BL O/0408/26

TRADE MARKS ACT 1994

IN THE MATTER OF UK APPLICATION NO. WO0000001761228
IN THE NAME OF ELMAR REIZEN B.V.
IN RESPECT OF THE FOLLOWING TRADE MARK

IN CLASSES 35, 39 AND 43

AND

OPPOSITION THERETO UNDER NUMBER 447657
BY HDC TRAVEL LIMITED

Background and pleadings

1. Elmar Reizen B.V. ("the holder") applied to designate the International Trade Mark WO0000001761228 ("the designation") in the UK on 11 October 2023 and claims an International Convention priority date of 26 May 2023. It is in respect of the following mark:

2. The designation was accepted and published in the Trade Marks Journal on 15 March 2024 in respect of the following services:

> **Class 35:** *Administrative services in connection with business management related to the sale of travel and travel-related products and services; administrative management of data also related to products and services related to booking of travel, excursions, tours, accommodations; the bringing together, for the benefit of others, of various travel and travel-related products and services enabling consumers to conveniently view and purchase them; providing information as well as advice and mediation relating to the aforesaid services; the aforesaid services also provided via the Internet, the cable network or other forms of data transfer.*
>
> **Class 39:** *Tour operator services for travel booking; travel agency services, namely, organizing and booking of travel and arrangements, as well as mediation with this; transportation of goods and people; travel reservations; organizing travel, excursions and tours; travel guide services; rental and mediation in the rental of cars and other means of transport; providing information as well as advice and mediation relating to the aforesaid services; the aforesaid services also provided via the Internet, the cable network or other forms of data transfer.*

Class 43: *Providing food and beverages; temporary accommodation; rental and reservation of temporary accommodation, such as apartments, holiday homes and hotels; tour operator reservation services for temporary accommodation; reservations for restaurants; providing information as well as advice and mediation relating to the aforesaid services; the aforesaid services also provided via the Internet, the cable network or other forms of data transfer.*

3. HDC Travel Limited ("the opponent") opposes the designation on the basis of section 5(2)(b) and section 5(4)(a) of the Trade Marks Act 1994 ("the Act"). The section 5(2)(b) ground is based on its earlier UK Trade Mark UK00003024835 for a series of two marks. The relevant details of the earlier marks are shown below:

Marks: Holiday Discount Centre/holidaydiscountcentre

Filing date: 4 October 2013

Registration date: 24 October 2014

Class 39: *Tour operator services; travel agency services; arranging, organising, advising on and booking of holidays, travel or tours; provision of tourist information all relating to travel or holidays; package holiday services; online travel agency services.*

Class 43: *Provision of holiday accommodation; temporary accommodation; travel agency services for reserving accommodation.*

4. The opponent argues that the respective services are identical, similar, complementary, or have the same purpose and that the marks are similar. It asserts that, as a result, use of the holder's mark is likely to lead to consumer confusion.

5. In respect of the ground based upon section 5(4)(a), the opponent relies on goodwill identified by the sign "Holiday Discount Centre". It claims use throughout the UK since 2011 in respect of the following list of services:

Tour operator services; travel agency services; arranging, organising, advising on and booking of holidays, travel or tours; provision of tourist information all relating to travel or holidays; package holiday services; online travel agency services.

Provision of holiday accommodation; temporary accommodation; travel agency services for reserving accommodation.

Online price comparison services in relation to travel and travel related products and services

6. The opponent claims that the holder's mark is similar to its sign. It claims that the addition of the word "Centre" in its sign and the stylised letter "O" in the holder's mark do not make a significant difference to the overall impression and asserts that the respective mark and sign are conceptually identical. It concludes that, as a result the holder's mark is prevented from use in the UK by the opponent's passing off rights.

7. The holder filed a counterstatement denying the claims made and adding that the distinctive character of the earlier marks is either very low or lacking in distinctive character altogether. It also requests that the opponent provides proof of use of its earlier trade mark relied upon.

8. The opponent filed evidence in these proceedings. The holder filed written submissions in lieu of evidence that I will keep in mind and refer to, to the degree that I consider it necessary. The opponent also filed evidence-in-reply to these submissions. I will refer to the opponent's evidence to the extent I consider necessary.

9. No hearing was requested but both parties filed written submissions in lieu of a hearing. I make this decision after taking careful consideration of the papers.

