

O-323-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3092183
BY SELYOR LTD**

TO REGISTER THE TRADE MARK:



IN CLASS 41

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 404516
BY MATTHEW LAUCLAN**

BACKGROUND

1. On 2 February 2015 Selyor Ltd (the applicant) applied to register the mark shown on the cover page of this decision in respect of “Coaching [training]” services in class 41. The application was published for opposition purposes on 17 April 2015.

2. Matthew Lauchlan (the opponent) opposed the application under Sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (the Act). The opposition is directed against all of the services in the application. The opponent relies upon his UK trade mark registration no. 2469685 for the mark shown below, applied for on 17 October 2007 and registered on 29 February 2008:



3. The opponent relies upon all of the services in his registration, namely:

Class 36:

Real estate services; real estate agencies; estate management; housing agents; leasing of real estate; rental of commercial or residential property; valuation services relating to the surveying of buildings and properties; advice, information and consultancy services relating to all the aforesaid services.

Class 41:

Training services; workshops; training services relating to property evaluation; training services relating to purchase, leasing and rental of commercial or residential property; real estate management training services.

4. The opponent contends that the services of the two parties are identical or highly similar and that the marks coincide in the element PROPERTY MENTOR which is the dominant element in both marks. Therefore, a likelihood of confusion exists and the applied for mark offends against Section 5(2)(b) of the Act.

5. In respect of the objection under Section 5(4)(a) of the Act, the opponent claims that he has used the mark since October 2007 in relation to real estate services, valuations and consultancy services relating to real estate as well as training services relating to property investment and the purchase of property. As a result of this use, the opponent claims, he has acquired a protectable reputation and the use of the contested mark would cause damage by virtue of diversion of business.

6. The applicant filed a counterstatement denying the claims and putting the opponent to proof of use.

7. Both sides filed evidence. Although I have read and considered all the evidence filed, I will summarise it to the extent that it is considered necessary. Both sides also filed written submissions in lieu of a hearing, which will not be summarised but will be referred to as and where appropriate.

DECISION

8. The opposition is brought under Sections 5(2)(b) and 5(4)(a) of the Act. I shall begin with section 5(2)(b).

9. Section 5(2)(b) of the Act reads:

“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.”

10. An earlier trade mark is defined in Section 6(1) of the Act, which states:

“6.-(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

11. As can be seen from the details given above, the opponent's mark is an earlier mark within the meaning of the Act. It can also be seen that the opponent's mark had been registered for more than five years at the time the application was published and as such, is subject to proof of use. The relevant period for the opponent to prove use of its mark is the five-year period ending with the date of the publication of the applied for mark, i.e. 18 April 2010 – 17 April 2015.

12. The relevant sections of the Act read as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

.....

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

13. Section 100 of the Act is also relevant and reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

14. With the above in mind, I now go on to consider the evidence that has been filed.

Opponent's evidence

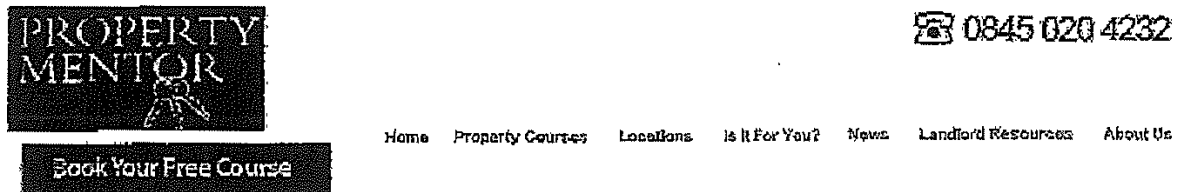
15. This comprises of a witness statement from the opponent, accompanied by five exhibits (ML1-ML5) and a witness statement from Mary Amelia Spears of HGF Limited, who represents the opponent in these proceedings.

16. The opponent explains that he has run his business since July 2006 and that details of his business can be found at www.propertymentor.co.uk. For the avoidance of doubt, I am unable to consider evidence relating to the opponent's website unless printouts of it have been filed. The opponent states that in 2007 he created the logo to use with the name PROPERTY MENTOR and this became his trade mark. The opponent says that he has been running training sessions on property purchase, sales, letting and mortgages since 2006 and that since the end of 2007/beginning of 2008 he began to also offer estate agency services, which includes refurbishment of property for his clients to make them more attractive to potential purchasers. The opponent says that he has also arranged finance for his clients. All these services have been offered under the registered mark.

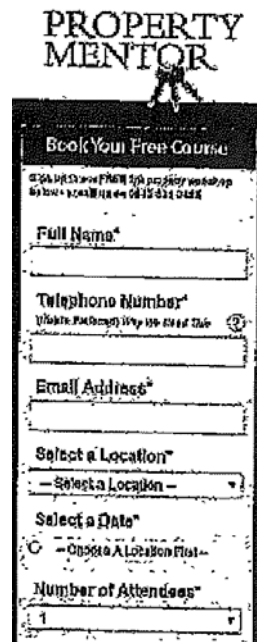
17. The opponent also states that he owns the domain names 'propertymentor.co.uk', 'propertymentor.com' and 'thepropertymentor.co.uk'. He says that he used to own the domain name 'thepropertymentor.com' but he inadvertently allowed it to lapse; this was subsequently bought by Susan Alexander, the applicant's Director. Exhibit ML1 consists of Internet printouts recording the registration of the aforesaid domain names.

