

O/061/12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2529011
BY
WINKWORTH OFFICE INTERIORS LTD
TO REGISTER THE TRADE MARK**

WINKWORTH INTERIORS

IN CLASSES 37 AND 42

AND

**THE OPPOSITION THERETO
UNDER NO 100638
BY
WINKWORTH FRANCHISING LTD**

Trade Marks Act 1994

**In the matter of application No 2529011
by Winkworth Office Interiors Ltd
to register the trade mark**

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by Winkworth Franchising Ltd**

1. On 19 October 2009, Winkworth Office Interiors Ltd (“the applicant”) applied to register the trade mark WINKWORTH INTERIORS. The application was published in the *Trade Marks Journal* on 19 March 2010. Following some amendments after publication to the list of services, the application now stands for the following services in classes 37 and 42:

Class 37: Construction services in relation to the fit-out of existing commercial buildings; office fit out services; project management and advisory services in the commercial property sector relating to all of the aforesaid services.

Class 42: Design and build fit out contractor services in the commercial property sector; planning of offices.

2. The application was opposed by Winkworth Franchising Ltd (“the opponent”) under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). In relation to the section 5(2)(b) and 5(3) grounds of opposition, the opponent relies upon all the services registered under its three earlier marks, as follows:

(i) UK 1276898

WINKWORTH

Class 36: Estate agency services; real estate and property management; rental of property and of real estate; valuation (financial) services; real estate appraisal; house agency services; insurance and financial services, all relating to estate agency activities, all included in Class 36.

Date of application: 1 October 1986

Date of completion of the registration procedure: 31 March 1989

(ii) UK 2407411

WINKWORTH

Class 35: Auctioneering services; provision of advertising space; information and advisory services relating to the aforesaid services.

Class 36: Estate agency services; real estate and property management; rental of property and real estate; valuation (financial) services; real estate and property appraisal; house agency services; real estate and property brokerage; insurance and financial services, all relating to estate agency activities; mortgage services; information and advisory services relating to the aforesaid services.

Class 42: Surveying; surveying of real estate and property; legal services relating to real estate and property; conveyancing services; information and advisory services relating to the aforesaid services.

Date of application: 24 November 2005

Date of completion of the registration procedure: 26 May 2006

(iii) Community Trade Mark ("CTM") 3371101

WINKWORTH

Class 35: Auctioneering services; provision of advertising space; information and advisory services relating to the aforesaid services.

Class 36: Estate agency services; real estate and property management; rental of property and real estate; valuation (financial) services; real estate and property appraisal; house agency services; real estate and property brokerage; insurance and financial services, all relating to estate agency activities; mortgage services; information and advisory services relating to the aforesaid services.

Class 42: Surveying; surveying of real estate and property; legal services relating to real estate and property; conveyancing services; information and advisory services relating to the aforesaid goods.

Date of application: 5 August 2003

Date of completion of registration procedure: 8 December 2004

3. Marks (i) and (iii) completed their registration procedures more than five years before the opposed application was published; however, mark (ii) did not. This means that the earlier marks (i) and (iii) are subject to the proof of use

provisions¹ but that mark (ii) can be considered on the basis of notional and fair use across the breadth of the services for which it is registered.

4. The opponent claims that there would be a likelihood of confusion under section 5(2)(b) because of the similarity between the parties' marks and the similarity between their respective services. Under section 5(3), the opponent claims that use of the applicant's mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the opponent's mark. In particular, the opponent claims that its mark is unique and that use of the applicant's mark would dilute the opponent's reputation; further that the opponent's mark enjoys a considerable cachet for premium services in the property market and that the applicant's use of its mark would "ride on the coat tails" of that reputation in other property-related services.

5. Under section 5(4)(a), the opponent relies upon its use in the UK, since at least the 1980s, of WINKWORTH in relation to estate agency services, property management services and "ancillary services". It claims that it has a significant goodwill and reputation and that use by the applicant of its similar mark on the services applied for would amount to a deceptive misrepresentation likely to damage the opponent's goodwill, preventable under the law of passing off.

6. The applicant filed a counterstatement in which it put the opponent to proof of use and reputation, denying the grounds of opposition, while admitting that the parties' marks are similar.