10. Throughout the proceedings, the opponent was represented by Travlaw Legal Services Limited and the holder by Maucher Jenkins.

11. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Evidence

12. The opponent's evidence consists of the witness statement of Stephen Campion, its managing director, together with an exhibit marked "SC1". He provides evidence in support of the opponent's claims regarding use of its marks and its passing off rights.

13. Its evidence-in-reply consists of the second witness statement of Mr Campion together with exhibits "SC2" and "SC3" and addresses the holder's submissions regarding distinctiveness of the opponent's mark and the issue of likelihood of confusion.

DECISION

14. I consider that the opponent's **"**holidaydiscountcentre" mark adds nothing to its case over that based upon the mark "Holiday Discount Centre". I will, therefore, only consider genuine use and the opponent's grounds based on section 5(2)(b) in respect of its earlier mark "Holiday Discount Centre".

Proof of use

15. The relevant statutory provisions are as follows:

> "6A(1) This section applies where
>
> (a) an application for registration of a trade mark has been published,
>
> (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
>
> (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.
>
> (1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the

form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

16. Section 100 of the Act states that:

"100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

17. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'*[2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at[36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]."

18. The relevant period is the five years ending with the date of application of the contested mark or its priority date. In the case of an international mark, this is taken as the date of designating the UK or, in this case, the priority date of 26 May 2023. The relevant five-year period when use must be demonstrated is, therefore, 27 May 2018 to 26 May 2023.

19. The opponent provides the following evidence of use:

- The opponent's business was established in 2011[1] and it operates a price comparison website "which promotes a diverse range of travel services including package holidays, flights, ferries and hotel bookings and provides information and advice on travel products and destinations."[2]

- The holidays and travel arrangements promoted on the opponent's website are provided by third parties and are booked by calling the provider.[3]

- Undated screen shots of the website are provided[4] that shows the following mark (hereafter "the figurative mark") appearing prominently at the top of a number of the pages:

[1] Mr Campion's first witness statement ("WS1") at [3]
[2] WS1 at [4]
[3] WS1 at [5]
[4] Exhibit SC1 at [2] – [9]

- Further screen shots of the website are provided[5], obtained from the Internet archive The Wayback Machine covering the date range 2011 – 2024. The mark shown above first appears in a screenshot from August 2014. Prior to that, a similar mark appears but with the figurative sun element having marked sun rays radiating from around the sun. There is one screenshot from each year of the relevant period, all showing the figurative mark.

- The opponent has used its mark throughout the relevant period in respect to all its services provided through this website.[6]

- The number of visitors to the opponent's website and the number of subscribers to its newsletters (sent out approximately 3 times a week) during the relevant period are shown below:[7]

Year Ending	Visitor Sessions	Subscribers
Oct 2019	3,497,475	20,809
Oct 2020	1,300,669	7,630
Oct 2021	427,215	4,792
Oct 2022	1,880,160	8,135
Oct 2023	1,987,290	9,176

- Examples of the newsletters sent to consumers between 2012 – 2022 are provided.[8] Only one of these appears to be from within the relevant period

[5] Exhibit SC1 at [10] – [23]
[6] WS1 at [10]
[7] WS1 at [11] and [13]
[8] Exhibit SC1 at [24] – [32]

because it is promoting “2022 getaways from your nearest departure point” but it is undated. It has the figurative mark appearing at the top of the page.

- An extract from the opponent’s Facebook account, dated 13 October 2021, shows that the account is called “Holiday Discount Centre”.[9]

- The opponent does not know how many holidays were purchased as a result of consumers seeing them promoted on its website, but calls to the third party providers, where the opponent’s reference number was quoted, were in the 10s of thousands for 4 of the 5 years in the relevant period and between 4900 and 25,900 chats were instigated in four of the five years (there were none in the year ending October 2019). It is estimated that there was a conversion rate of 1 in 10 chats and 1 in 5 calls.[10]

- The opponent’s revenue is generated by third parties who pay a fee for each enquiry referred, income from hosting advertisements on its website, and from occasional other advertising on behalf of third parties.[11] Revenue from these sources during the relevant period was:

Year Ending	Revenue (£)
Oct 2019	907,125
Oct 2020	268,954
Oct 2021	78,772
Oct 2022	331,220
Oct 2023	310,900

[9] WS1 at 14] and Exhibit SC1 at [34]
[10] WS1 at [15]
[11] WS1 at [16]

