

O/551/19

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003379954

BY LIGHT HUMAN HOTELS LIMITED

TO REGISTER THE TRADE MARK:

THE ORIGINALS HUMAN HOTELS

IN CLASSES 35 AND 43

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 600001117 BY

EUROPEENNE D'HOTELLERIE

BACKGROUND AND PLEADINGS

1. On 3 March 2019, Light Human Hotels Limited (“the applicant”) applied to register the trade mark **THE ORIGINALS HUMAN HOTELS** in the UK. The application was published for opposition purposes on 22 March 2019. Registration is sought for the following services:

Class 35 Hotels (Business management of -); Advertising services relating to hotels; Business management of hotels; Business management of hotels for others; Business management of resort hotels; Consultancy services relating to the administration and management of hotels; Secretarial services provided by hotels.

Class 43 Provision of hotel accommodation; Hotel accommodation; motels; hostels and boarding houses, holiday and tourist accommodation; Accommodation bureau services [hotels, boarding houses]; Accommodation bureaux [hotels, boarding houses]; Arranging of meals in hotels; Booking services for hotels; Electronic information services relating to hotels; Information relating to hotels; Providing accommodation in hotels and motels; providing exhibition facilities in hotels being the provision of temporary accommodation; provision of information relating to hotels; Rental of furniture for hotels being chairs and tables; reservation of accommodation in hotels; restaurant services provided by hotels.

2. The application is opposed by Europeenne D’Hotellerie (“the opponent”) by way of the Fast Track Opposition procedure commenced on 17 May 2019. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following trade marks:

THE ORIGINALS

EUTM no. 17892583

Filing date 26 April 2018; registration date 8 September 2018

Priority date 25 April 2018

("the First Earlier Mark")

THE ORIGINALS HOTELS

EUTM no. 17877070

Filing date 19 March 2018; registration date 20 August 2018

Priority date 16 March 2018

("the Second Earlier Mark")

3. The opponent is relying on some of the services for which its marks are registered, as identified in paragraph 15 below.

4. The opponent submits that the respective services are identical or similar and that the marks are similar.

5. The applicant filed a counterstatement denying the claim made.

6. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

"(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit."

7. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

8. The applicant is unrepresented and the opponent is represented by Baron Warren Redfern.

9. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

A hearing was neither requested nor considered necessary; only the opponent filed written submissions in lieu.

PRELIMINARY ISSUE

10. In its counterstatement, the applicant makes reference to EUIPO proceedings between the parties (relating to filing number 3062722). However, I understand that those proceedings related to the following marks:



11. Decisions of the EUIPO are not binding upon me but, in any event, as that case concerned different marks, it is not relevant to the decision I must make.

DECISION

12. Section 5(2)(b) of the Act states as follows:

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

(a)...

(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.”

13. The trade marks upon which the opponent relies qualify as earlier trade marks because they were applied for at an earlier date than the applicant's mark pursuant to section 6 of the Act. As the opponent's trade marks had not completed their registration process more than 5 years before the date of the application in issue in these proceedings, they are not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the services it has identified.

Section 5(2)(b) – case law

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

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

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

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

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

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

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

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

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

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

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, 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 services

15. The competing services are as follows:

| Opponent's services | Applicant's services |
|---|--|
| <p>The First Earlier Mark</p> <p><u>Class 35</u></p> <p>Advertising; Direct mail advertising; Publicity material rental; Updating of advertising material; Dissemination of advertising matter; Rental of advertising space and time; Publication of publicity texts; Publicity columns preparation; Advertising coordination; Advertising mail order; Interactive advertising, namely online advertising on a computer network or on the Internet; Business management; Assistance to management of commercial activities, Business administration; Business management and organization consultancy; Compiling and providing statistical business information; Subscription to all news, written, audio and/or visual media, among other, subscriptions to newspapers and magazines; Procurement services for others (purchasing goods and services for other businesses) in the field of hotels and providing food and drink; Personnel management and consultancy relating to employment, consultancy relating to personnel issues, recruitment of personnel; Public relations services; Opinion polling; Market research and studies; Sales promotion for others; Organisation of exhibitions for</p> | <p><u>Class 35</u></p> <p>Hotels (Business management of -); Advertising services relating to hotels; Business management of hotels; Business management of hotels for others; Business management of resort hotels; Consultancy services relating to the administration and management of hotels; Secretarial services provided by hotels.</p> <p><u>Class 43</u></p> <p>Provision of hotel accommodation; Hotel accommodation; motels; hostels and boarding houses, holiday and tourist accommodation; Accommodation bureau services [hotels, boarding houses]; Accommodation bureaux [hotels, boarding houses]; Arranging of meals in hotels; Booking services for hotels; Electronic information services relating to hotels; Information relating to hotels; Providing accommodation in hotels and motels; providing exhibition facilities in hotels being the provision of temporary accommodation; provision of information relating to hotels; Rental of furniture for hotels being chairs and tables; reservation of accommodation in hotels; restaurant services provided by hotels.</p> |