18. The opponent says that his mark (or a variant form of it) has been in continuous use since 2006; the variant form consists of the words PROPERTY MENTOR in blue on a white background. The opponent also states that the mark has been used in relation to all of the services in class 41. Exhibit ML2, which is said to support this claim, consists of a number of printouts from the website 'propertymentor.co.uk' dated between 20 April 2008 and 17 April 2015 and obtained from the web archive Waybackmachine. One or two copies are provided for each year. The copies are of poor quality and only in black and white but, on the top left of the pages it is possible

to discern the opponent's mark. The mark appears in the format shown below on pages dated prior to the relevant period:



And in the variant format shown below on copies dated within the relevant period:



19. The mark is presented above a box headed 'Book Your Free Course', underneath which there appears text that, insofar as it can be discerned, reads: "*Sign up to our FREE 2hrs property workshop below or call us on (illegible)....*". The box seems to allow the internet user to book a free course by selecting a 'pick-up' location. Pages 33-41, within the relevant period, announce forthcoming free courses. All the pages indicate that courses were available on 29 October (the year is not specified) from different locations, i.e. Ealing, Central London, Brent Cross, Gatwick Airport, Redditch and Manchester. Pages 33 and 35 indicate that the regular price for the free courses is £297, which is crossed out. The purpose of the free courses is outlined at page 30, dated prior to the relevant period, which explains that they are essentially tester sessions. The page reads:

“So what have you got to lose?

Our 2 hour tester sessions are completely free to attend, meaning if you can't find what you are looking for during our FREE property management course, you can simply walk away without having wasted any single penny!

However, we doubt you'll have such thoughts once you have witnessed our investment strategies in action...”

20. Information about the opponent's services is provided under the heading “Our Services” at page 28, dated prior to the relevant period, which reads:

“...we have created a range of opportunities that you can take advantage of that will provide you with continued support throughout your journey to becoming a property investor. Financial freedom does not have to be a dream. Through our unique step by step system, you can make it a reality. How? Through our range of services which are available to you any time, any place....all at Property Mentor:

Free tester session – in this two hour session we outline the benefit of becoming a property investor and show you how you can achieve financial freedom [...]

Two day workshop –during this weekend course you will learn the skills and techniques needed to begin or extend your property portfolio [...]

Stacking and structuring –after our workshop we will provide you with the resources to successfully research your properties [...]

Mentoring Programme – after completing our two day workshop we offer your ongoing support via our 12 additional training sessions – in your first year- and [illegible] extra days (per year) for the following four years. These sessions are free and optional [...].”

21. References to Property Management Courses, The Property Mentor Property Workshop and Free Property Courses also appear in pages dated within the relevant period.

22. The opponent has produced no evidence of sales, turnover and/or attendance to his courses but a number of pages contain testimonials or links to testimonials. In particular, page 37 and 38, within the relevant period, refer to “hundreds” of testimonials and contain the following promotional statement:

*“...at Property Mentor we have formulated 8 proven investment strategies that withstood 1 property boom AND 2 recessions.
8 PROVEN investment strategies which have successfully enabled us to help over 2,500 new and experienced property investors to create multi-million pound property portfolios of all shapes and sizes.”*

23. The opponent claims that he has also used the mark in relation to class 36 services and refers to additional historical evidence obtainable from a web archive. Whilst he provides the relevant link, he supplies no copies and I am therefore unable to consider this evidence. Exhibit ML3 is said to show data available on the opponent’s website ‘propertymentor.co.uk’, although the web address is not visible on the pages. The registered mark is not present but the words ‘Property Mentor’ in plain text appear throughout, either alone or accompanied by a trade mark symbol. The pages, (undated save for the printing date of 11 June 2015), promote the opponent’s courses. Free property courses are said to be run all over the UK and the pages show a function, which seems to allow the Internet user to select a course by entering a postcode. With the exception of the Full Weekend Course (the price of which is displayed on page 66 as £4,978.50), there is no other indication as to the cost of the opponent’s courses. A number of pages provide information on types of property investment, i.e. investment in repossessed properties, and also indicate that the opponent offers research and negotiating services in relation to property investment.

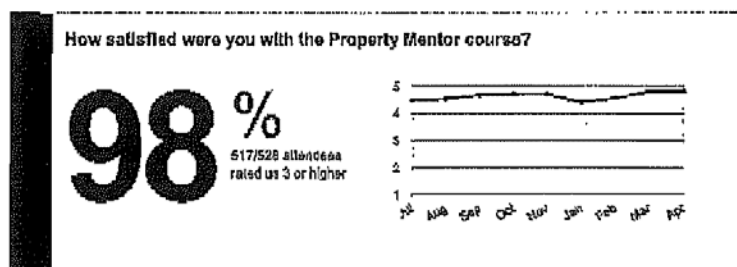
24. Whilst the opponent has produced no direct evidence of booking or attendance to any of his courses, pages 73-75 display the results of attendees' satisfaction surveys. Page 73 looks like this:

OUR SURVEY RESULTS

After surveying our most recent attendees, 98% of people described our workshops as highly informative and planned to implement our system in the next 30 days!

