

**O/195/18**

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3 168 476 MODA LIVING  
AND TRADE MARK APPLICATION No 3 168 498 MODA IN THE NAME OF MODA  
LIVING LIMITED

AND THE OPPOSITIONS THERETO BY MODA TV LIMITED

AND

IN THE MATTER OF TRADE MARK APPLICATIONS NO 3 189 578 MODA.COM  
AND 3 176 828 MODA.COM IN THE NAME OF MODA TV LIMITED

AND THE OPPOSITIONS THERETO BY MODA LIVING LIMITED

## Background and pleadings

1. MODA Living Limited (Party B) is the applicant in respect of UK Trade Mark Application No 3 168 476 MODA LIVING and UK Trade Mark Application No 3 168 498 MODA. They were applied for on 8<sup>th</sup> June 2016. They were accepted and published in the Trade Marks Journal on 8<sup>th</sup> July 2016 in respect of the following services:

Class 35:

*Advertising; business management; business administration; office functions; advertising services; business administration services; business advisory services; business consultancy services; business assistance, management and administrative services; business information and advisory services; business information services provided on-line from a computer database or the internet; business management services; business marketing services; business promotion services; business relocation services; marketing services; advertising of commercial or residential real estate; business and/or management consultancy services in association with the buying, selling, management, letting and/or leasing of real estate; promotional services in association with real estate; auctioneering of property; information advice and consultancy relating to all the above services.*

Class 36:

*Insurance; financial affairs; monetary affairs; real estate affairs; property valuation; leasing of property; real property letting; rental of property; property portfolio management; real property management; domestic property finding services; insurance for property owners; administration of property portfolios; insurance brokerage for property; financing of property loans; property investment services; financing of property development; time-share property management; commercial property investment services; financial evaluation of real property; information, consultancy and advisory services relating to all of the above services.*

Class 37:

*Building construction; property maintenance; construction of property; cleaning of property; maintenance of property; renovation of property; property development services; advisory services relating to the renovation of property; car cleaning and valeting services; information, consultancy and advisory services relating all of the above services.*

Class 42:

*Design services relating to residential property; planning of buildings; design of building developments; architecture services; building research services; design services for building interiors; technological research for the building construction industry; engineering services in the field of building technology; information, consultancy and advisory services relating to all of the above services.*

2. MODA TV Limited (Party A) oppose the trade marks on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier UK Trade Mark: 3 189 578 MODA.COM which was applied for on 6<sup>th</sup> October 2016 and published on 23<sup>rd</sup> December 2016<sup>1</sup>. The following services are relied upon in this opposition:

Class 35:

*Advertising, business management and business administration, employments agency services; conducting skills evaluation for individuals; business consultancy, office functions; business services for hotels.*

---

<sup>1</sup> The trade mark benefits from a priority date of 11<sup>th</sup> April 2016 and so is an earlier trade mark under Section 6 of the Trade Marks Act 1994.

Class 36:

*Financial services; investment services; fund and asset management; financial management and planning.*

Class 37:

*Building construction; installation, repair and maintenance of computer apparatus and instruments, electronic data processing apparatus and instruments, telecommunications apparatus and instruments.*

Class 38:

*Television, cable television and radio broadcasting services.*

Class 39:

*Transport; packaging and storage of goods; travel arrangement; physical storage of electronic media, namely, images, text, video and audio data.*

Class 41:

*Education; production and distribution of television shows and movies; services related to exhibitions, shows and fairs, organization and preparation in the field of fashion, culture and entertainment, music publishing services.*

Class 42:

*Immigration consultancy services for corporations and individuals; immigration consultancy services in relation to obtaining visas.*

Class 43:

*Hotel services; hotel and guest house rental and reservations; bar services; café-restaurants.*

Class 44:

*Medical services; Veterinary services; Hygienic and beauty care for human beings or animals; Agriculture, horticulture and forestry services.*

3. Party A argues that the respective services are identical or similar and that the marks are similar.
4. Party B filed a counterstatement denying the claims made.
5. Party B oppose the trade mark upon which Party A's opposition relies, namely 3 189 578 MODA.COM. This is on the basis of Section 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1004. The claim under Section 5(2)(b) and Section 5(3) is on the basis of its earlier UK trade mark No 3 081 315



6. In respect of the grounds under Section 5(2)(b) and 5(3), the following services are relied upon:

Class 35:

*Advertising; business management; business administration; office functions; auctioneering of property; advertising services relating to real property; advertising services relating to the sale of personal property; information, consultancy and advisory services relating to all of the aforesaid.*