commercial or advertising purpose;
Organisation and management of business operations to obtain customer loyalty in particular by means of loyalty cards; Administration of loyalty rewards schemes offering gift points; Business management of hotels; Assistance in the business management, for others, of hotels, hotel chains, restaurants, lodging houses, motels, guest houses, boarding houses, campsites, rural gîtes, chalets; Business management consultancy and assistance in the field of hotels, inns, motels and other temporary accommodation; The bringing together, for the benefit of others, of service providers in the form of gift boxes in the field of travel, accommodation, providing of food and drink, sports, access to beauty centres, fitness centres and spas, enabling customers to view and select those service providers; Providing of concierge services for travellers, namely confirmation of appointments, for others, and providing of business information to customers so as to meet the needs of each individual; Business brokerage (concierge services); Providing airfare and hotel rate comparison information; Business management and organisation consultancy relating to franchises; Services provided by a franchiser, Namely assistance in the operation or

management of hotels, restaurants, bars, spas, recreational facilities and fitness facilities; Planning of business meetings; Business management of resort hotels.

Class 43

Corporate hospitality (provision of food and drink); Temporary accommodation; Booking and rental of temporary accommodation; Rental and reservation of rooms for others; Services for reservation of hotel rooms and temporary accommodation, provided via the internet; Motels, guest houses, castles and manors, boarding houses, rural hostels and chalets, providing campground facilities; Rental of rooms for receptions, conferences, conventions, exhibitions, seminars and meetings; Bars, cafeterias and tea rooms; Catering; Procurement of food and drink; Holiday information and planning relating to accommodation; Advice and consultancy relating to hotels; Providing of information about hotels; Providing accommodation information online from a computer database, a global computer network or from the internet; Organization of banquets and cocktail-parties; Lending and rental of table linen, chairs, tables, tableware and glassware; Day-

nurseries; Boarding for pets; Providing of intermediation for travellers, namely providing of bed linen, chairs and tables, and restaurant reservations; Providing of business meeting facilities.

The Second Earlier Mark

Class 35

Advertising; Direct mail advertising; Publicity material rental; Updating of advertising material; Dissemination of advertising matter; Rental of advertising space, Rental of advertising time; Publication of publicity texts; Publicity columns preparation; Advertising coordination; Advertising mail order; Interactive advertising, namely online advertising on a computer network or on the Internet; Business management; Assistance to management of commercial activities, Business administration; Business management and organization consultancy; Compiling and providing statistical business information; Subscription to all news, written, audio and/or visual media, among other, subscriptions to newspapers and magazines; Procurement services for others (purchasing goods and services for other businesses) in the field of hotels and providing food and drink; Personnel management and consultancy relating to

employment, consultancy relating to personnel issues, recruitment of personnel; Public relations services; Opinion polling; Market studies, market research, sales promotion for others; Organisation of exhibitions for commercial or advertising purpose; Organisation and management of business operations to obtain customer loyalty in particular by means of loyalty cards; Administration of loyalty rewards schemes offering gift points; Business management of hotels; Assistance in the business management, for others, of hotels, hotel chains, restaurants, lodging houses, motels, guest houses, boarding houses, campsites, rural gîtes, chalets; Business management consultancy and assistance in the field of hotels, inns, motels and other temporary accommodation; The bringing together, for the benefit of others, of service providers in the form of gift boxes in the field of travel, accommodation, providing of food and drink, sports, access to beauty centres, fitness centres and spas, enabling customers to view and select those service providers; Providing of concierge services for travellers, namely confirmation of appointments, for others, and providing of business information to customers so as to meet the needs of each individual; Business brokerage

(conciierge services); Providing airfare and hotel rate comparison information; Business management and organisation consultancy relating to franchises; Services provided by a franchiser, Namely assistance in the operation or management of hotels, restaurants, bars, spas, recreational facilities and fitness facilities; Planning of business meetings; Providing of business meeting facilities.

