

O-507-19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3304546
BY RELIANCE HOMES LIMITED
TO REGISTER AS A TRADE MARK:**

RELIANCE HOMES

IN CLASSES 36 AND 37

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 413399
BY RELIANCE TRUST LIMITED**

Background and pleadings

1. On 17 April 2018, Reliance Homes Limited (“the applicant”) applied to register **RELIANCE HOMES** as a trade mark, under number 3304546 (“the contested mark”). The application was published for opposition purposes on 11 May 2018 in respect of the following services in classes 36 and 37:

Class 36: Financial services relating to property, real estate and investment; estate agencies; real estate and property management; real estate appraisal; leasing of real estate; rental of property; financial evaluation of real estate; mortgage advisory and administration services; financial services relating to property; insurance services relating to property; property management; property valuation; financial advice relating to taxation; property portfolio management; administration of property portfolios; financing of property loans; financing of property development; commercial property investment services; financial services relating to property; real estate and property management services; agency services for the leasing of real estate property; estate management services relating to transactions in real property; provision of information relating to the property market [real estate]; investment services relating to real property; real estate investment; real estate portfolio investment management; investment management services relating to property investments; investment account services relating to property investment; real property investment fund services; financial investment services relating to real property; development of real property investment portfolios; provision of property investment capital; administration of real property fund investment; arranging investments in real property, in particular capital investments, financing services and insurance; raising of capital; mortgage investment management; arranging of mortgages; mortgage investment management; construction and development project financing;

information, advice and consultancy in relation to all the aforesaid services.

Class 37: Property development; property maintenance, renovation and repair; construction of property; construction project management services; information, advice and consultancy in relation to all the aforesaid services.

2. The application is opposed by Reliance Trust Limited (“the opponent”). The opposition is brought under ss. 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”) and is, under each of these grounds, directed against all of the services in the application.

3. Under s.5(2)(b), the opponent relies upon three earlier trade marks.¹ The first is European Union trade mark (“EUTM”) number 1111202 **RELIANCE**, which has a filing date of 18 March 1999 and was entered in the register on 17 May 2000. The mark is registered in classes 9, 35, 37, 39 and 42. For the purposes of its opposition under s. 5(2)(b), the opponent relies upon the following goods and services:

Class 9: Security surveillance apparatus, security alarm systems; security apparatus for buildings; security control instruments; security devices for doors and windows; security installations; security monitoring apparatus; security warning apparatus; alarms; parts and fittings for all the aforesaid goods.

Class 35: Management of facilities.

Class 37: Installation, maintenance and repair of security apparatus and installations.

¹ The goods and services relied upon are as amended in written submissions dated 2 July 2019.

4. The second mark relied upon is UK trade mark number 2231161 **RELIANCE**. The mark was filed on 2 May 2000 and was entered in the register on 20 June 2003. This mark is registered in classes 9, 16, 25, 35, 37, 39 and 42.

5. The third registered mark relied upon is UK trade mark number 2224906 for the mark shown below:



The mark was filed on 7 March 2000 and has a registration date of 3 August 2001. It too is registered in classes 9, 16, 25, 35, 37, 39 and 42.

6. The same specifications are relied upon for both of the opponent's earlier UK trade marks, namely:

Class 9: Electronic surveillance apparatus; CCTV; security surveillance apparatus; security alarm systems; security apparatus for buildings; security control instruments; security devices for doors and windows; security installations; security monitoring apparatus; security warning apparatus.

Class 35: Management of facilities.

Class 37: Installation, maintenance and repair of security apparatus and installations.

7. Under s. 5(3), the opponent relies upon all three of the above trade marks. It relies upon the goods and services detailed above, as well as, in class 42, "security services and security consultancy" (EUTM 1111202) and "security services and consultancy services" (UK trade marks 2231161 and 2224906).

8. The opponent claims under s. 5(2)(b) that the marks are similar and that the goods and services are identical or similar, which will give rise to a likelihood of confusion, including the likelihood of association.

9. Under s. 5(3), the opponent claims that its marks have a reputation in the UK such that use of the contested mark would cause the relevant public to believe that there is an economic connection between the applicant and the opponent, where no such connection exists. It claims that the applicant is trading off the reputation of the earlier marks and could increase its own sales without making the associated investment, and that the applicant's marketing could be made easier by association with the opponent's marks. The opponent claims that there may be detriment to the reputation of the earlier mark owing to the opponent's lack of control over the applicant's activities, including the quality of the services to which the mark may be applied, and tarnishing may result from any connection made between the parties. The opponent further claims that the power of attraction of the earlier marks may be weakened and that the distinctive character of the earlier mark may be diluted or blurred through use of the contested mark.

10. Further, the opponent claims under s. 5(4)(a) that the signs **RELIANCE** and



have been used throughout the UK since 1980 in respect of the following goods and services:

Management of facilities, installation, maintenance and repair of security apparatus and installations; construction, maintenance and repair of prisons; construction, maintenance, cleaning and repair of buildings, management of contractors, project management, inspection of buildings, security services, security consultancy; security apparatus and equipment for use within and outside buildings.

