

O-1094-22

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION No. 1541131

AND THE REQUEST BY RPC IP HOLDINGS LLC

TO PROTECT THE TRADE MARK

LEGACY

RESORTS & RESIDENCES

IN CLASSES 35 & 43

AND IN THE MATTER OF OPPOSITION

THERE TO UNDER NO 429901

BY LEGACY HOTELS AND RESORTS LIMITED

BACKGROUND

1) RPC IP Holdings LLC (hereinafter the applicant), on the basis of its international registration based upon its registration held in the United States of America, requested protection in the United Kingdom of the trade mark shown above. Protection was sought for the following services:

- In Class 35: Real estate services, namely, real estate condominium sales management involving investment properties, attached to or affiliated with third party brands, used as personal residences or placed in rental pools available for shared use by others; real estate sales management; business development services; business management; business administration services; hosting, managing, organizing and providing special events for business purposes in the nature of exhibitions, fairs and shows; hosting, managing, organizing and providing business networking events in the nature of exhibitions, fairs and shows in the fields of real estate, advertising, branding, and management, membership clubs, hotels, restaurants, cafés, bars, gyms, and recreation services; promotional, marketing and advertising services; hosting, managing, organizing and providing marketing promotional events for others in the nature of exhibitions, fairs and shows; advertising of commercial or residential real estate; procurement, namely, purchasing tickets to entertainment and sporting events for others.
- In Class 43: Providing temporary office accommodation, namely, rental of meeting rooms; providing general purpose facilities for meetings, conferences, seminars, reception rooms and exhibitions; providing accommodation services for meetings, namely, provision of conference and meeting facilities; room hire services, namely, rental of rooms as temporary living accommodations; providing temporary office accommodation for rent; providing catering services; providing temporary kitchen facilities; providing refreshment facilities, namely, juice bar services, cafe services, snack bar services, smoothie bar services, coffee bar services, tea rooms; mobile café services for providing food and drink; agency services for arranging and booking hotels and accommodations; agency services for the reservation of temporary accommodation; day nurseries and crèche services; child minding services, namely, child day-care centre services; catering services, namely, mobile catering services; catering services provided online from a computer database or from the internet, namely, making reservations and bookings for the catering of food and drinks, booking of catering services for others; providing banquet facilities for special occasions; wine club services, namely, bar services featuring wine, providing information about wine characteristics, providing advice on wine and wine and food pairing; wine club services, namely, providing facilities for wine club meetings; club dining services, namely, providing restaurant services

to club members; arrangement, booking, reception services for temporary accommodation, management of arrivals and departures, provision, rental and reservation of holiday homes, tourist homes and apartments, rooms in hotels, hotel rooms, rooms in motels, temporary accommodation; reservation and booking services for meals; providing nurseries and child care center services; restaurant, bar and catering services.

2) The mark is described as “The mark consists of the phrase "LEGACY RESORTS & RESIDENCES", with the "LEGACY" component placed over the "RESORTS & RESIDENCES" component; The "LEGACY" element is visually larger than the "RESORTS & RESIDENCES" element and all letters are capitalized”. The mark was published in the usual way in accordance with the Trade Marks (International Registration) Order 2008 (SI 2008/2206 as amended) (“the 2008 Order”).

3) On 5 January 2022 Legacy Hotels and Resorts Limited (hereinafter the opponent) filed notice of opposition to the conferring of protection on this international registration. The opponent is the proprietor of the following trade marks:

Mark	Number	Dates of filing and registration	Class	Specification relied upon
LEGACY HOTELS	3235837	07.06.17 25.08.17	35	Advertising services relating to hotels; business management of resort hotels; business advisory services; administrative hotel management; business management of hotels; business management of resort hotels; consultancy services relating to the administration and management of hotels.
			36	Financing services relating to hotels.
			37	Cleaning of hotels.
			41	Training of hotel staff; entertainment services provided by hotels; training services relating to the cleaning of hotels; wedding celebrations (organisation of entertainment for-); conference services; arranging conferences; organisation of meetings and conferences; gymnasium services; services for the provision of exercise equipment; providing health club and gymnastic services.
			43	Hotel services; provision of hotel accommodation; reservation and booking services; restaurant services; provision of facilities, accommodation and venues for meetings, conferences, seminars, training courses, functions and events; rental of meeting rooms; rental of temporary accommodation; temporary room hire services; services for the booking of rooms, meeting rooms and temporary accommodation; catering services; services for the provision of food and drink; services for the organisation of catering at meetings, conferences, seminars, training courses, functions and events; advisory and consultancy services relating to all the aforesaid services; Hotel, restaurant, cafeteria, snack bar, tea room, catering, cocktail lounge, bar, coffee shop, banqueting and nightclub services; hotel restaurant services; hotel accommodation services;

				resort hotel services; hotel catering services; electronic information services relating to hotels; accommodation bureau services [hotels, boarding houses]; hotels; resort hotels; arranging of meals in hotels; arranging of wedding receptions [food and drink]; arranging of wedding receptions [venues]; providing conference rooms; provision of conference facilities; provision of conference, exhibition and meeting facilities; accommodation reservations; room reservation services; restaurant reservation services; hotel reservation services provided via the Internet; provision of information relating to hotels.
			44	Beauty, hairdressing, make-up and skin treatment services; health and beauty spa services; spa services; beauty and hairdressing salon services; massage services; beauty consultations and demonstrations; aromatherapy services; manicure and pedicure treatment services; hair removal services; provision of tanning, sauna and steam room facilities; advisory and consultancy services relating to all the aforesaid services.
			45	Planning and arranging of wedding ceremonies; wedding ceremony planning and arranging consultation services; providing wedding officiant services; planning and arranging of wedding ceremonies; wedding ceremony planning and arranging consultation services.

4) The grounds of opposition are, in summary:

a) The mark in suit is similar to the opponent's earlier mark visually, aurally and conceptually. The services applied for are similar or identical to those for which the opponent's earlier mark is registered. There is therefore a likelihood of confusion which offends against section 5(2)(b) of the Act.

b) The opponent has reputation in the mark LEGACY such that use of the mark in suit will take unfair advantage of the distinctive character and repute of the opponent; consumers will assume an economic link between the parties which will affect the economic decisions of consumers causing damage to the opponent. As such the mark in suit offends against section 5(3) of the Act.

c) The opponent has used its LEGACY mark in the UK since 2005 and has considerable reputation and goodwill in with regard to hotel services generally such that use of the mark in suit will cause a misrepresentation which will cause the opponent damage. As such the mark in suit offends against section 5(4)(a).

5) The applicant filed a counterstatement on 1 April 2022. The applicant basically denies all the grounds. It put the opponent to proof of its reputation and goodwill as claimed but does not seek proof of use.

6) Only the opponent filed evidence in these proceedings and both ask for an award of costs. Neither party wished to be heard, although the opponent filed written submissions which will be referred to as and when necessary.

7) 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 in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

DECISION

8) I shall first consider the ground of opposition under section 5(2)(b) which reads:

“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.”

9) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

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

10) The opponent is relying upon its trade mark listed in paragraph 3 above which is clearly an earlier trade mark. The applicant has not requested that all the opponent provide proof of use for the services for which it is registered. The opponent can therefore rely upon all of the services for which its mark is registered under this ground of opposition.

11) When considering the issue under section 5(2)(b) I take into account the following principles which 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 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.

The average consumer and the nature of the purchasing decision

12) 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 these goods 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.”

13) The services provided do not fall into a single group or category but span a number of groupings. Firstly, there are professional services offered to individuals and businesses such as “real estate services; purchasing tickets for events for others” in class 35, and “room hire and rental services including hotel room bookings; the provision of food and drink and catering services; childcare services; and booking services for holiday homes, restaurants, hotels etc” in class 43. Such services would be chosen with care as they usually revolve around special days such as weddings, celebrations and holidays and usually involve some planning, expense and frequently a group of people. In my opinion such services will usually be found on the internet or via media advertising (print, tv, radio etc), so the initial selection will often be visual. However, such services are often chosen as the result of personal recommendations and so aural considerations must be considered of almost equal importance.

