

O/0303/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3668801

BY NAEEM AL-ALAWI

TO REGISTER THE FOLLOWING TRADE MARK:



Friendly Professional Co-Working Space

IN CLASS 36

AND

AN OPPOSITION THERETO UNDER NUMBER 429184

BY WORKSPACE GROUP PLC

BACKGROUND AND PLEADINGS

1. On 14 July 2021, Naeem Al-Alawi (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK (“the contested mark”). The application was published for opposition purposes on 17 September 2021 and registration is sought for the following services:

Class 36: *Rental of offices for co-working.*

2. On 15 December 2021, Workspace Group Plc (“the opponent”) opposed the application in full, based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1995 (“the Act”). Under sections 5(2)(b) and 5(3) the opponent relies upon UK trade mark number 3178820: “**WORKSPACE**” (“the earlier mark”). The trade mark has a filing date of 5 August 2016, a registration date of 31 March 2018 and is registered for the following services:

Class 36: *Leasing of offices and premises; rental and leasing of commercial and industrial property and premises; real estate services; real estate agency.*

Class 43: *Providing temporary use of offices, rooms, and commercial accommodation.*

3. In accordance with section 6 of the Act, the mark relied upon by the opponent is considered an earlier mark. The mark had not been registered for five years at the date of application for the contested mark and so, in accordance with section 6A of the Act, the mark is not subject to proof of use; the opponent may rely upon all the services for which the mark is registered.

4. Under section 5(2)(b), the opponent claims that there is a likelihood of confusion on the basis that the marks are highly similar and the services are either identical or highly similar.

5. Under section 5(3), the opponent claims to have significant reputation in the UK for the services relied upon and claims that use of the contested mark would, without due

cause, take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier mark.

6. Under section 5(4)(a), the opponent relies upon the unregistered sign “**WORKSPACE**” which it claims to have used throughout the UK since 1990 in relation to *the rental and provision of office, commercial and business premises and facilities and the provision of temporary accommodation*. The opponent claims to have generated a substantial goodwill in the sign and that use of the contested mark would constitute a misrepresentation to the public that would damage the opponent’s goodwill. Therefore, use of the contested mark would be contrary to the law of passing off.

7. The applicant filed a defence and counterstatement essentially denying the grounds of opposition. It does, however, accept that the services are similar.

8. The opponent is represented by Beck Greener LLP; the applicant is unrepresented. Only the opponent filed evidence in these proceedings. Neither party requested a hearing and only the opponent filed written submissions in lieu. The evidence will be summarised to the extent that it is considered necessary.

EVIDENCE

9. The opponent filed evidence in the form of the witness statement of Catherine Mary Jewell dated 20 June 2022 and its corresponding seven exhibits (CMJ1 – CMJ7). Ms Jewell is a Partner at the opponent’s representatives. The exhibits provided with her witness statement are filed in support of the opposition under sections 5(3) and 5(4)(a).

10. Exhibit CMJ1 contains some of the evidence previously filed at the UKIPO during the examination stage of the opponent’s earlier mark to support a claim of acquired distinctiveness. The exhibit contains the witness statement of James Simon Friedenthal, dated 5 January 2017, and eight of its original eleven corresponding exhibits (JSF1-2, JSF5-8 and JSF10-11). Mr Friedenthal, at the date of his witness statement, was the Head of Corporate Development for the opponent.

11. Mr Friedenthal gives some history of the opponent, including that the company was incorporated in 1986 and registered at Companies House in 1997 following a company rebranding, reported in an article in Property Week on 1 August 1997.¹ It is stated that the opponent has a portfolio worth £1.8bn and operates more than 65 business centres which, between them, house more than 4,000 businesses.

12. The opponent's revenue (excluding revenue of joint ventures) for the years 1997 to 2015 is provided in Mr Friedenthal's witness statement as shown below:

Financial Year	Revenue in £millions
1997/1998	21.2
1998/1999	22.7
1999/2000	29.3
2000/2001	36.2
2001/2002	39.1
2002/2003	45.0
2003/2004	51.1
2004/2005	55.0
2005/2006	63.2
2006/2007	59.9
2007/2008	66.9
2008/2009	69.8
2009/2010	66.5
2010/2011	68.8
2011/2012	67.3
2012/2013	69.5
2013/2014	73.6
2014/2015	83.6

13. Mr Friedenthal explains that the opponent spent, in the 20 years up to the date of his witness statement, a "considerable amount of time promoting" the company and

¹ Exhibit JSF1.

the services provided under the WORKSPACE mark by way of publications, activities, website and social media activity and “making [themselves] available for media comment”.² Advertising figures for the years 2007 to 2016 are included within a table in the witness statement but have been redacted in their entirety. It is, however, stated that the annual spend in respect of marketing has been “around half a million pounds or greater” since 2007.³ Given the date of Mr Friedenthal’s witness statement, I take this figure to be relating to the period 2007 to 2017.