- The opponent promotes its services via YouTube, Facebook, Instagram, pay per click advertising, social media and Google ads. The opponent provides the following promotional spending figures:[12]

Year Ending	Total Spend (£)	Spend on Google Ads (£)	Clicks on Google Ads
Oct 2019	197,625	103,000	565,000
Oct 2020	43,066	6,710	152,000
Oct 2021	13,264	1,630	52,700
Oct 2022	100,045	8,550	144,000
Oct 2023	78,807	14,700	165,000

- The opponent provides further evidence in respect of its claimed passing off right, essentially expanding upon the evidence relating to its use between 2018 – 2023 by providing the number of visitor sessions to its website, subscribers to its newsletter, the number of calls to third party providers generated from its website together with revenue and spend for the years ending October 2015 – October 2018.[13] These are:

Year Ending	Visitor Sessions on website	Newsletter Subscribers	Calls Generated to Third Party Providers	Revenue (£)	Total Spend (£)	Spend on Google Ads (£)	Clicks on Google Ads
Oct 2015	8,523,767	-	411,237	3,133,894	1,938,074	1,090,000	2,750,000
Oct 2016	7,332,664	68,223	352,441	2,775,991	1,437,855	975,000	2,910,000

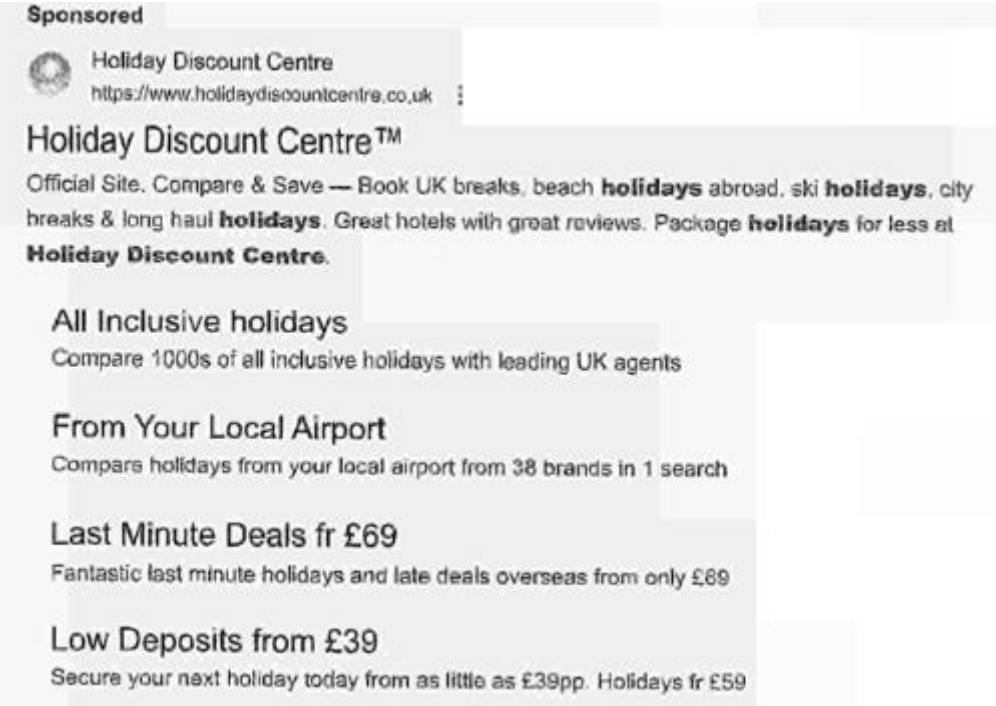
[12] WS1 at [18]
[13] WS1 at [20] – [25]

Oct 2017	6,327,345	85,399	230,643	1,917,142	1,044,152	719,000	2,400,000
Oct 2018	5,170,693	44,910	156,247	1,637,647	743,368	537,000	1,550,000

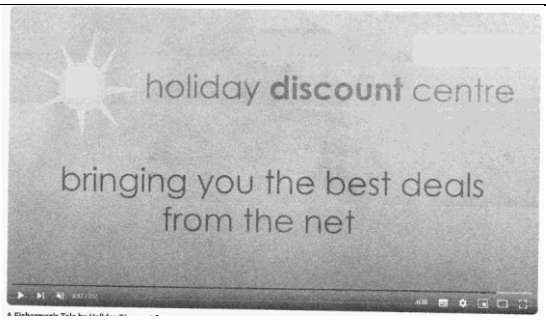
- An undated image of one of the opponent's Google ads is shown:[14]