With 96% stating that they planned to recommend our property course to a friend

OVERALL



25. Other survey questions include how attendees have rated, for example, the Property Mentor's presenter, their venue and the service. The figures, which are said to be based on the number of people who responded to each question, indicate that number of attendees range from 430 to 636. Whilst it is not said when these courses have taken place, page 77 refers to the results of a survey conducted in 2013. The opponent states that the material he uses when he delivers his courses carries the mark. ML4 consists of a copy of what the opponent describes as the 'Master Workbook', which, he says, is the basis of one of the courses he delivers over three days to his clients; this includes copies of presentation slides and copies of hand-outs. The copy is undated, save for the printing date of 10 November 2015. The variant mark features on the top of the front page and 'www.propertymentor.co.uk' appears at the bottom of the presentation slides. The content of the document includes references to the opponent's services and information/advice on property purchase/investment.

26. The opponent states that since 2006 he has spent £1,440,000 on marketing his coaching, finance and estate agencies services but he provides no breakdown of these figures. Exhibit ML5 consists of five samples of emails dated between 31 October 2013 and 27 October 2015, which the opponent claims he has sent at least

once a week to 24,000 people, albeit he does not provide any lists of these potential clients. The registered mark (in black and white) and the variant version feature in either the body of the email or the attachments. The content of the emails include: (i) information about properties offered as investment opportunities (dated after the relevant period), (ii) an article headed 'Property Mentor helps put big profits on Front Page' which is otherwise illegible but seems to refer a 'Property Mentor Delegate' who bought his first property in 2011 (dated within the relevant period), and (iii) information relating to mortgages and stacking rates (dated within the relevant period). The opponent also states that his website is a vehicle for selling training courses.

27. Ms Spears' statement consists of submissions rather than evidence. As such, it is neither necessary nor appropriate for me to summarise it here.

Applicant's evidence

28. The applicant filed a witness statement by Susan Alexander, a Director of the applicant. For reasons which will become apparent, I will return to this evidence later in my decision. At this stage, I will limit my consideration to the following exhibits, whose purpose is to rebut the claim that the applicant is seeking to benefit from the opponent's reputation:

- SA4: it consists of printouts from four websites¹ containing reviews, mostly negative, of the opponent's business. I note, in particular, the comments reproduced (as written) below:

"Property Mentor Reviews

Do NOT trust this company or Matthew Lauchlan or Jason Hammond [...]

This company has deceived and misrepresented their services to myself and hundreds of others. We were fooled into believing that their system works. We were told by signing up with the company we would get access to true below

¹ <https://uk.trustpilot.com/review/www.property-mentor.co.uk>, <https://www.homemove.co.uk/forum/property-mentor-scam-4849.html>, <http://propertytribes.com/printthread.php?tid=7996>

market value properties with legal and broker assistance....” (Page 1, published 2 January 2016)

.....

“Property Mentor is an investment company to be avoided at all costs...I am a new member here and I have to confess I have made a terrible mistake by joining a property investment company called Property Mentor of Milton Keynes in the UK. For those of you who do not know about this company, in brief they advertise themselves as being able to help individuals like myself who are eager to get involved in property investment.

The literature and advertising material says you can get into property investment by buying BMV (Below Market Value) property from them, which they source for you from as little as £10,000.

Now call me gullible but after attending their weekend away and agreeing to pay more than two thousand pounds for the entire course, I was persuaded to pay the required deposit as already stated. In return they would find a property, arrange a mortgage and valuation plus survey, the remainder to be used for the deposit [...]” (Page 2, published 18 September 2014).

.....

“Hello as anyone like myself and my friends attended one of these free property mentor workshop around the country?” (Page 8, review dated 28 August 2012)

.....

“Hi Everyone it could only be best described in the words of an attendee as a scam another pyramid!

However without little effort accounts filed with companies house show nothing yet him and his team expect you to part with £478 to attend a weekend course to gain this knowledge and then proceed to seek a further £4,000 for ongoing lifetime support no wonder a few of the attendees walked out at this point and the speaker having been challenged on costs brought the presentation to a halt...” (Page 9, review dated 29 August 2012)

.....

“I recently went to one of the “Free” Seminars that was supposed to cost £297. Anyway, I have to say I was impressed and for me it looked like a viable proposition: reason being that they were saying that the minute you buy your

first property through them you don't have any further liability to pay the £4,000 as mentioned...." (Page 10, review dated 17 September 2012)

.....

"Hello all

I felt that it was only fair to share the other side of this argument.

I am a Property Mentor delegate and now also work for the team.[...]