14. Exhibit JSF2 contains a printout of an archived page taken from the opponent’s former website in 2002. The page refers to various awards achieved by the opponent between 1996 and 2001. Seven awards presented to the opponent between 2014 and 2016 are listed in Mr Friedenthal’s witness statement,⁴ corroborated by printouts from the corresponding websites.⁵ The seven awards are shown below:

- a) **Best New Place to Work, The Pill Box – The London Planning Awards 2015;**
- b) **Best Real Estate PLC – UK Stockmarket Awards 2015;**
- c) **Specialist Property Company of the Year – Estates Gazette Awards 2014;**
- d) **Property Company of the Year – Property Week Awards 2015;**
- e) **Best Integration Site – Kentico Site of the Year Awards 2015;**
- f) **Offices Company of the Year – Estates;**
- g) **Workspace Provider of the Year – British Small Business Awards 2016.**

15. 129 pages of press clippings for the years 1997 to 2016 have been provided at Exhibit JSF6, including publications in The Financial Times, The Birmingham Post,

² At [22].

³ At [24].

⁴ At [28].

⁵ Exhibit JSF11.

The Independent, The Sunday Times, The Times, The Daily Telegraph, Estates Gazette and Property Week.

16. WORKSPACE features on monthly Property Week ‘wraps’ (sponsored adverts that wrap around the front and back covers of magazines) between December 2015 and June 2016. Property Week is said in Mr Friedenthal’s to be the “leading news magazine in the UK commercial and residential property market” with a “weekly audience measure of approximately 36,000”.⁶

17. The opponent sponsored and featured in the 2013 London Stock Exchange Group publication “1000 Companies to Inspire Britain”.⁷ WORKSPACE is described as creating “unique environments that enable businesses to have the freedom and opportunity to thrive”. At the date of the publication, WORKSPACE is listed as providing 90 business centres throughout London and 5.2 million square feet of business space. There is also a reference to 86% of customers recommending WORKSPACE.

18. On 13 January 2015, the opponent hosted the New & Growing Companies (NGC) Forum – a conference about new and growing companies powering the London economy – at the Houses of Parliament. A presentation was delivered by Professor Peter Tyler of the Department of Land Economy at the University of Cambridge; a copy of his presentation is provided at Exhibit JSF10. A slide on page 12 of the exhibit shows that 83% of businesses using WORKSPACE facilities have sales markets in the UK, 26% of those being outside London. A slide on page 14 shows that the opponent has a total job contribution to the London economy of 38,400 jobs per year and that the opponent’s customers contribute an estimated £1.92bn of GVA (Gross Value Added) to the London economy each year.

19. Online use of the WORKSPACE mark is shown at Exhibit JSF8, limited to use on the opponent’s own websites (former and current), as well as a list of the number of

⁶ At [12].

⁷ Exhibit JSF7.

Twitter followers to each of the opponent's WORKSPACE sites. At 10 June 2016, the number of followers totalled 37,597.

20. In regard to the reach of the opponent's websites, website traffic data for the years 2011 to 2015 has been included in a table broken down by regions of the UK (as well as outside of the UK), however, the entirety of the figures have been redacted.⁸

21. Exhibit CMJ2 to Ms Jewell's witness statement contains the witness statement of Richard Orr, dated 15 December 2016, which was filed during the application stage of the earlier mark. Mr Orr, at the time of his witness statement, was a director of Gather London Limited, a UK-based international communications consultancy. Gather London is described as being responsible for producing the opponent's communications documentation in order to maximise the public's engagement with its company. Mr Orr states that, in his view, and based on his experience, WORKSPACE is well-known and recognised as referring to the opponent.

22. Exhibit CMJ3 contains the witness statement of Brad Warwick, dated 7 December 2016, which was filed during the application stage of the earlier mark. Mr Warwick, at the time of his witness statement, was Co-Founder and Chief Operating Officer of Crafted, a UK digital agency providing consultancy to its clients to assist them in their internet and online strategy. Crafted has, since 2007, designed, developed and managed the opponent's website properties. Mr Warwick states that the opponent is very well-known and that, in his experience, the opponent is referred to as WORKSPACE.