11. The opponent claims that the mark is confusingly similar to the signs relied upon and that the consumer will be deceived as to the origin of the goods and services. There

will, as a consequence, be damage through loss of sales and a negative effect on the opponent's goodwill and reputation.

12. The applicant filed a counterstatement denying the grounds of opposition. In particular, it claims that the services relied upon by the opponent are a service sector wholly distinct from the services provided by the applicant.

13. The trade marks relied upon qualify as earlier marks in accordance with s. 6 of the Act. Given their registration dates, they are also subject to the proof of use provisions contained in s. 6A. The opponent indicated that both marks have been used for all of the goods and services upon which it relies; in its counterstatement the applicant only requested proof of use in respect of "management of facilities". The opponent may, therefore, rely upon the other goods and services without establishing that it has used the marks.

14. Both parties filed evidence, which I will summarise to the extent I consider appropriate. A hearing took place before me, by videoconference, on 4 July 2019, at which the applicant was represented by Richard Gallafent of Gallafents Ltd. The opponent filed written submissions in lieu of attendance, which I will bear in mind. The opponent has been represented throughout by D. Young & Co. LLP.

Evidence

15. Mr Gallafent made a number of concessions at the hearing, as a result of which it is not necessary to produce a comprehensive summary of the evidence. The key information from the opponent's evidence is set out below. I will return to the applicant's evidence as appropriate later in this decision; for the moment, it is sufficient to record that it is provided by Rajinder Makkar, the company secretary and "a significant shareholder" of the applicant. Mr Makkar gives evidence about the applicant company, including the nature of the services it offers.

16. The opponent's evidence is given by Brian Kingham, the Chairman of the opponent and founder of the Reliance Group. Mr Kingham explains that the opponent was incorporated in 2006 and is part of the Reliance Group of companies, all of which are authorised to use the opponent's "RELIANCE" trade marks. The company Reliance High-Tech is said to be a leading security systems firm which designs and installs integrated security systems. Prints from the company's website, www.rht.co.uk, are provided, which support the contention that the opponent provides a variety of security services across a range of sectors.² However, where a date is visible, it is 2018. "Environmental monitoring", "intelligent buildings management and conditions monitoring", as well as the health and safety of employees are mentioned but these all appear to be in the context of a security service (which includes design and installation services) rather than a facilities management service more widely.³ I note that custom applications and integration are mentioned.⁴ There is word-only use of "Reliance" and the following sign is visible:



17. A presentation showing the opponent's vacant property management services is exhibited; it dates from 2009 but the services and products are said still to be offered.⁵ There is use of "Reliance" in word form, as well as of the figurative mark. The services and products include physical security protection, routine inspection and patrols, key holding and access control, electronic surveillance, perimeter systems, monitoring and a response service. I note that the services include risk assessments and condition reports/checks. There is evidence that "access to tradesmen in emergencies relating to facilities such as water or electricity" forms part of the service.⁶

² BK2.

³ See, for example, BK2, pp. 9, 11, 12.

⁴ BK2, p. 14.

⁵ BK3, Kingham §7.

⁶ BK3, p. 29.

18. Mr Kingham provides details of some of the awards won by the opponent, the most recent of which is 2013.⁷ Annual turnover figures for Reliance High-Tech Limited are given.⁸ They are in excess of £20million each year between 2014 and 2018, though there is no indication of the proportion of turnover relative to the goods and services in the specification.

19. Details of some of the opponent's most prominent customers are given. These include major companies such as BMW and BP, as well as universities, police authorities and water companies from across the UK.⁹ The dates of such activities are, for the most part, unclear. However, the exhibit includes 'news' posts which refer to contracts won by the opponent for security systems at UCL in March 2018, for a surveillance system for the National Assembly for Wales in May 2017 and for site security management at John Menzies' headquarters in Scotland in December 2016.

20. The annual reports and accounts from 2004/2005 for Reliance Security Group are exhibited.¹⁰ Turnover for "security services" is given as £192.7 million, down from £209.3 million in 2004. The contracts mentioned all appear to be in the UK. Facilities management turnover is provided separately and is given as £117.5 million, up from £83.0 million in 2004. I note that there is a reference to building infrastructure and customer relationships in "specialist facilities management markets" (p. 56). The opponent is said to be providing a growing range of facilities management services at more than 2,500 UK locations and it won the *Premises and Facilities Management* magazine award. There is use in word-only form and in the form shown below:



⁷ Kingham, §8 and BK4.

⁸ Kingham, §9.

⁹ BK5.

¹⁰ BK6.

Proof of use

21. At the hearing Mr Gallafent accepted that the opponent has used the RELIANCE mark for facilities management. The opponent may, therefore, rely upon all of the goods and services it has identified, at least insofar as the word-only trade marks are concerned. I will consider the word marks first, returning to the figurative mark only if necessary.