I think that you will find numerous testimonials on our website, both videos and written— of course it is up to you if you think we have staged all of these. If you feel this then I would suggest you are perhaps a little too skeptical to get involved in property. They are real people who have gone through the process and have benefited from our help and support.

We have been established for over a decade, and are confident that we are here to stay.

Thierry we have been trying to work with you as an individual and have offered you numerous face to face meetings which you have declined to attend [...]

I would invite any existing Property Mentor members or other people who have

We are a very approachable company-holding weekly and monthly events where we can be met in person, and are happy to answer any questions no matter how cynical!

Please feel free to visit our website <http://www.propertymentor.co.uk> or drop me an email helen@propertymentor.co.uk" (Page 13, dated 19 October 2013)

- SA5: A copy of a Facebook page from 'Property Mentor Scam Victim' dated 2 May 2013. The page features the variant mark.

29. That concludes my summary of the evidence filed, insofar as I consider it necessary.

Proof of use

30. In considering whether genuine use of the opponent's mark has been made during the relevant period in respect of the services it seeks to rely on, I must apply

the same factors as I would if I were determining an application for revocation based on grounds of non-use. What constitutes genuine use of a mark has been subject to a number of judgments. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of marks. He stated:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

31. The correct approach to assessing the evidence is to view the picture as a whole, including whether individual exhibits corroborate each other².

32. The evidence illustrates that the opponent's website has been in existence since 2008 and that this was and still is, used to promote the opponent's training courses. The evidence also demonstrates that during the relevant periods, the opponent has used both the registered mark and a variant form of it, on his website and on marketing material, i.e. training material and promotional emails. The evidence is printed in black and white, however, the absence of colour is not fatal because whilst the mark is registered in colour, there is no claim to colour so notional and fair use of the mark covers all colours. On that basis, I am content to say that where the evidence shows the mark in white wording on a dark grey background, it is evidence of use of the mark as registered. Insofar as the variant mark is concerned, it is a positive version of the registered mark, the main difference being that the background rectangle is not visible due to the use of a white background. In considering whether the use of the variant mark constitutes use as permitted under section 6A(4)(a), I bear in mind the comments of Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, in *Nirvana Trade Mark* (BL O/262/06) and in *REMUS Trade Mark* (BL O/061/08):

“33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

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

² See the comments of Mr Geoffrey Hobbs QC, sitting as the Appointed Person in *Brandconcern BV v Scooters India Limited* (“Lambretta”) BL O/065/14.

33. In my view, the background being a banal shape adds nothing to the distinctiveness of the mark and the differences between the registered mark and the mark as used, do not alter the distinctive character of the mark. Therefore, I am of the view that the variant form of use can be relied upon.

34. It is true that there is some evidence of the opponent offering research and negotiating services in relation to property investment which, the opponent submits, demonstrates use beyond training services, i.e. real estate services in class 36. It may be that the opponent has in fact used the mark for these services, however, I do not believe that this has been adequately proven, as the evidence relating to this use is marked by its lacunae and is outside the relevant period. In any event, I do not think this matters because the contested services are in respect of coaching [training] service (in class 41) and the use shown with regards to the class 41 services provides the opponent with the best prospect of success. Thus, it is to this use that I will limit to my consideration.

35. Exhibit ML2 shows that during the relevant period the opponent's free property courses were offered in various locations in the UK and could be booked online or by phone. The applicant argues that there is no evidence of bookings or attendance to any free workshops. In this connection, it accepts that while "a few testimonies refer to having invested in the course", there is no evidence of sale; according to the evidence, the opponent's courses were delivered for free and were promotional in nature. On that basis, the applicant contends, the use shown is similar to that shown in *Silberquelle*. The opponent submits that, contrary to the *Silberquelle* case, the free services are not promotional items offered as a reward but rather relate to the same services in respect of which he claims use. It also relies on the independent reviews filed by the applicant which, he states, supports the existence of a market share held by the opponent for the relevant services.

36. In *Silberquelle* the Court of Justice of the European Union (CJEU) held that where the proprietor of a mark affixes that mark to items that it gives, free of charge (i.e. drinks in class 32), to purchasers of its goods (i.e. clothes in class 25), it does not make genuine use of that mark in respect of the class covering those items because the promotional items are not distributed with the aim of penetrating the

market for goods in the same class (i.e. drinks in class 32). This decision cannot be interpreted as meaning that any use free of charge does not constitute trade mark use. As pointed out by the opponent, in *Antartica v OHIM* case C-320/07 the CJEU held that:

“28. In support of the first part of the single plea, Antartica calls into question the use of the earlier mark for the goods and services in Classes 35 and 36 within the meaning of the Nice Agreement by submitting that The Nasdaq Stock Market offers them in the Community on a non-profit-making basis, whereas the use of a trade mark is based on the premiss that the goods or services for which it is registered are paid for.

29. It is sufficient to note in that respect that, even if part of the services for which the earlier mark is registered are offered by The Nasdaq Stock Market free of charge, that does not of itself mean that that commercial company will not seek, by such use of its trade mark, to create or maintain an outlet for those services in the Community, as against the services of other undertakings.

