domestic property” are clearly identical to “real estate leasing”, and “property leasing, leasing of real estate” in the Opponent’s specification. Finally, “mortgage advisory and administration services” is identical to “mortgage broking” and the advisory and consultancy services related to it, as contained in the Opponent’s specification.
40. In addition to the individual findings, with the possible exception of mortgage services, the services described above are covered by the more general category “estate agency services” as contained in the Opponent’s specification. I therefore find that in so far as Class 36 is concerned, the services are identical either in their own right or in accordance with the principles in *Gérard Meric*. I have already held the marks to be identical. The requirements of Section 5(1) are satisfied. The opposition to the application under Class 36 succeeds.
41. I turn now to consider the similarity of the services claimed by the Applicant in Class 35 to the services of the Opponent. The Applicant addresses this in paragraph 8 of its counterstatement:

“8. [...] not all of the services claimed by the Applicant in Class 35 are similar to those of the Opponent’s earlier trade mark as alleged in the Grounds of Opposition. Whilst services such as “auctioneering, appraisals and business acquisition” in Class 35 may be considered to conflict with “real estate agency, valuations and appraisals” in Class 36, there are a number of services in the Applicant’s specification that are different and so should be allowed. These include, for example, “advertising, marketing and promotional services,” advertising of financial, loan and mortgage services”, “compilation of information into computer databases”, “searching services for computer

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databases” and “providing an on-line commercial information directory on the internet.”

Relevant case law

42. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

43. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

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

44. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

45. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

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

46. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

47. In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Assessment of similarity

48. It can be inferred from the Applicant’s counterstatement that at least some degree of similarity is accepted. The Applicant appears to concede that “auctioneering, appraisals and business acquisition” is similar to “real estate agency, valuations and appraisals”, though in fact neither term appears in the specification of either party in the form quoted. Whether this statement is erroneous or volunteered simply as an example of similar services is unclear, but I agree in principle that auctioneering and estate agency are similar services to a reasonably high degree, as sale by auction is a common feature of the property market.

49. The Applicant cites specific examples which it submits should not be regarded as similar to the Opponent’s services. The list is not to be regarded as exclusive, so the remainder of the specification will be considered with the same degree of care. The specific examples are:

- a. Advertising, marketing and promotional services
- b. Advertising of financial, loan and mortgage services
- c. Compilation of information into computer databases
- d. Searching services for computer databases
- e. Providing an on-line commercial information directory on the internet

50. Turning first to the *Canon* factors, the intended purpose of these services in Class 35 is clearly to facilitate estate agency services. Whilst some of the

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services (such as advertising) could relate to other things, the terms would all cover advertising and related services relating to the sale and letting of properties on behalf of the applicant's clients, and are therefore similar in purpose and method of use. They will all be provided by estate agents or possibly through their websites. I therefore find that they are highly similar to the services of the earlier mark.

51. The same goes for auctioneering services and advertising of real estate property for sale or to let in electronic and printed format, all being highly similar to the services designated by the earlier mark. Searching services for databases is at least a complimentary service, if not merely another way of describing the method of providing estate agency services. I find that these may be highly similar, but are at least similar to a medium degree. Similarly, advertising of financial, loan and mortgage services is at least similar to a medium degree to mortgage broking as contained in the Opponent's specification, and in the case of advertising of mortgage services, highly similar.
52. Accordingly I find that most of the services claimed by the Applicant in Class 35 are highly similar to the services for which the earlier mark is registered, with the exception of those claims relating to databases and advertising of financial and loan services, which are similar (to a medium degree) to the services for which the earlier mark is registered.

Average consumer

53. It is necessary to determine who the average consumer is for the respective parties' services; I must then determine the manner in which the average consumer is likely to approach the choice of services and undertakings. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

54. Consumers of estate agency and related services fall into broadly two categories; buyers (and lessees) and sellers (and landlords). The latter are likely to take greater care over the selection of the service, as they are contracting directly for that service, be it sales and marketing, ongoing management, valuation and the like. The former are likely to take less care over the selection of the service, it being incidental to their choice of property. For the most part, buyers (and lessees) will not restrict themselves to the properties on offer from a single undertaking but will cast their net wide in search of the property that suits them. Nevertheless, at least a normal degree of care and attention will be paid by the average consumer, if not slightly higher having regard to the greater care likely to

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be taken by vendors. The marks may be encountered in brochures and on websites, and in signage outside properties. They may also be encountered verbally during telephone conversations or through the word of mouth recommendations of other consumers.

Distinctive character of the earlier mark

55. The degree of distinctiveness of the earlier mark is important in determining likelihood of confusion. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

56. My findings as to distinctive character of the earlier mark are presented at paragraph 19 above under the consideration of whether the Opponent's logo mark could serve as evidence of use of the word mark. I found that the earlier mark had a medium to low degree of distinctive character. The evidence filed does not show use in a manner that has materially enhanced the degree of distinctive character.

Likelihood of Confusion

57. A number of factors must be borne in mind in determining whether there is a likelihood of confusion. The interdependency principle states that a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective services, and vice versa. There is a higher likelihood of confusion in respect of an earlier mark of higher distinctive character, although that does not rule out a finding of confusion for marks which have only a low degree of distinctiveness. I must also consider the average consumer for the

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services, the nature of the selection process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

58. I have found that the marks are identical, the earlier mark has a medium to low degree of distinctive character, and that the average consumer is likely to take an average to above average degree of care. Based on these conclusions I find that there is a likelihood of confusion. This is so, given the balance of the various factors I have assessed, even if the mark has merely a low degree of distinctive character.

Conclusion

59. The opposition under Section 5(1) succeeds in relation to all services in Class 36. The opposition under Section 5(2)(a) succeeds in relation to all services in Class 35. As a result, subject to any successful appeal, the application is refused.

Costs

60. The opponent has been successful and is entitled to a contribution towards his costs. I note that the Opponent has reserved the right to request costs off the scale, however no such submissions have been made. I therefore assess costs according to the standard scale as follows:

£250 Preparing and considering statements
£500 Preparing evidence
£100 Opposition fee
£850

61. I order TRADING PLACES (STRETFORD) LIMITED to pay George Butler the sum of £850, payable within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 29th day of September 2015

**Andrew Wall
For the Registrar**