Section 5(2)(b)

22. Section 5(2)(b) of the Act reads 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”.

23. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, EU:C:1997:528, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, EU:C:1998:442, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, EU:C:1999:323, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, EU:C:2000:339, *Matratzen Concord GmbH v OHIM*, Case C-3/03, EU:C:2004:233, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, EU:C:2005:594, *Shaker di L. Laudato & C.*

Sas v OHIM, Case C-334/05P, EU:C:2007:333, and *Bimbo SA v OHIM*, Case C-591/12P, EU:C:2016:591:

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

Comparison of goods and services

24. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

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

25. Guidance on this issue has also come from Jacob J. (as he then was) *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

26. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, EU:T:2006:247, the General Court (“GC”) stated that:

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

27. It is permissible to group terms together in making the comparison if the considerations are similar: *Separode Trade Mark* BL O/399/10.

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

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

29. In *Kurt Hesse v OHIM*, Case C-50/15 P, EU:C:2016:34, the CJEU stated that complementarity is an autonomous criterion 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, EU:T:2008:338, the GC 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”.

30. The opponent submits that all of the goods and services relied upon are used, or could be used, in conjunction with properties and buildings. It states that “security surveillance apparatus, security alarm systems, security installations, security monitoring apparatus and security warning apparatus and alarms are more often than not attached to, connected to, or used for the purpose of safeguarding properties and buildings”.¹¹ The opponent submits that the services relied upon in class 37 include the installation, maintenance and repair of security apparatus on property sites and within or external to buildings. It claims that all of the goods and services covered by the earlier marks are similar and/or complementary. It relies upon a previous decision of this tribunal (O/274/17) in that regard. It has made no submissions regarding the class 37 services of the application.

¹¹ Submissions, §11.

31. Mr Gallafent submitted that the goods and services are clear and distinct. In his submission, the applicant's services are locked into property development and finance and he invites me to treat the abovementioned IPO decision with care.

32. As regards that decision, the comparison was indeed between services in classes 36 and 37. However, the services at issue were not the same services as those at issue in the instant proceedings. As Mr Gallafent pointed out, I have also had the benefit of written as well as oral submissions, which the hearing officer in the previous case did not have. Whilst I note the content and findings of that decision, it is not binding upon me, nor is it particularly persuasive.

33. Before beginning the comparison, it is necessary to address the meaning of "management of facilities" in class 35 of the opponent's specification. Given the imprecision of "facilities", I have considered whether the term is too vague to be the subject of a comparison.¹² However, that argument was not raised before me. I have no submissions from the parties on the exact interpretation to be applied. I note that the *Oxford Dictionary of English* ("OED") defines "facilities management" as "the maintenance of an organization's buildings and equipment".¹³ The International Organization for Standardization ("ISO") defines the term, with references and emphasis omitted, as the "organizational function which integrates people, place and process within the built environment with the purpose of improving the quality of life of people and the productivity of the core business".¹⁴ As I understand it, and as appears to be confirmed by the above definitions, "facilities management" is a recognised field of business, primarily concerned with the maintenance of buildings and equipment, though its exact borders are somewhat unclear. However, there is some tension between the *OED* definition, which would cover the physical act of maintenance as well as its organisation, and the ISO definition, which focuses on the organisational aspect of the

¹² See, by analogy, *Advance Magazine Publishers, Inc. v OHIM*, Case T-229/12, where the General Court held that "accessories" is a vague term, too imprecise to identify the characteristics of the goods at issue.

¹³https://www.oxfordreference.com/view/10.1093/acref/9780199571123.001.0001/m_en_gb0997822?rskey=Qr4E0x&result=1 [accessed 13 August 2019]. It is appropriate for a decision maker to take into account dictionary definitions to confirm his/her own understanding of words, even when those references are not in evidence; see *Forex* (BL O/100/09) at [19].

¹⁴ <https://www.iso.org/obp/ui/#iso:std:iso:41011:ed-1:v1:en> [accessed 20 August 2019].

service. The term “management of facilities” itself suggests management or organisation rather than a maintenance service itself. I consider that this is the ordinary meaning conveyed by the words which, when read with the appropriate focus on the core meaning of the service, are sufficiently clear and precise. It is also consistent with the registration in class 35, which is the appropriate class for business support services (as opposed to repair and maintenance services, which are proper to class 37), though I do not consider it necessary in this instance to resort to the class number as an aid to interpretation. My view is, therefore, that “management of facilities” is not a synonym for a maintenance or repair service, though it will include the organisation of such services. Further, “management of facilities” has multiple strands, such as health and safety (for example, a facilities management company might be responsible for ensuring that all of an office’s electrical equipment meets the minimum requirements), environmental and security matters as well as space allocation. Given the absence of evidence or submissions to assist me, I proceed on that basis. I also should note that I have borne in mind the comments of Carr J. in *Pathway IP Sarl v Easygroup Ltd*, where he held that “facilities” in the term “provision of office facilities” did not include office accommodation (at [113]).¹⁵ However, that was a finding of fact based on the interpretation of a particular term and can be distinguished from the present case not only because of the different terms involved but also because of the above definitions, and the absence of any argument from the parties as to how I should construe this term.

Class 36

Real estate and property management; property management; real estate and property management services; information, advice and consultancy in relation to all the aforesaid services.