Class 43

Corporate hospitality (provison of food and drink); Operation of hotel complexes; Temporary accommodation; Booking and rental of temporary accommodation; Rental and reservation of rooms for others; Services for reservation of hotel rooms and temporary accommodation, provided via the internet; Motels, guest houses, castles and manors, boarding houses, rural hostels and chalets, providing campground facilities; Rental of rooms for receptions, conferences, conventions, exhibitions, seminars and meetings; Bars, cafeterias and tea rooms; Catering; Procurement of food and drink; Holiday information and planning relating to accommodation; Advice and consultancy relating to hotels; Providing of information about

| | |
|---|--|
| <p>hotels; Providing hotel information online from a computer database, a global computer network or the Internet; Organization of banquets and cocktail-parties; Lending and rental of table linen, chairs, tables, tableware and glassware; Day-nurseries; Boarding for pets; Providing of intermediation for travellers, namely providing of bed linen, chairs and tables, and restaurant reservations; Providing accommodation information online from a computer database, a global computer network or from the internet.</p> | |
|---|--|

16. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“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.”

17. Guidance on this issue has also come from Jacob J. (as he then was) in 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.

18. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court 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 for 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.”

Class 35

17. “Hotels (Business management of -)”, “Business management of hotels”, “Business management of hotels for others” and “Business management of resort hotels” in the applicant’s specification falls within the broader category of “Business management” in the opponent’s specifications. These services can, therefore, be considered identical on the principle outlined in *Meric*.

18. “Advertising services relating to hotels” in the applicant’s specification falls within the broader category of “Advertising” in the opponent’s specifications. These services can, therefore, be considered identical on the principle outlined in *Meric*.

19. “Business management consultancy and assistance in the field of hotels” in the opponent’s specifications is self-evidently identical to “Consultancy services relating to the administration and management of hotels” in the applicant’s specification.

20. The term “secretarial services provided by hotels” in the applicant’s specification is not entirely clear in its meaning. However, as this service is provided by hotels, this is presumably a service provided to hotel customers. Consequently, I consider this to cover administrative or organisational services that a hotel might provide to its guests. “Providing of concierge services for travellers, namely confirmation of appointments, for others, and providing of business information to customers so as to meet the needs of each individual” in the opponent’s specifications will, therefore, fall within this broader category. These services are, therefore, identical on the principle outlined in *Meric*.

Class 43

21. “Provision of hotel accommodation”, “Hotel accommodation”, “motels”, “hostels and boarding houses, holiday and tourist accommodation” and “providing accommodation in hotels and motels” in the applicant’s specification fall within the broader category of “temporary accommodation” in the opponent’s specifications. These services can, therefore, be considered identical on the principle outlined in *Meric*.

22. “Accommodation bureau services [hotels, boarding houses]”, “Accommodation bureaux [hotels, boarding houses]” and “Booking services for hotels” in the applicant’s specification fall within the broader category of “booking and rental of temporary accommodation” in the opponent’s specifications. These services can, therefore, be considered identical on the principle outlined in *Meric*.

23. “Arranging of meals in hotels” and “restaurant services provided by hotels” in the applicant’s specification are similar to “Corporate hospitality (provision of food and drink)” in the opponent’s specifications. A significant part of corporate hospitality is the service of providing food and drink to customers and their clients (although it may also include broader services such as the provision of entertainment). Hotels providing corporate hospitality services would, therefore, as part of these services, arrange meals for the customers and their clients. The services will be highly similar as they will overlap in trade channels, user, method of use and purpose.

24. “Providing of information about hotels” in the opponent’s specifications is self-evidently identical to “information relating to hotels” and “provision of information relating to hotels” in the applicant’s specification.