23. I consider it important to note here that from the evidence listed above (as well as the remainder of the evidence filed during the application stage), the UKIPO did not make an assessment as to the degree of distinctive character of the opponent's mark (nor its goodwill or reputation). It simply used this evidence to assess whether the mark had acquired any distinctive character at all i.e. whether it was able to overcome an objection under sections 3(1)(b) and (c) of the Act in order to become a registered trade mark in the UK. The evidence was deemed satisfactory for this purpose. The

⁸ At [17].

totality of the evidence before me will be assessed afresh for the purposes of determining the degree of distinctive character of the mark and the opponent's claimed reputation and goodwill. No conclusions previously drawn from this evidence by the UKIPO will be relevant to my assessment, though it is true that the relevant factors under consideration may overlap.

24. Exhibit CMJ4 contains a list of the yearly company accounts filed at Companies House between 1987 and 2021, selected content pages from which (for the years 2016 to 2021) are included at Exhibit CMJ5. Nothing in the 53 pages of Exhibit CMJ5 has been highlighted as particularly important for the opponent and Ms Jewell has not referred me to any specific evidence. I do, however, note that it contains financial and operational statistics, key performance indicators and the opponent's property portfolio list for the years 2016 to 2021, all of the properties for those years falling in London or Greater London. The opponent's revenue for the years 2013 to 2021 is as follows:

Year Ending	Revenue (£m)
31 March 2021	142.3
31 March 2020	161.4
31 March 2019	149.4
31 March 2018	128.9
31 March 2017	108.8
31 March 2016	101.2
31 March 2015	83.6
31 March 2014	73.6
31 March 2013	69.5

25. Exhibit CMJ6 contains a Wikipedia page entry for the opponent. It states that the opponent's property portfolio, comprising (mainly freehold) office buildings, industrial estates, serviced offices and warehouses, was valued at £2.6 billion in March 2020.

26. Exhibit CMJ7 contains an article from the BBC news website dated 13 December 2019, entitled "Workspace sticks with non-executive". Ms Jewell explains in her

witness statement that this article is evidence that the opponent is referred to as “Workspace”.

27. That concludes my summary of the evidence insofar as I consider it necessary.

DECISION

Relevance of EU law

28. 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. This is why this decision continues to refer to the trade mark case law of EU courts.

Section 5(2)(b)

29. Section 5(2)(b) of the Act 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.”

30. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

Relevant law

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

The principles

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

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

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

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

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

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

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

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

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

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

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

Comparison of services

32. The competing services are shown in the table below:

The earlier mark	The contested mark
<i>Class 36: Leasing of offices and premises; rental and leasing of commercial and industrial property and</i>	<i>Class 36: Rental of offices for co-working.</i>

<p><i>premises; real estate services; real estate agency.</i></p>	
<p>Class 43: <i>Providing temporary use of offices, rooms, and commercial accommodation.</i></p>	

33. In *Gérard Meric v OHIM*, the General Court (“GC”) confirmed that even if services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):⁹

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

34. I consider that to be the case here. The applicant’s services clearly fall within the scope of the opponent’s *leasing of offices and premises; rental and leasing of commercial and industrial property and premises and providing temporary use of offices, rooms, and commercial accommodation*. I find these services identical in accordance with *Meric*.

The average consumer and the purchasing act

35. It is necessary for me to determine who the average consumer is for the respective parties’ services. I must then determine the manner in which the services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

⁹ Case T-133/05

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

36. The average consumer of the respective services is either a member of the general public, or a business, who is seeking an office space from which to work. As the services are not inexpensive and might involve long-term investment or contracts, they strike me as ones which all users will select with an above medium level of care. The selection process will involve mainly visual considerations, with consumers being exposed to the marks in advertising, on websites and in brochures and catalogues. There is also the potential for aural considerations to be relevant on the basis of word of mouth recommendations or bookings made over the telephone.


Comparison of marks

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

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relevant 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.”

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

39. The trade marks to be compared are as follows:

The earlier mark	The contested mark
<p style="text-align: center;">WORKSPACE</p>	

40. I will address, first, the following submission made by the applicant in its counterstatement:

“[...] opponent’s logo has a circle in blue with a smaller circle in front of it in a darker blue.”

