

O-590-15

TRADE MARKS ACT 1994


**IN THE MATTER OF TRADE MARK APPLICATION 3064290
BY HANDSAM LIMITED
TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 16, 35, 41 & 45:**

handsam |  Schooltripsadvisor

AND

**OPPOSITION THERETO (NO. 403213) BY
TRIPADVISOR LLC**

Background and pleadings

1. These opposition proceedings concern whether the trade mark handsam |  Schooltripsadvisor should be registered for the following goods and services:


Class 16: Magazines; Books; Leaflets; Printed guides; Printed manuals; Printed matter for educational purposes; Teaching materials for education; Printed matter for instructional purposes.

Class 35: Business advice; Business management advisory services; Advice relating to business information systems; Consultancy relating to business management; Business advisory services for educational establishments.

Class 41: Advisory services relating to education; Advisory services relating to the organisation of events; Advisory services relating to the organisation of field trips and visits.

Class 45: Consultancy services relating to health and safety; Information services relating to health and safety; Fire safety consultancy services.

2. The applicant is Handsam Limited who filed the trade mark on 15 July 2014. The trade mark was subsequently published for opposition purposes on 8 August 2014.

3. The opponent is TripAdvisor LLP. Its opposition is based on grounds under sections 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Trade Marks Act 1994 (the Act). The opponent operates a well-known web-site which provides user generated reviews under the name **TRIPADVISOR**. It has trade mark registrations for this mark, along with another mark it uses which combines those words with an owl device  tripadvisor.

4. Both sides are legally represented. The opponent is represented by Filemot Technology Law Ltd (Filemot), the applicant by Counterculture Partnership LLP (Counterculture). Both sides attended a hearing before me on 18 November 2015 at which Ms Barbara Cookson (of Filemot) represented the opponent; the applicant was represented by Mr Jonathan Moss, of Counsel, instructed by Counterculture.

The evidence

5. Both sides filed evidence. The opponent's evidence goes mainly to the use/reputation of its marks. Following a case-management conference (CMC) which took place before me earlier in the proceedings to discuss various evidential issues, I directed that the parties attempt to agree a statement of common ground. They duly did so, which is clearly helpful in a case like this. To that extent, the parties are agreed that:

"1. The Opponent's TRIPADVISOR mark is a well-known and famous mark in the United Kingdom.

2. The Opponent's owl logo is a well-known and famous mark in the United Kingdom.

3. The Opponent's reputation, as embodied in the TRIPADVISOR mark and the TripAdvisor owl logo, is for the vacation and business trips market for (1) publishing third party information (including reviews), and (2) providing search services; both services provided on the internet and mobile platforms for travel, travel arrangements, accommodations, vacations, and vacation rentals, transportation, restaurants, activities, attractions, events, landmarks, and points of interest.

4. The Opponent and the marks referred to above have been and continue to be referenced in the mainstream United Kingdom media since at least 2007 such that a significant proportion of the United Kingdom population is aware of the Opponent in the context of travel planning.

5. At least 75% of the population of the United Kingdom would have been aware of the Opponent's marks referred to above in relation to travel planning at the relevant date (July 2014).

6. 82% of those surveyed in 2014 stated they trusted the information published by the Opponent.

7. A number of teachers and those working in the educational sector accessed the third party information published by the Opponent and used the Opponent's search services for vacation travel, vacation accommodations and vacation rentals at the relevant date.

8. TRIP ADVISOR and its logo have been used in the United Kingdom as claimed in the statements of use on the TM7.”

6. Given the above common ground, I do not consider it necessary to summarise the opponent's evidence in detail. I will, though, touch on certain aspects of the evidence when it is particularly pertinent to the issues that need to be determined. However, for the record, I will highlight who the opponent's witnesses are and what, in general terms, they gave evidence about:

- i) Ms Caroline Gordon – Ms Gordon is teacher. She gives evidence about using TRIPADVISOR for both school and personal use. For school use she has used it to gain independent assessments of what a hotel is like, hotels which the school's travel company booked for a school trip.
- ii) Mr Ian Hamilton – Mr Hamilton is an ex-teacher who gives similar evidence to Ms Gordon.
- iii) Ms Olivia de Jager – Ms De Jager is another teacher. She also uses TRIPADVISOR albeit only for personal use. She has not used it for planning school trips as it has never seemed relevant to her, particular given that travel companies provide full packages.

- iv) Mr Bradford Young – Mr Young is a legal advisor working for the opponent. He gives evidence about the opponent's business and the use of its mark. This includes the use of "badges" incorporating the opponent's mark on third party websites and on physical premises to show potential customers that they are reviewed on the TRIPADVISOR website. The opponent also provides certain business with certificates of excellence and stickers are provided to the recipients to display to potential customers. He also gives evidence about listings on the TRIPADVISOR website for attractions and provides some randomly selected reviews which have been placed on TRIPADVISOR by people who went to such attractions as part of a school trip.
- v) Ms Rebecca Southern – Ms Southern is the opponent's senior director of "PR, EMEA and Latin America". She also gives evidence about the opponent's business. She discusses some market research the opponent has carried out, albeit not specifically for the purpose of these proceedings. She focuses on the "trust factor" which she says TRIPADVISOR benefits from. She also discusses services that the opponent provides to business which essentially relate to paid for advertising on the TRIPADVISOR website. I note that Ms Southern also refers to the applicant's use. I will touch on this in more detail later, but she provides screen shots of a website on which the applicant's mark is used and which:

"includes reviews of visitor attractions, links to updates on venues, and destination "info updates". The majority of these attractions, venues and destinations are covered by reviews and information on our own TRIPADVISOR website".

She also states that as well as using a confusingly similar mark, the applicant has used a very similar font and colour scheme.

7. The applicant's evidence is given by Mr Simon Lowe, its managing director. In summary, the main points that Mr Lowe makes are:

- i) The applicant was founded in 2008. The name HANDSAM is based on the initial letters of the words health and safety management, which Mr Lowe describes as the applicant's core business.
- ii) The applicant provides "systems, services and expert advice" to education service providers on a range of topics from health and safety, employment law, business management and school trip planning. It does not deal with consumers.
- iii) Mr Lowe states that the individuals within its client organisations are highly professional people from the education field. The applicant has a client support team and develops a personal relationship on a one-to-one basis. Mr Lowe considers the applicant to be "indisputably known as the leading provider of school management consultancy, health and safety management systems and services, school trip planning systems and consultancy services and training in the UK". Mr Lowe refers to many of

the organisations the applicant has worked with. He estimates that it has worked with over 2,700 schools and currently has over 70,000 registered users.