14) The second group of services are those primarily aimed at businesses such as “administration and management services; organising fairs and exhibitions etc; advertising, marketing and branding; membership schemes” in class 35; “provision of office and other accommodation;” in class 43. Again, such services would be selected with care as they would directly affect the businesses ability to trade and its profit levels as well as reputation etc. In my opinion such services will usually be found on the internet or via media advertising (print, tv, radio etc), so the initial selection will often be visual. However, such services are often chosen as the result of personal recommendations and so aural considerations must be considered of almost equal importance.

15) Overall, the typical consumer is the UK public which includes businesses; the selection will be made with a higher than average degree of attention and initially be made visually, although aural considerations are almost equally important.

Comparison of services

16) In its written submission dated 21 October 2022 the opponent withdrew its opposition under section 5(2)(b) to the following services in class 43: “day nurseries and crèche services; child minding services, namely, child day-care centre services; providing nurseries and child care center services”. 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) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the 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 für 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”.

18) I shall first compare the services in class 35. I first look at the applicant’s services “Real estate services, namely, real estate condominium sales management involving investment properties, attached to or affiliated with third party brands, used as personal residences or placed in rental pools available for shared use by others; real estate sales management”. The opponent contends that its services of “rental of temporary accommodation; accommodation reservations” in class 43 are the same or similar as it contends that “The users are the same. The trade channels are the same or similar in that they all relate to the rental or sale of real estate / accommodation. The nature, method of use and purpose of the services are also clearly highly similar. The goods are also plainly complementary; a company which offers real estate services such as a real estate agency will also predominantly provide services for the rental of properties.”

19) Whilst I am willing to accept some of the broad principles of the opponent’s arguments I do not accept that the services are highly similar but merely similar to a low to medium degree.

20) Moving onto the next part of the applicant’s class 35 services, namely: “business development services; business management; business administration services”. To my mind these are clearly fully encompassed by the opponent’s “business management of resort hotels; business advisory services; administrative hotel management; business management of hotels; business management of resort hotels; consultancy services relating to the administration and management of hotels” and must be deemed identical.

21) Next in class 35 are the applicant’s services: “hosting, managing, organizing and providing special events for business purposes in the nature of exhibitions, fairs and shows; hosting, managing, organizing and providing business networking events in the nature of exhibitions, fairs and shows in the fields of real estate, advertising, branding, and management, membership clubs, hotels, restaurants, cafés, bars, gyms, and recreation services; promotional, marketing and

advertising services; hosting, managing, organizing and providing marketing promotional events for others in the nature of exhibitions, fairs and shows". The opponent contends that these are highly similar to its services in Class 35 of "Advertising services relating to hotels; business management of resort hotels; business advisory services" and in Class 43 of "provision of facilities, accommodation and venues for meetings, conferences, seminars, training courses, functions and events; services for the organisation of catering at meetings, conferences". I note that the opponent shortened the last part of this specification from "services for the organisation of catering at meetings, conferences" to "organisation of meetings and conferences". When a specification clearly refers to catering it is not acceptable to simply ignore the word and hence change its meaning completely. Clearly a large number of events such as fairs, exhibitions and shows are held in hotels. It is also clear that overall there is a degree of overlap between the two sets of services such that they must be considered to be similar to at least a medium degree.

22) Similarly, the opponent's specification of "Advertising services relating to hotels" wholly encompasses the applicant's "advertising of commercial or residential real estate" and must be regarded as identical.

23) Lastly, in class 35 is the applicant's "procurement, namely, purchasing tickets to entertainment and sporting events for others". It is accepted that such booking services also typically offer a complete package of accommodation and food and so the opponent's specification in Class 43 of "reservation and booking services for meals; restaurant, bar and catering services" must be regarded as being highly similar.

24) Moving onto the class 43 services sought to be protected. Considering the applicant's specification of "Providing temporary office accommodation, namely, rental of meeting rooms; providing general purpose facilities for meetings, conferences, seminars, reception rooms and exhibitions; providing accommodation services for meetings, namely, provision of conference and meeting facilities; room hire services, namely, rental of rooms as temporary living accommodations; providing temporary office accommodation for rent" It is clear that the opponent's specification shown alongside in the table below is to all intents and purposes identical language and the opponent's specification encompasses the applicant's specification.