34. It seems to me that all of these terms include the day-to-day running and care of properties. A business offering “management of facilities” will ensure the upkeep and maintenance of a business’s buildings and equipment, among other things. Whilst a

¹⁵ [2018] EWHC 3608 (Ch)

property management service would not ensure the maintenance of equipment, it is plainly likely to be concerned with the maintenance of buildings. It would appear, therefore, that the same services are offered under the terms above and under “management of facilities”. However, whilst there results a clear overlap in nature, purpose, users and methods of use, and a potentially competitive relationship, the respective services also include other tasks which the other does not: a property management company might concern itself with the sale/rental of properties, while a facilities management services may include matters such as employees’ health and safety or space allocation. This does not appear to be a situation in which one term is completely subsumed within the other, as in *Meric*. However, there is a clear overlap and overall the services are similar to a reasonably high degree. I have not commented on the information and advisory services separately. That is because, here and in the comparisons which follow, I do not consider that they are standalone services which would not be covered by the earlier specification: advice and information is an intrinsic part of the services offered under the earlier specification and the contested advisory services will therefore have a level of similarity which corresponds to that of the other contested services.

Estate agencies; leasing of real estate; rental of property; agency services for the leasing of real estate property; information, advice and consultancy in relation to all the aforesaid services.

35. All of the above services are or include letting agency services. A landlord may engage a letting agent on a range of different bases, from simple showing of the property and administration of the contract and fees, to a full-service arrangement, where the agent is responsible for the day-to-day management of the property. That will inevitably mean that the agent is not only contacted regarding problems with the property but that the agent, rather than the landlord, will be held responsible for ensuring that any such problems are remedied. In the absence of evidence on the point, it seems unlikely that a letting or estate agent would be expected to carry out such works themselves; more probable, the tenant would expect a third party to be engaged.

A facilities management company may have the same model. As with the property management services discussed above, I consider that the services offered under these terms are likely to be, at least in part, identical but that the respective services also encompass other key services (for example, assistance in the purchase of property) which the other does not. They are similar to a reasonably high degree.

Financial services relating to property, real estate and investment; financial evaluation of real estate; mortgage advisory and administration services; financial services relating to property; insurance services relating to property; financial advice relating to taxation; financing of property loans; financing of property development; commercial property investment services; financial services relating to property; estate management services relating to transactions in real property; investment services relating to real property; real estate investment; real estate portfolio investment management; investment management services relating to property investments; investment account services relating to property investment; real property investment fund services; financial investment services relating to real property; development of real property investment portfolios; provision of property investment capital; administration of real property fund investment; arranging investments in real property, in particular capital investments, financing services and insurance; raising of capital; mortgage investment management; arranging of mortgages; mortgage investment management; construction and development project financing; information, advice and consultancy in relation to all the aforesaid services.

36. The above services are all types of financial services. Their nature and purpose are different from the opponent's "management of facilities". The channels of trade for the above are unlikely to intersect with those of facilities management and their methods of use will be different. Both sets of services may be used by business consumers but this overlap is at a high level of generality and I do not consider it would, on its own, engage overall similarity. The services are neither in competition, nor complementary: the use of financial services, even when those services might have property as their ultimate object, is far removed from facilities management. There is no similarity.

Property portfolio management; administration of property portfolios.

37. The inclusion of the word “portfolio” in these terms suggests that the services are, in essence, financial services, albeit ones connected with property. The services strike me as concerned with the management/administration of a group of properties as assets or investments (i.e. in a financial sense). The services would not involve ensuring the maintenance of properties themselves but strategic activities such as the assessment of their value in the portfolio and decisions about investment/realisation of those assets. Accordingly, I can see little in common between these services and the opponent’s “management of facilities” which, in contrast, appears concerned with overseeing the mundanities of property care and maintenance. There is no similarity of nature or purpose. The users may overlap but this is not enough to result in overall similarity. The channels of trade are unlikely to intersect and there is neither competition nor complementarity. These services are not similar.

Real estate appraisal; property valuation; information, advice and consultancy in relation to all the aforesaid services.

38. Although these services involve property, the specific purpose of appraisal and valuation services is different from the purpose of facilities management. Bearing in mind the cautions regarding the interpretation of specifications for services it would, I think, be stretching the ordinary meaning of the term too far to conclude that the maintenance and upkeep of buildings also includes the valuation of property, though I acknowledge that the result of a valuation might have an impact on deciding whether maintenance is economic. The nature and methods of use are unlikely to coincide. I accept that property management services may share channels of trade with real estate appraisal and valuation services: plainly, both are offered by estate agents. I am more doubtful that facilities management services (i.e. the broader term, which encompasses a range of services) reach the market through the same channels. It seems to me that facilities management services are a particular type of service and that they will not share channels of trade with valuation or appraisal services. There may be an overlap in

users but it is at a superficial level. There is no competition and no complementarity in the sense defined in the case law. These services are not similar.

Provision of information relating to the property market [real estate]; information, advice and consultancy in relation to all the aforesaid services.