7. Both parties filed evidence and the matter then came to be heard before me on 23 November 2011. The applicant was represented by Mr John Reddington, for Williams Powell, and the proprietor was represented by Ms Lindsay Lane, of Counsel, instructed by Cleveland.

Evidence

Preliminary issue

8. The applicant made an application to adduce further evidence, a fortnight before the hearing. At the hearing, I refused the application since it was late, the evidence could have been produced earlier, it had no material bearing on the matters before me, and the point was covered elsewhere in the applicant's evidence (it comprised photographs of office interiors before and after the applicant had refurbished them; similar photographs appear on the applicant's website, screenshots of which are in its main evidence).

9. The opponent's earlier mark (ii) is not subject to proof of use and is registered for the same services as the CTM (mark iii) and for services which cover those

¹ See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

registered under mark (i). Mark (ii) represents the opponent's strongest case (all three marks being identical WINKWORTH marks). For the purposes of section 5(2)(b) and 5(3), I will confine my analysis to a comparison between mark (ii) and the application; it is therefore unnecessary to consider proof of use because the earlier mark can be considered on a notional basis across the full range of its registered services. Consequently, the evidence summary I give here will reflect facts which are relevant to a decision on this basis, also taking into account those facts which are relevant to the section 5(4)(a) ground. Some of the evidence filed forms submission rather than fact. I will, of course, bear these submissions in mind in making my decision, but I will not detail them here.

The opponent's evidence

10. The opponent's evidence begins with a witness statement from Mr Dominic Agace who is the opponent's Chief Executive Officer. The opponent is successor-in-title to the Winkworth & Co estate agency business established in Mayfair, London, in 1835. The opponent operates estate agencies on a franchise basis; at the date of Mr Agace's statement (4 March 2011), the expansion of the business during the 1990s and 2000s had resulted in 58 offices in London and 77 offices in total in the UK. Mr Agace states that, of the 70% of estate agents that are on the Rightmove website, the opponent has a 15% market share in London (according to Rightmove). The opponent's expertise has led to employees commenting on property trends in the media, such as The Times, Financial Times, The Guardian and The Evening Standard. Turnover figures for the period 2005 to 2010 were £26,077,663 rising to £30,493,401. The advertising spend for 2010 was around £2.7 million and over £100,000 per annum was spent on advertising in "Country Life" magazine. In 2010, an edition of this magazine was dedicated to WINKWORTH, celebrating its longevity.

11. WINKWORTH appears on the estate agency offices' fascias, on its website (winkworth.co.uk), on "For Sale" and "To Let" boards, on its stationery, on magazine advertisements and on direct mail advertisements (exhibits DA2-4). Mr Agace explains that the opponent's core services are residential sales and residential lettings, but that it has also provided (between 2005 and 2010) other property related services including property management, auctions, surveying services and financial services. Mr Agace states that property management is provided as an adjunct to the opponent's letting services and includes the maintenance, development and refurbishment of client's properties for a managing agents' fee. In relation to surveying, Mr Agace gives evidence that surveying services have been provided under licence by a firm of chartered surveyors and that the opponent also provides in-house chartered surveyors for clients requesting property development services. The opponent has also provided financial services under the WINKWORTH mark, although not in the last five years. Mr Agace's second witness statement and exhibits (in reply to the applicant's evidence) include DA11 which is a surveyors' franchise agreement between the opponent and a Mr Ian Peto, licensing WINKWORTH for surveying

of residential and commercial property. Mr Agace states that the bulk of the opponent's business is property of a residential nature, but that it also acts for vendors selling commercial or mixed use properties, such as a building in Notting Hill (asking price £12,000,000) which was configured for commercial and residential use (DA13).

12. Mr Agace's father, Simon Agace, has also filed a witness statement. Mr Simon Agace is the opponent's non-executive chairman; it was he who expanded the business in the 1980s, developing it as a residential estate agency specialising in the mid to luxury end of the London market. Much of his statement develops arguments about why estate agencies need to diversify and provide more than the core selling service, rather than showing actual evidence of recent diversifying by the opponent. Mr Agace states, although does not give specific examples, that the opponent acts as a project manager for clients buying a property which requires refurbishment, bringing in interior designers, surveyors, IT and electrical specialists: this is his role in the opponent's business. The opponent also has in-house property managers who advise on maintenance costs, investment managers who advise on property design to get maximum rental value, and estate agents who advise on the ultimate value of the project. Mr Agace states that since the 1980s he has employed a number of specialists to look after, decorate, refurbish and manage property, including interior design (some of these are detailed in exhibits SA1 to 4). Mr Agace states that his current portfolio of interior refurbishments consists of the conversion of two flats into a luxury £3 million house, the conversion of three houses in Shepherd's Bush and a further property in London, the total spend being around £700,000.

