

O/581/21

TRADE MARKS ACT 1994

**IN THE MATTER OF UK REGISTRATION
NO. 3487256 BY
ICON OFFICES LIMITED
IN RESPECT OF THE TRADE MARK:**

Icon Offices

IN CLASS 36

AND

**A REQUEST FOR INVALIDATION
THERE TO UNDER NO. 503482
BY
ICON REAL ESTATE MANAGEMENT B.V.**

Background & Pleadings

1. The trade mark (“contested mark”) shown on the front page of this decision stands registered in the name of Icon Offices Limited (“the registered proprietor”). The mark was applied for on 6 May 2020 in the United Kingdom and was registered on 4 September 2020 in respect of the following services:

Class 36: Rental and leasing of offices.

2. Icon Real Estate Management B.V. (“the applicant”) has applied for a declaration of invalidity against the registration under the provisions of Section 47 and Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The applicant relies upon its EUTM¹ registration number 18003308 for the following (word) mark:

ICON

3. The mark was filed on 21 December 2018 and registered on 10 May 2019 for the following services in Class 36:

Class 36: Real estate portfolio management; commercial real estate brokerage.

4. Under Section 6(1) of the Act, the applicant’s trade mark clearly qualifies as an earlier trade mark. As it had not completed its protection procedure more than five years before the date of the application for invalidation (or the date on which the contested mark was filed), the applicant’s trade mark

¹ Although the UK has left the EU and the EUTM relied upon by the applicant now enjoys protection in the UK as a comparable trade mark, the EUTM remains the relevant right in these proceedings. That is because the application for invalidity was filed before the end of the Transition Period and, under the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, I am obliged to decide the opposition on the basis of the law as it existed before the end of the Transition Period.

is not subject to the proof of use provisions contained in Sections 47(2A) – (2E) of the Act.

5. The applicant, in its application for invalidation, claims that the contested mark is highly similar to the earlier mark for identical services. Also, the applicant contends that “[t]he first part of both marks contains of [sic] the distinctive, identical element ICON. The registrant’s trademark registration contains the descriptive element “Offices”. This element is descriptive as it directly refers to the relevant services consisting of real estate (i.e. offices) management services.” Therefore, registration of the contested mark should be invalidated under Section 5(2)(b) of the Act.
6. The registered proprietor filed a defence and counterstatement, denying the claims of the applicant. The registered proprietor states: “[o]ur business activities are completely different. Our business is rental of our own serviced and virtual offices and the provision of company formation and business support solutions. Our trademark is registered under Class 36 – Rental and leasing of offices. This is completely different to the class of services that the opponent provides and that they have their Trademark registered for. [...]” (sic)
7. During the evidence rounds, both parties filed written submissions. Also, the applicant filed submissions in lieu of a hearing.² Neither party requested a hearing. Thus, this decision has been taken following a careful consideration of the papers.
8. In these proceedings, the applicant is represented by Equipp B.V. and the registered proprietor is a litigant in person.
9. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law

² The registered proprietor filed late submissions in lieu which were out of time. As no supporting reasons have been given for the late submissions, these were not taken into account.

in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

Preliminary issues

10. In its submissions, the registered proprietor disputes the territorial effect of the applicant's mark in the UK. In particular, it posits that:

“The jurisdictions in which we operate are completely different. We are a UK based company with property based in the UK. Based on information gathered from the Opponent's website they do not appear to have any commercial property interests in the UK. Their interests appear to only be in Amsterdam, Rotterdam, The Hague and Brussels. The geographical location of our prospective target consumers therefore differ vastly.” (sic)

11. As I have already delineated in paragraph 4 of this decision, the applicant's earlier mark is not subject to the proof of use requirement, based on Section 47 of the Act. Consequently, the applicant is entitled to rely on its trade mark for the full range of services without having to show that it has been used in the UK (or indeed the EU). In addition, the applicant is the proprietor of a EUTM registration, which, as already stated above, is relevant in these proceedings. Therefore, the applicant's mark qualifies as an earlier mark enjoying protection in the UK as per Section 6(1) of the Act.
12. In addition, the registered proprietor raises the point that the parties use different logos. I should highlight that I must determine the matter on based on the marks before me, and any comparison between the logos that the parties use on their websites is of no relevance in these proceedings.