- iv) The applicant has worked directly with a number of education sector only organisations, some of which focus on the promotion of school trips within the education sector. Mr Lowe states that he is not aware of the opponent working in such a field.
- v) Mr Lowe then makes a number of points on the opponent's lack of reputation in the applicant's field and in the education sector more generally. He has never known of the opponent being classed as a competitor or alternative to the applicant. Mr Lowe states that he has never seen a reference on the opponent's website to any specialist providers of schools trips and travel in the education sector (he gives examples such as Club Europe, Eurostudy, Studytrips School tours, Study Experiences).
- vi) Mr Lowe states that he is a registered user of the opponent's website but he has been unable to source any information on the UK school trip sector specific government accreditation schemes which exist in the UK, nor the Government's relevant BSI mark, nor any information about the Government's formal definition of a school trip ("learning outside the classroom"); prints from the TRIPADVISOR website showing nil return searches for all this are provided.
- vii) The applicant has not received a call or correspondence that should have been addressed to the opponent, nor is it aware of anyone making an erroneous approach to the opponent.
- viii) Mr Lowe states that the applicant wishes to market its online health and safety software platform to those who organise educational visits. He states that a designer was commissioned to produce the graphical representation that became the applied for mark. He states that the font and colouring is exactly the same as used by the applicant since 2008 for its other marks, including its registered trade mark. Page 11 of Mr Lowe's exhibit is a representation of one of its marks for the words "handsam / your safety net". He adds that the shape and colour of the bus graphic are typical of school buses. He adds that the word "advisor" was chosen instead of "adviser" as it was more professional, which is the most appropriate for the applicant's business; he provides an online version of the Oxford Dictionary which defines "adviser" as a person who gives advice in a particular field. The extract goes on to suggest that both spellings are correct albeit adviser is more common but, particularly in the US, adviser is seen as less formal whereas "advisor" suggests an official position.
- ix) Mr Lowe states that domain name registrations were made before the intended service was launched.
- x) The applicant has never been the subject of any claim for negligence nor has it made a claim against its professional indemnity insurance. Mr Lowe

states that it has been, and remains, a highly respected professional advisory service.

- xi) Mr Lowe states that in the sign-up process for the opponent's website, part of the process asks what type of traveller the user is; no options relating to education or school traveller/organiser is given.
- xii) The top internet search results for "schooltripadvisor" do not reference the opponent. The top internet search results for "schooltripsadvisor" provide results that solely refer to the applicant.
- xiii) The applicant made a Right Start application for its mark which, Mr Lowe states, was to receive a "legitimate review of the application". Disclaimers were added to make it clear that no claim was being made to the generic non-distinctive elements of the mark. Whilst the examiner of the Right Start application suggested some amendments to the disclaimers, it is clear that the disclaimers were there from the outset, disclaiming the exclusive right to use the terms "school trips" and "trips advisor".

8. The opponent's reply evidence comes from Mr Young. The main points that Mr Young makes are:

- i) In reply to Mr Lowe's statement that the applicant does not provide information and bookings for general travel and does not provide information on hotels or other accommodation, Mr Young considers this to lack credibility. He provides screenshots from the applicant's website which contains its terms and conditions and which make references to hotels and travel. For example, one entry states "we may use your location to show you reviews of hotels and restaurants". Mr Young also states that the applicant's terms and conditions are near identical to those of the opponent so he assumes that the applicant copied them to take further advantage of the opponent. Mr Young does not, though, provide a copy of the opponent's terms and conditions so this claimed near identity cannot be verified.
- ii) Mr Young assumes that some of the school trips covered by the applicant's website will involve overnight excursions so it is likely that the applicant will provide some information about accommodation and hotels, just as TRIPADVISOR does.
- iii) Mr Young considers Mr Lowe to have mis-characterised the opponent's website as an hotel and accommodation only website. Mr Young refers to the wider aspects it covers and, also, he refers to the common ground document mentioned earlier which covers these wider aspects.
- iv) Examples are given of two reviews for activities on the TRIPADVISOR website where reference is made to UK school trip accreditation schemes. He also gives two examples of service providers who flag not only their rating on TRIPADVISOR, but also make reference to the accreditation scheme.

- v) That teaches are also members of the public. He states that thousands of reviews are placed by school teachers.
- vi) Mr Young provides two press articles about an educational establishment scoring website which uses the name "School Guide". The press articles mention that the website has taken inspiration from the way in which TRIPADVISOR operates, but Mr Young highlights that, unlike the applicant, they chose a name without implying any association with TRIPADVISOR.
- vii) In relation to Mr Lowe's comments that the colour and font of the applied for mark is the same as its other marks, Mr Young points out that he is not aware of what such marks are. He also considers Mr Lowe's statement to be misleading. To support this he states that the applicant's website on which the mark is used uses varying colours. He states that the shade of green used to highlight the domain name is a shade of green very close to the green used by TRIPADVISOR. He states that whilst the front page website has been changed to a bluer colour, "TRIPADVISOR green" reappears on the landing page accessed from social media advertisements. Mr Young also highlights the wheels on the device element of the applicant's mark – they are green as applied for, but black in actual use which makes them more reminiscent of the opponent's owl device (specifically the eyes).
- viii) In relation to the domain name, whilst Mr Young accepts that handsamschooltripsadvisor was registered after the filing of the application, he highlights that two domain names (schooltripadvisor.com) and (schooltripadvisor.co) were registered before filing. He considers this to show that the applicant was trying to take advantage of the fame of the TRIPADVISOR brand. He also considers that the use of the Right Start process, and the use of disclaimers, achieve the same object, although he does not explain why this is so.
- ix) Mr Young considers that later use (by the applicant) and the result of internet searches (as provided by the applicant) are not pertinent. Nevertheless, he goes on to provide his own search results, particularly in an attempt to show that the searches of Mr Lowe are misleading. If I understand his point correctly, he considers that when Mr Lowe conducted his search (for schooltripadvisor) he would have been faced with results that included TRIPADVISOR because the search algorithm would have initially generated a response "showing results for *school tripadvisor*" with an option to click on "search instead for schooltripadvisor"; Mr Young states that the results provided were this second option (the exact search) which was a "devious process". Mr Young conducted his own search (on the Bing search engine) which produced hits for the opponent (the first two hits) and the applicant (the third hit).

My approach

9. It was common ground at the hearing that the primary grounds of opposition were sections 5(2)(b) and 5(3) of the Act. I will deal initially with those grounds, in that order. I will also focus, at least initially, on the following applied for services:

Class 41: Advisory services relating to the organisation of field trips and visits.

10. Whilst some of the other goods and services of the earlier mark may be closer (some are even identical), when one bears in mind the reputation of the earlier mark(s), the above term is likely to represent where the opponent has the greatest prospect of success. Of course, I will return to the other goods and services later and explain why the opposition would succeed or fail, as the case may be.