13. The opponent has also filed two witness statements from other estate agents as evidence to show the range of services commonly provided by estate agencies. Eric Walker, of Bushells Estate Agency in London, states that it is his experience that clients will ask an estate agent about design, refurbishments, building, furnishing, periodic maintenance, and repairs in relation to property to be sold or rented. He also states that he is aware that some estate agencies provide these "ancillary services" themselves, typically through an in-house contractor or third party provider. The latter would provide services as "white label" services, which Mr Walker explains means that the estate agency provides the services directly to the end client under its own brand name. Mr Walker believes this to be particularly prevalent at the upper end of the residential property market, and particularly in central London, where landlords and vendors often live overseas and so call upon the estate agency to provide interior design and refurbishment services. Mr Walker states that it would be "highly unusual" for an estate agency engaging in property management not to offer such services.

14. Jeremy Leaf heads a firm of estate agents and chartered surveyors, also in London (Jeremy Leaf & Co.). He states that he is entirely independent of the opponent, whom he knows of because of its strong reputation and as a

competitor. His statement is broadly consistent with that of Mr Walker in terms of the ancillary services supplied by some estate agencies. Although Mr Leaf says that he is unable to point to specific estate agents, his knowledge is gained from reading the trade press such as estate agent's magazines (Negotiator, Estate Agency News, Letting News and Estate Agency Today) which frequently include advertisements from companies providing furnishing services to estate agents.

15. Peter Houlihan is the opponent's trade mark attorney. His witness statement adduces results of internet searches for estate agencies to see what types of services are typically provided. For example, Knight Frank estate agents provide both residential and commercial property and also building consultancy services including refurbishment, maintenance and repair. Robert Irving Burns Property Consultants provide property management and building services, including surveyors who are involved in the property management process, dealing with major repair and maintenance contracts and dilapidations. Their building surveyors also deal with refurbishment schemes. Savills Estate Agents provide "bespoke design solutions for new build or refurbishment using our in-house or external architects, as well as expert administration of construction work, repairs and preventative maintenance." One of the Associate Directors of Savills has, as his title on Savills' website, "Associate Director Interior Services". Its building and project consultancy team includes building surveyors, project managers, designers and general practice surveyors. Under 'project management', the website says "Specialising in office fit-out and relocation, landlord refurbishment, industrial and logistics development and new build development management". Under 'design and construction, the website says "Extension, conversion, adaption and refurbishment of all building types, planned preventive maintenance, remedial works and contract administration and "We provide comprehensive, commercial and 'joined up' advice from design to procurement and future adaptations to ensure you maximise value and optimise cost."

The applicant's evidence

16. Mr Ashley Winkworth is the owner and managing director of the applicant, which he formed in 2005, focussing on the specialist provision of office 'fit-outs' within the commercial office market supporting clients (end users) and commercial office landlords. Feasibility studies are conducted, and services provided such as heating, venting and cooling, power supply, IT infrastructure, office layout design, project management of contractors and suppliers, advice on furniture selection, support of commercial property agents who require office layout designs/advice for marketing purposes and who require advice on interior fitting-out of office space. The price of fit-out contracts is typically £80,000. Mr Winkworth says that it is vital that the job is completed on time because of the commercial risk to the client in not being operational by the due date; consequently, clients conduct careful research before selecting a fit-out contractor. He says "The idea that a fit-out client might contract for fit-out services worth tens of thousands of pounds purely on the basis that the

contractor's name is similar to that of an estate agent, is frankly laughable." Mr Winkworth states that he has never been asked if his business is part of the opponent's company and he puts this down to the services not being the same or similar to those provided by an estate agent. Much of Mr Winkworth's witness statement deals with his perception of the different ways of operation of his business and a residential estate agency business. Since the notional specifications of the parties go wider than this, I will bear these facts and submissions in mind, referring to them where necessary later in the decision, rather than providing a full summary here.