41. The applicant appears to be referring to a different mark used by the opponent as opposed to the mark relied upon. The earlier mark relied upon by the opponent is the one shown in the table above, which is in word-only format. It is this mark that I will be comparing to the contested mark.

42. The earlier mark is in word-only format and consists of the word “WORKSPACE”. As there are no other elements, the overall impression lies in the word itself.

43. The contested mark is figurative and comprises a cube device featuring either the letter G, W or S on each visible side, the conjoined words “GoWorkSpace” and, below these elements, the words “Friendly Professional Co-Working Space”. In “GoWorkSpace”, the word “Go” is presented in green, “Work” in black and “Space” in yellow. The same colours are used on the cube device, which is positioned at the

beginning of the mark: green for the side featuring the letter “G”, black for the letter “W” and yellow for the letter “S”. The words “Friendly Professional Co-Working Space” are presented in a smaller, grey font. In figurative marks, it is not the case that word elements must always be considered to be dominant.¹⁰ Given the size of the cube device in relation to the words “GoWorkSpace” and its position at the beginning of the mark, I consider it to be as dominant in the mark as the aforementioned words. The words “Friendly Professional Co-Working Space” are in a much smaller and paler-coloured font; they are likely to be seen as a promotional message and so they play a lesser role in the overall impression.

Visual comparison

44. Visually, I agree with the opponent that the competing marks are similar to the extent that they share the word “WORKSPACE”. The fact that they are written in upper case versus sentence case is not relevant to the comparison since either case constitutes fair and notional use. The use of the colours black and yellow, however, creates a visual difference; use of a word mark only covers use in a different colour if the entirety of the mark is in the same colour, not multiple different colours. The cube device and the word “Go” are equally dominant in the contested mark and cannot be ignored: they create further visual differences. The remaining words in the contested mark, despite playing a lesser role, further differentiate the marks visually. Overall, I consider there to be no more than a medium degree of visual similarity between the marks.

Aural comparison

45. The word “WORKSPACE” in the earlier mark will be given its ordinary English pronunciation comprising two syllables. There is no reason why the word “Go” in the contested mark will not be articulated; each word in “GoWorkSpace” will be given its ordinary English pronunciation comprising three syllables. The cube device is decorative and the letters presented thereon are unlikely to be articulated. Similarly, the promotional and laudatory nature of the words “Friendly Professional Co-Working

¹⁰ See *L&D SA v OHIM* [2008] E.T.M.R. 62 and *Metamorfoza d.o.o. v EUIPO*, Case T-70/20, EU:T:2021:253.

Space” mean they too are unlikely to be articulated. The point of aural overlap lies in “WORKSPACE”. However, the additional word “Go” acts as a point of aural difference. Overall, I consider the marks to be aurally similar to a medium to high degree.

Conceptual comparison

46. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM*.¹¹ The assessment must be made from the point of view of the average consumer.

47. The common element “WORKSPACE” will bring to mind a space in which to work, the immediate concept for the earlier mark. The word “Go” preceding the common element in the contested mark adds a different element to the concept but makes the meaning slightly more ambiguous than “WORKSPACE” alone. Consumers may see the contested mark as “Go” and “Workspace” separately, giving each element its own ordinary meaning rather than the words hanging together. Alternatively, consumers may see “GoWorkSpace” as a space to ‘go to work’. In any case, I consider the marks to be conceptually highly similar.

Distinctive character of the earlier mark

48. In *Lloyd Schuhfabrik Meyer* 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).

¹¹ [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

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).”

49. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

50. The fact that the opponent made a successful claim to acquired distinctiveness at the examination stage of the earlier mark is only relevant to the extent that the earlier mark, as a registered trade mark, is deemed to have at least some distinctive character.¹² Whilst “WORKSPACE” describes the services for which the earlier mark is registered, I am constrained to hold that it has a degree of inherent distinctiveness, which I consider to be very low.

51. Turning now to consider whether the distinctiveness of the earlier mark has been enhanced through use, I refer to the opponent’s evidence of use, summarised above. The opponent has provided sales figures for the last 25 years (supported by Companies House records), which I note appear significant, totalling almost £1.8 billion, and have continued to grow over that time. Whilst the opponent has not mentioned its market share, I bear in mind its annual marketing spend of at least half a million pounds between 2007 and 2017, its achievement of various awards, and

¹² *Formula One Licensing BV v OHIM*, Case C-196/11P.

press coverage between 1997 and 2016. There has clearly been significant and longstanding use of the mark in the UK. Despite the fact that the evidence points to the opponent only operating business centres in London, evidence of the promotion of the mark is UK-wide and, as at 2015, 26% of the businesses using the opponent's services are businesses whose markets are outside of London, though this percentage is likely to have changed over the last 8 years. The evidence demonstrates that the earlier mark's distinctiveness has been enhanced by way of the use made of it, though given its very low level of inherent distinctiveness, to no more than a medium degree.