Section 5(2)(b)

11. Section 5(2)(b) of the Act states that:

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

(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.”

12. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when

all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The marks being relied upon

13. The opponent relies on three Community trade mark (CTM) registrations as follows:

A) CTM 6441381 for the mark: **TRIPADVISOR**

The following services of the registration are relied upon:

Class 38: Providing on-line electronic bulletin boards for transmission of messages among computer users in the field of travel.

Class 39: Travel information services; providing an online computer database in the field of travel information services; providing online travel information in the form of reviews of travel service providers, travel destinations, and local attractions.

Class 42: Computer services, namely, providing search engines for obtaining travel data on a global computer network; hosting a website containing reviews of hotel accommodations and travel service providers, travel destinations, and local attractions.

Class 43: Providing lodging information services; providing online accommodation information in the form of reviews of hotel accommodations

This earlier mark is subject to the proof of use provisions, the opponent making a statement of use matching the above. As per the common ground stipulations, it is accepted that genuine use has been made with the consequence that the opponent may rely on all of the above.

B) CTM 11884137 for the mark: **TRIPADVISOR**

The mark is registered for a wide range of services in classes 35, 41 and 45, the full list of services being set out in the Annex to this decision. For present purposes, I note that the class 41 services covers “education” “education information” and various entertainment services. This mark is not subject to the proof of use provisions.

C) CTM 6989404 for the mark:  **tripadvisor**

The following services of the registration are relied upon:

Class 38: Providing on-line electronic bulletin boards for transmission of messages among computer users in the field of travel.

Class 39: Travel information services; providing an online computer database in the field of travel information services; providing online travel information in the form of reviews of travel service providers, travel destinations, and local attractions.

Class 42: Computer services, namely, providing search engines for obtaining travel data on a global computer network; hosting a website containing reviews of hotel accommodations and travel service providers, travel destinations, and local attractions.

Class 43: Providing lodging information services; providing online accommodation information in the form of reviews of hotel accommodations

This earlier mark is subject to the proof of use provisions, the opponent making a statement of use matching the above. As per the common ground stipulations, it is accepted that genuine use has been made with the consequence that the opponent may rely on all of the above.

Comparison of goods/services

14. When making a comparison, all relevant factors relating to the goods/services in issue should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

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

15. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

“(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

16. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06 it was stated:

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

17. In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston.”

18. In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in 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 the trade”¹ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning². I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

“..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

19. As already stated, I am considering the position in relation to:

Class 41: Advisory services relating to the organisation of field trips and visits.

20. The opponent’s second registration (mark B) for the word mark **TRIPADVISOR** covers various services in class 41, including “education” and “education information”. Such services would not, in my view, encompass advisory services relating to field trips and visits. Education relates to educational services such as schooling and training. Education information relates to information on such matters. That the opponent’s term does not encompass the applied for services means that they are not identical. In terms of similarity, the purpose is not the same, although, there may be some similarity of purpose because an educator will often wish to undertake field trips and visits as part of the curriculum, so advisory services relating

¹ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

² See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

to such matters has a related end purpose. The nature and method of use is, though, different. There is no competition between the services, nor any clear aspect of complementarity (in the sense described by the case-law), although it is possible that the provider of education information may also provide advice on field trips etc to support learning. Overall, I conclude that there is a low to medium, what I will call moderate, level of similarity between these services.

21. The class 41 services also cover various entertainment, sporting and cultural activities. Whilst such activities are likely to include activities where a field trip or visit may end up, it does not follow that the provider of advisory services for the organisation of field trips etc has any direct relationship with the activity undertaken. I do not consider the opponent's position to be improved here. Any similarity must be extremely low.

22. In terms of marks A and B, both cover the provision of travel and related information via various platforms. The closest service is likely to be:

“Providing online travel information in the form of reviews of travel service providers, travel destinations, and local attractions.

23. Advisory services relating to field trips and visits will no doubt involve advising and providing information on a range of matters relating to the organisation of a field trip or visit, including advice on the relevant attraction or end goal of the visit. Whilst advising on the travel aspects may not fall within the scope of the applied for term, one would expect a service provider of this nature to normally offer such advice. I can only compare what has been applied for, but the overlapping nature means that there is some similarity in purpose because both services are aimed at assisting the process of arranging either travel (including attractions) on the one hand and field trips (which must include the relevant attraction/end goal) on the other.

24. The method of use may be similar. The terms of the opponent listed above are based upon reviews - there is no reason why the applied for terms could not be provided in this form. Indeed, it is clear from the applicant's website that this is the case. There was a discussion at the hearing as to whether the applicant's website could be taken into account because it was not clear whether it was up and running before the relevant date. I do not consider the date it was up and running to matter in this instance because even if it was after the relevant date it can be relied upon to exemplify the potential nature of the service and how it is to be used, so long as it represents a fair and normal use, which I consider it does. Thus, I consider that there is similarity in how the services will be used.

25. The applied for services will be used by the educational profession. The services of the earlier mark are for the general public. Whilst this could be said to create a difference in users, one must bear in mind that members of the educational sector are also members of the public. This leads to a potential aspect of competition, in other words, a member of the educational profession may make a competitive choice between the services. He or she may go to the specialist service provider or, alternatively, may instead use the services of the earlier mark to help plan the field trip or visit. The channels of trade are likely to be different, a specialist service provider will be unlikely to start offering the general travel service information, and

vice versa. Overall, I consider there to be a medium degree of similarity between these services. I note in passing that Mr Moss was highly critical of the evidence provided by the teachers, as summarised earlier. He complained that their statements were very similar and words may have been put into their mouths. This, in my view, is not significant. As indicated at the hearing, it is logical to assume that some school teachers will use TRIPADVISOR to look at reviews of relevant service providers when considering school trips. This is all the witnesses were saying (although one indicated that they did not do so).

Average consumer and the purchasing act

26. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. 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.”

27. Even for the applied for services, I am not persuaded that the selection process is higher than the norm. The educational professional (who I accept is the average consumer for the applied for services) may need to be particularly careful about the selection of the company that provides travel to and from the field trip or the selection of the attraction to be visited, but the selection of a company to take some form of advice is not of the same level of importance. Nevertheless, it is likely to be a reasonable selection process, albeit neither higher nor lower than the norm. I think the same applies to the services of the earlier mark, albeit, the average consumer for them is the general public.

28. In terms of the selection process, this would involve perusal of websites, brochures etc, so the visual impacts of the marks are likely to be more important in the assessment. However, I do not ignore the aural impacts of the marks altogether as the services could be the subject of word of mouth recommendations etc.