39. Although the opponent's "management of facilities" will include the giving of advice about its services, my view is that the advice itself will be entirely different: one concerns matters such as the cost and options for maintaining/repairing property/equipment whilst the other involves information about, for example, trends in the property market at large. Therefore, whilst there is some similarity at a very general level because both will involve providing information, the information itself will differ, as will its purpose. Users may intersect but, again, only in the most superficial manner, whilst there is no overlap in channels of trade, no competition and no complementarity. Overall, these services are not similar.

40. I should add that I have considered whether the opponent's position might be stronger in relation to its other goods and services, in classes 9 and 37. I take the view that those goods and services are no more similar to the opposed services than the services in class 35 assessed above. In terms of the goods, there is an inevitable difference in nature, purpose and method of use with services. However, even the services in class 37 have less commonality of nature and purpose with the contested services than those considered in class 35. There is no competition and no complementarity, either: whilst the various goods and services might be used together, they do not have a sufficiently close relationship that they are essential for one another or that the consumer will consider the same undertaking to be responsible for both.

Class 37

Property maintenance, renovation and repair; information, advice and consultancy in relation to all the aforesaid services.

41. I have indicated, above, that “management of facilities” will include the organisation of property maintenance and repair services. As both will result in the maintenance/repair of property, there is overlap in their purpose, although there are also differences because one focuses on arranging maintenance and the other on carrying it out. Their natures will differ. There is potential for competition between the services, as a property maintenance company might be employed directly to maintain property rather than a facilities management company. The users will intersect and there may be complementarity: a service offering management of facilities will necessarily require the use of maintenance, renovation and repair services. The closeness of the relationship between the services is such that they may well be perceived as provided by the same undertaking. These services are similar to a medium degree.

Property development; construction of property; construction project management services; information, advice and consultancy in relation to all the aforesaid services.

42. A property development service is concerned with the construction, including construction management, of property. “Construction of property” is also a wide term and would include, in my view, all aspects of construction, including its organisation. As I have indicated above, the opponent’s facilities management services will include the planning and organisation of maintenance/repair work. It seems to me that the purpose of the above services will have some overlap in this regard, as they may all be concerned with property renovation as well as building new buildings. There may be some overlap in nature, though the channels of trade are unlikely to coincide. The services are not in direct competition: a facilities management company is unlikely to be appointed to handle work which would otherwise be contracted to a developer or

construction company. Nor are the services complementary in the sense defined in the case law. The services are similar to a fairly low degree.

43. I have considered whether the opponent's class 37 services put it in a better position. I do not consider that they would. Whilst property development may include security features such as security gates, as, indeed, the applicant's own evidence shows, and whilst the developer or constructor might fit security apparatus as part of the larger project, at least where unsophisticated apparatus is concerned, they are not providing a separate installation service. Even though the developer or constructor might be held responsible for the quality of, for example, the erection of fencing, the core purposes of the services are different, as are the channels of trade. There is neither competition nor complementarity. If there is any similarity, it is only at a low level.

The average consumer and the nature of the purchasing act

44. It is necessary for me to determine both who the average consumer is for the respective parties' goods and services and the manner in which these goods and services are likely to be selected by the average consumer 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".

45. The parties' goods and services are likely to be purchased by both businesses and members of the public. Some, such as facilities management services or commercial property investment services, are more likely to be used by businesses than members of the public; others, such as mortgage advisory services, are more likely to be used by the public. As the services all involve potentially large sums and long-term investment or contracts, they all strike me as ones which the business user will select with at least a reasonably high level of care, which will rise to a high level in certain instances (investment management services, for example, are likely to be selected following careful research and be based upon factors such as previous performance and reputation). The member of the public is also likely to pay a reasonably high level of attention to choosing the services, given that the services involve their money and/or property (even modest maintenance work is likely to be subject to multiple quotations), with the potential for significant inconvenience or lasting consequences if a poor choice is made.

46. The selection process will involve mainly visual considerations, with both groups of consumer exposed to the marks in advertising, on websites, in brochures and catalogues. However, there is also potential for an oral aspect to the process, given that personal recommendations or discussions with consultants and financial advisors may play their part.

Distinctive character of the earlier trade mark

47. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public: *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In *Lloyd Schuhfabrik*, 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-2779, 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)".

48. At the hearing, Mr Gallafent accepted that the opponent had goodwill and a reputation in the security industry (he drew no distinction between the various goods and services of the registration). He also accepted that the opponent had "some" goodwill and reputation for facilities management services.

49. In *CXO2 Trade Mark*, BL O/393/19, Phillip Johnson, sitting as the Appointed Person, stated:

"39. [...] I agree with the Hearing Officer that reputation in itself does not make a mark highly distinctive. However, while distinctiveness and reputation are different, the nature, factors, and evidence used to prove enhanced distinctiveness are the same as for reputation. Furthermore, reputation for the purposes of section 5(3) is a higher threshold than for acquired distinctiveness. In other words, if there is a reputation then distinctiveness

should be enhanced. Where it fits on the distinctiveness scale after this enhancement is a question of fact in each individual case”.