Class 36:

*Insurance; financial affairs; monetary affairs; real estate affairs; property valuation; leasing of property; real property letting; rental of property; property portfolio management; real property management; valuation of property; property (Real estate -) finance; domestic property finding services; insurance for property owners; administration of property portfolios; insurance brokerage for property; financing of property loans; property (Real estate -) investment; financing of property development; time-share property management; commercial property investment services; real property evaluation [financial]; property appraisal services [valuation]; information, consultancy and advisory services relating to all of the aforesaid.*

Class 37:

*Building construction; property maintenance; construction of property; cleaning of property; maintenance of property; renovation of property; property development services [construction]; advisory services relating to the renovation of property; information, consultancy and advisory services relating to all of the aforesaid.*

Class 42:

*Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; design services relating to residential property; architecture services; building research services; information, consultancy and advisory services relating to all of the aforesaid.*

7. Under Section 5(2)(b), Party B argue that the respective services are identical and/or similar and the marks are similar.
8. Under Section 5(3), it argues that its earlier trade mark enjoy a reputation and that use of the later trade mark would lead the public to mistakenly believe

there to be an economic connection between this and the earlier trade mark. Further, it claims that the later trade mark will unfairly benefit from the time and expenditure undertaken by the opponent in promoting its earlier trade mark. In addition, the opponent has no control over the activities over the applicant. The provision of an inferior service could therefore lead to detriment to reputation. Finally, the earlier trade mark is distinctive and the use of such similar signs would clearly be detrimental to its distinctive character.

9. Under Section 5(4)(a), Party B argues that since January 2014, it has used the following signs: MODA and MODA LIVING. Further, that they have been used throughout the UK. The full list of services upon which the signs are claimed to have been used is attached at Annex 1, which is reproduced entirely from the Notice of Opposition. According to Party B, use of the later trade marks would lead to misrepresentation and damage.

10. Finally, Party B also oppose a further trade mark application of Party A, namely 3 176 828 MODA.COM. This was applied for on 22<sup>nd</sup> July 2016 and published in the Trade Marks Journal on 21<sup>st</sup> October 2016 in respect of the following goods:

Class 07:

*Machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles).*

11. The basis of this opposition by Party B mirrors that against Trade Mark No 3 189 578. As such, the basis of the claims will not be repeated here.

12. In response to both oppositions, Party A filed a counterstatement denying the claims made.

13. Only Party B filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary.

14. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.
15. Both of Party B's oppositions will be considered together for convenience and will also be considered first in this decision. If Party B's oppositions succeed, then Party A's oppositions will necessarily fail.

## Evidence

16. This is a witness statement, dated 31<sup>st</sup> July 2017, from Mr Oscar Brooks, the Acquisitions Director of Party B. Mr Brooks explains that his company has



used the signs MODA, MODA LIVING and (hereafter referred to as the MODA signs) since July 2014 in respect of all of the services listed above, in particular specialising in the Private Rented Sector in respect of property development activities. The following is relevant information:

- Exhibit OB2 contains extracts from the current website along with those from the historical website. These were, according to Mr Brooks, obtained from the Wayback Machine and demonstrate continuous use of the MODA signs.
- Exhibit OB3 is the result of Google analytics for the company website for the periods September 2014 to July 2017. These figures, according to Mr Brooks, demonstrate over 62,000 sessions by over 44,000 users.
- Exhibit OB4 is an example marketing brochure for a typical property development of the company. According to Mr Brooks, this demonstrates the manner in which the MODA signs are used, together with the range of services provided. These include property development, financial services, advertising services, entertainment and sports facilities, design services in respect of property, food and drink services and spa services.



- OB5 is an extract from the current website demonstrating use of the signs in Manchester, Liverpool, Leeds, London, Birmingham, Glasgow and Edinburgh.
- Exhibits OB6, 7, 8 and 9 contain examples of media coverage of the MODA signs and business activities. It is noted that these are numerous and include details regarding the value of property developments that MODA are engaged in. Notably, a project worth £1 billion is mentioned. This appears to be dated in 2014.
- Exhibit OB10 are sample invoices relating to design and development of the MODA signs, dated 2015-2017. It would appear these signs were used by MODA during its property development activities.
- Exhibit OB11 contains brand guidelines for the MODA signs.

## **DECISION**

### **Party B's Oppositions**

17. Both of Party B's oppositions will be considered simultaneously.

### **Section 5(2)(b)**

18. Sections 5(2)(b) of the Act is as follows:

"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".