17. Of the opponent's evidence in relation to Knight Frank and Savills, Mr Winkworth states that both of these companies are well known for introducing fit-out companies to third party clients who seek specialist fit-out skills; they are not his competitors. He says "For the commercial estate agents and fit-out companies to co-exist within the same market and to "share" clients, the services offered by those parties have to be both independently beneficial to the client and therefore different (i.e. the agents finding the building and the builder carrying out the fit-out). Mr Winkworth says that the majority of the work is concentrated in Mayfair, London; he comments that in a period of almost 6 years the parties have never crossed paths whilst operating in the same geographical area.

18. The applicant has also filed a witness statement from its trade mark attorney, Mr John Reddington. Mr Reddington exhibits the results of an on-line directory search for the name Winkworth in London which he conducted in June 2001: he found 127 individuals.

Decision

Section 5(2)(b)

19. Section 5(2)(b) of the Act states:

"(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."

20. The leading authorities which guide me in this ground are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca*

Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

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

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the

distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

Comparison of services

21. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

“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.”

‘Complementary’ was defined by the GC in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06*:

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

22. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] R.P.C. 281 for assessing similarity between goods and services also included an assessment of the channels of trade of the respective goods or services.

23. In *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 Jacob J held that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of

activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

Jacob J also said, in *Treat*:

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all a trade mark specification is concerned with use in trade”.

Neither should specifications be given an unnaturally narrow meaning, as per *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267. In *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, although in the context of a non-use issue, the court considered interpretation of specifications:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use”.

24. A further factor to bear in mind is that if goods or services fall within the ambit of terms within the competing specification, they are considered to be identical, as stated by the General Court (“GC”) in *Gérard Meric v OHIM*, case T-133/05.

25. As I have already said, the opponent’s best case lies with its earlier mark number 2407411. The parties’ respective specifications are:

Earlier mark 2407411	Application
Class 35: <i>Auctioneering services; provision of advertising space; information and advisory services relating to the aforesaid services.</i>	Class 37: <i>Construction services in relation to the fit-out of existing commercial buildings; office fit out services; project management and advisory services in the commercial property sector relating to all of the aforesaid services.</i>
Class 36: <i>Estate agency services; real estate and property management; rental of property and real estate; valuation (financial) services; real</i>	Class 42: <i>Design and build fit out</i>

<p><i>estate and property appraisal; house agency services; real estate and property brokerage; insurance and financial services, all relating to estate agency activities; mortgage services; information and advisory services relating to the aforesaid services.</i></p> <p>Class 42: <i>Surveying; surveying of real estate and property; legal services relating to real estate and property; conveyancing services; information and advisory services relating to the aforesaid services.</i></p>	<p><i>contractor services in the commercial property sector; planning of offices.</i></p>
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26. The parties in this case have provided evidence in order to showing the nature of the trade and how the various services are provided. Evidence can be of assistance, for example to show what is normal in trade or to explain the nature of complex goods or services. However, comparing the parties' services is ultimately a question of trade mark law and therefore a jury question for me to decide.

27. Firstly, I will consider the similarity of the opponent's services with the applicant's Class 42 services, which are:

Design and build fit out contractor services in the commercial property sector; planning of offices;

The opponent has cover for surveying services, also in Class 42. *To survey* is defined in Collins English Dictionary (2000) as:

"4. *Brit* to inspect a building to determine its condition and value.

and *surveying* is defined as:

"2. the setting out on the ground of the positions of proposed construction or engineering works."

28. Bearing in mind the authorities cited above, there will be an element of surveying involved in planning of offices, their design and their fit out, in order, firstly, to assess the building's condition and, secondly, to set out the proposed construction/engineering works (I note that Mr Winkworth says in his evidence that he conducts feasibility studies). All these services would be sought by a client wanting conversion of a commercial space and so the users are the same and the survey, planning, design and build services could be procured from the

same channel of trade. A survey will be an important element of the process of planning and design and build services of proposed construction works, so they are complementary in the sense that the customer may think that the responsibility lies with the same undertaking. Although they do not share nature or purpose, the applicant's services *Design and build fit out contractor services in the commercial property sector; planning of offices* share a reasonable level of similarity with the opponent's *surveying* services in view of the other similarities between them.