Likelihood of confusion

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

53. I have found the marks to be visually similar to no more than a medium degree, aurally similar to a medium to high degree and conceptually highly similar. I have found the earlier mark to have a very low degree of inherent distinctive character, enhanced to a medium degree through use. I have identified the average consumer to be either a member of the general public or a business, both of whom will pay an above medium level of care to a mainly visual purchase, though I do not discount an aural element to the purchase. I have found the services at issue to be identical.

54. Notwithstanding the principle of imperfect recollection, I consider that there are sufficient visual differences between the marks to avoid them being mistakenly recalled as each other. Whilst the marks are aurally similar to a medium to high degree, the purchase is mainly visual and I am of the view that the additional elements in the contested mark – the additional word “Go”, the cube device and the phrase “Friendly Professional Co-Working Space” – will enable the average consumer to differentiate between them. Whilst the latter of these differences plays a lesser role in the overall impression, none of the additional elements are negligible to the effect that the average consumer would entirely forget or misremember them. It is also relevant that the beginnings of marks tend to have more visual and aural impact than the ends¹³ given that the marks begin with different words. Even accounting for the identical services, I do not consider there to be a likelihood of direct confusion.

55. I go on now to consider whether the average consumer, having recognised that the marks are different, considers the common element of both marks (the word “WORKSPACE”) and determines, through a mental process, that the marks are related and originate from the same, or an economically linked undertaking.

56. Indirect confusion was described in the following terms by Iain Purvis QC (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc.*¹⁴

“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 recognised 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

¹³ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

¹⁴ BL O/375/10

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 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).”

57. 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.

58. During the course of this decision I have explained that the common element “WORKSPACE” results in conceptual similarity to a high degree, but that the earlier mark has a very low degree of inherent distinctive character. Although the distinctiveness of the earlier mark has been enhanced to a medium degree through

use, the word “WORKSPACE” continues to hold meaning in relation to the services at issue. Thus it is far more likely that it will be seen as a coincidence that two entities incorporate the word “WORKSPACE”: it is not so strikingly distinctive that consumers would assume that the contested mark is a variant of the earlier mark. Neither is the first word in the contested mark, “Go”, simply a non-distinctive element added to the word “WORKSPACE”. The differences between the marks are enough, even bearing in mind the identical services, for the consumer not to be confused: the contested mark is simply another undertaking using the word “WORKSPACE”, unrelated to the opponent. There is no likelihood of indirect confusion.

59. The section 5(2)(b) ground of opposition fails.

Section 5(3)

60. Section 5(3) states:

“(3) A trade mark which-

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 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.”

61. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

62. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oréal v Bellure* and Case C-323/09, *Marks and Spencer*

v Interflora and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. 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* and *Environmental Manufacturing, paragraph 34*.

(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'Oréal 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'Oréal v Bellure*).

Reputation

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

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

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

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

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

64. I recall that I found the opponent's evidence sufficient to establish that the distinctive character of the earlier mark had been enhanced through use. The factors that were relevant in that assessment are also the ones that I must consider when deciding whether the mark has a reputation. In particular, the opponent has shown longstanding use dating back to 1997, including revenue, awards achievements and press coverage. However, the opponent has not provided details of its market share; although the revenue figures appear substantial, I have no way of knowing what percentage of the market this would represent, particularly bearing in mind the opponent's services include the rental of commercial property in London, something I cannot imagine has a low cost attached to it. Overall, I am satisfied that the earlier mark had, at the date of application of the contested mark, a reasonable reputation. However, given the nature of the evidence filed, I am not satisfied that this reputation extends to the broad terms *real estate services* or *real estate agency*. The opponent may rely upon its reputation in *leasing of offices and premises; rental and leasing of commercial and industrial property and premises and providing temporary use of offices, rooms, and commercial accommodation*.

Link

65. My assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

66. In *Adidas-Salomon*, the CJEU held that the similarity of signs must be assessed in the same way for sections 5(2) and 5(3) of the Act. As such, my findings at paragraphs 42 to 47 are equally applicable here and I adopt them accordingly.