## Comparison of goods and services

19. In the judgment of the Court of Justice of the European Union (“the CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

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

- (a) The respective 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.

21. The following guidance is also taken into account: in *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

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

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

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

Whilst on the other hand:

“.....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.

23. The earlier services are:

Class 35:

*Advertising; business management; business administration; office functions; auctioneering of property; advertising services relating to real property; advertising services relating to the sale of personal property; information, consultancy and advisory services relating to all of the aforesaid.*

Class 36:

*Insurance; financial affairs; monetary affairs; real estate affairs; property valuation; leasing of property; real property letting; rental of property; property portfolio management; real property management; valuation of property; property (Real estate -) finance; domestic property finding services; insurance for property owners; administration of property portfolios; insurance brokerage for property; financing of property loans; property (Real estate -) investment; financing of property development; time-share property management; commercial property investment services; real property evaluation [financial]; property appraisal services [valuation]; information, consultancy and advisory services relating to all of the aforesaid.*

Class 37:

*Building construction; property maintenance; construction of property; cleaning of property; maintenance of property; renovation of property; property development services [construction]; advisory services relating to the renovation of property; information, consultancy and advisory services relating to all of the aforesaid.*

Class 42:

*Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of*

*computer hardware and software; design services relating to residential property; architecture services; building research services; information, consultancy and advisory services relating to all of the aforesaid.*

24. The later goods and services are:

**Application No 3 176 828:**

Class 07:

*Machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles).*

**Application No 3 189 578:**

Class 35:

*Advertising, business management and business administration, employments agency services; conducting skills evaluation for individuals; business consultancy, office functions; business services for hotels.*

Class 36:

*Financial services; investment services; fund and asset management; financial management and planning.*

Class 37:

*Building construction; installation, repair and maintenance of computer apparatus and instruments, electronic data processing apparatus and instruments, telecommunications apparatus and instruments.*

Class 38:

*Television, cable television and radio broadcasting services.*

Class 39:

*Transport; packaging and storage of goods; travel arrangement; physical storage of electronic media, namely, images, text, video and audio data.*

Class 41:

*Education; production and distribution of television shows and movies; services related to exhibitions, shows and fairs, organization and preparation in the field of fashion, culture and entertainment, music publishing services.*

Class 42:

*Immigration consultancy services for corporations and individuals; immigration consultancy services in relation to obtaining visas.*

Class 43:

*Hotel services; hotel and guest house rental and reservations; bar services; café-restaurants.*

Class 44:

*Medical services; Veterinary services; Hygienic and beauty care for human beings or animals; Agriculture, horticulture and forestry services.*

**Contested goods in Class 07:**

25. The most likely potential clash will be in respect of the earlier construction services so this will be considered first. In this regard, the contested goods

differ in nature and method of use. They are also more likely to differ in respect of the end user: professionals (builders and heavy industry) in respect of the goods as opposed to the general public and the business customer in respect of construction services. They are also not in competition with the earlier construction (or indeed any of the earlier terms). In addition, the channels of trade will differ. The later goods could potentially be used during building work, dependent upon the exact nature of each. However, it is considered that this is not a complementary relationship as envisaged by the case law (above), namely that they are indispensable to one another with the result being that the relevant public would believe that the same undertaking (or an economically related one) is responsible for both the goods and services. I have no evidence nor persuasive submissions on the point which convince me that there is similarity here. As such, I cannot conclude that they are similar. In addition, they are not similar to any of the remaining earlier terms.

#### **Contested services in Class 35:**

26. It is noted that the later terms: *advertising, business management and business administration; office functions* appear in an identical manner in the earlier specification. They are identical. Further, the later *employments agency services; conducting skills evaluation for individuals* is included within the earlier *business management and business administration*. The later *business consultancy* is a business management function and so is included within the earlier *business management*. Finally, the contested *business services for hotels* is considered to also be included within the earlier *business management*. They are identical.

#### **Contested services in Class 36:**

27. The earlier *financial affairs* and the later *financial services* are considered to be one and the same. They are identical.

28. The earlier term *financial affairs* is considered to be a very broad term encompassing a wide range of different financial services and activities. This will include the following contested terms: fund and asset management; financial management and planning and applying the guidance in MERIC, the respective services are identical.

29. The earlier term *property (Real estate) investment* is clearly included within the later *investment services* and so, the terms are self-evidently identical.

