

O/0409/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3889476

BY ROSEWOOD HOLDINGS & INVESTMENTS LIMITED

TO REGISTER:

Rosewood

ROSEWOOD

ROSEWOOD

LUXURY DEVELOPMENTS

AS A SERIES OF 3 TRADE MARKS IN CLASSES 37 & 42

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 441831 BY

NEW WORLD HOTEL MANAGEMENT LIMITED

BACKGROUND AND PLEADINGS

1. On 15 March 2023, Rosewood Holdings & Investments Limited (“the applicant”) applied to register the series of trade marks shown on the cover of this decision in the United Kingdom in respect of the following services:

Class 37

Building; Building construction; Building of apartment buildings; Building of houses; House building; Building demolition; Building of foundations; Rental of building scaffolds, working and building platforms; Building inspection [in the course of building construction]; Building of offices; Building of bridges; Installation of building scaffolds, working and building platforms; Building, construction and demolition; Building insulation; Building restoration; Building services relating to building for habitation; Building reinforcing; Building of factories; Building damp-proofing; Damp-proofing [building]; Repair and maintenance of building scaffolds, working and building platforms; Building of underground structures; Cleaning of building facades; Building maintenance; Erection of scaffolding for building and construction; Building construction supervision services for building projects; Building repairs; Building insulating; Insulating (Building -); Building repair; Building construction and repair; Road building; Building of shops; Custom building construction; Building of roads; Building sealing; Sealing (Building -); Building of railways; Building construction consultancy; Building and construction services; Building construction services; Underwater building and construction; Installation services for building scaffolds, working and building platforms; Ship building; Building cleaning; Building of schools; Yacht building; Building consultancy; Building construction and demolition services; Building services; Building of hospitals; Leasing of building machinery; Residential and commercial building construction; Building repair and renovation; Erection of formwork for building and construction; Rental of building construction machinery; Building construction supervision; Supervision of building construction; Supervision (Building construction -); Supervision of building renovation; Supervision of building demolition; Building of industrial properties; Rental of construction and building equipment; Cleaning of building exteriors; Construction of buildings; Buildings (Construction of -); Installation of

glazed building structures; Building refurbishment services; Cleaning of building interiors; Building of commercial properties; Hiring of building machinery; Rental of building machinery; Consultancy relating to residential and building construction; Building services relating to building for industry purposes; Construction of foundations for buildings; Installation of building insulation; Buildings (Renovation of -).

Class 42

Design of building exteriors; Design of building interiors; Building design services.

2. The series of marks was published for opposition purposes on 7 April 2023.
3. On 7 July 2023, the application was opposed by New World Hotel Management Limited (“the opponent”). The opposition is based on sections 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and concerns all the services in respect of which registration is sought. Claims were also originally brought under sections 5(3) and 5(4)(a) but, for reasons I shall explain shortly, only sections 5(2)(a) and 5(2)(b) remain.
4. Under section 5(2)(a), the opponent relies on the following marks:

UKTM No. 2587846 (“the 846 mark”)

ROSEWOOD

Filing date: 14 July 2011

Registration date: 6 January 2012

Class 35

Business management of hotels, resorts, tourist homes and serviced apartments.

Class 36

Real estate and property management services; real estate services, namely, leasing, renting and management of vacation homes, condominiums and villas, and management of condominium properties; home owners association

services, namely, community compliance management in the nature of management of common grounds and amenities.

Class 43

Hotel, resort hotel, resort condominium, lodging services; providing social meeting, banquet and social function facilities; provision of conference and meeting facilities.

UKTM No. 911625308 (“the 308 mark”)

ROSEWOOD

Filing date: 5 March 2013

Registration date: 30 July 2013

Class 43

Hotel and lodging services.

Class 45

Concierge services for others comprising requested personal arrangements and reservations and providing information to meet individual needs rendered at local hotels, resorts and entertainment venues.

5. Under section 5(2)(b), the opponent relies on the following marks:

UKTM No. 3023683 (“the 683 mark”)

ROSEWOOD LONDON

Filing date: 26 September 2013

Registration date: 21 February 2014

Class 35

Resort hotel management services.