30. As the Court of First Instance held in paragraph 45 of the judgment under appeal, the Nasdaq indices refer to the stock exchange price quotation and financial services provided by The Nasdaq Stock Market, covered by the earlier mark and in respect of which it was registered.”

37. Accordingly, the fact that the services are offered free of charge does not prevent a finding of genuine use. The conclusion I draw from the evidence is that the free property training courses were promoted and provided by the opponent as free standing services within a business model, whereby they were designed (i) to give an insight into property investment and (ii) to encourage the purchase of other property investment training services offered (commercially) by the opponent. By contrast with the case which gave rise to the decision in *Silberquelle* and similarly to the facts in *Antartica*, here the services offered free of charge are services for which the mark is registered. As such, I am satisfied that that the free property courses

were offered by the opponent in the course of trade as a mode of maintaining or creating a share in the market for the registered services.

38. As to the extent and breath of use, the exhibits fail to give precise information as to its scale. There are no turnover figures, there is no direct evidence of visitor numbers and/or evidence of use of the site by customers and there is no direct evidence that courses took place. The only evidence in that respect consists of promotional statements from the opponent's website, namely: (i) a statement referring to the opponent having provided his services to 2,500 property investors (within the relevant period); (ii) the reference to hundreds of testimonials (within the relevant period) (iii) the results of surveys conducted on attendees (undated, although one of the survey is said to have been conducted in 2013). These figures are not referred to in the opponent's witness statement and are promotional in nature, a factor which must be considered when weighing the evidence; on the other hand, they have not been challenged by the applicant. I also consider that whilst the marketing figures are not broken down, an accurate figure is provided, which is not challenged and that given the focus of the opponent's business on training courses and the continuity of the use, it is likely that a non-insignificant proportion of the marketing expenses relates to these services and covers the relevant period.

39. In my view, when combined with the independent reviews, the promotional and marketing figures support the overall view that trade has been conducted under the mark and on the balance of probabilities, I am prepared to accept that the opponent's courses (free or otherwise) took place and were attended during the relevant period. Looking at the evidence in its totality, and taking into account the following:

- i. the continuity of the use;
- ii. that the opponent's website was in operation during the relevant period, that it enabled booking online or via phone and that courses were announced as forthcoming in various UK geographical locations;
- iii. the marketing expenditures, the copy of the course material, the promotional figures from the website and the independent reviews;

- iv. the nature of the services, i.e. that the services in question are not everyday purchase but are addressed to a narrow market;

I find that although the evidence is not particularly well marshalled and suffers from a number of flaws as set out above, the use shown constitutes real commercial exploitation of the mark in the UK market and therefore there is genuine use of the mark relied upon during the relevant period.

Services which can be relied upon and fair specification

40. I must now determine the services on which use has been shown. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

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

41. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) set out the correct approach for devising a fair specification where the mark has not been used for all the goods/services for which it is registered. He stated:

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

(as he then was) in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch); [2004] FSR 19. He said at paragraph [20]:

“... I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. ... Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods – are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

64. Importantly, Jacob J there explained and I would respectfully agree that the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be adopted is, in essence, a relatively simple one. The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed

independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories.

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

42. I am satisfied that the mark has been used in respect of some of the registered services in class 41. I consider that the average consumer would describe the services upon which use has been shown as:

Class 41: Training and workshop services in respect of property investment.

Section 5(2)(b) - case-law

43. The following principles are gleaned from the decisions 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 greater 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

44. In comparing the respective specifications, all the relevant factors should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the Court stated at paragraph 23:

“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”.

45. The parties’ services are:

Opponent’s services (following the proof of use assessment)	Applicant’s services
Class 41 <i>Training and workshop services in respect of property investment</i>	Class 41 <i>Coaching [training] services</i>

46. As per the judgment of the General Court (GC) in *Gérard Meric v OHIM*, case T-133/05, services can be considered identical where the services of the earlier mark

are included in a more general category, included in the specification of the application and vice versa. Applying this to the parties' specifications, the applicant's *coaching [training] services* are broad and cover within their ambit the opponent's *training and workshop services in respect of property investment*. The competing services are therefore identical on the *Meric* principle.

The average consumer and the nature of the purchasing act

47 As the case law above indicates, it is necessary for me to determine who the average consumer is for the services at issue; I must then determine the manner in which these services will be selected in the course of trade. 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.”

48. The applicant submits (reproduced as written):

“33. ...The parties do not offer “over counter products”, which consumers need to order aurally. Consumers are more likely to come across the marks on the Internet or on leaflets or advertising posters. The visual impact of the marks leave in the mind of the consumer will therefore prevail over its pronunciation.”

49. The opponent submits:

“17. Referring to paragraph 33 of the Applicant’s submissions, the Opponent would point out the real prospect of oral recommendations of each respective business. The services are not normally purchased on the basis of visual inspection and the public will refer to the services by reference to the words in the trade mark”.