- An undated search on the Google platform for "holiday discount centre" shows several further sponsored advertisements.[15] These are very similar and one of these is shown below:

[14] WS1 at [18] and Exhibit SC1 at [40]
[15] WS1 at [28] and Exhibit SC1 at [45]



- A screenshot of one of the opponent's YouTube adverts from 2013 and 2015 are provided.[16] These are reproduced below:

July 2013	March 2015
	

20. I have considered whether the evidence summarised above demonstrates genuine use of the earlier mark "Holiday Discount Centre" during the relevant period, i.e. 27 May 2018 to 26 May 2023. The opponent's evidence is focussed on yearly figures from October to October, I assume on the presumption that the five-year period is calculated from the designation date rather than the priority date of the contested

[16] WS1 at [27] and Exhibit SC1 at [43] and [44]

mark. However, I proceed on the basis that the figures for those years would be similar to the overlapping years that run from May to May. I remind myself that use must be by way of real commercial exploitation of the mark on the market for the services concerned and not merely token use aimed at preserving the registration.

21. The evidence demonstrates that the opponent operates a price comparison website which promotes travel services provided by third parties, with bookings being made directly with those third parties. The opponent has provided screenshots from the Internet Archive for each year of the relevant period showing the mark being used on the website. This is supported by figures for visitor sessions, newsletter subscribers, enquiries (calls and chats) generated for third party providers, revenue derived from referrals and advertising, and promotional expenditure (including Google ads) for each year ending October 2019 to October 2023. While some individual items (such as certain newsletters and examples of adverts) are undated or fall outside the relevant period, the overall picture is of sustained, outward-facing commercial activity conducted under the mark during the relevant period, with substantial consumer traffic and measurable income streams. In the context of the travel sector, I am satisfied that this goes beyond token use and demonstrates real commercial exploitation of the figurative mark (shown in the evidence) in the UK.

22. There is also evidence of some use of the word mark in sponsored advertisements and adverts on YouTube, however, these are either before the relevant period or undated, therefore, fail to support the claim of use during the relevant period.

23. Next, I need to consider whether use of this figurative mark is an acceptable variant use of the earlier mark that consists only of the words “Holiday Discount Centre”. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

> “13. […] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still.”

24. In *Hyphen GmbH v EU IPO,* Case T-146/15, the General Court held that use of the mark shown on the left below constituted use of the registered mark shown on the

right. The court held that the addition of a circle, being merely a banal surrounding for the registered mark, did not alter the distinctive character of the mark as registered.

25. The court set out the following approach to the assessment of whether additional components are likely to alter the form of the registered mark to a material extent.

> "28. ..a finding of distinctive character in the registered mark calls for an assessment of the distinctive or dominant character of the components added, on the basis of the intrinsic qualities of each of those components, as well as on the relative position of the different components within the arrangement of the trade mark (see judgment of 10 June 2010, *ATLAS TRANSPORT*, T-482/08, not published, EU:T:2010:229, paragraph 31 and the case-law cited; judgments of 5 December 2013, *Maestro de Oliva*, T-4/12, not published, EU:T:2013:628, paragraph 24, and 12 March 2014, *Borrajo Canelo* v *OHIM — Tecnoazúcar (PALMA MULATA)*, T-381/12, not published, EU:T:2014:119, paragraph 30).
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> 29 For the purposes of that finding, account must be taken of the intrinsic qualities and, in particular, the greater or lesser degree of distinctive character of the [registered] mark used solely as part of a complex trade mark or jointly with another mark. The weaker the distinctive character, the easier it will be to alter it by adding a component that is itself distinctive, and the more the mark will lose its ability to be perceived as an indication of the origin of the good. The reverse is also true (judgment of 24 September 2015, *Klement* v *OHIM — Bullerjan (Form of an oven)*, T-317/14, not published, EU:T:2015:689, paragraph 33).
>
> 30 It has also been held that where a mark is constituted or composed of a number of elements and one or more of them is not distinctive, the alteration of those elements or their omission is not such as to alter the distinctive character

of that trade mark as a whole (judgment of 21 January 2015, *Sabores de Navarra* v *OHIM — Frutas Solano (KIT, EL SABOR DE NAVARRA)*, T-46/13, not published, EU:T:2015:39, paragraph 37 and the case-law cited).