25. “Electronic information services relating to hotels” in the applicant’s specification falls within the broader category of “providing of information about hotels” in the opponent’s specifications. These services can, therefore, be considered identical on the principle outlined in *Meric*.

26. “Providing exhibition facilities in hotels being the provision of temporary accommodation” in the applicant’s specification falls within the broader category of “rental of rooms for receptions, conferences, conventions, exhibitions, seminars and meetings” in the opponent’s specifications. These services can, therefore, be considered identical on the principle outlined in *Meric*.

27. “Rental of furniture for hotels being chairs and tables” in the applicant’s specification falls within the broader category of “lending and rental of [...] chairs, tables [...]” in the opponent’s specifications. These services can, therefore, be considered identical on the principle outlined in *Meric*.

28. “Reservation of accommodation in hotels” in the applicant’s specification falls within the broader category of “rental and reservation of rooms for others” in the opponent’s specifications. These services can, therefore, be considered identical on the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

29. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which the services are likely to be selected by the average consumer. 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.”

30. The opponent states that the average consumer will be either a member of the general public or a business user. I agree. There will be various factors taken into consideration when purchasing the services, such as official rating of the service provider, location, ease of use and suitability for the customer's particular requirements. Consequently, even for those services which may incur a lower cost, there will still be a medium degree of attention paid during the purchasing process. For some of the services, where a greater cost may be involved, I recognise that the level of attention paid may be higher than medium.

31. The services are likely to be selected following inspection of the premises frontage or the website of the services providers. The services may also be selected following review of adverts. Visual considerations are likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase of the services, given that word-of-mouth recommendations may play a part.

Comparison of trade marks

32. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

33. 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.

34. The respective trade marks are shown below:

| Opponent’s trade marks | Applicant’s trade mark |
|--|----------------------------|
| THE ORIGINALS (the First Earlier Mark) THE ORIGINALS HOTELS (the Second Earlier Mark) | THE ORIGINALS HUMAN HOTELS |

35. In its Notice of Opposition, the opponent states:

“3.1 The Opponent’s earlier marks consist of the word combinations, THE ORIGINALS and/or THE ORIGINALS HOTELS. The word combination THE ORIGINALS forms the distinctive and dominant element of the latter of the two marks relied upon. The Opponent’s marks would be seen as and referred to as THE ORIGINALS. The earlier marks are distinctive to at least an average degree of having no descriptive connotation with the services listed in the registrations.

3.2 The Applicant’s mark consists of the word combination THE ORIGINALS HUMAN HOTELS. The word combination THE ORIGINALS forms the critical beginning of the mark, as well as having independent presence in the mark applied for, which is immediately identifiable separate from the word combination HUMAN HOTELS; the latter forming a separate independent distinctive element of the mark applied for, but the mark will overall be seen as comprising of two distinct and clearly different elements which do not “hang together”. The mark applied for would be perceived as being part of THE ORIGINALS brand. It is settled case law that complex multi-element marks may be assessed for their individual distinctive elements even though one would first see a mark as a whole.

3.3 By virtue of the position set out above, the marks are similar visually, phonetically and conceptually to a high degree. In respect of the visual and phonetic aspects, both play a part in the assessment of marks. The average consumer will undertake research to identify providers of the services sought which will, in this day and age, involve internet search results. Equally, the oral use is important when receiving recommendations from friends and colleagues.”

36. The applicant’s trade mark consists of the words THE ORIGINALS HUMAN HOTELS. The words HUMAN HOTELS are an unusual choice of words to describe hotel services. Clearly, it is implicit that hotel services are for human use. Nonetheless,

whilst this is an unusual choice of wording, it describes the services being provided under the mark and will, therefore, play a lesser role in the overall impression. The words THE ORIGINALS will play a greater role. The First Earlier Mark consists of the words THE ORIGINALS. There are no other elements to contribute to the overall impression which lies in the words themselves. The Second Earlier Mark consists of the words THE ORIGINALS HOTELS. Again, the word HOTELS is descriptive of the services offered under the marks and so will be given little trade mark significance by the consumer. The words THE ORIGINALS will play a greater role in the overall impression, with the word HOTELS playing a lesser role.