Comparison of marks

29. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to

analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

handsam |  schooltripsadvisor

v

TRIPADVISOR

&

 tripadvisor

31. Before going any further with the comparison, I highlight that many of Ms Cookson’s submissions focused on the similarity of the marks after the opponent’s reputation had been factored in. This is not the correct approach. In *Ravensburger AG v OHIM*, Case T-243/08, the General Court held that:

“27. It is appropriate at the outset to reject that complaint as unfounded. The reputation of an earlier mark or its particular distinctive character must be taken into consideration for the purposes of assessing the likelihood of confusion, and not for the purposes of assessing the similarity of the marks in question, which is an assessment made prior to that of the likelihood of confusion (see, to that effect, judgment of 27 November 2007 in Case T-434/05 *Gateway v OHIM – Fujitsu Siemens Computers (ACTIVY Media Gateway)*, not published in the ECR, paragraphs 50 and 51).”

32. Furthermore, Mr Moss submitted that because the words schooltripsadvisors were wholly descriptive meant that there was no real similarity. In *L’Oréal SA v OHIM*, Case C-235/05 P, the CJEU stated:

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

33. In terms of overall impression, the opponent’s word mark is comprised of the conjoined words **TRIPADVISOR**. Neither word dominates the other in any way - they form a unit with one word qualifying the other. The overall impression is based on that two word combination. In relation to the opponent’s figurative mark, the owl device is at the start of the mark and catches the eye. That said, the TRIPADVISOR word combination is not materially dominated by the device. This is the sort of mark where the two elements make a roughly equal contribution to its overall impression; the owl may play a slightly greater role on account of the varying degrees of distinctiveness of the elements (which the average consumer is likely to take into account in the overall impression the mark makes upon them) but not by much.

34. The overall impression of the applicant’s mark is more complex. It is made up of the words HANDSAM, the conjoined words SCHOOLTRIPSADVISOR, and the device of a school bus which is superimposed over the word SCHOOL, with the S and second O of the word SCHOOL forming its wheels. I accept Mr Moss’ submission that HANDSAM is likely to be the element that has greatest relative weight, but, as per the assessment of the opponent’s mark, not by much. The second verbal element (the three conjoined words) make a clear impact on the mark, an impact which is reinforced by the school bus, which also plays a role in the overall impression. I also observe that because the bus is superimposed over the word school, this results, in my view, in the words TRIPSADVISOR having more visual impact than the word SCHOOL.

35. In terms of visual similarity, it is apparent that all the marks contain either the words TRIPADVISOR or TRIPSADVISOR. This is apparent not just because of its mere presence in the applied for mark, but also because of the slight emphasis given to TRIPSADVISOR (over the word SCHOOL) as mentioned earlier. I agree with Ms Cookson that the additional S is not significant in creating a difference. However, there are some clear differences: the addition of the word HANDSAM, the addition of the word SCHOOL, the addition of the bus, the addition of an owl in the case of the opponent’s figurative mark. Ms Cookson made a submission on the basis of the concentric circles created by the owl’s eyes in the opponent’s figurative mark and the wheels on the bus in the applicant’s mark; I do not think this materially increases the visual similarity between the marks. Overall, weighing the visual similarities and differences, and bearing in mind the overall impressions of the marks, I think that any

visual similarity is of only a moderate degree in respect of the opponent's word mark and a low degree for its figurative mark.

36. Aurally, the applicant's mark will be articulated as HAND-SAM-SCHOOL-TRIPS-AD-VI-SOR. The opponent's mark will be articulated as TRIP-AD-VI-SOR. The articulation of the former is longer than the later. They end in a very similar way, but the applicant's mark has a very different beginning. I consider there to be a low degree of aural similarity.

37. Conceptually, Ms Cookson made no submissions. Mr Moss said that if any concept was taken it would be based upon the word HANDSAM as that is the most memorable part of the mark. I come to the view that there must be some conceptual similarity because both marks make reference to trips and an advisor of some sort. The inclusion of HANDSAM does not avoid this because HANDSAM has no meaningful concept.

Distinctive character of the earlier marks

38. The degree of distinctiveness of the earlier mark must be assessed. 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).”

39. Inherently, TRIPADVISOR is weak in distinctive character. Mr Moss submitted that it is entirely descriptive (and thus also entirely descriptive within the applied for mark). Whilst I will come back to this point, all that I need to conclude at this juncture is that regardless of the level of inherent distinctiveness, there can be no question that the earlier marks are, due to the use that has been made of them, distinctive to a very high degree. This is borne out by the common ground stipulations, the

applicant accepting the opponent's evidence that at least 75% of the UK public would be aware of the mark(s). Of course, the reputation does not extend to everything in the opponent's mark. It would not extend, for example, to education or education information in class 41 or the many various services listed in the second of its word mark registrations. The reputation is limited to the type of services set forth in the common ground stipulations.

Likelihood of confusion

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

41. Some arguments I rule out as lacking pertinence are as follows: (i) Mr Moss' submission that the absence of an infringement action by the opponent was telling – I see nothing telling in this at all; (ii) Mr Lowe's evidence of an absence of confusion because it is not clear how long any parallel trade has existed and, furthermore, the absence of confusion is rarely helpful; (iii) any references to similarity created by the colour of the marks because no claim has been made under section 5(2)(b) that the earlier marks have a particular reputation in colour³; (iv) Ms Cookson's submission about the making of a Right Start application is, furthermore, not telling, (v) nor is the existence of any disclaimers; (vi) Ms Cookson also referred to a cookie entry on the applicant's website informing potential users that they are not associated with the opponent – this is not telling as it cannot be taken in any way to be an acceptance that there would otherwise be confusion.

42. I should say upfront that the differences that exist between the marks are ample to avoid the marks from being directly mistaken for one another. Notwithstanding the principle of imperfect recollection, the marks are simply not close enough for this to occur. If there is to be a positive finding under section 5(2)(b) then it will be on the basis of indirect confusion. Indirect confusion was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of

³ The making of such a claim was open to the opponent in view of the guidance in *Specsavers International Healthcare v Asda Stores Ltd* (Case C-252/12).

the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

43. Of course, I bear in mind that the three categories of indirect confusion identified by Mr Purvis QC are just illustrative – he stated that indirect confusion “tends” to fall in one of them.