31 It must also be remembered that, in order for the second subparagraph of Article 15(1)(a) of Regulation No 207/2009 to apply, the additions to the registered mark must not alter the distinctive character of the mark in the form in which it was registered, in particular because of their ancillary position in the sign and their weak distinctive character (judgment of 21 June 2012, *Fruit of the Loom* v *OHIM — Blueshore Management (FRUIT)*, T-514/10, not published, EU:T:2012:316, paragraph 38).

32 It is in the light of those considerations that it must be determined whether the Board of Appeal was correct in finding, in paragraph 9 of the contested decision, that it had not been proven that the European Union trade mark rights had been used in a manner so as to preserve them either in the form registered or in any other form that constituted an allowable difference in accordance with the second subparagraph of Article 15(1)(a) of Regulation No 207/2009."

26. These findings indicate that the relative distinctiveness of the registered mark and the components added to (or omitted from) it in use are relevant factors to take into account in the required assessment. In the case before the court, the addition of a circle around the registered mark was not sufficient to alter the distinctive character of the registered mark.

27. Further the court held that, although it was relatively more distinctive than the registered mark, the addition of the word 'Hyphen' to the registered mark in a circle ("sign No.3") did not alter the distinctive character of the registered mark either. In this connection, the court stated that:

"57 It must borne in mind in that regard that, where several signs are used simultaneously, steps must be taken to ensure that, for the purposes of the application of the second subparagraph of Article 15(1)(a) of Regulation No 207/2009, such use does not alter the distinctive character of the registered

sign, having regard inter alia to business practices in the relevant sector (judgment of 24 September 2015, *Form of an oven*, T-317/14, not published, EU:T:2015:689, paragraph 31; see also, to that effect, judgment of 8 December 2005, *CRISTAL CASTELLBLANCH*, T-29/04, EU:T:2005:438, paragraphs 33 and 34).

58 The joint use of a figurative element and a word element on the same textile or clothing item does not undermine the identification function of the registered mark; it is not unusual in the clothing sector to juxtapose a figurative element with word element linked to the designer or manufacturer, without the figurative element losing its autonomous identification function in the overall impression. This finding extends to all the goods and services referred to in paragraph 6 above.

59 Thus, in sign No 3, the target consumer's attention will be drawn to both the word element and the figurative element."

60. It follows that, in sign No 3, the mere addition of the word element 'hyphen c' does not alter the distinctive character of the registered mark, as found, in essence, by the Board of Appeal in paragraph 29 of the contested decision."

28. The evidence primarily indicates use of a mark consisting of a figurative sun element appearing to the left of the unstylised words "Holiday Discount Centre". The words are clearly legible and, in my view, will be the element by which the opponent's website will be identified by, and referred to as. There are also the additional words "The Holiday Price Comparison Site" that appears below the words "Holiday Discount Centre" but in a smaller font. I consider these additional words to be wholly descriptive in nature and have a subservient role in the mark and do not detract from the distinctive character of the other combined elements of the figurative mark. I also consider that the figurative sun element reinforces the meaning attached to the words "Holiday Discount Centre". In reaching these findings I have kept in mind that the mark "Holiday Discount Centre" has, at best, allusive connotations in respect of a website promoting discounted holidays but I acknowledge that section 72 requires that I proceed on the basis that the mark has at least the minimum level of distinctive character for

registration. The figurative sun element is also of very low or even no distinctive character in respect of holiday services and does not change the distinctive character to the word mark. Consequently, I am satisfied that use of the figurative mark constitutes use of the earlier word mark for the purposes of section 6A(4)(a) of the Act.

29. Turning to the scope of genuine use, I bear in mind that genuine use in relation to services does not require that the opponent itself performs every aspect of the underlying travel service, however, its business model is such that it does not appear to provide any aspect of such services beyond the promotion of third-party holidays and travel-related offerings. Consumers using the opponent's services must contact the third parties directly to book any service being promoted on the opponent's website so it will be clear to the consumer that the opponent is not the provider of such services. Consequently, I disagree with the opponent's submission that the evidence demonstrates use in respect of all the services listed in the specification of services of its earlier mark.

30. In light of this finding, I must consider what would be a fair specification that reflects the genuine use shown. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited,* BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

> "In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

31. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, as follows:

> "245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. […] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered."