50. It appears, therefore, that I am bound to accept that the earlier marks have enhanced their distinctive character through the use which has been made of them. As no concession was made regarding the level of distinctiveness now enjoyed by the marks, that remains a matter for me to decide.

51. The word “reliance” is not inherently very distinctive: it alludes to the reliability of a particular product, service or service provider. Nevertheless, it still has a level of inherent distinctive character between low and medium.

52. The opponent has filed evidence of significant annual turnover. However, there is no breakdown of the turnover in relation to the goods and services relied upon. The company for which turnover figures are provided is Reliance High-Tech. The evidence regarding this company does not indicate a facilities management service but a security service. I acknowledge, of course, that some of the services provided might also be provided by a facilities management company. However, the opponent itself draws a distinction between security services and facilities management in the company’s annual statement. I also take into account that references in the evidence are to the company as a security expert, or to its services as security services, rather than these being aspects of a wider facilities management business.

53. Although the evidence is lacking in precision, given that the applicant has conceded that the opponent has a reputation in the security industry, my view is that the earlier marks benefited at the application date from a reasonable level of enhancement because of the use which has been made of them for goods and services connected with security. I am not persuaded that the same applies to facilities management services: there is no clear evidence of the opponent’s involvement in those services after 2005. Much can happen in fourteen years, including a complete abandonment of a business area. Any enhancement in relation to facilities management services is small.

Overall, therefore, whilst the distinctiveness of the earlier marks in relation to the goods and services in classes 9 and 37 (and 42) is such that the marks can be considered distinctive to a reasonably high degree, their distinctiveness in relation to facilities management is no more than medium.

Comparison of trade marks

54. It is clear from *Sabel* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, 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”.

55. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the marks.

56. Due weight must be given to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

Opponent's marks	Applicant's mark
RELIANCE	RELIANCE HOMES

57. The opponent's marks are the single word "RELIANCE", presented in capital letters. The overall impression resides in that word alone.

58. The applicant's mark consists of the words "RELIANCE HOMES", presented in capital letters. The word "HOMES" has little or no distinctiveness in relation to the goods and services at issue: where it is not wholly descriptive (i.e. where the services are not in relation to domestic properties), it is still unlikely to be given much, if any, trade mark significance. The word "RELIANCE" therefore plays the greater part in the overall impression, with "HOMES" having a weaker role.

59. Both marks share the word "RELIANCE". The difference arises from the word "HOMES" in the application. However, bearing in mind the relative weight of the word "HOMES" in the overall impression, as well as the position of the identical element, the marks are visually similar to a high degree.

60. The words in each of the marks are common and will be given their usual pronunciation. It is possible that the mark applied for will be articulated simply as "RELIANCE". In that scenario, the marks will be aurally identical. If both words in the application are verbalised, again taking into account the overall impressions, the marks are aurally similar to a high degree.

61. Both marks convey the same message with the word "RELIANCE", namely one of trust or dependence. There is the additional concept of homes in the later mark but, as I have said, this is a concept with little or no distinctiveness in relation to the goods and services. The marks are conceptually similar to a high degree.

Likelihood of confusion

62. The factors considered above have a degree of interdependency and must be weighed against one another in a global assessment (*Canon* at [17]; *Sabel* at [22]). They must be considered from the perspective of the average consumer and a

determination made as to whether the average consumer is likely to be confused. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

63. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Iain Purvis Q.C., sitting 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”.

64. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting 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.

65. Where there is no similarity between the goods and services, there can be no confusion.¹⁶ The opposition under s. 5(2)(b) is dismissed for the services which I have found to be dissimilar. As for the remaining services, the marks at issue have a high degree of visual, aural and conceptual similarity. In relation to “management of facilities”, the earlier mark is distinctive to a medium degree. Notwithstanding the higher than average to high level of attention which will be displayed by the average consumer, my view is that, even where there is only a fairly low level of similarity between the goods and services, there is a likelihood of confusion. This is because there is no means of distinguishing between the marks other than the, at best, non-distinctive word “HOMES”. The lack of distinctiveness of this word leaves the way open for both direct confusion, the word being forgotten or all but discounted in the later mark, and indirect confusion, where the difference might be noted but will be attributed to the same company using a variant mark.

66. The opposition under s. 5(2)(b) succeeds in relation to:

Class 36: Estate agencies; real estate and property management; leasing of real estate; rental of property; property management; real estate and property management services; agency services for the leasing of real estate property; information, advice and consultancy in relation to all the aforesaid services.

Class 37: Property development; property maintenance, renovation and repair; construction of property; construction project management services; information, advice and consultancy in relation to all the aforesaid services.