Class 43

Temporary accommodation; hotel, resort hotel services; resort condominium, lodging services; providing social meeting, banquet and social function facilities; provision of conference and meeting facilities.

UKTM No. 3276960 (“the 960 mark”)

ROSEWOOD RESIDENCES

Filing date: 13 December 2017

Registration date: 9 March 2018

Class 36

Real estate and property management services; real estate services, namely, leasing, renting, and management of vacation homes, condominiums, and villas, and management of condominium properties; resort management services; homeowner association services, namely, community compliance management in the nature of management of common grounds and amenities.

6. These marks all qualify as earlier marks under section 6(1)(a) of the Act. The opponent stated that it had used the marks for all the services relied upon.

7. The opponent claims that the marks in the contested series are identical (section 5(2)(a)) or closely similar (section 5(2)(b)) to the earlier marks, and that they enjoy an enhanced degree of distinctive character. It also claims that the services are similar. Therefore, it asserts that the application should be rejected as there exists a likelihood of confusion on the part of the public which includes a likelihood of association between the parties' marks.

8. The applicant filed a defence and counterstatement. It admits that the first and second marks in the contested series are identical to the 846 and 308 marks and that the third mark in the series contains the entirety of those marks. It denies that the contested marks are similar to the 683 and 960 marks. It also denies that the parties' respective services are similar and put the opponent to proof of use of the earlier marks for all the services that are not underlined in paragraphs 4 and 5 above.

PROCEDURAL ISSUES

9. On 4 July 2024, the parties jointly wrote to the Registry requesting a stay of the proceedings to enable discussions to take place regarding a possible settlement. I note here that the parties had applied for a cooling off period on 21 September 2023 and that this had expired on 22 April 2024. A stay was granted until 9 September 2024 and the parties were informed that, if a settlement were not reached by that date, the opponent would be required to submit evidence on or before 9 October 2024.

10. On 9 October 2024, the opponent filed a request for a one-month extension to the deadline to file evidence. The reason given was that progress was being made on a settlement agreement and more time was needed to finalise it. The Registry responded on 11 October 2024, noting that the reasons given suggested that a stay of proceedings would be more appropriate. In addition, it noted that the request did not provide the information referred to in Tribunal Practice Notice (“TPN”) No. 2/2011, such as what had been done to date and what was left to do. A period of 7 days was given to the opponent to file reasons to support a further stay. In the meantime, the applicant had written to the Registry objecting to the extension and saying that it had on 9 October 2024 received a further settlement agreement that it found to be unacceptable.

11. On 18 October 2024, the opponent filed a retrospective request for an extension of time along with a witness statement from Adam Siegartel of the opponent’s US representatives, Cowan, Liebowitz & Latman, P.C., and six exhibits. The applicant requested a case management conference (“CMC”) which I held on 4 December 2024. The opponent was represented by Harry Rowe of Mathys & Squire LLP, the opponent’s legal representative, and Mr Siegartel. The applicant was represented by Michael Downing of Downing IP Limited, the applicant’s legal representative. I refused the extension of time by letter on 5 December 2024:

“ ...

At the CMC, the thrust of the opponent’s argument was that it had understood that the parties had reached a final settlement in principle. [Mr Rowe] argued that it was this that had caused the delay in filing the evidence, as the opponent had presumed that the applicant would

countersign a stay request. [Mr Rowe] noted that it was the first request for an extension of time and would not lead to any delay in the proceedings, as the evidence had now been filed.

Mr Siegartel added that the opponent had moved ahead as quickly as possible when it became clear to it that there was no longer a chance of a settlement. The exhibits to the witness statement are all print-outs from various websites that were captured on 16 October 2024. Mr Siegartel explained this by saying that the opponent had wanted to show the most current pages. He characterised the evidence as '*very modest*'.

Having reflected on the submissions made at the CMC, I have decided to refuse the request to extend the deadline for filing evidence. My reasons are set out below.