Decision

13. Section 47 of the Act states that:

“(2) The registration of a trade mark may be declared invalid on the ground –

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

14. The invalidation application is based specifically on Section 5(2)(b) of the Act which states that:

“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.”

15. The principles, considered in this case, stem from the decisions of the European 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

- 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 Services

16. When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

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

17. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

- “(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 *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“[...] the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

19. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks)* (IP TRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far.

Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

20. 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."

21. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The General Court clarified the meaning of "complementary" goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

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

22. The competing services to be compared are shown in the following table:

Applicant's Services	Proprietor's Services
<u>Class 36</u> : Real estate portfolio management; commercial real estate brokerage	<u>Class 36</u> : Rental and leasing of offices

23. In its written submission's, the applicant claims that:

“The contested services have the same intended purpose and nature as Icon’s services: organisational management of real estate is required for rental and leasing of offices.

It also includes maintenance aspects. When property is let, advice on management of the property and development and maintenance is often also required.

Moreover, the earlier ‘real estate portfolio management’ service consists of managing an entire real estate portfolio with the objective of preserving and increasing value. It involves the leasing, rental, acquisition, financing and disposition of properties. This can be achieved by managing various real estate assets or by actively letting, leasing, acquiring or selling individual components of a portfolio.

The services also coincide in distribution channels. Being services offered by specialised firms either through physical or online offices, their trade channel is business to business.”

24. In its written submissions, the registered proprietor mainly reiterates that it operates in a different area of activity from the applicant, providing a detailed comparison, which I will not reproduce here, between their services and business models and the applicant's.

25. Although the registered proprietor states that the services, which the parties actually trade in, are different, this has no bearing on my decision.

This is because I must consider the matter notionally based on the terms that the parties have registered or seek to register.³

26. In this regard, the contested term “*rental and leasing of offices*” relates to business tenancy services, while the registered proprietor’s term “*real estate portfolio management*” relates to services that involve the planning, overseeing, management, and risk assessment of a selection of (property) assets. The respective services coincide in their overarching nature and purpose, which is the monetisation of properties. The respective services could overlap in trade channels and be in competition. They may also overlap in users, such as professionals and businesses, and method of use. Also, the respective services could be offered as a bundle of solutions. Therefore, I find the respective services to be similar to a medium to high degree.

27. In relation to the contested term and the applicant’s “*commercial real estate brokerage*”, the latter concerns the services involving the coordination, negotiation and execution of commercial property transactions, including submission of listings, offers, and purchases, selling and leasing of properties. The respective services are similar in nature to the extent that they concern real estate services of one type or another. Also, they are similar in purpose as one can use the services at question to acquire or provide commercial property, even though the applicant’s services concern permanent properties compared to the registered proprietor’s temporary ones. The respective services may share similar trade channels, providers, users, and method of use, but it is unlikely to compete with or complement each other. Considering all the factors, I conclude that the services in question are similar to a medium to high degree.

³ See *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at paragraph 22 and *Roger Maier v ASOS* [2015] EWCA Civ 220 at paragraphs 78 and 84.

Average Consumer and the Purchasing Act

28. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J described the average consumer in these terms:

“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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

29. The average consumer of the services at issue will predominantly be businesses but without excluding members of the public. The degree of attention for the respective services in Class 36 will be at least reasonably high as the services will facilitate the transaction of large sums and long-term investments or contracts, followed by thorough and careful research. Primarily, the average consumer's encounter with such services will be on a visual level, such as signage on premises or high street, promotional material, journal advertisements, and website use. However, I do not discount word-of-mouth recommendations that may play a part in the selection process.

Comparison of Trade Marks

30. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

31. 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.

32. The marks to be compared are:

Applicant's Mark	Registered Proprietor's Mark
ICON	Icon Offices

Overall Impression

33. In its written submissions, the applicant highlights that:

“The Applicant’s sign ICON OFFICES contains the descriptive element “Offices”. This element is descriptive as it directly refers to the relevant services consisting of real estate (i.e. offices) management services. As a result, ICON is clearly the overlapping and most dominant element in both the earlier trademark as well as in the contested sign ICON OFFICES, due to the descriptive nature of the element “Offices”.”