67. I have not, so far, considered the figurative mark. Given that the specification is identical to that of the UK word mark, it will not put the opponent in a better position: where the opposition under this ground has failed, it is because of a lack of similarity

¹⁶See, for example, *Waterford Wedgwood plc v OHIM*, Case C-398/07 P, EU:C:2009:288 (CJEU).

between the respective goods and services. Briefly, however, my view is that the opposition under the figurative mark would succeed to the same extent as detailed above. Use of the figurative mark, or an acceptable variant under s. 6A(4)(a), accompanies that of the word marks and I can see no reason why the concessions and my consequent findings regarding use and distinctiveness would not apply to the same extent. There is somewhat less visual similarity but “Reliance” remains the dominant element of the earlier figurative mark, whilst the levels of aural and conceptual similarity are as described above. Even where the earlier mark has only a medium degree of distinctiveness and a high level of attention is paid to the selection of the services, the visual similarities between the marks outweigh any differences and would lead to indirect confusion.

Section 5(3)

68. 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”.

69. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, EU:C:1999:408, *General Motors*, [1999] ETMR 950; Case 252/07, EU:C:2008:655, *Intel*, [2009] ETMR 13; Case C-408/01, EU:C:2003: 582, *Adidas-Salomon*, [2004] ETMR 10; C-487/07, EU:C:2009:378 *L’Oreal v Bellure* [2009] ETMR 55; and Case C-323/09, EU:C:2011:604, *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

70. In *General Motors*, 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".

71. As one of the earlier word marks is an EUTM, I also keep in mind the guidance of the CJEU in *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07, EU:C:2009:611, at [20] to [30] and *Burgerista Operations GmbH v Burgista Bros Limited* [2018] EWHC 35 (IPEC) at [69].

72. I will begin by determining the position regarding the word marks, returning if necessary to the figurative mark.

73. The applicant accepts that the earlier marks have a reputation in relation to the goods and services relied upon. My comments at paragraphs 52 to 53 are also applicable here. The opponent's turnover is significant but the evidence provided is indicative of a security company. I am prepared to accept that the opponent has a reasonable reputation in relation to the goods and services relied upon in classes 9, 37 and 42. The evidence does not support the conclusion that the opponent has a

substantial reputation in facilities management. This reputation I would assess as modest.

Link

74. Mr Gallafent argued that there would be no link. The opponent claims that the earlier marks would be brought to mind, due to the proximity of the goods and services and the level of the opponent's reputation.

75. The factors identified in *Intel* for determining whether there would be the relevant link are:

(i) the degree of similarity between the marks

I have assessed the similarity between the marks at paragraphs 57 to 61, above. I adopt those findings here.

(ii) the nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

My comments regarding the goods and services at issue in classes 9, 35, 36 and 37 are at paragraphs 34 to 43, above, and apply equally here. In terms of the opponent's security and security consultancy services, there is no similarity of nature or purpose in respect of the contested services; while I accept that construction management might include the arrangement of site security, it is unlikely to involve providing that service. The users will overlap at a high level of generality. Channels of trade are unlikely to intersect and there is no competition. Nor can I see that there is complementarity: although the services might be used together, they are not important for one another's use in the sense which would give rise to complementarity as defined in the case law. Overall, security services are not similar to the contested services.

(iii) the strength of the earlier mark's reputation

The earlier mark has a reasonable reputation for all of the goods and services relied upon in classes 9, 37 and 42. It has only a modest reputation for facilities management services.

(iv) the degree of the earlier mark's distinctive character, whether inherent or acquired through use

As I have already intimated, the distinctive character of the earlier mark has been enhanced through use, to a reasonably high level for its security-related goods and services but only to a medium degree for facilities management services.

(vi) whether there is a likelihood of confusion

There is a likelihood of confusion for those services specified at paragraph 66, above. I do not see that there would be any confusion for the remaining services: the goods and services are too different, despite the other factors such as similarity between the marks and the enhanced distinctiveness of the earlier mark, for confusion to arise.

76. Taking all these factors together, I find that there would be the required link where there is some similarity between the services. However, despite the similarity between the marks, and taking into account the relative distinctiveness and reputation of the earlier marks, I do not consider that the requisite link would be made for the remaining services. The evidence does not establish a reputation or level of distinctiveness sufficient to bridge the gap between the respective services. The opposition under this ground fails in respect of the services found not to be similar.

Unfair advantage

77. Unfair advantage was considered in *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch). Arnold J. considered the earlier case law and concluded that:

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

78. Where there is a likelihood of confusion (i.e. the public believe that the contested mark is connected to the owner of the earlier mark with a reputation), this is bound to give the contested mark an unfair advantage. The ground under s. 5(3) therefore succeeds in respect of “estate agencies; real estate and property management; leasing of real estate; rental of property; property management; real estate and property management services; agency services for the leasing of real estate property; information, advice and consultancy in relation to all the aforesaid services” in class 36 and “property development; property maintenance, renovation and repair; construction of property; construction project management services; information, advice and consultancy in relation to all the aforesaid services” in class 37.

79. In view of this finding, it is not necessary for me to consider the other heads of damage and I decline to do so.

80. I should add that I do not consider that the earlier figurative mark would put the opponent in a better position. That mark is dominated by the word “Reliance” but is visually less similar overall. Nonetheless, had I needed to decide whether the mark had a reputation, and bearing in mind the applicant’s concessions on this point, my findings would have been as for the word marks. I would have held that where there is similarity between the services there is a link and confusion but, where the goods and services are not similar, no link would be made, for the same reasons as given above.