I am not persuaded that the opponent has discharged the burden of justifying the exercise of discretion in this instance. I consider that it is important to note that the stay in the proceedings had ended on 9 September 2024. That was the deadline for filing any further stay request, and as such a request had not been received, the opponent had a further month in which to prepare its evidence. The Tribunal's letter of 8 July 2024 clearly set out this deadline, and the requirement to submit evidence by 9 October 2024. It is, in my view, reasonable to expect the parties to manage the timetable of the proceedings and abide by any deadlines that are set and, if there are exceptional circumstances that justify extending those deadlines, to give full explanations. It does not appear that the opponent sought to gain agreement from the applicant to the request of a further stay until 9 October 2024.

I accept that the evidence has now been filed but note that, while this is a relevant factor, it is not determinative.

[Mr Rowe] referred me to the decision of Laddie J in *Hunt-Wesson Inc's Trade Mark Application*, [1996] RPC 233, in which he emphasised the desirability of avoiding a multiplicity of proceedings. It is indeed the case that, if the opponent may no longer pursue the section 5(3) and 5(4)(a)

grounds because the evidence is refused and the section 5(2)(b) ground is unsuccessful or only partially successful, it might file an application to invalidate the mark. However, this would remain a possibility, even if the evidence were admitted, were the opposition to be not wholly successful.

The opposition will therefore continue under section 5(2)(b) only, on the basis of those services in relation to which the applicant has not requested proof of use.”

12. I can confirm that this letter contained a typographical error and the intention was that the opposition would also continue under section 5(2)(a). This error was not identified at the time and both parties have proceeded on the basis that both subsections of section 5(2) are relevant.

13. Those services upon which the opponent may rely are as follows:

<p>846 mark</p> <p>ROSEWOOD</p>	<p><u>Class 43</u></p> <p><i>Hotel services; providing social meeting, banquet and social function facilities; provision of conference and meeting facilities.</i></p>
<p>308 mark</p> <p>ROSEWOOD</p>	<p><u>Class 43</u></p> <p><i>Hotel services.</i></p>
<p>683 mark</p> <p>ROSEWOOD LONDON</p>	<p><u>Class 43</u></p> <p><i>Hotel services; providing social meeting, banquet and social function facilities; provision of conference and meeting facilities.</i></p>

EVIDENCE AND SUBMISSIONS

14. The applicant filed evidence from three witnesses. The first is Toby Cove, a Director of Rosewood Holdings & Investments Limited (the applicant). His witness statement is dated 11 February 2025 and is accompanied by five exhibits. It explains the origin of the marks and provides information on the history of his business.

15. The applicant's second witness is Suki Singh, who is sole Director of Chaucer Homes Group Limited. His witness statement is dated 28 January 2025. It goes to the distinction between hotel services and property development services.

16. The applicant's third witness is Hazel MacLean, a Chartered Trade Mark Attorney at Downing IP Limited, the applicant's legal representative. Her witness statement is date 3 February 2025 and is accompanied by three exhibits. It is a vehicle for filing extracts from websites about hotels with the name "Chaucer".

17. The opponent filed evidence in reply in the form of a witness statement from Mr Siegartel dated 14 April 2025. This is accompanied by seven exhibits. There is a significant degree of overlap between this witness statement and exhibits and the documents that the opponent wanted to file as evidence in chief, although I note that some of these have been updated. These exhibits consist of information that Mr Siegartel has obtained from the internet. There is no evidence from anyone employed by the opponent. The opponent also filed written submissions dated 14 April 2025.

18. The applicant, in its final written submissions, argues that this evidence is not strictly in reply. I see from the case file that the evidence in reply was admitted on 15 April 2025 and that the applicant made no objection at the time. That would, in my view, have been the appropriate point at which to raise any concerns. I shall therefore refer to Mr Siegartel's evidence where relevant in this decision.

19. Neither party requested to be heard and both filed written submissions in lieu of a hearing on 13 May 2025.

RELEVANCE OF EU LAW

20. 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.

DECISION

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

“A trade mark shall not be registered if because—

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(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.”