29. Next, I will consider the opponent's services and the applicant's class 37 services.

Construction services in relation to the fit-out of existing commercial buildings; office fit out services;

I consider the closest of the opponent's services to these terms to be *property management* and *rental of property and real estate*. Property management and rental of property services do not share the same nature or purpose as construction services for fitting out existing commercial buildings or office fit out services. They are not in competition with each other and are not complementary in the sense of one being important or indispensable for the other. Construction services are not accessed via the same channels of trade as property management or property rental services. Although I have considered the evidence provided by the opponent, it does not persuade me that it is the norm in trade for property management agents, letting agents or estate agents to provide construction services in relation to fit-out, and the evidence relating to "white label" provision is inconclusive and somewhat vague; it appears to be opinion rather than fact from third party 'experts'. I am unconvinced that it would be right to depart from a prima facie finding based on the core meanings of the terms. Although the services are all buildings related, applying the case law cited above, I conclude that property management and rental of property services are not similar to *Construction services in relation to the fit-out of existing commercial buildings; office fit out services*.

30. *Project management and advisory services in the commercial property sector relating to all of the aforesaid services [i.e. to construction services in relation to the fit-out of existing commercial buildings; office fit out services].*

This is a further step away from the closest of the opponent's services which are, *property management* and. Property management is the management of property on behalf of a landlord and rental of property is the provision to a third party of property for (usually) a consideration: the rent. Neither of these share nature, purpose, channel of trade and are not complementary to or in competition with project management and advice relating to construction services for office fit outs. Again, although both parties' services relate to aspects of services

connected with buildings, this is similarity at too general a level to be caught by the process of comparison required by with the case law cited above.

31. To sum up, there is a reasonable level of similarity between the opponent's services and the applicant's class 42 services, but there is no similarity between the opponent's services and any of the applicant's services in class 37.

Average consumer and the purchasing process

32. The average consumer is reasonably well informed and reasonably circumspect and observant, but his level of attention is likely to vary according to the category of goods or services. The average consumer for the applicant's services is the commercial professional, looking for office fit-out services. I agree with the applicant that those looking for these services will pay close attention to selecting such services. The purchasing process will involve both visual and aural aspects; such decisions will be discussed and will involve the perusal of brochures and website information.

33. The opponent's services are not limited to the commercial consumer, so here the average consumer encompasses both the commercial consumer and the general public. At stake are potentially large sums of money; buying a property is one of the largest financial decisions/transactions made in a lifetime. Although it is the property itself which engages the highest level of attention, the services associated with selling property and obtaining surveys a property will be chosen with a reasonable amount of care, although not the very highest level. In relation to property rental and property management services, those seeking to rent or have property managed for rental are likely to pay close attention to the service provider to ensure fair treatment and proper maintenance of the property. Again, for the opponent's services, the selection process will be both visual and aural. Overall, the average consumer's level of attention will be reasonably high.

Comparison of trade marks

34. The marks to be compared are:

Opponent's mark	Applicant's mark
WINKWORTH	WINKWORTH INTERIORS

The authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details. The opponent's mark consists of the single word WINKWORTH which,

self evidently, is its distinctive and dominant component. The applicant's mark consists of this same word, as its first element, and the word INTERIORS which, in the context of property, is descriptive. The dominant and distinctive element in the applicant's mark is also WINKWORTH on account of both its position at the front of the mark and because INTERIORS is descriptive in relation to the services at issue.

35. Half of the applicant's mark, WINKWORTH is visually identical to the single word in the opponent's mark, and this is also, as I have said above, the beginning of the applicant's mark. This carries though to the phonetic comparison: WINKWORTH will be pronounced identically in both marks and is the element of the applicant's mark which will be heard first. Looking at the marks as wholes, including the word INTERIORS, there is a good level of visual and aural similarity.

36. INTERIORS has obvious meaning. WINKWORTH, as is obvious from the applicant's evidence, is a surname. Mr Reddington has found it to be a surname in his search in an on-line directory, although it does not appear to be particularly common (I say more about this below). WINKWORTH conforms to a pattern which is recognisable in the UK as a name, either a surname or a place name; insofar as there is any conceptual meaning in relation to WINKWORTH, it will be shared.

37. I will bring forward all these points when I come to make a global assessment as to whether there is a likelihood of confusion.