**Contested services in Class 37:**

30. Building construction appears in both specifications. They are identical. The remainder of the contested services are: *installation, repair and maintenance of computer apparatus and instruments, electronic data processing apparatus and instruments, telecommunications apparatus and instruments*. The earlier trade mark includes the following terms in Class 42, namely, *design and development of computer hardware and software*. Such services may be provided by the same undertaking and also coincide in terms of end user. As such, there is a degree of similarity here. This is pitched as being low.

**Contested services in Class 38:**

31. These are all broadcasting services which have nothing in common with any of the earlier services. Neither side provided persuasive submissions and it is not obvious to me how the respective services are similar. Therefore, I conclude there is no similarity.

**Contested services in Class 39:**

32. These terms all relate to transport, packing and storage of goods, as well as travel arrangement. Neither side provided persuasive submissions on this point and it is not obvious to me how the respective services are similar. Therefore, I conclude there is no similarity.



#### **Contested services in Class 41:**

33. The contested *Education* has some features in common with *scientific and technological services and research and design relating thereto*. Most notably research activities are likely to form part of both, leading to the advancement of knowledge. They can also be provided by the same undertaking, an illustrative example being a University lecturer, who also carries out research in the field. They are considered similar, to a low to moderate degree.

34. The remaining contested terms have nothing in common with the earlier terms. Neither side have provided persuasive submissions on this point and it is not obvious to me how the respective services are similar. Therefore, I conclude there is no similarity.

#### **Contested services in Class 42:**

35. These are consultancy services in respect of immigration. They are niche and have nothing in common with the earlier terms. Neither side have provided persuasive submissions on this point and it is not obvious to me how the respective services are similar. Therefore, I conclude there is no similarity.

#### **Contested services in Class 43:**

36. These are hotel services and those related thereto. They have nothing in common with the earlier terms. Neither side have provided persuasive submissions on this point and it is not obvious to me how the respective services are similar. Therefore, I conclude there is no similarity.

#### **Contested services in Class 44:**

37. Likewise, these contested terms have nothing in common with the earlier terms. are clearly not similar to those in the earlier trade mark. Neither side have provided persuasive submissions on this point and it is not obvious to

me how the respective services are similar. Therefore, I conclude there is no similarity.

38. The position can be summed up as follows:

39. The following goods and services have been found to be identical and/or similar (the latter to varying degrees):

**Application No 3 189 578:**

Class 35:

*Advertising, business management and business administration, employments agency services; conducting skills evaluation for individuals; business consultancy, office functions; business services for hotels.*

Class 36:

*Financial services; investment services; fund and asset management; financial management and planning.*

Class 37:

*Building construction; installation, repair and maintenance of computer apparatus and instruments, electronic data processing apparatus and instruments, telecommunications apparatus and instruments.*

Class 41:

*Education.*

40. The remainder have been found to be not similar, namely:

**Application No 3 176 828:**

Class 07:

*Machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles).*

**Application No 3 189 578:**

Class 38:

*Television, cable television and radio broadcasting services.*

Class 39:

*Transport; packaging and storage of goods; travel arrangement; physical storage of electronic media, namely, images, text, video and audio data.*

Class 41:

*Production and distribution of television shows and movies; services related to exhibitions, shows and fairs, organization and preparation in the field of fashion, culture and entertainment, music publishing services.*

Class 42:

*Immigration consultancy services for corporations and individuals; immigration consultancy services in relation to obtaining visas.*

Class 43:

*Hotel services; hotel and guest house rental and reservations; bar services; café-restaurants.*

Class 44:

*Medical services; Veterinary services; Hygienic and beauty care for human beings or animals; Agriculture, horticulture and forestry services.*


## **Comparison of marks**

41. 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 Court of Justice of the European Union 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.”

42. 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.

43. The respective trade marks are shown below:

	<p style="text-align: center;">MODA.COM</p>
<p style="text-align: center;">Earlier trade mark</p>	<p style="text-align: center;">Contested trade marks</p>

44. The earlier trade mark is a complex mark comprised of a number of elements as shown. It is noteworthy that MODA appears in a different colour from the remaining word and graphical elements. Further, it has a thicker font style. These features enable it to stand out as both dominant and distinctive (though the other elements are not ignored. In the later trade mark, it is likely to be read as a website address. The “.com” feature is instantly recognisable and meaningful. The MODA element is also distinctive here, though it is accepted that it shares visual dominance with “.com”.