50. What I must consider is the average consumer for the services which I found to be identical. The services at issue are directed to members of the general public who are interested in property investment. The services will be selected with a higher than average level of care and attention since the choice of the service provider could be a factor to the success or failure of the investment. The selection process is predominantly visual, with the marks being encountered on websites or in brochures etc., although, there is some potential for aural considerations, as I do not exclude that, for example, the services may be acquired following word of mouth recommendations.

Distinctive character of earlier mark

51. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*²⁶, 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).”

52. In its submissions, the applicant claims that the term ‘property mentor’ is descriptive of the services offered by the parties because it is a generic term commonly used in trade and, as such, it should be disregarded. The opponent accepts that the term ‘property mentor’ is inherently weak but denies that it is non-distinctive. As a preliminary point, I should say that the validity of opponent’s mark is not under attack and I am not aware of any invalidation action being pursued. Consequently, the opponent’s mark remains *prima facie* valid as a trade mark registration, as per Section 72 of the Act and the fact that the mark is registered means that it is accorded at least some level of distinctive character³. What I must consider, under section 5(2)(b) is the level of distinctiveness of the mark for the purpose of determining its scope of protection. This is measured against the perception of the relevant public at the time the applied for mark was filed, i.e. 2 February 2015.

53. In support of its claim, the applicant provides a witness statement from Ms Susan Alexander with exhibits. Ms Alexander states that in 2007 she attended a property (investment) education programme after which she started coaching and mentoring others in relation to property and business ventures and that she has built a strong reputation in the field. She says that people from the investment property sector started referring to her as ‘Property Mentor’, ‘The Property Mentor’ and ‘Property Coach and Mentor’ since 2008 and that she has been referring to herself as such since then. She provides undated dictionary extracts for the words ‘property’ and ‘mentor’. She says (reproduced as written):

³ *Formula One Licensing BV v OHIM*, Case C-196/11P

“These terms are everyday, customary, words of the English language. The word “mentor” is a well-known synonym for ‘coach’, ‘guide’ or ‘guru’. The two terms combined will have an obvious meaning for the public, which will easily and immediately understand that they refer to a self-proclaimed adviser who gives guidance to individuals on how to invest in property. On seeing the words “property mentor” it is in my view inconceivable that an ordinary lay person would not understand what is meant by them and what the role of a “property mentor” is.”

54. Whilst the individual words making up the mark may be in common usage, what has to be shown is that the words in combination, i.e. property mentor, are in common usage in the relevant trade and would be perceived as descriptive of the services offered.

55. Ms Alexander’s exhibits are as follows:

- SA1 – this exhibit consists of four pages of results of a Google search carried out on 9 February 2016. The search term is ‘property mentor’. The results include (i) references to the opponent’s and to applicant’s businesses or websites, which show the term ‘property mentor’ being used in a trade mark sense; (ii) references to phrases including ‘property mentor’ which suggest use in a descriptive manner;
- SA2 and SA3 – these exhibits consist of Internet printouts illustrating third parties using the term ‘property mentor’ in a descriptive fashion, i.e. to indicate an expert investor who offers personal advice and assistance (on a one-to-one basis) to those who are eager to invest in property. Most of the pages are either undated (save for a printing date of January and February 2016) or dated outside the relevant period, but some of this material show a publication date/copyright notice prior to the relevant date.

56. Whilst these documents show use of the term ‘property mentor’ on websites, the term as such does not appear in any established dictionary. In considering what the

average consumer will perceive when he encounters the PROPERTY MENTOR element in the opponent's mark, I bear in mind that there is a distinction between "marks (or elements of marks) which are apt to describe goods [and services] – in the sense that the term is appropriate to do so – and marks [or elements of marks] which use *established* descriptive terms"⁴. In the present case, the term 'property mentor' is not descriptive of training and workshop services (in respect of property investment); rather, on the evidence, it is a term being used in what appears to be a specialised market in relation to an individual, i.e. an expert investor who offers personal advice and assistance (on a one-to-one basis) to those who are eager to invest in property. The element 'property mentor' in the opponent's mark is therefore not apt to describe the services (or a characteristic or quality of the services) and it would not be naturally used to describe them.

57. Having rejected the claim that the term 'property mentor' is descriptive for the services, I must ask if the evidence is enough to conclude that the term is well established taking into account the expectation of the average consumer. In my view, it is not. The target public for the respective services is a member of the public. The evidence demonstrates that the term 'property mentor' has been used on UK websites by a number of third parties in the context of a specialised sector, i.e. the property investment/education sector, prior to the relevant period. Whilst I accept that a number of customers might have been familiar with the term, the evidence in its totality fails to establish that the term was widely known prior to the relevant date and that the average consumer for the services would have an awareness of it.