25) The applicant's services "room hire....temporary accommodation" are clearly identical to the opponent's hotel and temporary accommodation services.

26) The catering services of the two parties listed next in the table below are clearly identical in their coverage of the provision of food and drink and are identical.

27) Lastly, I turn to the applicant's services relating to wine clubs listed below. These are clearly encompassed in the opponent's "bar services" and so the services listed below must be regarded as identical.

Applicant's specification in Class 35	Opponent's specification in class 35 unless specified	Similarity
Real estate services, namely, real estate condominium sales management involving investment properties, attached to or affiliated with third party brands, used as personal residences or placed in rental pools available for shared use by others; real estate sales management.	In Class 43: rental of temporary accommodation; accommodation reservations.	Similar to a low to medium degree.
business development services; business management; business administration services.	Business management of resort hotels; business advisory services; administrative hotel management; business management of hotels; business management of resort hotels; consultancy services relating to the administration and management of hotels.	Identical.
hosting, managing, organizing and providing special events for business purposes in the nature of exhibitions, fairs and shows; hosting, managing, organizing and providing business networking events in the nature of exhibitions, fairs and shows in the fields of real estate, advertising, branding, and management, membership clubs, hotels, restaurants, cafés, bars, gyms, and recreation services; promotional, marketing and advertising services; hosting, managing, organizing and providing marketing promotional events for others in the nature of exhibitions, fairs and shows.	Advertising services relating to hotels; business management of resort hotels; business advisory services. In Class 43: provision of facilities, accommodation and venues for meetings, conferences, seminars, training courses, functions and events; services for the organisation of catering at meetings, conferences.	Similar to at least a medium degree. Similar to at least a medium degree.

Advertising of commercial or residential real estate.	Advertising services relating to hotels.	Identical.
Procurement, namely, purchasing tickets to entertainment and sporting events for others.	In class 43: reservation and booking services for meals; restaurant, bar and catering services.	Highly similar.
Applicant's specification in Class 43	Opponent's specification in Class 43 unless specified	
Providing temporary office accommodation, namely, rental of meeting rooms; providing general purpose facilities for meetings, conferences, seminars, reception rooms and exhibitions; providing accommodation services for meetings, namely, provision of conference and meeting facilities; providing temporary office accommodation for rent.	<p>Provision of facilities, accommodation and venues for meetings, conferences, seminars, training courses, functions and events; rental of meeting rooms; rental of temporary accommodation; temporary room hire services; services for the booking of rooms, meeting rooms and temporary accommodation; provision of conference facilities; provision of conference, exhibition and meeting facilities; accommodation reservations.</p> <p>In Class 41: conference services; arranging conferences; organisation of meetings and conferences.</p>	<p>Identical.</p> <p>Highly similar.</p>
Room hire services, namely, rental of rooms as temporary living accommodations; agency services for arranging and booking hotels and accommodations; agency services for the reservation of temporary accommodation; arrangement, booking, reception services for temporary accommodation, management of arrivals and departures, provision, rental and	Hotel services; provision of hotel accommodation; reservation and booking services; rental of temporary accommodation; services for the booking of rooms, meeting rooms and temporary accommodation; hotel accommodation services;	Identical.