32. This approach was approved by the Supreme Court in *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, subject to the proviso that it must be seen in light of more recent guidance by the CJEU that that the essential criterion to apply for the purposes of identifying a coherent subcategory of goods or services capable of

being viewed independently is their purpose and intended use (for example, *Ferrari SpA v DU* (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106, at paragraphs 36-53).

33. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) at [47], the late Carr J pointed out that it is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do; for example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally.

34. It is clear that at the core of the opponent's holiday price comparison website is its *provision of tourist information all relating to travel or holidays* and I find that the opponent has demonstrated genuine use of the earlier mark "Holiday Discount Centre" during the relevant period in respect of these services. However, I do not consider that it is appropriate to conclude that the genuine use shown supports the retention of other terms. Unlike in *Property Renaissance Ltd* where it would be a very usual expansion for a *holdall* business to also produce other items of *luggage*, it is not clear to me that a holiday price comparison service would naturally expand into providing the holidays themselves. There is no evidence to the contrary and it is not obvious that the average consumer would expect this. Therefore, I consider that the average consumer would not describe the opponent's holiday price comparison services by reference to any of the other terms in its Class 39 or Class 43 specification.

35. In light of the above, I find that the opponent has demonstrated genuine use of the earlier mark "Holiday Discount Centre" during the relevant period in respect of *provision of tourist information all relating to travel or holidays*. It has failed to do so in respect of the other services listed.

Section 5(2)(b)

36. Section 5(2)(b) of the Act is as follows:

> "5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

37. Section 5A of the Act states as follows:

"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."

38. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

(i) mere association, in the strict sense that the later mark brings 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; and

(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 goods and services

39. When making the comparison, all relevant factors relating to the goods/services in the specifications should be taken into account, as per *Canon*, where the CJEU stated at paragraph 23 of its judgement:

> "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."

40. In addition, Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, also identified a further relevant factor, namely, the respective trade channels through which the goods or services reach the market.

41. The holder's Class 39 term *providing information .. relating to the aforesaid services* [that include *booking of travel and arrangements*, *travel reservations; organizing travel, excursions and tours; travel guide services*] self evidently includes identical services to the opponent's *provision of tourist information all relating to travel or holidays*. I will proceed on the basis that at least some of the respective services are identical.

Comparison of marks

42. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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."

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

and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

44. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
Holiday Discount Centre	

45. The opponent's earlier mark consists of three readily understood words that, when combined conveys the idea of a place or business described as a "centre" for obtaining discounted holidays. No one word is more dominant than the other and the distinctive character, to the extent that it exists, resides in the combination of the three words.

46. The contested mark consists of the words "Holiday" and Discounter" where a stylised sun image replaces the letter "o" in the word "Discounter". Once again, the words are readily understood. These words are likely to be perceived as describing something or someone who is capable of discounting holidays. The visual stylisation and the image of the sun in a contrasting colour to the words contributes to the distinctive character of the mark and the distinctive character resides in the combination of the words and the visual presentation.

47. Visually, the earlier mark is presented as three separate words with initial capitals and no stylisation. The contested mark, by contrast, is presented in a stylised format and includes a figurative element in the form of a sun motif which substitutes for the letter "o" within the word "Discounter". Notwithstanding these points of difference, the marks coincide in the word "Holiday", which appears as the first word in each. However, in my view the remaining elements, namely "Discount Centre" on the one hand and "Discounter" on the other, differ in length, structure and presentation but I keep in mind that the second word of the earlier mark is wholly contained in the contested mark (where the sun motif in the contested mark is perceived as a letter

“o”). Further, the earlier mark is wholly verbal, whereas the contested mark includes the additional figurative element. Taking these factors into account, I find that the marks share a medium degree of visual similarity.

48. Aurally, the earlier mark will be articulated as the seven syllables HOL-E-DAY-DIS-COUNT-CEN-TER. The contested mark will be articulated as the six syllables HOL-E-DAY-DIS-COUNT-ER. The respective first five syllables are identical. The respective second words differ only in that, in the contested mark, the word has the additional syllable ER at the end. The additional word “centre” in the earlier mark also creates a point of difference at the end of the mark. Taking all of this into account, I find there to be a medium degree of aural similarity.