44. So far I have assessed that there is a medium degree of similarity with the opponent’s class 39 services. These are the type of services for which the opponent enjoys a significant reputation. There is also a moderate level of visual similarity with the opponent’s word mark, a low level of visual similarity with the figurative mark, a low level of aural similarity between all the marks and some conceptual similarity. However, the one factor that needs to be added to the mix is what I described at the hearing as the “rub” in all this. That is, that despite the opponent’s TRIPADVISOR mark being highly distinctive on account of its use, it was inherently weak to begin with, which means that there is capacity for other traders to make innocent and coincidental use of similar expressions without confusing the average consumer. Ms Cookson submitted that this would not operate here because the fame of TRIPADVISOR was so great that the average consumer would see TRIPSADVISOR in the applied for mark (it was submitted that the additional S between TRIP and ADVISOR would be overlooked) and immediately see it as a reference to the opponent’s business with the consequence that the applied for mark was an expansion of the TRIPADVISOR business in the school field, or the school trips field, perhaps in partnership with another undertaking. Mr Moss, on the other hand, submitted that the average consumer would see the inclusion of the words SCHOOLTRIPSADVISOR as nothing more than a description of what was to be provided, advice relating to school trips.

45. If the opponent had no reputation then the matter would, in my view, be straightforward. There would be no likelihood of confusion because the consumer would put the common presence of the words TRIPADVISOR / [SCHOOL]TRIPSADVISOR down to co-incidence not economic connection. But, given my comments about the reputation of TRIPADVISOR, it is clear that the mark

is strikingly distinctive (through use) of the opponent. Much, nevertheless, depends on context. It is possible that something which is highly distinctive on the one hand, loses that distinctiveness when used in another manner. This is something which could easily occur when one is dealing with words which, on face value, are weak to begin with. Here, the answer to the question turns on the perception of the average consumer when they encounter the applied for mark. This is the type of case where the average consumer may not have a binary response. Some will simply see it in the way Mr Moss described, but there is potential for some to see it as Ms Cookson has described. I bear in mind that it is sufficient that a sufficiently significant percentage of relevant consumers are confused, but it is not necessary that the majority of consumers are misled. In *J.W.Spear & Sons Ltd and Others v Zynga Inc.* [2015] EWCA Civ 290, Floyd J. summed up the Court of Appeal's earlier judgment in *Interflora Inc. and another v Marks and Spencer plc* [2014] EWCA Civ 1403 like this:

“37. In relation to what the court described as the crucial question, namely whether the average consumer, as a hypothetical person, necessarily has a single reaction and so precludes a consideration of the perceptions of a proportion of the relevant public the court in *Interflora* identified the following propositions:

i) the average consumer test provides the court with a perspective from which to assess the particular question it has to decide, for example whether a statement is liable to mislead purchasers.

ii) a national court may be able to assess this question without the benefit of a survey or expert evidence.

iii) a national court may nevertheless decide, in accordance with its own national law, that it is necessary to have recourse to an expert's opinion or a survey for the purpose of assisting it to decide whether the statement is misleading or not.

iv) absent any provision of EU law dealing with the issue, it is then for the national court to determine, in accordance with its own national law, the percentage of consumers misled by the statement that, in its view, is sufficiently significant in order to justify banning its use.”

46. Whilst I am not necessarily convinced that the majority of average consumers would be confused, I am, however, given the strength of the reputation, given the similarity that exists between the marks, given the slight visual emphasis that TRIPSADVISOR gets in distinction from the SCHOOL element, and given the similarity between the services being considered, satisfied that there is a likelihood of some confusion and it is likely to be of a significantly sufficient level for the ground under section 5(2)(b) to be upheld. This finding relates to the class 41 services: “Advisory services relating to the organisation of field trips and visits”

The other goods and services under section 5(2)(b)

47. The application is also made in relation to a number of other goods/services. I will go through them class by class, starting with the following:

Class 35: Business advice; Business management advisory services; Advice relating to business information systems; Consultancy relating to business management; Business advisory services for educational establishments.

48. I accept that the opponent's second word mark (mark B) covers identical services (see the Annex to this decision). However, that the services are identical does not necessarily improve the opponent's position (or even match it) from what I have assessed so far. This is because the landscape has changed as the opponent has no reputation in the field of business advice or business management. Ms Cookson submitted that the opponent does have a particular relationship with the business world as per the evidence of Ms Southern relating to paid for advertising etc. However, this does not give the opponent any form of reputation in relation to the applied for services. I do not consider it likely that the average consumer (or even a significantly sufficient proportion) would be confused. Neither is the opponent in any better position relying on the services for which it has a reputation as they are not similar to the applied for services. The opposition under section 5(2)(b) fails for these services.

49. The findings I have made in the preceding paragraph apply in equal measure to the following services:

Class 41: Advisory services relating to education

Class 45: Consultancy services relating to health and safety; Information services relating to health and safety; Fire safety consultancy services.

50. Again, whilst the specification outlined in the annex contains some identical/highly similar terminology, the absence of a relevant reputation means that there is no likelihood of confusion.

51. I next consider:

Class 41: Advisory services relating to the organisation of events

52. Again, class 41 of the specification in the annex covers the organization of various events, however, without a relevant reputation for these services the opposition fails for the same reasons I have already outlined.

53. However, I consider that there is some similarity with the earlier marks' reputed services. An advisory service relating to the organisation of an event will include provision of information about the event itself and how best to organise it. Whilst the reputed services are not advising on how to organise anything, they nevertheless provide information to would be organisers which such people could use in their planning process. The subject matter of the information/advice is not quite the same (an event vs travel service providers/destinations/attractions) but there is some overlap on the basis of the breadth of activity an event may encompass. I consider there to be a moderate degree of similarity between the services. When this is added to the degree of mark similarity as already assessed, coupled with the reputation, there is a likelihood of confusion.

54. I next consider:

Class 16: Magazines; Books; Leaflets; Printed guides.

55. In relation to these goods, they could all relate to travel information including containing reviews of travel destinations and local attractions. They could therefore have a similar purpose to the reputed services. The nature is, of course, different to the opponent's services. There is a difference in method of use between the goods and the services, but some similarity as they both involve reading relevant information. There could also be a degree of competition. There is a medium degree of similarity, similarity which exists with the services of the opponent which have a reputation. For similar reasons to those already expressed, I consider that there is a likelihood of confusion.

56. That leaves:

Class 16: Printed manuals; Printed matter for educational purposes; Teaching materials for education; Printed matter for instructional purposes

57. I come to the view that the nature of these goods is not susceptible to providing the same information as the opponent's services, nor, indeed, the advice relating to organising field trips etc. Given the absence of such a link, I come to the view that there will be no likelihood of confusion, notwithstanding that the specification in the annex contains (non reputed) services (eg publication of electronic books) which have some similarity with these goods.

Outcome under section 5(2)(b)

58. The ground of opposition succeeds in respect of

Class 16: Magazines; Books; Leaflets; Printed guides.

Class 41: Advisory services relating to the organisation of events; Advisory services relating to the organisation of field trips and visits.