reservation of holiday homes, tourist homes and apartments, rooms in hotels, hotel rooms, rooms in motels, temporary accommodation.	resort hotel services; hotels; resort hotels; arranging of meals in hotels.	
Providing catering services; providing temporary kitchen facilities; providing refreshment facilities, namely, juice bar services, cafe services, snack bar services, smoothie bar services, coffee bar services, tea rooms; mobile café services for providing food and drink; catering services, namely, mobile catering services; catering services provided online from a computer database or from the internet, namely, making reservations and bookings for the catering of food and drinks, booking of catering services for others; providing banquet facilities for special occasions; reservation and booking services for meals; restaurant, bar and catering services; club dining services, namely, providing restaurant services to club members.	Reservation and booking services; restaurant services; catering services; services for the provision of food and drink; services for the organisation of catering at meetings, conferences, seminars, training courses, functions and events; Hotel, restaurant, cafeteria, snack bar, tea room, catering, cocktail lounge, bar, coffee shop, banqueting and nightclub services; hotel restaurant services; hotel catering services; arranging of meals in hotels; restaurant reservation services.	Identical.
Wine club services, namely, bar services featuring wine, providing information about wine characteristics, providing advice on wine and wine and food pairing; wine club services, namely, providing facilities for wine club meetings.	Hotel, restaurant, cafeteria, snack bar, tea room, catering, cocktail lounge, bar, coffee shop, banqueting and nightclub services; rental of temporary accommodation.	Identical.

28) In short, the class 43 services of the two parties are identical. In respect of the class 35 services sought to be protected these fall into four camps:

Identical	business development services; business management; business administration services; advertising of commercial or residential real estate.
Highly similar	procurement, namely, purchasing tickets to entertainment and sporting events for others.
Similar to a medium degree	hosting, managing, organizing and providing special events for business purposes in the nature of exhibitions, fairs and shows; hosting, managing, organizing and providing business networking events in the nature of exhibitions, fairs and shows in the fields of real estate, advertising, branding, and management, membership

	clubs, hotels, restaurants, cafés, bars, gyms, and recreation services; promotional, marketing and advertising services; hosting, managing, organizing and providing marketing promotional events for others in the nature of exhibitions, fairs and shows.
Similar to a low to medium degree	Real estate services, namely, real estate condominium sales management involving investment properties, attached to or affiliated with third party brands, used as personal residences or placed in rental pools available for shared use by others; real estate sales management.

Comparison of trade marks

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

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

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

Opponent's trade mark	Applicant's trade mark
LEGACY HOTELS	LEGACY RESORTS & RESIDENCES

31) The opponent contends:

“30. The Application is a device mark consisting of the word LEGACY in large and bold letters and the words RESORTS & RESIDENCES which sit below the word LEGACY in a smaller font. The Earlier Mark is a word mark comprised of the words LEGACY and HOTELS. The dominant element of the Application and the Earlier Mark is the word LEGACY; HOTELS and RESORTS & RESIDENCES will be viewed as descriptive of the nature of the services provided by the undertaking and therefore little trade mark weight will be attributed to it by the average consumer, resulting in it playing a much lesser role in the overall impression of the mark. The dominant and distinctive element of the mark and therefore the overall impression, resides in the word LEGACY.

31. Visual Comparison: The Earlier Mark and the Application are each comprised of the distinctive and dominant element LEGACY. The Earlier Mark and the Application comprise the additional words HOTELS and RESORTS & RESIDENCES respectively. These are visual differences. The Application is also stylised; however, the stylisation is nothing more than a stylised representation of the rest of the mark. Therefore, although it would not go completely unnoticed by the average consumer it is likely to have little impact on the overall impression created by the mark. The Application is therefore similar to a high degree to the Earlier Mark.

32. Aural Comparison: Aurally the Application is identical to the Earlier Mark. The additional verbal HOTELS and RESORTS & RESIDENCES elements present in the are unlikely to be articulated as they will be regarded as descriptive of the services. The only common element between all marks is the word LEGACY which is identical in each and will be given its normal pronunciation. Alternatively, the marks are similar to a very high degree.

33. Conceptual Comparison: The marks overlap conceptually to the extent that all marks will bring to mind the identical notion of the word LEGACY, which will be given its ordinary meaning as an English word; something that has developed as a result of its past or creating something enduring that can be passed on in the future. The marks differ in the words HOTELS and RESORTS & RESIDENCES. They will also be given their ordinary meaning but will be regarded as descriptive of the services provided. Further, HOTELS is synonymous with RESORTS & RESIDENCES. The marks are therefore conceptually identical.”

32) In its counterstatement the applicant commented “The Applicant denies that the word LEGACY is the primary element of each mark.”