22. 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 they have kept in their 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 marks

23. The applicant has admitted that the first two marks in the series are identical to the 846 and the 308 marks.



24. Turning now to the third mark in the contested series, I remind myself that it is clear from *SABEL BV v Puma AG*, Case C-251/95, (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 (“CJEU”) stated in *Bimbo SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-519/12 P, that:

“34. ... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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.”

25. Artificial dissection of the marks would therefore be wrong, although it is necessary for me to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

26. The respective marks are shown below:

Contested mark	Earlier mark (the 683 mark)
	

27. In the interests of clarity, I wish to say that I do not consider that this third mark is identical to the 846 or 308 marks relied on under section 5(2)(a). This is because the CJEU said in *S.A. Société LTJ Diffusion v Sadas Vertbaudet SA*, Case C-291/00, that

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

The words “LUXURY DEVELOPMENTS” would not, in my view, go unnoticed by the average consumer.

28. The 683 mark consists of two words, the second of which would be perceived as an indication of the place in which the services are supplied. The dominant and distinctive element of the mark is “ROSEWOOD”. The third mark in the contested series is a stylised three-word mark, with the largest of these words being “ROSEWOOD”. The remaining words, “LUXURY DEVELOPMENTS”, would be seen as indicating the services provided, and the underlining of the word is decorative. The dominant and distinctive element of this later mark is “ROSEWOOD”.

29. Taking into account the identity of the dominant and distinctive element of the marks and the non-distinctive quality of the remaining elements, I find that the marks are visually similar to a high degree.

30. The word “ROSEWOOD” would be pronounced identically in both marks. I do not consider that it is likely that the average consumer would articulate the remainder of either marks. This is because there is a tendency for the public to contract long marks, particularly where the additional words refer to the nature of the goods or services provided: see *Pensa Pharma v OHIM*, Case T-544/12, paragraph 107, and *Enrich International Ltd v Udokporo*, BL O/1141/25, paragraphs 13-18. I also consider that the same applies for the geographical “LONDON”. I find that the marks are aurally identical.

31. Conceptually, both marks will bring to mind a type of wood. The earlier mark will additionally evoke the idea of a business based in London, while the third mark in the contested series conveys a message about the type of activity carried out under the mark. I find that the marks are conceptually highly similar.

Distinctive character of the earlier marks

32. Distinctive character is a measure of how strongly a mark distinguishes the goods or services of one undertaking from those of others. The factors that I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*, Case C-39/97:

“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).”

33. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of the mark can be enhanced by the use that has been made of it. When considering whether the distinctive character of a mark has been enhanced, it is the perception of the UK consumer at the relevant date (15 March 2023) that is key.

34. The dominant and distinctive element of the earlier marks, “Rosewood”, is a type of wood. It does not describe or allude to the services at issue. Consequently, I find that the earlier marks have a medium degree of inherent distinctive character.

35. The opponent claims that the earlier marks also enjoy an enhanced degree of distinctive character. Much of the evidence on which it relies is after the relevant date. Exhibits AS4 and AS5 consist of extracts from the opponent’s website, with a copyright date of 2025. However, a brochure confirms that the Rosewood London hotel opened in 2013.¹ I have no information on the revenue generated by this hotel or occupancy rates; neither do I have any examples of advertising, beyond the opponent’s own website, or figures for marketing spend. I note here briefly that it does not appear to me that the opponent’s website was targeted towards consumers in the UK. There is a general number for international enquiries, but that is all.

36. Exhibit AS6 contains a collection of articles from publications and websites. Some of these post-date the relevant date. The ones published before that date are listed below:

¹ Exhibit AS4, page 9.

- a) “How the capital’s artiest hotel, Rosewood London, is celebrating the new season”, *Tatler*, 29 September 2022;
- b) “These luxury hotels go all out for the holidays”, TVR website, 7 December 2022;
- c) “Rosewood London launches second collaboration with My Wardrobe HW”, FashionUnited.uk website, 22 June 2022;
- d) “Rosewood to open second London hotel in 2024”, Hospitality Design website, 8 March 2021;
- e) “Former US Embassy to become second London home for Rosewood”, Space – International Hotel Design, 8 March 2021;
- f) “Rosewood announces plans for second London property”, Sleeper Magazine website, 10 March 2021;
- g) “Rosewood shares details on second London property”, Luxury Travel Advisor, 10 March 2021.