Distinctiveness of the earlier mark

38. It is necessary to consider the distinctive character of the opponent's mark because the more distinctive it is, either by inherent nature or by use (nurture) the greater the likelihood of confusion². The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public³.

39. As I have said above, WINKWORTH will be seen as a name (surname or place), although not a well-known name. Mr Reddington submitted that surnames are "intrinsically weak" as trade marks. I do not accept this generalisation. A common surname may be weak in distinctive character because there are so many individuals with that name that the name is less able to do the job of distinguishing one undertaking from another, but this cannot be said of all surnames just because they are surnames. Surnames form one of the earliest methods of differentiating one's goods from those of another and

² *Sabel BV v Puma AG* [1998] RPC 199.

³ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

consumers are accustomed to their use as natural tools of differentiation. Mr Reddington's evidence shows that there are 127 individuals of that name in London. Given the size of London, this does not appear to be a common surname. Although not as high in inherent distinctive character as a wholly invented word, I consider that WINKWORTH has a good degree of inherent distinctive character.

40. The evidence filed by the opponent is almost wholly focussed upon residential estate agency services, mostly in London. Whilst the evidence shows a large market share in relation to the London residential estate agency market, this does not of itself support a claim to an enhanced level of distinctive character for residential estate agency services because this level of use is not UK-wide, nor does the evidence support such a claim for all the other services relied upon. However, as already said, the mark is inherently distinctive to a good degree and this applies to all the services relied upon.

Likelihood of confusion

41. The applicant has made reference in its evidence and submissions to its use of the mark which has not resulted in confusion with the opponent's mark, even in the same locality. Absence of confusion has been the subject of judicial comment and a registry tribunal practice notice, TPN 4/2009. There must be evidence to suggest that the relevant public has shown that it distinguishes between the parties' services. The opponent's evidence is centred on the residential property sector and the applicant's evidence shows use on commercial fit-out services. This does not show concurrent use in a market which demonstrates that the public has become used to distinguishing between the undertakings. Although there may, hitherto, have been no overlap in the parties' target markets, peaceful coexistence appears to have depended upon a marketplace status quo which has now been disrupted by the applicant seeking a trade mark registration putting co-existence on an entirely different footing. There is no automatic entitlement to a registration simply because a mark has been used. Further, the applicant cannot speculate, on the basis of historical use, as to what services the opponent may choose to use its registration upon in the five years it has to use it following completion of its registration procedure (or, if it assigned these services to another proprietor, what use that proprietor may make of the registration). This is the principle of notional and fair use; my assessment as to the likelihood of confusion must be in relation to the notional coverage of the parties' specifications, not their use to date⁴.

⁴ *Oakley, Inc v OHIM* Case T-116/06. "76 Consideration of the objective circumstances in which the goods and services covered by the marks in dispute are marketed is fully justified. The examination of the likelihood of confusion which the OHIM authorities are called on to carry out is prospective. Since the particular circumstances in which the goods covered by the marks are marketed may vary in time, and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, that is, that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the

42. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified. This includes keeping in mind the whole mark comparison and the principle of interdependency, whereby a lesser degree of similarity between the services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). In this case, the marks are visually and phonetically similar to a good degree. Both marks contain the identical WINKWORTH name with the applicant's mark additionally including the descriptive word Interiors. Consequently, they are conceptually similar. Similarity between marks cannot, however, compensate for absence of similarity between services⁵. As there is no similarity between any of the opponent's services with the applicant's class 37 services, there is no likelihood of confusion in relation to the application in class 37.

43. The applicant's class 42 services are similar to the opponent's services to a reasonable degree. WINKWORTH has a good degree of inherent distinctive character and the 'INTERIORS' part of the applicant's mark, being entirely descriptive of building interiors, will not put a distance between the marks. Bearing in mind the interdependency principle and, even with the reasonably high level of attention which the notional average consumer will pay in choosing the parties' services, it is, in my view, inevitable that confusion will occur.

44. Consequently, the opposition succeeds under section 5(2)(b) in relation to the applicant's class 42 services but fails in relation to the class 37 services. That being the case, I will turn to the other grounds of opposition. I find it convenient to deal firstly with section 5(4)(a) of the Act.

commercial intentions, whether carried out or not – and which are naturally subjective – of the trade mark proprietors (*QUANTUM*, paragraph 75 above, paragraph 104, and *T.I.M.E. ART/Devinlec v OHIM*, paragraph 75 above, paragraph 59).