33) Each mark has the word LEGACY as its first element, and in the case of the applicant the font used is considerably larger than that used for the other elements of the mark. The opponent’s mark has the word “HOTELS” as its second element whereas the applicant’s mark has the words “RESORTS & RESIDENCES” below its first element. Given the nature of the services of the two parties it is clear that for many of the services the secondary words of each mark “Hotel” and “resorts & residencies” will be seen as descriptive of the services on offer. By contrast the first element of both marks is the well-known English word LEGACY which has a meaning of a bequest usually after the death of a relative, or a reference to an office system such as computer hardware or software that is out of date but is difficult to replace. Neither definition has any meaning with regard to the vast majority of the specifications of the two parties.

34) In making the comparison I will take into account the views expressed in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, where the General Court noted that the beginnings of word tend to have more visual and aural impact than the ends. The court stated:

“81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters ‘lo’ which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter ‘r’, which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root ‘mundico’ in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter ‘r’ at the end of the two signs. Given those similarities, the applicant’s argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix 'mundi' are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar.

35) Although I also note that in *Bristol Global Co Ltd v EUIPO*, T-194/14, the General Court held that there was a likelihood of confusion between AEROSTONE (slightly stylised) and STONE if both marks were used by different undertakings in relation to identical goods (land vehicles and automobile tyres). This was despite the fact that the beginnings of the marks were different. The common element – STONE – was sufficient to create the necessary degree of similarity between the marks as wholes for the opposition before the EUIPO to succeed.

36) I also take account of *The Picasso Estate v OHIM*, Case C-361/04 P, where the Court of Justice of the European Union found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

37) Conversely in *Nokia Oyj v OHIM*, Case T-460/07, the General Court stated that:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

38) I also note that in *Usinor SA v OHIM*, Case T-189/05, the General Court found that:

“62. In the third place, as regards the conceptual comparison, it must be noted that while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Lloyd Schuhfabrik Meyer*, paragraph 25), he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him (Case T-356/02 *Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT)* [2004] ECR II-3445, paragraph 51, and Case T-256/04 *Mundipharma v OHIM – Altana Pharma (RESPICUR)* [2007] ECR II-0000, paragraph 57).

63. In the present case, the Board of Appeal correctly found that the signs at issue have a common prefix, 'galva', which evokes the technique of galvanisation, that is, the act of fixing an electrolytic layer to a metal to protect it from oxidation.

64. By contrast, the Board of Appeal incorrectly took the view that a conceptual comparison of the second part of the signs was not possible, because the suffixes 'llia' and 'lloy' were meaningless.

65. That conclusion is based on an artificial division of the signs at issue, which fails to have regard to the overall perception of those signs. As stated in paragraph 59 above, the relevant public, which is French-speaking but has knowledge of the English language, will recognise in the mark applied for the presence of the English word 'alloy', corresponding to 'alliage' in French, even if the first letter of that word ('a') has merged with the last letter of the prefix 'galva', according to the usual process of haplology. That mark will therefore be perceived as referring to the concepts of galvanisation and alloy.

66. As far as the earlier mark is concerned, the suffix 'allia' is combined with the prefix 'galva' in the same way. The evocative force of the suffix 'allia' will enable the relevant public – on account of its knowledge and experience – to understand that that is a reference to the word 'alliage'. That process of identification is facilitated still further by the association of the idea of 'alliage' (alloy) with that of galvanisation, the suffix 'allia' being attached to the prefix 'galva'.

67. By breaking down the signs at issue, the relevant public will therefore interpret both signs as referring to the concepts of galvanisation and alloy.

68. Consequently, the conclusion to be drawn is, as the applicant correctly maintains, that the signs at issue are conceptually very similar, inasmuch as they both evoke the idea of galvanisation and of an alloy of metals, although that idea is conveyed more directly by the mark applied for than by the earlier mark".

39) Clearly, the marks share the identical word as the first element which is also the distinctive and dominant element in each mark. The additional elements also convey very similar images "hotels" and "resorts and residencies" both conjure immediate images of places where people live for a period particularly when on holiday, a resort such as Torremolinos . As the term "residencies" comes after the word "resorts" it conjures an image of a timeshare, which is a "home" but only one visited infrequently and possibly shared with others. The additional elements of each mark are clearly different in both visual and aural terms. **However, to my mind, the visual, aural and**

conceptual similarities far outweigh any visual or aural differences. The marks are similar to a high degree.