Section 5(4)(a)

81. 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”.

82. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, HHJ 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)".

83. 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”.

84. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Daniel Alexander Q.C., sitting as the Appointed Person, considered the matter of the relevant date in a passing off case. He said:

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

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

85. Mr Makkar, providing the applicant’s evidence, states that the applicant was incorporated on 11 November 2016. He states that “Reliance Investments Limited” has built a number of homes but there is no supporting documentary evidence. Mr Makkar gives turnover figures for 2016 to 2018, which are in excess of £2 million per annum. However, as these turnover figures are for thirteen different companies “operating under the umbrella of the Applicant company”, it is not possible to determine what, if any, of this turnover was attributable to a company using either “reliance” or “Reliance Homes” as a distinguishing sign.¹⁷ There is in evidence a company portfolio which shows “RELIANCE HOMES” on its cover but it is undated and the properties mentioned in the document are ones which are proposed rather than completed developments. There is also a property investment brochure, dated 2018. It is not, therefore, clear whether this brochure was in use before the application date. The evidence before me does not establish that the mark was in use prior to the date of application. That being the case, the relevant date is the date of application, i.e. 17 April 2018.

Goodwill

86. The applicant accepts that the opponent had, at the relevant date, a protectable goodwill in the security industry, along with “some” goodwill for facilities management. The evidence of turnover is sufficient to establish a reasonably strong goodwill in respect of the former; any goodwill in facilities management can, given the fourteen-year evidential gap, be only modest. The claim under s. 5(4)(a) also encompasses

¹⁷ Makkar, §8.

services which are not included in the registered specifications, namely “construction, maintenance and repair of prisons; construction, maintenance, cleaning and repair of buildings, management of contractors, project management”. There is no evidence that the opponent’s business involved such services at the relevant date.

Misrepresentation

87. 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]”

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”.

88. I recognise that the test for misrepresentation is different from that for the likelihood of confusion, namely that misrepresentation requires that “a substantial number of members of the public are deceived” rather than whether the “average consumer are confused”. However, as recognised by Lewison LJ in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that this is the case here. Whilst I consider that there would be a misrepresentation in respect of those services for which I have found confusion under s. 5(2)(b), I find that the relevant public is unlikely to be misled into purchasing the applicant’s dissimilar services in the belief that they are the services of the opponent or that they were connected in any meaningful sense to the opponent. There is no evidence that it is usual for providers of security or facilities management services to diversify their business into the financial services at issue, nor do I consider that the relevant public would believe that to be the case. Despite the reasonably high level of distinctiveness of the sign upon which the opponent relies, and whilst taking into account the level of goodwill for the respective services, there would be no misrepresentation. The opposition under s. 5(4)(a) succeeds and fails to the same extent as the opposition under s. 5(2)(b).

Conclusion

89. The opposition has succeeded in relation to the following services, for which registration will be refused:

Class 36: Estate agencies; real estate and property management; leasing of real estate; rental of property; property management; real estate and property

management services; agency services for the leasing of real estate property; information, advice and consultancy services in relation to all the aforesaid services.

Class 37: Property development; property maintenance, renovation and repair; construction of property; construction project management services; information, advice and consultancy in relation to all the aforesaid services.

90. The application will proceed to registration for the following services in class 36 only:

Class 36: Financial services relating to property, real estate and investment; real estate appraisal; financial evaluation of real estate; mortgage advisory and administration services; financial services relating to property; insurance services relating to property; property valuation; financial advice relating to taxation; property portfolio management; administration of property portfolios; financing of property loans; financing of property development; commercial property investment services; financial services relating to property; estate management services relating to transactions in real property; provision of information relating to the property market [real estate]; investment services relating to real property; real estate investment; real estate portfolio investment management; investment management services relating to property investments; investment account services relating to property investment; real property investment fund services; financial investment services relating to real property; development of real property investment portfolios; provision of property investment capital; administration of real property fund investment; arranging investments in real property, in particular capital investments, financing services and insurance; raising of capital; mortgage investment management; arranging of mortgages; mortgage investment management; construction and development project financing;

information, advice and consultancy in relation to all the aforesaid services.

Costs

91. The applicant has retained most of its specification in class 36 but has lost its specification in class 37. It seems to me that, whilst the applicant is entitled to an award of costs, this should be reduced by 25% to reflect the proportion of success. Mr Gallafent confirmed at the hearing that costs are sought on the published scale (Tribunal Practice Notice 2/2016 refers). I also bear in mind that neither party filed a great deal of evidence. I therefore award costs to the applicant as follows:

Considering the notice of opposition and preparing a counterstatement:	£200
Considering the other party's evidence and filing evidence:	£500
Preparing for and attending the hearing:	£800
Sub-total:	£1,500
Less 25%:	-£375
Total:	£1,125

92. I order Reliance Trust Limited to pay Reliance Homes Limited the sum of **£1,125**. 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 29th day of August 2019

Heather Harrison

For the Registrar

The Comptroller-General