37. Some of these websites appear to be targeted towards a US audience, as they use US date conventions and spelling. There is no information to enable me to assess how likely it is that the average consumer in the UK may have come across these articles. In addition, I note that the brochure to which I have already referred mentions some awards from 2022 and an article from *Condé Nast Traveler* indicates that the London hotel won Readers’ Choice Awards in 2018, 2019, 2020, 2021, 2022 and 2023, and appeared on something called the “Gold List” in 2020. There is no context for any of these awards.

38. The opponent submits that *“Whilst a finding of reputation requires that a certain threshold of recognition be met, the threshold for a finding of enhanced distinctiveness may be lower; enhanced distinctiveness is anything above inherent distinctiveness”*.² In *O2 Worldwide Limited v CX02.COM (UK) Limited*, BL O/393/19, Professor Phillip Johnson, sitting as the Appointed Person, explained in paragraph 39 of his decision that reputation is indeed a higher threshold than enhanced distinctiveness. That said, I do not consider that it necessarily follows that distinctiveness would be enhanced on the basis of a small number of press articles or the mere fact that a hotel operated since 2013. I am required to assess whether the use that has been made of the mark

² Submissions in lieu of a hearing, paragraph 24.

means that it is more likely that the average consumer will identify the services as coming from a particular undertaking. In my view, the evidence is insufficient for this purpose. I do not find that the distinctive character of the earlier marks has been enhanced.

Comparison of Services

39. It is settled case law that I must make my comparison of the services on the basis of all relevant factors. These include the nature of the services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. As the General Court (“GC”) said in *Boston Scientific Ltd v OHIM*, Case T-325/06, goods and services are complementary when

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

40. The applicant’s services can be characterised as building services, including maintenance and restoration; services related to building, such as rental of construction and building equipment; and building design services.

41. The opponent’s services are *Hotel services; providing social meeting, banquet and social function facilities; provision of conference and meeting facilities*. The opponent submits that its terms are broad enough to cover temporary accommodation, long-term stays, customised accommodation, refurbishment, repair and renovation services.³ In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin considered the approach to be adopted in interpreting terms in a specification:

“365. ... The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their

³ Ibid, paragraph 39.

possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 195; [2004] RPC 40 at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specification of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case.”

42. In my view, the core of the possible meanings of *Hotel services* is the provision of temporary accommodation in the form of rooms or suites in an establishment that may also be expected to offer facilities such as restaurants, bars and meeting rooms. The core meaning would not extend to refurbishment, repair and renovation services, or to the provision of self-catering accommodation or long-term rentals that are intended to be the equivalent of a home.

43. The opponent refers to both parties’ services being aimed at the luxury end of the market. In the context of registering a new mark, it is necessary to consider all the circumstances in which the mark applied for might fairly be used, should it be registered: see *O2 Holdings Limited & Anor v Hutchison 3G UK Limited*, Case C-533/06, paragraph 66. At this point, I note that the opponent’s exhibits AS2 and AS3 are extracts from its website that the opponent submits show that it provides services other than hotels, such as luxury rentals and serviced apartments. Whether that is the case or not, is not relevant here. This is because I must make my decision on the basis of the terms in the specification. The same point applies with respect to the applicant’s services shown in Exhibit AS1. Differences or similarities between the parties’ current services are relevant to the extent that those differences or similarities are apparent from the lists of services in the specification.