37. Visually, the First Earlier Mark is reproduced entirely in the applicant's mark. As a general rule, the beginnings of marks tend to make more impact than the ends¹. The marks differ in the addition of the words HUMAN HOTELS in the applicant's mark which have no counterpart in the First Earlier Mark. However, as these elements are descriptive they play a lesser role in the overall impression. I consider the marks to be visually similar to a medium to high degree.

38. The same points apply to the Second Earlier Mark, although this also contains the word HOTELS. I consider all three marks to be visually highly similar.

39. Aurally, the words THE ORIGINALS will be pronounced identically in all three marks. The words HUMAN HOTELS in the applicant's mark and HOTELS in the Second Earlier Mark may not be pronounced at all due to their descriptive nature. If this is the case, then the marks will be aurally identical. If these words are pronounced, then there will be a medium to high degree of aural similarity with the First Earlier Mark and a high degree of aural similarity with the Second Earlier Mark.

40. Conceptually, the words THE ORIGINALS will be given their ordinary dictionary meaning. That is, a reference to something that was the first of its kind or particularly interesting or special². The words HUMAN and HOTELS will also be given their ordinary dictionary meaning. As noted above, when used as a combination in the

¹ *El Corte Ingles, SA v OHIM*, Cases T-183/02 and T-184/02

² <https://dictionary.cambridge.org/dictionary/english/original?q=originals>

applicant's mark, they are an unusual choice of words but are, nonetheless, descriptive in the context of hotel services. Overall, I consider the marks to be conceptually highly similar.

Distinctive character of the earlier trade marks

41. 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-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).”

42. Registered trade marks possess varying degrees of inherent distinctive character ranging from the very low, because they are suggestive or allusive of a characteristic of the services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

43. The opponent has not pleaded that the distinctive character of its marks has been enhanced through use; nor has it filed any evidence to support such a claim. Consequently, I have only the inherent position to consider. The words THE ORIGINALS are ordinary dictionary words. They are not highly allusive but do suggest that the services offered might be particularly unique or that there is some longevity to the services provided under the marks. The word HOTELS is descriptive and will not contribute significantly to the distinctive character of the Second Earlier Mark. Consequently, I consider both marks to be inherently distinctive to a slightly lower than medium degree.

Likelihood of confusion

44. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

45. I have found the First Earlier Mark and the applicant's mark to be visually similar to a medium to high degree and aurally similar to a medium to high degree if the words HUMAN HOTELS in the applicant's mark are pronounced. If they are not pronounced, then the marks will be aurally identical. I have found the Second Earlier Mark and the applicant's mark to be visually highly similar and aurally highly similar if the words HUMAN and HOTELS in the marks are pronounced. If they are not pronounced, then

the marks will be aurally identical. I have found all three marks to be conceptually highly similar. I have found both earlier marks to have slightly lower than medium degree of inherent distinctive character. I have identified the average consumer to be a member of the general public or a business user, who will select the services primarily by visual means (although I do not discount an aural component). I have concluded that the level of attention paid during the purchasing process will generally be medium, although I recognise that a higher than medium degree of attention may be paid where there is a higher cost involved. I have found the parties' services to be identical or highly similar.

46. Bearing in mind the principle of imperfect recollection, as well as the similarities between the marks, I consider that they are likely to be mistakenly recalled or misremembered as each other. This is particularly the case given that they are registered for identical or highly similar services. I consider there to be a likelihood of direct confusion.

47. I now turn to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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.”

48. If the differences between the marks are identified, I consider that the average consumer will conclude that these are alternative marks used by the same or economically linked undertakings. I consider this to be the case notwithstanding the fact that the opponent's marks have a slightly lower than medium degree of inherent distinctive character. I consider there to be a likelihood of indirect confusion.

CONCLUSION

49. The opposition is successful in its entirety, and the application is refused.

COSTS

50. As the opponent has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2015. In the circumstances, I award the opponent the sum of £450, calculated as follows:

| | |
|--|-------------|
| Filing a notice of opposition and considering the applicant's counterstatement | £150 |
| Filing written submissions in lieu | £200 |
| Official fee | £100 |
| Total | £450 |

51. I hereby order Light Human Hotels Limited to pay Europeenne D'Hotellerie the sum of £450. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 19th day of September 2019

S WILSON

For the Registrar