59. But fails in respect of:

Class 16: Printed manuals; Printed matter for educational purposes; Teaching materials for education; Printed matter for instructional purposes.

Class 35: Business advice; Business management advisory services; Advice relating to business information systems; Consultancy relating to business management; Business advisory services for educational establishments.

Class 41: Advisory services relating to education.

Class 45: Consultancy services relating to health and safety; Information services relating to health and safety; Fire safety consultancy services.

Section 5(3)

60. Section 5(3)⁴ of the Act reads:

“5-(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark,

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

Reputation

61. The earlier mark must have a reputation. In *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572 the CJEU stated:

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

62. The earlier mark is a CTM so the relevant test is to establish a reputation in a substantial part of the EU⁵. The applicant accepts that the opponent has a reputation. It is clear, in my view, that the reputation is a strong one.

The required link

63. In addition to having a reputation, a link must be made between the subject trade mark and the earlier mark. In *Adidas-Salomon*, the CJEU stated:

“The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23). The existence of such a link must, just like a likelihood of confusion in the context of Article 5(1)(b) of the Directive, be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, in respect of the likelihood of confusion, *SABEL*, paragraph 22, and *Marca Mode*, paragraph 40).”

⁴ Section 5(3) was amended by The Trade Marks (Proof of Use, etc) Regulations 2004 (SI 2004 No. 946) giving effect to the judgments of the CJEU in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* (C- 292/00) and *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* (“*Addidas-Salomon*”) (C-408/01).

⁵ See, for example, *Pago International* (case C-301/07)

64. In *Intel Corporation Inc v CPM (UK) Ltd* (C-252-07) (“Intel”) the CJEU provided further guidance on the factors to consider when assessing whether a link has been established. It stated:

“41 The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case...

42 Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public”.

Similarity of marks

65. I have already assessed the similarity between the marks at paragraphs 29-37 above.

The services

66. I have found some of the goods/services to be similar (certain of the goods in class 16, certain of the services in class 41). In relation to the other goods and services (essentially those for which I found no likelihood of confusion), they are quite different from the services for which the opponent possesses a reputation.

Reputation and distinctive character

67. Whilst the words TRIPADVISOR are weak in inherent distinctiveness, I come to the view that in respect of the reputed services, the resultant reputation is very strong and that the mark, in respect of the reputed services, has become distinctive to a very high degree.

Link or not?

68. It is worthwhile breaking the goods and services down to some extent because it is possible that a link may be found when certain goods and services are considered, but it does not follow that a link will always be made.

69. In relation to:

Class 16: Magazines; Books; Leaflets; Printed guides.

Class 41: Advisory services relating to the organisation of events; Advisory services relating to the organisation of field trips and visits.

these are the goods/services for which I have found a likelihood of confusion so it follows that a link will be made. However, even if I am wrong to have found that there was a likelihood of confusion, I still consider that a link will be made. At the very least, members of the relevant public will pause to wonder if the goods/services have something to do with TRIPADVISOR. That pausing to wonder will inevitably result in the earlier mark(s) being brought to mind.

70. In relation to:

Class 16: Printed manuals; Printed matter for educational purposes; Teaching materials for education; Printed matter for instructional purposes.

Class 35: Business advice; Business management advisory services; Advice relating to business information systems; Consultancy relating to business management; Business advisory services for educational establishments.

Class 41: Advisory services relating to education.

Class 45: Consultancy services relating to health and safety; Information services relating to health and safety; Fire safety consultancy services.

these are the goods and services for which I found no likelihood of confusion. In my view, the goods and services are sufficiently distinct that when all the relevant factors are considered, the earlier mark will not be brought to mind. The opposition fails for this reason in relation to these goods and services.

The heads of damage

71. There are three potential heads of damage under section 5(3). They are often referred to as: i) free-riding, ii) dilution, and iii) tarnishing. The three kinds of damage were conveniently summarised by the CJEU in Case C-487/07, *L'Oréal v Bellure*, as follows:

“39. As regards detriment to the distinctive character of the 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 is weakened, since use of an identical or similar sign by a third party leads to dispersion of the identity and hold upon the public mind of the earlier mark. That is particularly the case when the mark, which at one time aroused immediate association with the goods or services for which it is registered, is no longer capable of doing so (see, to that effect, *Intel Corporation*, paragraph 29).

40. As regards detriment to the repute of the mark, also referred to as ‘tarnishment’ or ‘degradation’, such detriment is caused when the goods or services for which the identical or similar sign is used by the third party may be perceived by the public in such a way that the trade mark’s power of

attraction is reduced. The likelihood of such detriment may arise in particular from the fact that the goods or services offered by the third party possess a characteristic or a quality which is liable to have a negative impact on the image of the mark.

41. As regards the concept of ‘taking unfair advantage of the distinctive character or the repute of the trade mark’, also referred to as ‘parasitism’ or ‘free-riding’, that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation.”

Unfair advantage

72. This was Ms Cookson’s primary head of damage. In my view, the position with the first set of goods/services (paragraph 69) is clear. If there is a likelihood of confusion with an earlier mark with a reputation then I consider it to follow that the owner of the applied for mark will be gaining an advantage. There is some debate as to whether the judgment of the CJEU in *L’Oreal v Bellure* means that an advantage gained by the user of a junior mark is only unfair if there is an intention to take advantage of the senior mark, or some other factor is present which makes the advantage unfair. The English Court of Appeal has considered this matter three times. Firstly, in *L’Oreal v Bellure* [2010] RPC 23 when that case returned to the national court for determination. Secondly, in *Whirlpool v Kenwood* [2010] RPC 2: see paragraph 136. Thirdly, in *Specsavers v Asda Stores Limited*¹ [2012] EWCA Civ 24: see paragraph 127. On each occasion the court appears to have interpreted *L’Oreal v Bellure* as meaning that unfair advantage requires something more than an advantage gained without due cause. However, the absence of due cause appears to be closely linked to the existence of unfair advantage. See paragraph 36 of the opinion of Advocate General Kokott in Case C-65/12 *Leidseplein Beheer and Vries v Red Bull*. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

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

73. In circumstances such as these where there is a clear advantage then the words of Arnold J hold good. However, in case I am wrong on my view that there would be an advantage gained by the applicant due to there being a likelihood of confusion, I will consider the position as if there had been no likelihood of confusion.