58. In my view 'property mentor' would not be immediately and unambiguously perceived as designating the respective services. Even understood as referring to someone who offers his knowledge in the field of property, this could be in connection to any aspects of property. The most that can be said is that the term is allusive and of a weak distinctive character, as it is accepted by the opponent. Insofar as the other matters of the opponent's mark are concerned, the rectangular background is of banal shape and the keys device simply reinforces the concept of property. Lastly, the evidence fails to provide details relating to the size of the

⁴ BL-O-472/11 para 30



relevant market and the opponent's market share, thus, I am unable to conclude that the distinctive character of the mark has been enhanced through its use. In my view, the mark is endowed with a low degree of distinctive character.

Comparison of marks

59. 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 them, 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.”

60. It would be wrong therefore artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features, (which are not negligible) and therefore contribute to the overall impressions created by them. The respective marks are shown below:

Opponent's mark	Applicant's mark
	

Overall impression

61. I have already said in the preceding paragraphs that I reject the applicant's submission that PROPERTY MENTOR is wholly descriptive of the services relied upon by the opponent; it follows that I also reject the applicant's submissions that PROPERTY MENTOR cannot constitute the dominant and distinctive element of the opponent's mark and so should be disregarded in the assessment of the similarity between the marks. In this connection, I note that it is well established that distinctiveness is not a factor that is relevant to the assessment of the similarity of the marks⁵.

62. Both marks are in colour, however, they make no claim to colour and thus, colour is not relevant for the purposes of my comparison⁶. I will therefore make the comparison on the basis of the neutral (without colour) version of the marks.

63. The opponent's mark consists of the word PROPERTY positioned above the word MENTOR. Both words are set to the left and are presented in white stylised block capital lettering and incorporating the device of a 'set of keys' hanging in the ring of the letter O. The words are in white against a dark grey rectangular background which make them stand out. The key device is in a light grey shade of colour, which makes the contrast slightly less accentuated. Owing to this and to the size and to the central and prominent position, I find that the words PROPERTY MENTOR play a dominant role in the overall impression of the mark.

64. Turning to the applicant's mark, this consists of two elements. The first is a square device divided in four sections. The top two sections incorporate a capital T, on the left, and a capital P, on the right both presented in a bold typeface. The two bottom sections include the silhouette of two basic characters holding hands, which may be perceived as a stylised M, on the left and the silhouette of a house on the right. Both the letters and devices are in white against a dark grey rectangular background which, again, makes them stand out. The second element of the mark is made up of the three words THE PROPERTY MENTOR presented in capital letters

⁵ *Ravensburger AG v OHIM*, case T-243/08

⁶ See *Mary Quant Cosmetics Japan Ltd v. Able C&C Co Ltd*, O-246-08 and *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch).

on the top of the other and aligned to the left; the definite article 'THE' is in grey and in a normal typeface, the word 'PROPERTY' is in dark grey and in a heavier font and the word MENTOR is again, in grey and in a normal typeface. Although forming the second element of the mark, given its size in relation to the first (device) element, both the device and the word elements contribute equally to the overall impression the mark conveys.

Visual similarity

65. On a visual comparison, there is a degree of similarity between the respective marks given that both contain the words PROPERTY MENTOR presented in a similar format. There are also visual differences between the marks in that the device elements are dissimilar and the definite article 'THE' has no equivalent in the opponent's mark. I thus conclude that there is a low to medium degree of visual similarity.

Aural similarity

66. From an aural perspective, the device elements will not be articulated. Aurally, the marks are similar to a high degree. The only difference is the additional articulation "THE" in the applied for mark (some average consumers may not even articulate it anyway) which, in my view, creates a negligible difference. The applicant points to the fact that his mark includes the element 'TPM', however, given the degree of stylisation, the letter M might not even be perceived. In my view, the acronym TPM is not immediately perceivable but even if it were, it is unlikely to be articulated. In the unlikely event it were to be articulated, there would be at least a medium to high degree of aural similarity.

Conceptual similarity

67. Conceptually, whatever the meaning attributed to PROPERTY MENTOR, it will be the same in both marks. The inclusion of the devices makes a visual impression, but adds very little from a conceptual perspective as the set of keys (in the opponent's mark) and the silhouette of a house (in the applied for mark) merely

reinforce the concept of property. Insofar as the silhouette of two characters forming the letter M (in the applied for mark) is concerned, the applicant argues that it represents two individuals shaking hands as if they concluded a deal. I disagree, as the device is so stylised that, where perceived, it will simply be seen as two characters with connecting diagonal arms; if any concept is taken from it, it will be of two individuals holding rather than shaking hands as they look more like two frontal facing characters. In my view the marks are conceptually similar to a high degree, if not identical.

Likelihood of confusion

68. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective services and vice versa. I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision I found that:

- The competing services are identical;
- The average consumer for the services is the public at large. The services are likely to be selected with a higher than average degree of care and attention; the purchasing process is likely to be primarily visual although aural considerations may play a part;
- the words PROPERTY MENTOR play a dominant role in the opponent's mark, which is endowed with a low degree of distinctive character;
- The competing marks are visually similar to a low to medium degree, aurally similar to a high degree, or alternatively, aurally similar to, at least, a medium to high degree and conceptually similar to a high degree, if not identical.