Distinctive character of the earlier trade mark

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

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

41) The opponent’s mark is inherently distinctive for the services it offers as the term “Legacy” has no real meaning, as far as I am aware, in relation to these services. In relation to hotels the term usually used for an old fashioned or simply old hotel is “heritage”. “Legacy” is a well known English word with two meanings (see paragraph 33 above) neither of which is appropriate for the services for which the opponent’s mark is registered. The opponent’s mark must be regarded as **inherently distinctive to at least a medium degree**. The evidence filed by the opponent shows that in the UK it has ten hotels which operate under its mark whilst there are ten other hotels which it manages but which trade under a franchise name such as Hilton. In the five years 2016-2020 inclusive the turnover of the company has averaged at approximately £2million per annum. This is not put into context of the UK market for all of the services offered, but it is clear not particularly substantial, **and so it cannot benefit from enhanced distinctiveness**.

Likelihood of confusion

42) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive the trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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 he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer for the services is a member of the general public including businesses who will select the services by predominantly visual means, although aural considerations are of almost equal importance and that they are likely to pay a higher than average degree of attention to the selection of said services.
- the marks of the two parties have a high degree of similarity.
- the opponent's mark has a medium level of inherent distinctiveness, but cannot benefit from an enhanced distinctiveness through use.
- I found the services of the two parties to range from identical to similar to a low to medium degree, as set out below:

Identical	business development services; business management; business administration services; advertising of commercial or residential real estate.
Highly similar	procurement, namely, purchasing tickets to entertainment and sporting events for others.
Similar to a medium degree	hosting, managing, organizing and providing special events for business purposes in the nature of exhibitions, fairs and shows; hosting, managing, organizing and providing business networking events in the nature of exhibitions, fairs and shows in the fields of real estate, advertising, branding, and management, membership clubs, hotels, restaurants, cafés, bars, gyms, and recreation services; promotional, marketing and advertising services; hosting, managing, organizing and providing marketing promotional events for others in the nature of exhibitions, fairs and shows.
Similar to	Real estate services, namely, real estate condominium sales management involving

a low to medium degree	investment properties, attached to or affiliated with third party brands, used as personal residences or placed in rental pools available for shared use by others; real estate sales management.
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43) It is necessary to consider the likelihood of both direct and indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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

45) Whilst in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

46) Earlier on in this decision I found that the average consumer would take a higher than average degree of attention to the selection of the services in question. Despite this extra precaution on the part of the average consumer it is my view that the marks are so alike that the average consumer

will see them as being two branches from the same tree, one dealing with hotels the other with resorts and timeshare. Even where there is only a low to medium degree of similarity in the services such as those concerned with “real estate services” I believe that the average consumer will be confused by the similarity of the marks into believing that the businesses are linked, there will be direct confusion in respect of all the services applied for by the applicant. The ground of opposition under section 5(2)(b) succeeds in full in respect of the services opposed.

47) I next turn to the ground of opposition under section 5(3) which reads:

“5. (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.”

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

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

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

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

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

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

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

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

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

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

49) The first hurdle is the issue of reputation as set out at points (a) and (b) above. The onus is upon the opponent to prove that its trade mark enjoys a reputation or public recognition. The evidence filed by the opponent is far from overwhelming but it is just enough for them to clear the first hurdle regarding reputation in respect of hotels and the services associated with running hotels.

50) I next have to consider whether the public will make a link. In Case C-408/01, *Adidas-Salomon*, the CJEU held that:

“28. The condition of similarity between the mark and the sign, referred to in Article 5(2) of the Directive, requires the existence, in particular, of elements of visual, aural or conceptual similarity (see, in respect of Article 5(1)(b) of the Directive, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23 in fine, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 27 in fine).

29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).”