45. Visually, the marks coincide in respect of the word MODA and differ in all other respects. The inclusion of MODA in each inevitably leads to a finding of visual similarity, though this is pitched at being low to medium.

46. Aurally, it is considered most likely that the earlier trade mark will be articulated as “MOH-DAH LIV-ING” and the later trade marks as “MOH-DAH-DOT-COM”. They are aurally similar, to a low to medium degree.

47. Conceptually, MODA, it is noted that it is Italian for “fashion”. However, in the absence of submissions on the point, I consider this will not be understood by the average consumer thus it is likely to be perceived as meaningless and has the look and feel of an invented word. The remaining words in each of the

trade marks have their own particular meanings. There is no concept in common here.

## **Average consumer and the purchasing act**

48. 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*.

49. 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.”

50. The average consumer is both the general public and the business sector. It is likely that availing one self of goods and services of this nature is relatively costly and they would be acquired fairly infrequently. As such, it is considered that a relatively high degree of attention would be displayed during the purchasing process. Further, that this is likely to follow a period of research. Visual and aural considerations are therefore important.

## Distinctive character of the earlier trade mark

51. 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).”

52. The earlier trade mark is a complex trade mark, with its most dominant and distinctive element being MODA. This is likely to be perceived as an invented word. It is considered that bearing in mind the overall complexity of the earlier trade mark, it has a higher than average degree of distinctive character.

53. It is noted that the opponent claims it enjoys a reputation in respect of all of its earlier goods and services for which the earlier trade mark is registered. However, the evidence does not provide any details of turnover or market

share. The degree of knowledge of the earlier trade mark in respect of the average consumer cannot therefore be assessed. I cannot conclude that a reputation has been shown and so cannot go on to consider whether or not this also means it enjoys a greater degree of distinctiveness as a result of the use made of it.

## **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

54. 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.

### *The principles*

(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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

55. The marks have been found to be similar visually and aurally, to a low to medium degree. There is no concept in common. The goods and services

have been found to be similar, to varying degrees, though it is considered that nothing turns on this point. The earlier trade mark enjoys an above average degree of distinctiveness and the later trade mark coincides with the earlier in respect of its most distinctive element, namely MODA. I take into account both imperfect recollection and that the average consumer would display a higher than average degree of attention during the purchasing process. I also take into account the following:

56. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained 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 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.

57. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

58. It is considered that upon encountering the later mark, the average consumer, is likely to recall the earlier trade mark and view the later trade mark as merely denoting the web address of the same trader as uses the earlier trade mark. It is considered that such a scenario is indirect confusion as the two trade marks

are believed to have originated from the same undertaking. This is not mere association. As such, the opposition under Section 5(2)(b) in respect of application No 189 578, succeeds in respect of the following:

**Application No 3 189 578:**

Class 35:

*Advertising, business management and business administration, employments agency services; conducting skills evaluation for individuals; business consultancy, office functions; business services for hotels.*

Class 36:

*Financial services; investment services; fund and asset management; financial management and planning.*

Class 37:

*Building construction; installation, repair and maintenance of computer apparatus and instruments, electronic data processing apparatus and instruments, telecommunications apparatus and instruments.*

Class 41:

*Education.*

59. It fails in respect of:

**Application No 3 176 828:**

Class 07:

*Machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles).*

**Application No 3 189 578:**

Class 38:

*Television, cable television and radio broadcasting services.*

Class 39:

*Transport; packaging and storage of goods; travel arrangement; physical storage of electronic media, namely, images, text, video and audio data.*

Class 41:

*Production and distribution of television shows and movies; services related to exhibitions, shows and fairs, organization and preparation in the field of fashion, culture and entertainment, music publishing services.*

Class 42:

*Immigration consultancy services for corporations and individuals; immigration consultancy services in relation to obtaining visas.*

Class 43:

*Hotel services; hotel and guest house rental and reservations; bar services; café-restaurants.*

Class 44:

*Medical services; Veterinary services; Hygienic and beauty care for human beings or animals; Agriculture, horticulture and forestry services.*

60. As such, I shall go on to consider the remaining grounds in respect only of the goods and services that have survived Party B's opposition to Application Nos 3 189 578 and 3 176 828.

### Section 5(3) – REPUTATION

61. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) 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.”

62. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This 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 (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

## REPUTATION – THRESHOLD

63. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. 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.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

64. I have already considered the opponent's evidence in this regard. It is noted that it has no details regarding market share and turnover. In this regard, I bear in mind the following guidance:

65. In *Rise Construction Management Limited v Barclays Bank*,<sup>2</sup> Professor Philip Johnson as the Appointed Person rejected an appeal against the Hearing Officer's decision that the earlier mark had not been shown to have acquired a reputation for s.5(3) purposes. He said:

---

<sup>2</sup> BL O/635/17



“76. Even if the Hearing Officer had considered all the evidence of other successful management projects (Bow Street Magistrates’ Court, the UK Pavilion at the Madrid Expo, the Royal Opera House, or Kidzania) and the attendant publicity as well as given some (possibly) very little weight to the awards it would have made no material difference. None of this material addresses the fundamental difficulties faced by the Respondent namely that there was no evidence presented as to market share, no evidence from trade bodies or from people with standing in the industry, and no evidence of the market in which the reputation was claimed.

77. In respect of this final point, at the end of the Hearing, I asked Mr Hollingworth in what market the Respondent claimed reputation. He said the “construction industry” and that his client was known as a project manager in that industry. There was no evidence presented as to the size of the construction industry market (a further problem for Mr Hollingworth identified by the Hearing Officer: see paragraph 56). Nevertheless, I can take notice of the fact that the industry is worth many tens of billions of pounds and employs well over a million people. The Respondent’s turnover (which as the Hearing Officer pointed out, does not break down between UK and overseas: paragraph 12) is at most £8million and the number employed nearly 100.

78. While the requirement for a reputation is “not onerous” (see *Enterprise Holdings, Inc v Europcar Group UK Ltd & Anor* [2015] EWHC 17 (Ch) at paragraph 120) and there was possibly more evidence the Hearing Officer should have considered to make her determination, none of the missing evidence could have materially changed her conclusion that “RISE has positive connotations of moving upwards” (paragraph 56) and that the Respondent did not have the necessary reputation in relation to construction management (paragraph 73). Furthermore, once the relevant market was identified by Mr Hollingworth as the behemoth that is the construction industry, the Hearing Officer’s statement might even appear generous. Accordingly, I dismiss the cross-appeal in relation to section 5(3).”

66. It is true that the evidence contains several examples of press coverage of the opponent including details of a development project worth £1 billion. This sounds like a significant amount of money, however its true value is impossible to determine minus any context. I am not provided with any information regarding the construction industry and its worth, nor how it is stratified. I cannot conclude that the opponent has a reputation. And so the opposition based upon Section 5(3) fails.

### Section 5(4)(a) – Passing Off

67. Section 5(4)(a) states:

“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.”

### General principles of Section 5(4)(a)

68. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court stated that:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case ( *Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341 ,

HL, namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56 In relation to deception, the court must assess whether "*a substantial number*" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

69. Halsbury's Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 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.”

## Meaning of goodwill

70. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL):

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

71. The earlier signs relied upon are MODA and MODA LIVING. It is considered clear from the evidence that the opponent's business is in respect of property

development/construction and has attracted a protectable goodwill. It is noted from the pleadings that the opponent has claimed it has a goodwill in a range of services beyond the core construction/property development. It is also accepted that in providing a service of this nature, the end product (in the opponent's case, a residential property) will include certain facilities such as on site gyms/restaurants and the like. This is shown in a brochure from the opponent, which is included in the evidence. However, it is considered that it is not the opponent that would be providing gym and/or restaurant services (rather it would have built them) and its business is unlikely to be perceived as doing so by the relevant public. The opponent is a property developer and constructs residential properties. This is where its goodwill lies. It is therefore on this basis that I will go on to consider the remaining services of the applicant to assess whether or not there will be a misrepresentation.

72. The remaining contested goods and services are:

Class 07:

*Machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles).*

Class 38:

*Television, cable television and radio broadcasting services.*

Class 39:

*Transport; packaging and storage of goods; travel arrangement; physical storage of electronic media, namely, images, text, video and audio data.*

Class 41:

*Production and distribution of television shows and movies; services related to exhibitions, shows and fairs, organization and preparation in the field of fashion, culture and entertainment, music publishing services.*

Class 42:

*Immigration consultancy services for corporations and individuals; immigration consultancy services in relation to obtaining visas.*

Class 43:

*Hotel services; hotel and guest house rental and reservations; bar services; café-restaurants.*

Class 44:

*Medical services; Veterinary services; Hygienic and beauty care for human beings or animals; Agriculture, horticulture and forestry services.*

73. It is clear that these are a vastly different field of activity from that of property development/construction. However, under Section 5(4)(a), the fields of activity do not need to coincide in order for misrepresentation to bite. The closeness of the respective fields of activity is a relevant consideration though. In this respect I bear in mind the following guidance on misrepresentation:

74. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

75. The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis* ” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

76. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J. made the following findings about the lack of a requirement for the parties to operate in the a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business. The expression “common field of activity” was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd.*

(1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego case Falconer J.* acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

77. The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

‘...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’:

*Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency)* [1972] R.P.C. 838 at page 844 per Russell L.J.