49. Conceptually, as I have already noted, the earlier mark conveys the idea of a place or business described as a “centre” for obtaining discounted holidays. The contested mark conveys the idea of a person, trader, or service which discounts holidays (i.e. a “discounter” of holidays). While both marks allude to discounted holidays and therefore share a degree of overlap in the general concept of obtaining a cheaper holiday, the concepts are not identical: one is framed as a place/centre, whereas the other is framed as an actor/service. Further, the sun motif present in the contested mark reinforces a holiday-related association and, in my view, it reinforces the underlying concept conveyed by the words. Overall, I find there to be a medium to high degree of conceptual similarity, arising from the shared allusion to discounted holidays.

Average consumer and the purchasing act

50. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer,* Case C-342/97.

51. In *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

(a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by and enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

52. The average consumer of the respective services is likely to be members of the general public looking to identify a discounted holiday. These are not everyday purchases but will be occasional for most consumers but more regular for some. Purchases are likely to be visual in nature, seeing the marks either online or on the high street, however I do not ignore aural considerations that may also play a part (e.g. where advertisements are broadcast on radio). The cost of these purchases will vary and may, on occasions, be reasonably expensive and the average consumer is

likely to pay a reasonable level of attention during the purchasing process that is not particularly high, but neither is it low.

Distinctive character of the earlier trade mark

53. 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 *WindsurfingChiemsee 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)."

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

55. As discussed earlier, the earlier mark consists of three readily understood words that, when combined, convey the idea of a place or business described as a "centre" for obtaining discounted holidays. In accordance with section 72 of the Act, a registered mark "*shall be prima facie evidence of the validity of the original registration*". Therefore, I must assume that the mark has the minimum level of distinctiveness for registration, however, I would not place its distinctive character any higher than this in respect of all the services for which it is registered.

56. In respect of whether the earlier mark benefits from an enhanced level of distinctive character, I keep in mind that In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

> "38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.
>
> 39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it."

57. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

58. The opponent filed evidence of use that I summarised earlier. I note that there is evidence of some sponsored online advertisements showing use of the mark as registered, but these are undated. Most other use is of the following composite mark:

59. This mark consists of a sun motif appearing at the front of the mark and the words "The holiday price comparison site". Keeping in mind the minimal inherent distinctive character of the words "Holiday Discount Centre", and whilst the additional elements are equally low in distinctive character (I consider a sun motif to have very little distinctive character in respect of holiday services and the words "The holiday price comparison site" merely describes the website's function), the distinctive character of the mark resides in the combination of all the elements.

60. There is also some evidence of use of a similar mark where the figurative element has sun rays radiating from around the sun. There is no evidence that this sign was used after 2013. Once again, I consider that the distinctive character resides in the combination of the elements.

61. In summary, whilst it is clear from the evidence that the opponent has traded continuously since 2011, there is insufficient evidence to conclude that the mark, as registered, has acquired any enhanced level of distinctive character as at its filing date or at any time since. The opponent relies upon the fact that during the pre-registration examination of the earlier mark, the Registry accepted that it had acquired distinctive character through use. I am not bound by such a finding and I must reach a view based upon the evidence before me and I consider that this fails to illustrate that the earlier mark has an enhanced distinctive character because of the use made of it. In reaching this conclusion, I have kept in mind that most of the use has been in combination with other elements where the distinctive character resides in the combination of these elements.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

62. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that

exists between the marks and the goods/services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods/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 goods/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.

63. I remind myself that I made the following findings:

- At least some of the respective services are identical.
- The distinctive character of both marks resides in the combination of all elements with no one element being dominant.
- The respective marks share a medium level of visual and aural similarity and a medium to high level of conceptual similarity.
- The average consumer is a member of the general public and the purchasing process is primarily visual in nature but I do not ignore aural considerations. The purchasing process involves a reasonable (neither high, nor low) level of care and attention.
- The earlier mark is endowed with only a minimum level of inherent distinctive character and this is not enhanced through use.

64. In reaching my decision, I have kept these factors firmly in mind. The earlier mark is comprised solely of commonplace words which directly convey a message about the nature and purpose of the services in issue. As a consequence, the average consumer will be accustomed to encountering similar combinations of words in the marketplace that may create the same or very similar message.