69. The applicant's case rests on the proposition that the common element of the mark, PROPERTY MENTOR, is descriptive and non-distinctive and as such should be disregarded in assessing the likelihood of confusion. I have found that the term is inherently weak but that it is not wholly descriptive. In connection to this, I note that in *PETMEDS*, BL O-471-11 Daniel Alexander, sitting as the Appointed Person, held that:

"33. [...] However, it is important not to treat the *F1* case as having established a general rule that, wherever an element of a mark could fairly be said to describe goods, it cannot be regarded as the distinctive and dominant component of the mark for the purpose of an evaluation under s.5(2)(b) of the Act.

34. That is confirmed by *Shaker di Laudato v. OHIM* T-7/04 [2009] ETMR 16 where the Court of First Instance, on a case remitted from the Court of Justice, said:

39. The Board of Appeal held that the word 'limoncello' was the dominant component of the trade mark applied for and that, therefore, the marks at issue were visually and phonetically practically identical, while Shaker claims, in essence, that as the word 'limoncello' does not have distinctive character, since it describes lemon-based liqueurs, it cannot be the dominant component of that mark for the purposes of the comparison of the marks at issue.

40. It should be borne in mind that, according to the case-law, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components. It is only if all the other components

of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element. That could be the case, in particular, where that component is capable alone of dominating the image of that mark which members of the relevant public keep in their minds, such that all the other components are negligible in the overall impression created by that mark (*OHIM v Shaker*, paragraphs 41 and 42, and Case C-193/06 P *Nestlé v OHIM* [2007] ECR I-114, paragraphs 42 and 43).

35. The court held that the word which the relevant public would remember was 'limoncello', in view of its prominent location and its position in relation to the other components of the mark, the fact that it was written in large white letters on a blue background, which made it stand out from that background and its size as compared with all the other word components of that the composite mark in issue. It therefore held that the word 'limoncello' was likely to dominate the overall impression created by the trade mark applied for in the minds of the relevant public. That was so notwithstanding the descriptive meaning of limonchelo.

36. In *L'Oreal SA v OHIM (Trade Marks and Designs)* [2006] EUECJ C-235/05, [2006] ECR I-57 in which registration of FLEXIAIR was refused because of the prior registration of FLEX, the Court of Justice said at [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.”

37. The Court of Justice therefore considered that, while it was a factor, the weak level of distinctiveness of an earlier mark was not invariably determinative of the issue of likelihood of confusion.

38. In my judgment, these cases show that [the] it is impossible to treat a common element which is even accepted to be descriptive in a blanket way in comparing marks in s.5(2)(b) cases. Each case must be considered on its own facts having regard to the particular circumstances of trade. To the extent that the Hearing Officer proceeded on the basis that the PETMEDS element of a mark could not constitute the dominant and distinctive element if it was descriptive does not do full justice to the richness of the descriptiveness/distinctiveness spectrum.”

70. As in the above case, I find that PROPERTY MENTOR in the opponent’s mark will be perceived as an indicator of origin, i.e. a business name. This is confirmed, in part, by the evidence which demonstrates that PROPERTY MENTOR is being used, in relation to the opponent’s business, as a trade mark. In the words of Mr Alexander, I find that “the only element of the opponent’s mark which the average consumer would be likely to regard as having trade mark significance is the term [PROPERTY MENTOR]. Moreover, [PROPERTY MENTOR] in both marks appears in the place where members of the public often expect to see a term with origin denoting significance” and it is presented in a similar format. That said, there are some visual differences between the marks which I consider sufficient to prevent direct confusion (one mark being mistaken for another). That being the case, the question is whether, nevertheless, there would be indirect confusion. In reaching a conclusion on this point, I remind myself of the finding of Mr Iain Purvis Q.C. sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, where he stated:

“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 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).”

71. Whilst the visual differences between the respective marks may avoid direct confusion, they are created by elements which are not highly distinctive. Having found that the most important point of similarity between the competing marks

consists of the words PROPERTY MENTOR, which will be regarded as the dominant element in the opponent's mark and taking into account the identity of the services and the similarities between the marks, I conclude that there is likelihood of indirect confusion. In particular, the applicant's mark may be seen as a re-branding of the opponent's mark and the similarity, despite the differences, will result in an expectation on the part of the average consumer that the identical services at issue come from the same or linked undertaking(s).

Conclusion

72. The opposition succeeds under Section 5(2)(b) of the Act. As the opposition has been successful against all of the applicant's services under this ground, there is no need to consider the additional claims under Section 5(4)(a).

Costs

73. The opposition has been successful and the opponent is entitled to a contribution towards his costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide and taking account of the fact that both the opponent and the applicant filed evidence, I award costs to the opponent on the following basis:

Official fees: £ 200

Preparing a statement and considering the other side's statement: £ 200

Preparing evidence and consider other side' evidence: £ 600

Written submissions: £ 200

Total: £ 1,200

74. I order Selyor Ltd to pay Matthew Lauchlan the sum of £ 1,200 as a contribution towards his costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 8th day of July 2016

Teresa Perks

For the Registrar

The Comptroller – General