34. The registered proprietor contends that:

“All of our clients and business associates always refer to us by our full name Icon Offices, as one part of our name is not complete without the other. We do not refer to ourselves in the abbreviated format of “Icon” and no evidence exists to support this. There is therefore no confusion between our name and that of the Opponents.

Our use of the word “Offices” is not descriptive. It does not relate to services consisting of real estate (i.e offices) management services. Our use of the word “Offices” is used as a plural noun relating to a room, set of rooms, or building used as a place for commercial, professional, or bureaucratic work. The word “ICON” therefore is not the most dominant element in our trademark. Both words in our trademark work together and each one is not complete without the other.”

35. Both the registered proprietor’s and the applicant’s marks are word marks consisting of the words “ICON” and “Icon Offices”, respectively. The former is presented in upper case while the latter in title case, whilst both are in a standard font. Registration of a word mark protects the word itself presented in any regular font and irrespective of capitalisation.⁴ The overall impression of the respective marks lies in the words themselves. Nevertheless, I accept that the second word element “Offices” is likely to be seen as descriptive by the average consumer. As a result, it will play a

⁴ See *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

lesser role in the overall impression, while “Icon” will be seen as the dominant element of the mark.

Visual Comparison

36. The contested mark fully incorporates the applicant’s mark, “Icon”. I also note that this identical element appears at the beginning of both marks, a position which is generally considered (although I accept just a rule of thumb) to have more impact due to consumers in the UK reading from left to right.⁵ The only visual point of difference is the presence of the second word element “Offices” in the contested mark. Taking into account the overall impression of the marks and the similarities and differences, I consider there to be a medium to high degree of visual similarity between the marks.

Aural Comparison

37. The registered proprietor’s mark consists of two words, “Icon Offices”, from which the first is a two-syllable word and the other is a three-syllable word, which will be articulated as “IE-KON OF-I-SIZ”. In contrast, the applicant’s mark is a single worded mark comprised by two syllables, i.e. “IE-KON”. Consequently, the marks will be aurally similar to a medium to high degree when these similarities and differences are weighed together with the overall impression.

Conceptual Comparison

38. With their written submissions, both parties have made contentions regarding the conceptual aspect of the respective marks. On the one hand, the applicant has submitted a number of potential definitions that the word “ICON” may receive based on Collins English Dictionary, stating:

“The word ‘ICON’ will be perceived as referring to *‘something or someone being important as a symbol of a particular thing; a*

⁵ See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

representation of Christ, the Virgin Mary, or a saint, esp. one painted in oil on a wooden panel, depicted in a traditional Byzantine style and venerated in the Eastern church; an image, picture, representation; a person or thing regarded as a symbol of a belief, nation, community, or cultural movement; a pictorial representation of a facility available on a computer system, that enables the facility to be activated by means of a screen cursor rather than by a textual instruction' [citation omitted]. The element ICON has an identical conceptual meaning in both the earlier trademark and contested sign.”

On the other, the register proprietor with its submissions highlights the failure of the applicant to point which of these meanings the average consumer will attribute to the mark, claiming that:

“The opponent has not identified which of these 2 very different meanings is applicable to the use of their word “Icon” in their Trademark. Therefore, the Opponent’s statement “The element ICON has an identical conceptual meaning in both the earlier trademark and contested sign” does not hold merit as they have failed to provide evidence to support that their use of the word Icon has the same descriptive meaning as our use of the word Icon.”

The applicant in its written submissions in lieu states that:

“5. It is irrelevant what meaning is applicable to the ICON trade marks as long as the consumer is aware that “icon” has a meaning that is identical for both ICON and ICON OFFICES, which is the case in the current dispute. As the applicant explained in the previous submission, “icon” may refer to “something or someone being important as a symbol of a particular thing”. The meaning of “ICON” in both trade marks may also refer to “iconic” in the sense of an “iconic building”. This conceptual meaning is, again, identical for both ICON and ICON OFFICES. In addition, the visual and aural similarity is

obvious. As a result, the overall impression of ICON and ICON OFFICES is highly similar.”