⁵ The CJEU said in *Waterford Wedgwood plc v OHIM* Case C-398/07: “35 It must be noted that the Court of First Instance, in paragraphs 30 to 35 of the judgment under appeal, carried out a detailed assessment of the similarity of the goods in question on the basis of the factors mentioned in paragraph 23 of the judgment in *Canon*. However, it cannot be alleged that the Court of First Instance did not take into account the distinctiveness of the earlier trade mark when carrying out that assessment, since the strong reputation of that trade mark relied on by Waterford Wedgwood can only offset a low degree of similarity of goods for the purpose of assessing the likelihood of confusion, and cannot make up for the total absence of similarity. Since the Court of First Instance found, in paragraph 35 of the judgment under appeal, that the goods in question were not similar, one of the conditions necessary in order to establish a likelihood of confusion was lacking (see, to that effect, *Canon*, paragraph 22) and therefore, the Court of First Instance was right to hold that there was no such likelihood.”

5(4)(a)

45. This section of the Act reads as follows:

“5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

46. As the opponent has achieved partial success under its section 5(2)(b) ground of opposition, I will confine my analysis under this ground to class 37 of the application which survived the attack under section 5(2)(b). These services are:

Construction services in relation to the fit-out of existing commercial buildings; office fit out services; project management and advisory services in the commercial property sector relating to all of the aforesaid services.

47. In *Wild Child Trade Mark* [1998] RPC 455, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, said:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purpose of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.*[1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] A.C. 731 is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of ‘passing off’, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

Goodwill

48. The opponent claims that it has a significant goodwill as a result of its use in the UK, since at least the 1980s, of WINKWORTH in relation to estate agency services, property management services and “ancillary services”. Its evidence shows use upon a narrower range of services than the services relied upon for its section 5(2)(b) ground: it is almost wholly in relation to residential estate agency services. Where Mr Simon Agace states he acts as a project manager in relation to refurbishment, the evidence of this is sketchy, so it is impossible to gauge the extent of this activity. Most of what he says concerns his business in the 1980s. There is no evidence that at the date of the application (which is the material date⁶) that there was a protectable goodwill in the sign WINKWORTH beyond the opponent’s core activities of selling high-end residential properties. It is clear from the evidence that, in relation to residential estate agency services, there was goodwill in relation to WINKWORTH in London and the south east of England.

⁶ Section 5(4)(a) is derived from article 4(4)(b) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks, which states:

“rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark.”

The date on which the application was filed was 19 October 2009.

Misrepresentation/Damage

49. Although I did not find the services which I am now considering under this ground to be similar to the opponent's services within the parameters of section 5(2) case law, there are no such restrictions under section 5(4)(a) in considering whether the parties' respective business activities are close or otherwise. For example, in *Lego System Aktieselskab and Another v Lego M Lemelstrich Ltd* [1983] FSR 155 the distance between the fields of activity, toys and irrigation equipment, was bridged by an enormous reputation, Lego being classed as a household word. In *Harrods Limited v Harrodian School Limited* [1996] R.P.C. 697, Millet LJ said:

"There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business... What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

"...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant":

Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency) [1972] R.P.C. 838 at page 844 per Russell L.J.

In the *Lego* case Falconer J. likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the

further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

“even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.”

50. Despite the closeness of the parties' marks, I am doubtful that a substantial⁷ number of persons would be deceived into believing there to be a connection between a residential property estate agency and an undertaking providing construction services for the fit out of commercial buildings, and project management and advisory services relating thereto. The types of property are completely different and so are the services; as said above, any similarity is on a highly general level in that they both deal with buildings. A consumer would not normally approach an estate agent to provide construction services or vice-versa; still less would a consumer approach a residential estate agent to procure construction services for the commercial sector. The opponent's level of goodwill is not on such a scale as to be able to cross this divide. There will be no misrepresentation. **The section 5(4)(a) ground fails.**

Section 5(3)

51. Section 5(3) of the Act states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

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

⁷ *Neutrogena Corporation and Ant. V. Golden Limited and Anr.* [1996] R.P.C. 473).