65. I have found that the respective marks share the common elements “Holiday” and “Discount” (the latter being the second element in the earlier mark and the first eight letters of the ten letter second element of the contested mark). In *Face2FaceHR Partners Limited v Peninsula Business Services Limited*, O/0368/23, Emma Himsworth K.C., as the Appointed Person, reviewed the case law in *Whyte and Mackay v Origin* [2015] EWHC 1271 (Ch) and *Nicoventures Holdings Limited v The London Vape Co Ltd* [2017] EHWC 3303 (Ch), as well as guidance in the Common Communication on the Common Practice of Relative Grounds of Refusal - Likelihood of Confusion (impact of non-distinctive/weak components) dated 2 October 2014, which is referred to in the case law. Miss Himsworth summarised the correct approach when assessing the likelihood of confusion where the only common element between the marks in issue has no or low distinctiveness as follows, at paragraph 44:

> “(1) The distinctiveness of the mark as a whole must be assessed, taking into account that a minimum degree of distinctiveness must be acknowledged.
>
> (2) The distinctiveness of each of the components of both marks must be assessed with priority being given to the coinciding elements.
>
> (3) The focus of the assessment of the likelihood of confusion should be on the impact of the non-coinciding components on the overall impression of the mark.
>
> (4) Account must be taken of the similarities/differences in the non-coinciding elements of the marks.
>
> (5) A coincidence of an element with a low level of distinctiveness will not usually lead to a likelihood of confusion.
>
> (6) There may be a finding of a likelihood of confusion if (a) the non-coinciding elements of the mark are of lower (or equally low) degree of distinctiveness or are of insignificant visual impact and the overall impression is similar; or (b) the overall impression of the marks is highly similar or identical.”

66. Where the shared elements between the marks are of a descriptive or weakly distinctive nature, the average consumer will attach less trade mark significance to those elements. In such circumstances, relatively modest points of difference, whether

in the remaining word elements, in structure, or in stylisation, are capable of weighing more heavily in the overall impression and are more likely to be noticed and remembered. I consider this is the case here and it neutralises the submission of the opponent that where marks share a strong level of conceptual similarity, this can result in marks being confusingly similar even where there is only a medium degree of visual and aural similarity.

67. Applying all of the above to the facts of this case and keeping the above guidance in mind, I accept that there is a degree of similarity arising from the similarity of the respective word elements that both create the idea of discounted holidays. However, I consider that the visual differences identified and the slight conceptual difference created by the "Discounter" element in the contested mark and the word "Centre" in the earlier mark are sufficient to prevent the average consumer from mistaking one mark for the other. This, together with the contested mark's stylisation and the use of the sun motif in place of the letter "o" in the word "Discounter", create overall impressions which are distinct. In my view, the earlier mark's minimum level of distinctive character means that the shared holiday/discount concept does not "pull" the marks together to the extent required for direct confusion.

68. I have also considered whether the similarities are such that the average consumer, whilst appreciating that the marks are not identical, would nevertheless assume that the services provided under them originate from the same undertaking or from economically-linked undertakings. I do not consider that to be the case. Given the descriptive nature of the shared notion of "holiday" and "discount", the average consumer would be more likely to interpret the coincidence as no more than two different traders using similar promotional language. The points of difference, albeit not extensive, are sufficient, against the background of the earlier mark's very limited distinctive character, to dispel any assumption of the respective marks originating from the same or linked undertaking. There is, therefore, no likelihood of either direct or indirect confusion.

69. In conclusion, the section 5(2)(b) ground fails in its entirety.

Section 5(4)(a)

70. I recognise that the test for misrepresentation is different to that for likelihood of confusion, namely, that misrepresentation requires "a substantial number of members of the public are deceived" rather than whether the "average consumer is confused". However, as recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora,* [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that this is the case here and I find that a substantial number of members of the public are not likely to be misled into purchasing the holder's services in the belief that they are the opponent's services. Further, I have found that at least some of the respective services are identical when considering the section 5(2)(b) grounds, therefore, the potential added value of a claim under section 5(4)(a) created by there being no requirement for the parties to be in the same field of activity does not exist. I conclude that the requisite link that would lead to misrepresentation does not exist.

Conclusion

71. The opposition fails in its entirety, and the contested mark can proceed to registration.

COSTS

72. The holder has been successful and is entitled to a contribution towards its costs. In the circumstances I award the holder costs, calculated as follows:

Considering the Notice of Opposition and preparing counterstatement	£400
Considering evidence and preparing submissions in reply	£900
Preparing final written submissions	£500
Total:	**£1800**

73. I therefore order HDC Travel Limited to pay Elmar Reizen B.V. the sum of £1800. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an unsuccessful appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 12th day of May 2026

Mark Bryant

For the Registrar