78. In the *Lego case Falconer J.* likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

79. Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.



80. Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

'even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.'

81. In the same case Stephenson L.J. said at page 547:

'...in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged "passer off" seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.' "

82. It is considered that the contested services are a significant distance from those for which the opponent has demonstrated a goodwill. It is difficult to see how a potential customer can be misled here. As such, it is considered that

there is no misrepresentation. As such, the opposition based upon Section 5(4)(a) also fails.

83. The sum of all this is that the oppositions by Party B succeed partially in respect of Application No 3 189 578.

### **Party A's Opposition**

84. As the success is only partial in respect of this application, the cross opposition on which it is based must be considered. As already stated above, this is based upon Section 5(2)(b). I have already outlined the relevant legislation and case law above and so will not repeat this here.

85. I will firstly compare the respective goods and services. The earlier goods and services are:

Class 07:

*Machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles).*

Class 38:

*Television, cable television and radio broadcasting services.*

Class 39:

*Transport; packaging and storage of goods; travel arrangement; physical storage of electronic media, namely, images, text, video and audio data.*

Class 41:

*Production and distribution of television shows and movies; services related to exhibitions, shows and fairs, organization and preparation in the field of fashion, culture and entertainment, music publishing services.*

Class 42:

*Immigration consultancy services for corporations and individuals; immigration consultancy services in relation to obtaining visas.*

Class 43:

*Hotel services; hotel and guest house rental and reservations; bar services; café-restaurants.*

Class 44:

*Medical services; Veterinary services; Hygienic and beauty care for human beings or animals; Agriculture, horticulture and forestry services.*

86. The contested services are:

Class 35:

*Advertising; business management; business administration; office functions; advertising services; business administration services; business advisory services; business consultancy services; business assistance, management and administrative services; business information and advisory services; business information services provided on-line from a computer database or the internet; business management services; business marketing services; business promotion services; business relocation services; marketing services; advertising of commercial or residential real estate; business and/or*

*management consultancy services in association with the buying, selling, management, letting and/or leasing of real estate; promotional services in association with real estate; auctioneering of property; information advice and consultancy relating to all the above services.*

Class 36:

*Insurance; financial affairs; monetary affairs; real estate affairs; property valuation; leasing of property; real property letting; rental of property; property portfolio management; real property management; domestic property finding services; insurance for property owners; administration of property portfolios; insurance brokerage for property; financing of property loans; property investment services; financing of property development; time-share property management; commercial property investment services; financial evaluation of real property; information, consultancy and advisory services relating to all of the above services.*

Class 37:

*Building construction; property maintenance; construction of property; cleaning of property; maintenance of property; renovation of property; property development services; advisory services relating to the renovation of property; car cleaning and valeting services; information, consultancy and advisory services relating all of the above services.*

Class 42:

*Design services relating to residential property; planning of buildings; design of building developments; architecture services; building research services; design services for building interiors; technological research for the building construction industry; engineering services in the field of building technology; information, consultancy and advisory services relating to all of the above services.*

87. I have already compared the Class 07 goods with building construction in Class 37 earlier in the decision. The same reasoning applies here and so I will not repeat the analysis. As regards the remainder of the contested services, it is considered that none of them bear any relation to the earlier services. They differ in nature and purpose. They have different channels of trade. They have different methods of use and are not in competition. They are not complementary. They are considered to be not similar.

88. Similarity of goods and services is a requirement for Section 5(2)(b) to bite<sup>3</sup>. Without a finding of similarity, the opposition cannot succeed. The opposition by MODA TV therefore fails.