51) The level of similarity required for the public to make a link between the marks for the purposes of 5(3) may be less than the level of similarity required to create a likelihood of confusion. In *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, the CJEU stated (at paragraph 72 of its judgment) that:

“The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say,

to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

52) In C-252/07 *Intel Corp* [2008] ECR I-8823 at paragraph 42 the court set out the factors used to assess a link. Those factors include:

the degree of similarity between the conflicting marks;

the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;

the strength of the earlier mark’s reputation;

the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;

the existence of the likelihood of confusion on the part of the public.

53) Earlier in this decision I found that the marks of the two parties are similar to a high degree. I also found that the opponent’s had a reputation in hotels and the running of hotels. All of the opponent’s services are centered around the core of its business in managing / running hotels and providing all the services one associates with hotels such as catering, functions etc. I found earlier that the two parties’ services ranged between identical to similar to a low to medium degree. However, this did not include the services in class 43 “day nurseries and crèche services; child minding services, namely, child day-care centre services; providing nurseries and child care center services” which were removed from the grounds under sections 5(2)(b) and 5(4). The opponent’s mark is registered for a wide range of services which the average consumer would associate with the provision of hotels such as accommodation; management; financing; training; consultation; entertaining; cleaning; functions such as weddings, seminars, fairs and conferences; gymnasiums; provision of food and drink; beauty and spa services such as massage, hairdressing, manicures, steam rooms and tanning. Such services are not unusual for hotels to provide as they increasingly diversify to maximise their revenue and utilise their assets such as conference rooms, swimming pools and car parking. In my experience, it is increasingly common for creche type facilities to be offered for customers to take advantage of the ability to park to drop off children or simply leave them for an hour or more whilst using a facility such as a gym or spa. To my mind, despite the additional attention that the average consumer will pay to choosing the type of services involved in

this case, if a member of the public saw the applicant's mark they would immediately make the link to the opponent, to all of the services sought to be protected by the applicant. **The ground of opposition under section 5(3) succeeds in full.**

54) The last ground of opposition is under section 5(4)(a) which reads:

“5.(4) 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.”

55) In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court conveniently summarised the essential requirements of the law of passing off as follows:

“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).”

56) Whilst 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.”

57) Earlier in this decision I found that use of the mark in suit, actual or on a fair and notional basis, would result in confusion with the opponent's mark. Accordingly, it seems to me that the necessary misrepresentation required by the tort of passing off will occur.

58) In a *quia timet* action it is clearly not possible to show that damage has been suffered. In *Draper v Trist and Trisbestos Brake Linings Ltd* [1939] 56 RPC 429 Goddard L.J. stated:

“But in passing-off cases, the true basis of the action is that the passing-off by the defendant of his goods as the goods of the plaintiff injures the right of property in the plaintiff, that right of property being his right to the goodwill of his business. The law assumes, or presumes, that if the goodwill of a man's business has been interfered with by the passing-off of goods, damage results therefrom. He need not wait to show that damage has resulted, he can bring his action as soon as he can prove passing-off; because it is one of the class of cases in which the law presumes that the Plaintiff has suffered damage. It is in fact, I think, in the same category in this respect as an action for libel. We know that for written defamation a plaintiff need prove no actual damage. He proves his defamation. So, with a trader; the law has always been particularly tender to the reputation and goodwill of traders. If a trader is slandered in the way of his business, an action lies without proof of damage.”

59) Consequently in the instant case if the applicant has established a goodwill and shown deception then damage can be considered as the automatic sequitur and the three elements of the classic trinity of passing-off will have been established. **The opposition under Section 5(4)(a) of the Act must succeed in full against all of the services opposed.**

CONCLUSION

60) The opponent has been successful under sections 5(2)(b) and 5(4) against all of the services opposed, and also successful under section 5(3) against all of the services sought to be protected by the applicant. As a result the mark in suit, International Registration 1541131, will not be granted protection in the UK.

COSTS

61) As the opponent was successful it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£300
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Official Fee	£200
Providing evidence	£550
Providing submissions	£800
TOTAL	£1,850

62) I order RPC IP Holdings LLC to pay Legacy Hotels and Resorts Limited the sum of £1,850. This sum to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th day of December 2022

George W Salthouse
For the Registrar,
the Comptroller-General