39. In the absence of evidence and despite the dictionary definitions provided by the parties in relation to the word “ICON” in both marks, it is my view that the consumers in the UK will immediately recognise this as an ordinary dictionary word, and a significant proportion of the relevant public will perceive it to mean a symbol either from a metaphorical or literal standpoint.⁶ In any event, regardless of the way in which the average consumer conceptualises the word ICON, they are likely to form the same concept of that word when it appears in the other mark. The only conceptual difference between the marks is that the word “Offices”, appearing in the registered proprietor’s mark, suggests that the services are related to non-domestic properties. Notwithstanding the difference highlighted, there is still a high degree of conceptual similarity.

Distinctive Character of the Earlier Trade Mark

40. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

“In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does

⁶ See *Interflora Inc & Anor v Marks and Spencer Plc* [2014] EWCA Civ 1403, paragraph 129.

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).”

41. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.
42. In the absence of evidence of use, I have only the inherent distinctiveness of the applicant’s mark to consider. As outlined in the previous section, the applicant’s word mark is an ordinary dictionary word. The average consumer will be familiar with the term and potentially might attribute a very mild suggestive/allusive quality to the mark, that of having great significance. However, the suggestiveness/allusion is quite mild, and I still regard the earlier mark to be distinctive to a medium degree.

Likelihood of Confusion

43. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that 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.⁷ It is essential to keep in

⁷ See *Canon Kabushiki Kaisha*, paragraph 17.

mind the distinctive character of the applicant's trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.⁸

44. 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*, Case 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.”

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume

⁸ See *Lloyd Schuhfabrik Meyer*, paragraph 27.

that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

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

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

45. I note that the categories identified above by Mr Purvis Q.C. are not exhaustive.⁹
46. 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.
47. Earlier in this decision, I have concluded that:
- the services at issue are similar to a medium to high degree;
 - the average consumer of the parties' services is predominantly professionals and businesses without entirely excluding members of the public, who will select the services by visual means, but without dismissing the aural means, and will likely pay at least a reasonably high degree of attention to the selection of such services;

⁹ *Thomson Hotels LLC v TUI Travel Amber E&W LLP* BL- O-440/14 at paragraph 29.

- the competing marks are visually and aurally similar to a medium to high degree, and conceptually similar to a high degree; and
 - the earlier mark has a medium degree of distinctive character.
48. Taking into account the above factors and the doctrine of imperfect recollection, I am satisfied that there is a likelihood of direct confusion. The point of difference created by the word element “Offices” will be treated as non-distinctive, thereby increasing the significance of the common word element “ICON”, which will be the element that will most likely to be recalled. I also note that the similarities between the marks coupled with the similarity of services, all ranging from medium to high, and the medium degree of inherent distinctiveness are such that they will lead the average consumer to mistakenly recall the marks as each other, even though at least a reasonably high degree of attention will be paid during the purchasing process.
49. If I am wrong on direct confusion, in terms of indirect confusion, even when the differences between the marks are identified by the average consumer, they will assume that the services offered under the respective marks originate from the same or economically linked undertakings. Notably, the consumer may perceive that the registered proprietor’s services, bearing the mark “Icon Offices” to be a brand extension or variation of the “ICON” mark, or vice versa, particularly bearing in mind the descriptiveness of the points of difference. Consequently, I find there to be a likelihood of indirect confusion between the marks regarding the services at issue.

Outcome

50. The application for invalidation has been successful in full. The trade mark is declared invalid with effect from 6 May 2020 for all the services for which it is registered, and the registration will be cancelled.

Costs

51. The applicant has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of £1,500 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

£200	Official opposition fee
£200	Filing a notice of opposition and considering the counterstatement
£600	Preparing submissions and considering and commenting on the other side's submissions
£500	Preparing submissions in lieu
£1,500	Total

52. I, therefore, order Icon Offices Limited to pay Icon Real Estate Management B.V. the sum of £1,500. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 4th day of August 2021

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General