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

67. I have compared the respective services at paragraph 34, above and found them to be identical. Those findings are equally applicable here. The average consumer of the relevant services will, as I found above, be a member of the general public or a business paying an above medium degree of attention and for whom the selection will be mainly but not exclusively visual.

The strength of the earlier mark's reputation

68. The earlier mark has a reasonable reputation for *leasing of offices and premises; rental and leasing of commercial and industrial property and premises and providing temporary use of offices, rooms, and commercial accommodation*.

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

69. The earlier mark has a very low degree of inherent distinctiveness, which has been enhanced to a medium degree through use.

Whether there is a likelihood of confusion

70. I have found no likelihood of confusion under section 5(2). However, I bear in mind that the level of similarity required for the public to make a link between the marks for the purposes of section 5(3) may be less than the level of similarity required to create a likelihood of confusion under section 5(2): *Intra-Press SAS v OHIM*.¹⁵ The CJEU stated (at paragraph 72 of its judgement) 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 OHIM*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

71. For a link to be found, the burden is on the opponent to show enough of a reputation which can overcome the differences between the marks and cause the earlier mark to be brought to mind by the later mark. To my mind, bearing in mind what is common between the marks (“WORKSPACE”), the visual and aural differences between the marks are not overcome by the opponent’s reasonable reputation. Although the earlier mark has enhanced its distinctiveness to a medium degree (through use), what is common between the marks is a word which consumers are bound to use when referring to any space in which they work. It cannot be doubted that the word “WORKSPACE” is one which the public would expect to see different

¹⁵ Joined cases C-581/13P & C-582/13P.

traders using for offering work spaces to rent. This is the only similarity between the marks. When adding in a separate word, “GO”, and the stylistic differences, the word “WORKSPACE” in the contested mark is likely not to bring to mind the opponent but a reference to a space in which people work. Taking all of the above factors into consideration, I conclude that the relevant public will not make a link between the marks.

72. The opposition under section 5(3) also fails.

Section 5(4)(a)

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

“(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, where the condition in subsection (4A) is met,

(aa) [...]

(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.”

74. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

Relevant law

75. 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).”

Relevant date

76. In *Advanced Perimeter System Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC (as he then was), as the Appointed Person, endorsed the registrar’s assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

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

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of

the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.”

77. The applicant has not filed evidence of use of its mark. Consequently, the relevant date for this opposition is the date of the application, i.e. 14 July 2021.

Goodwill

78. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217:

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

79. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd.'s Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

80. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

81. Bearing in mind my summary and assessment of the evidence earlier in this decision, I am satisfied that the opponent has demonstrated a protectable goodwill in its earlier mark in relation to some of the services on which it relies – *the rental and provision of office, commercial and business premises and facilities*. This is on the basis of, inter alia, evidence of use dating back to 1997 and revenue in the tens, or hundreds, of millions annually since then.

Misrepresentation

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

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

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

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

And later in the same judgment:

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

83. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation [2016] EWCA Civ 41*, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchin LJ concluded:

“[...] if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

84. Although this was an infringement case, the principles apply equally under 5(2): see *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch). In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewison LJ had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a substantial number” of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal’s later judgment in *Comic Enterprises*, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

85. I recognise that the test for misrepresentation is different from that for likelihood of confusion in that it entails “deception of a substantial number of members of the public” rather than “confusion of the average consumer”. However, as recognised by the above case law, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that to be the case here. Similar to my finding of no likelihood of confusion, even accounting for the opponent’s goodwill, I am not satisfied that what is similar between the marks – the word “WORKSPACE” – is sufficient for a substantial number of members of the public to be deceived.

86. The section 5(4)(a) ground has failed.

OUTCOME

87. The opposition has failed in its entirety and the application may proceed to registration.

COSTS

88. The applicant has been successful and would ordinarily be entitled to a contribution towards its costs. As the applicant is unrepresented, at the conclusion of the evidence rounds, the Tribunal, by way of a letter dated 7 December 2022, invited the applicant

to indicate whether it wished to make a request for an award of costs and, if so, to complete the attached pro-forma including a breakdown of its actual costs. The applicant failed to return the pro-forma. As it incurred no official fees in the defence of its application, I make no award of costs in this matter.

Dated this 24th day of March 2023

E FISHER (née VENABLES)

For the Registrar