74. From that perspective, I have already found that there would be a link. Members of the relevant public would bring TRIPADVISOR to mind. I have also said that they would pause to wonder. This, in itself, could lead to an advantage. If a person is wondering if the applicant is in some way connected with the opponent then they will also be wondering if they will get the same level of service and type of service from them. It is abundantly clear that TRIPADVISOR is extremely popular in the UK. Ms Cookson also referred to the opponent's trust factor. As stated in the common ground stipulations, 82% of people surveyed in 2014 stated that they trusted the information published by the opponent. Such trust could easily rub off onto the applicant. I therefore hold that the applicant would, even if there was no confusion, gain an advantage from this type of association. I also consider that such an advantage is clear enough not to require proof that this was the intention. In any event, I am persuaded, on the balance of probabilities, that the applicant's intention was, at the very least, to bring the TRIPADVISOR mark to mind in some way. There are a number of factors which lead me to this. None of these factors, on their own, would likely have been sufficient, but in combination they are:

- i) The applicant (specifically Mr Lowe) clearly knew of TRIPADVISOR, the services it provides, and its method of operation.
- ii) Mr Lowe's evidence provides very little information about the coining of the mark. Whilst he talks about its colour/font, and the choice of using ADVISOR rather than ADVISER, no evidence is given about the selection of the whole mark.
- iii) The registering of domain names without the word HANDSAM is somewhat inconsistent with a submission that the words are purely descriptive.
- v) Whilst Ms Moss is right to suggest that no-one has a monopoly in providing advisory services which rely on user generated reviews, the way in which the applicant's website operates is another aspect of "co-incidence".

75. For the record, I have not placed any weight on the copying of terms and conditions (because what was being copied is not provided) or the colour/font submission (because Mr Lowe has stated that the applicant has used this colour previously). I have also placed little weight on the concentric circles point as this would constitute a too subtle a similarity for the average consumer to notice. However, the other factors nevertheless suggest to me that the co-incidences are more than mere co-incidences. I come to the view that the applicant wished to offer a TRIPADVISOR style service and to send a message (in the mark) that this is what it had done. The ground of opposition succeeds under section 5(3) for the services (paragraph 69) being considered, whether or not there was a likelihood of confusion.

76. In relation to the services at paragraph 70, the opposition fails, as without a link none of the heads of damage will arise. Even if a link had been made, I consider that it would have been such a fleeting one that there would be no consequence. I struggle to see, for the services in question, how any advantage will be gained and, furthermore, in relation to dilution, the earlier mark is just as capable as distinguishing its goods and services as it ever was. The final head of damage is tarnishing. This does not even get close to succeeding for the goods/services (or those already considered). In *Red Bull GmbH v Sun Mark Ltd* [2012] EWHC 1929 (Ch) Arnold J stated:

“93 The present state of the law with regard to detriment to the repute of the trade mark is conveniently summarised in Kerly’s Law of Trade Marks and Trade Names (15th edn.) at §9–131 as follows:

“Detrimental effect occurs where the later mark is used for goods or services which provoke a reaction of annoyance or displeasure, whether through their intrinsic nature or because of the unpleasant mental association with the goods for which the earlier mark is reputed: *Ferrero v Kindercare Learning (KINDERCARE/kinder et al)*, *Case R-1004/2000*, [2005] E.T.M.R. 6 OHIM BoA at para.30. It may also occur when the trade mark applied for is used in an unpleasant, obscene or degrading context, or in a context which is not inherently unpleasant but which process to be incompatible with the earlier trade mark’s image: *Elleni Holding* [2005] E.T.M.R. 51 at para. 43. These cases give rise to the phenomenon of ‘tarnishment’, whereby the reputed mark ceases to convey desirable messages to the public: hence the detriment to its distinctive character.”

77. There is nothing inherent in the nature of the opposed services which, if the applied for mark were to be used in relation to them, would have any obvious negative connotations. Furthermore, any suggestion that the applicant may offer inferior services is just hypothetical. Indeed, Mr Lowe’s evidence is that the applicant is a leading and well-respected business in its field, and there is no reason to doubt this.

Section 5(4)(a) – passing off

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

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

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

(b)...

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

79. Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing-off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

"The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

80. Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

The relevant date

81. Whether there has been passing-off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, stated:

“39. In *Last Minute*, the General Court....said:

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

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

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd* O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before

the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read too much into paragraph [51] of *Last Minute* and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could be prevented at the application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of *Last Minute*, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the opponent's goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of Floyd J in *Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom's TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user's mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: "date of commencement of the conduct complained of". If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess

whether the position would have been any different at the later date when the application was made.’ ”

82. The filing date of the subject trade mark is 15 July 2014. There is no pre-filing use to consider, the date on which the applicant’s website commenced use is not clear. Accordingly, the matter need only be assessed as of 15 July 2014.

Discussion

83. It is clear that the opponent has the requisite goodwill. I asked Ms Cookson where this ground of opposition would take the opponent beyond its case under section 5(2)(b). The only difference she highlighted was that the earlier sign relied on in the pleading was in its green colour scheme. Whilst I accept that the earlier signs are used in green, there is nothing to show how significantly associated the colour green is with the opponent. Therefore, I do not see how the opponent can be in any materially different position to succeed in opposing the goods and services on which it has so far failed. For reasons of procedural economy, I do not propose to go into this ground in any further detail. The claim would have succeeded to the same extent as section 5(2)(b) and no more.

Section 3(6)

84. Section 3(6) of the Act states that:

“A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

85. In *Red Bull GmbH v Sun Mark Ltd & Anr* [2012] EWHC 1929 and [2012] EWHC 2046 (Ch) (“*Sun Mark*”) Arnold J summarised the general principles underpinning section 3(6) as follows:

“Bad faith: general principles

130 A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/ Article 3(2)(d) of the Directive/ Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, “Bad faith in European trade mark law” [2011] IPQ 229.)

131 First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see *Case C-529/07 Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132 Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2009] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. *Case C-259/02 La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and *Case C-192/03 Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133 Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207–2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134 Fourthly, bad faith includes not only dishonesty, but also “some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined”: see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135 Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see Cipriani at [185].

136 Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137 Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138 Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

“41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48).”

86. Whether the trade mark was applied for in bad faith must be assessed at a particular point in time. As stated in the *Sun Mark* case, the relevant date is the application date of the application to register the trade mark. The relevant date is 15 July 2014.

87. I only intend to consider this ground of opposition in relation to the goods and services for which I have found the opposition case to have failed thus far. I can do so quickly. It cannot be an act of bad faith, absent any other circumstance, to apply to register a trade mark that is neither confusingly similar to the opponent's earlier mark, which does not take unfair advantage of, or is not detrimental to, the distinctive character or the repute of the earlier trade mark, or which does not misrepresent itself as being associated with the opponent's goodwill. To borrow a saying, this is a case of no harm, no foul.

Conclusion

88. The opposition succeeds in respect of:

Class 16: Magazines; Books; Leaflets; Printed guides.

Class 41: Advisory services relating to the organisation of events; Advisory services relating to the organisation of field trips and visits.