44. The purpose of the opponent’s services is to provide temporary accommodation, in the case of *Hotel services*, or to provide space in which third parties can hold social functions, business meetings, conferences or similar events. They are targeted

towards the general public, as well as organisations. The applicant's services differ in nature, purpose and method of use. The opponent has submitted that consumers will be exposed to the parties' marks in the same distribution and commercial channels. Its Exhibit AS7 contains extracts from websites which it submits show that a number of luxury hotels also offer branded residences, serviced apartments and luxury rentals in London. However, the applicant's services are construction services and building design services, not real estate services, such as rental of property or estate management. In the absence of evidence relating to the services in the applicant's specification, I disagree that there will be shared trade channels. I do not consider that they are in competition or that they are complementary. The average consumer is, in my view, unlikely to believe that the parties' services are provided by the same undertaking. I accept that there is likely to be some overlap in user, but this is on the basis that the opponent's services are targeted towards the general public and organisations of all types. The greater the level of generality, the less relevant it is likely to be to a question of confusion: see *Unicorn Studio Inc v Veronese (Société par Actions Simplifiée)* [2024] EWHC 1098 (Ch), paragraph 23. I can see no meaningful similarity between the services of the opponent and those of the applicant.

45. In *eSure Insurance Limited v Direct Line Insurance Plc*, [2008] EWCA Civ 842 CA, Lady Justice Arden stated that:

"49. ... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity."

46. As I have found no similarity between the parties' services, the opposition under section 5(2)(a) and 5(2)(b) fails.

OUTCOME

47. The opposition has failed and, subject to a successful appeal, Application No. 3889476 may proceed to registration.

COSTS

48. The applicant has been successful and is entitled to a contribution towards the costs it has incurred from these proceedings. It requests that it be awarded costs at the top end of the scale, or even above it, to reflect the differences in the approaches of the parties. Rule 67 of the Trade Marks Rules 2008 states that:

“The registrar may, in any proceedings under the Act or these Rules, by order award to any party such costs as the registrar may consider reasonable, and direct how and by what parties they are to be paid.”

49. The applicant argues that it has behaved reasonably, and I note that it did sensibly admit that the first two marks in the contested series are identical to the 846 and 308 marks. In addition, it did not put the opponent to proof of use of some of the services in Class 43. The applicant criticises the opponent for adopting what it describes as a “*kitchen sink*” approach to the opposition, with a number of marks which it claimed added nothing to the merits of the case.⁴ While there is some duplication in the specifications of the marks, there are also differences, and at the outset the opponent was relying on a larger number of grounds. These included section 5(4)(a), under which the opponent claimed that it had acquired goodwill through use of a family of marks. I am not persuaded that the opponent was acting unreasonably here.

50. The applicant also submits that the opponent’s evidence was not of any value. I agree that Exhibit AS1 was duplicative of evidence filed by the applicant and that Exhibits AS2, AS3 and AS7 were not relevant to the issues to be determined. I do not agree with the applicant that Exhibits AS4, AS5 and AS6 were unnecessary in the view of its admission that the marks had been used for some of the Class 43 services, in particular *Hotel services*, although I do note that some of this evidence was either undated or was published after the relevant date. The opponent had claimed that the earlier marks had enhanced distinctive character. In the end, the evidence did not persuade me that this was the case, but I do not think that this merits more than a partial uplift to what I might have awarded to reflect the irrelevance of Exhibits AS2, AS3 and AS7. I also bear in mind the fact that it has not been necessary for me to refer

⁴ Written submissions in lieu of a hearing, paragraph 52.

to the applicant's evidence. I do, however, consider it appropriate to award some costs in relation to the preparation for, and attendance at, the CMC.

51. Finally, I want to address the applicant's comments about the "*David v Goliath*" nature of this case. The applicant submits that objections to small businesses' applications by large companies should be restricted to those where there is at least some similarity in the goods or services. However, section 5(3) of the Act provides protection for marks with a reputation and damage may be found under this section even if the goods and services are dissimilar. The kind of restriction proposed by the applicant would go against the intention of the legislators.

52. I have calculated the award to the applicant as follows:

£450 for preparing a statement and considering the other side's statement;
£400 for preparing for and attending a case management conference;
£800 for preparing evidence and considering and commenting on the other side's evidence;
£450 for preparing written submissions in lieu of a hearing.
£2100 in total

53. I therefore order New World Hotel Management Limited to pay Rosewood Holdings & Investments Limited the sum of £2100. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 12th day of May 2026

Clare Boucher
For the Registrar,
Comptroller-General