89. The following can therefore proceed to registration as follows:

**No 3 168 476 MODA LIVING and UK Trade Mark Application No 3 168 498  
MODA:**

Class 35:

*Advertising; business management; business administration; office functions; advertising services; business administration services; business advisory services; business consultancy services; business assistance, management and administrative services; business information and advisory services; business information services provided on-line from a computer database or the internet; business management services; business marketing services; business promotion services; business relocation services; marketing services; advertising of commercial or residential real estate; business and/or management consultancy services in association with the buying, selling, management, letting and/or leasing of real estate; promotional services in*

---

<sup>3</sup> See: *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU)

*association with real estate; auctioneering of property; information advice and consultancy relating to all the above services.*

Class 36:

*Insurance; financial affairs; monetary affairs; real estate affairs; property valuation; leasing of property; real property letting; rental of property; property portfolio management; real property management; domestic property finding services; insurance for property owners; administration of property portfolios; insurance brokerage for property; financing of property loans; property investment services; financing of property development; time-share property management; commercial property investment services; financial evaluation of real property; information, consultancy and advisory services relating to all of the above services.*

Class 37:

*Building construction; property maintenance; construction of property; cleaning of property; maintenance of property; renovation of property; property development services; advisory services relating to the renovation of property; car cleaning and valeting services; information, consultancy and advisory services relating all of the above services.*

Class 42:

*Design services relating to residential property; planning of buildings; design of building developments; architecture services; building research services; design services for building interiors; technological research for the building construction industry; engineering services in the field of building technology; information, consultancy and advisory services relating to all of the above services.*

**Application No 3 176 828 MODA.COM:**

Class 07:

*Machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles).*

**Application No 3 189 578 MODA.COM:**

Class 38:

*Television, cable television and radio broadcasting services.*

Class 39:

*Transport; packaging and storage of goods; travel arrangement; physical storage of electronic media, namely, images, text, video and audio data.*

Class 41:

*Production and distribution of television shows and movies; services related to exhibitions, shows and fairs, organization and preparation in the field of fashion, culture and entertainment, music publishing services.*

Class 42:

*Immigration consultancy services for corporations and individuals; immigration consultancy services in relation to obtaining visas.*

Class 43:

*Hotel services; hotel and guest house rental and reservations; bar services; café-restaurants.*

Class 44:

*Medical services; Veterinary services; Hygienic and beauty care for human beings or animals; Agriculture, horticulture and forestry services.*

## **COSTS**

90. Both parties have achieved a roughly equal measure of success in these proceedings. I therefore order that each party bear its own costs.

**Dated this 27<sup>th</sup> day of March 2018**

**Louise White**  
**For the Registrar**



# Annex 1

---

**Class 35:** Advertising; business management; business administration; office functions; advertising services; business administration services; business advisory services; business consultancy services; business assistance, management and administrative services; business information and advisory services; business information services provided on-line from a computer database or the internet; business management services; business marketing services; business promotion services; business relocation services; marketing services; advertising of commercial or residential real estate; business and/or management consultancy services in association with the buying, selling, management, letting and/or leasing of real estate; promotional services in association with real estate; auctioneering of property; information advice and consultancy relating to all the above services.

**Class 36:** Insurance; financial affairs; monetary affairs; real estate affairs; property valuation; leasing of property; real property letting; rental of property; property portfolio management; real property management; domestic property finding services; insurance for property owners; administration of property portfolios; insurance brokerage for property; financing of property loans; property investment services; financing of property development; time-share property management; commercial property investment services; financial evaluation of real property; information, consultancy and advisory services relating to all of the above services.

**Class 37:** Building construction; property maintenance; construction of property; cleaning of property; maintenance of property; renovation of property; property development services; advisory services relating to the renovation of property; car cleaning and valeting services; information, consultancy and advisory services relating all of the above services.

**Class 38:** Telecommunication services; telecommunication portal services; providing access to the internet; providing user access to portals on the internet; chat room services; operating chat rooms; providing access to internet chat rooms; providing on-line electronic bulletin boards; provision of email services; radio broadcasting services; information, advice and consultancy relating to all of the above services; all the aforementioned services provided in connection with residential property services and not in relation to a television channel.

**Class 39:** Car parking services.

**Class 41:** Entertainment services; provision of cinema services; provision of sports facilities; provision of gymnasiums; gymnasium services; provision of recreational facilities; information, consultancy and advice relating to all of the above services; all the aforementioned services provided in connection with residential property services and not in relation to a television channel.

**Class 42:** Design services relating to residential property; planning of buildings; design of building developments; architecture services; building research services; design services for building interiors; technological research for the building construction industry; engineering services in the field of building technology; information, consultancy and advisory services relating to all of the above services.

**Class 43:** Provision of food and drink; provision of temporary accommodation; café services; restaurant services; bar services; catering services; information, advice and consultancy in relation to all of the above services.

**Class 44:** Spas; provision of spa services.