89. But fails in respect of:

Class 16: Printed manuals; Printed matter for educational purposes; Teaching materials for education; Printed matter for instructional purposes.

Class 35: Business advice; Business management advisory services; Advice relating to business information systems; Consultancy relating to business management; Business advisory services for educational establishments.

Class 41: Advisory services relating to education.

Class 45: Consultancy services relating to health and safety; Information services relating to health and safety; Fire safety consultancy services.

Costs

90. On the balance of the terms won and lost, the applicant has been more successful. However, more time and effort was deployed in relation to the terms on which the opponent won. This is a case of swings and roundabouts. Each side shall bear its own costs.

Dated this 15th day of December 2015

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

Annex – specification for the second word mark

Class 35: Advertising; Business management; Business administration; Office functions; Computerized file management; Administrative processing of purchase orders; Updating of advertising material; Advertising by mail order; Employment agencies; Business auditing; Auctioneering; Direct mail advertising; Business management assistance; Commercial or industrial management assistance; Procurement services for others [purchasing goods and services for other businesses]; Business management of hotels; Accounting; Data search in computer files for others; Shop window dressing; Demonstration of goods; Retail or wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies; Invoicing; Business management of sports people; Business management and organization consultancy; Advisory services for business management; Business management of performing artists; Commercial information agencies; Business research; Photocopying services; Import-export agencies; Business inquiries; Business information; Commercial administration of the licensing of the goods and services of others; Commercial information and advice for consumers [consumer advice shop]; Compilation of information into computer databases; Compilation of statistics; Document reproduction; Layout services for advertising purposes; Marketing studies; Marketing; Marketing research; Typing; Modelling for advertising or sales promotion; News clipping services; Economic forecasting; Cost price analysis; Relocation services for businesses; On-line advertising on a computer network; Opinion polling; Organization of fashion shows for promotional purposes; Organization of exhibitions for commercial or advertising purposes; Organization of trade fairs for commercial or advertising purposes; Outsourcing services [business assistance]; Personnel management consultancy; Personnel recruitment; Public relations; Presentation of goods on communication media, for retail purposes; Price comparison services; Production of advertising films; Professional business consultancy; Psychological testing for the selection of personnel; Publication of publicity texts; Business management consultancy; Business organization consultancy; Radio advertising; Publicity agencies; Publicity; Transcription; Sales promotion for others; Secretarial services; Writing of publicity texts; Sponsorship search; Systemization of information into computer databases; Dissemination of advertising matter; Shorthand; Arranging newspaper subscriptions for others; Arranging subscriptions to telecommunication services for others; Word processing; Telephone answering for unavailable subscribers; Telemarketing services; Business efficiency expert services; Television advertising; Drawing up of statements of accounts; Payroll preparation; Publicity columns preparation; Distribution of samples; Bill-posting; Tax preparation; Office machines and equipment rental; Rental of photocopying machines; Publicity material rental; Rental of advertising space; Rental of advertising time on communication media; Rental of vending machines; Business investigations; Business appraisals.

Class 41: Education; Providing of training; Entertainment; Sporting and cultural activities; Academies [education]; Organization of balls; Arranging of beauty contests; Arranging and conducting of concerts; Arranging and conducting of conferences; Arranging and conducting of congresses; Arranging and conducting of seminars; Arranging and conducting of symposiums; Arranging and conducting of workshops [training]; Arranging and conducting of colloquiums; Lending libraries; Ticket agency services [entertainment]; Bookmobile services; Nursery schools; Correspondence courses; Circuses; Coaching [training]; Electronic desktop publishing; Disc jockey services; Discotheque services; Animal training; Dubbing; Educational examination; Entertainer services; Vocational retraining; Vocational guidance [education or training advice]; Holiday camp services [entertainment]; Party planning [entertainment]; Film production, other than advertising films; Movie studios; Rental of cine-films; Television entertainment; Cinema presentations; Amusements; Amusement parks; Photography; Microfilming; Photographic reporting; Gymnastic instruction; Health club services [health and fitness training]; Entertainment information; Education information; Calligraphy services; Club services [entertainment or education]; Boarding schools; Layout services, other than for advertising purposes; Conducting fitness classes; Presentation of live performances; Operating lotteries; Rental of lighting apparatus for theatrical sets or

television studios; Scriptwriting services; Modelling for artists; Providing museum facilities [presentation, exhibitions]; Music composition services; Production of music; Night clubs; News reporters services; Publication of electronic books and journals on-line; Game services provided on-line from a computer network; Organization of competitions [education or entertainment]; Organization of fashion shows for entertainment purposes; Organization of shows [impresario services]; Organization of sports competitions; Organization of exhibitions for cultural or educational purposes; Orchestra services; Translation; Gambling; Personal trainer services [fitness training]; Booking of seats for shows; Practical training [demonstration]; Production of radio and television programmes; Videotape film production; Production of shows; Radio entertainment; Videotape editing; Recreation information; Religious education; Services of schools [education]; Writing of texts, other than publicity texts; Providing amusement arcade services; Providing casino facilities [gambling]; Sport camp services; Language interpreter services; Providing golf facilities; Providing karaoke services; Providing recreation facilities; Providing sports facilities; Recording studio services; Theatre productions; Sign language interpretation; Timing of sports events; Providing on-line electronic publications, not downloadable; Subtitling; Tuition; Publication of books; Publication of texts, other than publicity texts; Rental of camcorders; Rental of show scenery; Rental of movie projectors and accessories; Toy rental; Rental of sound recordings; Rental of audio equipment; Rental of radio and television sets; Rental of skin diving equipment; Rental of sports grounds; Rental of sports equipment, except vehicles; Rental of stadium facilities; Rental of stage scenery; Rental of tennis courts; Games equipment rental; Rental of videotapes; Rental of video cassette recorders; Physical education; Music-halls; Videotaping; Zoological garden services.

Class 45: Security services for the protection of property and individuals; Personal and social services rendered by others to meet the needs of individuals; Copyright management; Adoption agency services; Marriage agencies; Baby sitting; Baggage inspection for security purposes; Undertaking; Funerals; Personal body guarding; Guards; Detective agencies; Missing person investigations; Genealogical research; Horoscope casting; Fire-fighting; Security consultancy; Dating services; Chaperoning; Licensing of computer software; Licensing of intellectual property; Crematorium services; Night guards; Opening of security locks; Organization of religious meetings; Monitoring of burglar and security alarms; House sitting; Pet sitting; Planning and arranging of wedding ceremonies; Lost property return; Inspection of factories for safety purposes; Clothing rental; Rental of fire alarms; Rental of fire extinguishers; Rental of safes; Evening dress rental; Personal background investigations; Online social networking services relating to geography, travel and leisure activities.