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

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*; but the reputation of the earlier mark may extend beyond the consumers for the goods and services for which it is registered; *Intel, paragraph 51*;

(c) It is necessary, but not sufficient, for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*;

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

(e) Although it is not a necessary factor, a link between the trade marks is necessarily established where the similarity between the marks causes the relevant public to believe that the goods/services marketed under the later mark come from the owner of the earlier mark, or from an economically connected undertaking; *Intel, paragraph 57*;

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

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

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

(i) Detriment to the repute of the earlier mark is caused when the goods or services for which the later mark is used by the third party may be perceived by the public in such a way that the earlier trade mark's power of attraction is reduced; *L'Oreal, paragraph 40*.

(j) Unfair advantage covers, in particular, cases where a third party seeks to ride on the coat-tails of the senior mark in order to benefit from a transfer of the image of the earlier mark, or of the characteristics it projects to the goods/services identified by the later mark; *L'Oreal, paragraph 41*.

53. Firstly, in order to get off the ground, the opponent's mark must a reputation. Mr Dominic Agace states that, of the 70% of estate agents that are on the Rightmove website, the opponent has a 15% market share in London (according to Rightmove). Turnover figures for the period 2005 to 2010 were £26,077,663 rising to £30,493,401. The evidence points to a good level of reputation in relation to residential estate agency services in London and the south east of England, but not beyond that within the UK. However, there is a substantial concentration of the UK populace in London and the South East. I find that the opponent has sufficient reputation under this ground (based on its earlier national mark, number 2407411), but that its reputation is limited to residential estate agency services.

54. The next requirement for the opponent under this ground is to establish that a link will be made between the respective marks. Whether there is a link must be assessed globally, taking into account all factors relevant to the circumstances of the case; paragraph 42 of *Intel* lists these factors as including:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark's reputation;
- the degree of the earlier mark's distinctive character, whether inherent or acquired through use; and
- the existence of the likelihood of confusion on the part of the public.

55. Looking at the case against these factors, those which favour the opponent's case are that the marks are closely similar (INTERIORS playing a descriptive role) and WINKWORTH is inherently distinctive to a good degree. The opponent's mark has a reputation in relation to residential estate agency service but although this appears strong in London, its strength is limited to London. Against the opponent are the factors that I have found there to be no similarity between the services and no likelihood of confusion.

56. This last factor feeds into two more considerations. Not only are residential estate agency services dissimilar to the applicant's construction services relating to fit-out of commercial properties, project management and advisory services relating thereto, but there is also quite some disparity between them. There is no overlap and the customer base for both will be different. As said earlier, a consumer would not normally approach an estate agent to provide construction services or vice-versa; still less would a consumer approach a residential estate agent to procure construction services for the commercial sector. Whether there is a link is not a mathematical test, but I find that this case falls roughly half-way amongst the five factors listed above. Taking a balanced view, I accept that there will be a link. However, the link will not be a strong one. That there is a link is also not sufficient, of itself, for success under section 5(3). The opponent has pleaded all three heads of damage. In relation to detriment to distinctive character, there must be evidence of, or a serious likelihood that there will be, a change in the economic behaviour of the opponent's consumers of its residential estate agency services as a result of the applicant's use of its mark on construction services for commercial/office fit outs. There is no evidence of this and I cannot see that there would be a serious likelihood of this either such that the opponent's mark is weakened in its ability to identify its own services. Nor will there be detriment to the repute of the opponent's mark by the use of the applicant's mark; there is nothing about the applicant's services which suggests that the opponent's mark's power of attraction is reduced. Finally, the dissimilar services and the weakness of the link point away from the taking of unfair advantage; there will be no image transfer from the opponent's mark in relation to residential estate agency services, even those which are high-end, to the applicant's mark for provision of commercial/office fit-out services. There would be no link strong enough to convey any advantage to the applicant or cause any detriment to the opponent. **The section 5(3) ground fails.**

Outcome

57. The opposition is successful against the application in respect of the class 42 services but has been unsuccessful in relation to the class 37 services. The application may proceed to registration for the services applied for in class 37; the services in class 42 will be refused⁸.

⁸ Tribunal Practice Notice 1/2011 refers.

Costs

58. Each side has been successful in relation to approximately half the coverage of the specification and so I direct each side to bear its own costs.

Dated this 15th day of February 2012

**Judi Pike
For the Registrar,
the Comptroller-General**