O/0723/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3616345

IN THE NAME OF OMNICOM HOLDINGS LTD

TO REGISTER THE FOLLOWING TRADE MARK:

IN CLASSES 9, 16 AND 41

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 426418

BY KONAWOOD LIMITED

Background and pleadings

1. On 25 March 2021, Omnicom Holdings Ltd ('the applicant') applied to register the trade mark as shown on the front page of this decision. It was accepted and published on 28 May 2021 in respect of the following goods and services:

> Class 9: Electronic publications; digital publications; downloadable publications and media including books, magazines, reviews, newsletters, reports, articles, podcasts, video clips, interviews, editorials, spoken word recordings; electronic databases; data, information, audio, video and other media and multimedia, made available from the Internet including by downloading; computer software; software applications; electronic licences, certificates, forms and awards; all of the aforesaid being made in the UK.
>
> Class 16: Printed matter; printed publications; printed forms and documents; instructional, educational and teaching materials in printed form; printed reports; educational and promotional publications; newsletters; printed matter, namely articles; magazines; leaflets; posters; photographs; tickets and passes; printed awards and certificates; stationery; all of the aforesaid being made in the UK.
>
> Class 41: Information relating to entertainment or education, provided on-line from a computer database or the Internet; providing on-line electronic publications; publication of electronic books and journals on-line, education; providing of training; entertainment; sporting and cultural activities, entertainment; social and cultural events; organising and hosting awards.

2. On 25 August 2021, Konawood Limited ("the opponent") filed a notice of opposition against the application. The opposition is brought under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 ("the Act") and is directed against all the applied for goods and services.

3. In respect of the 5(2)(b) claim, the opponent relies upon the trade mark:

UK registration no: 903065992[1]

Filing date 24 February 2003; registration date 18 May 2004

Relying on all goods and services in Classes 16 & 41 namely:

Class 16: Printed matter; stationery; books; brochures; magazines; photographs; posters; newspapers and periodicals.

Class 41: Entertainment services relating to the travel industry; organising, managing, conducting and hosting of award ceremonies; presentation and granting of awards; production and presentation of shows and performances; advisory, consultancy, information and management services relating to all the aforesaid services.

4. By virtue of its earlier filing date of 24 February 2003, the opponent's trade mark constitutes an earlier mark, in accordance with section 6 of the Act. As it had been registered for more than five years at the filing date of the application, it is subject to the proof of use requirements specified within section 6A of the Act.

[1] The opponent's earlier mark was initially registered at the European Union Intellectual Property Office (EUIPO). On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM. As a result of the earlier mark being registered as a EUTM, at the end of the Implementation Period, it was automatically converted to a comparable UK trade mark. The comparable UK mark is now recorded on the UK trade mark register and has the same legal status as if it had been applied for and registered under UK law, and the original filing date remains.

5. I note that the earlier mark now stands as an expired earlier mark on the register, with the expiration date being 24 February 2023. However, the expired status of the mark does not negate the proceedings before me since it had not expired at the filing date of the opposed mark.

6. In its notice of opposition, the opponent contends that registration of the applicant's mark for the opposed goods and services would be contrary to section 5(2)(b) because the marks are similar and the goods and services at issue are identical or similar.

7. In respect of the 5(4)(a) claim, the opponent relies on the sign "The British Travel Awards", which it claims to have used throughout the UK since 2003. The opponent claims that its sign has been used in respect of the following goods and services:

> Printed matter; stationery; books; brochures; magazines; photographs; posters; newspapers and periodicals.
>
> Entertainment services relating to the travel industry; organising, managing, conducting and hosting of award ceremonies; presentation and granting of awards; production and presentation of shows and performances; advisory, consultancy, information and management services relating to all the aforesaid services.

8. As a result of this use, the opponent claims to have built up a reputation and goodwill. The opponent contends that use of the applicant's mark would likely result in purchasers and users of the applicant's goods and services being confused into believing that the opposed goods and services originate from the opponent. The opponent believes that registration of the applicant's mark would therefore be contrary to section 5(4)(a) of the Act.

9. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use in respect of its earlier registered mark.

10. The opponent is represented by Travlaw Legal Services Limited whereas the applicant is represented by Hamptons Simmons & Brown. Both parties filed evidence in these proceedings. Neither party requested a hearing; however, the opponent did file written submissions in lieu. This decision is taken following careful consideration of the papers.

11. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

Evidence

12. The opponent's evidence in chief came in the form of a witness statement of Lorraine Barnes Burton. Ms. Barnes Burton is the director of events and partnership of the opponent's company. The witness statement is accompanied by a single exhibit labelled LBB1. A statement of use proforma has also been provided by Ms. Barnes Burton and is accompanied by a single annex labelled annex 1. The main purpose of the evidence is to demonstrate that the earlier mark has been put to genuine use during the relevant period and to show that the opponent has built up goodwill in its earlier unregistered mark so as to have acquired the passing off rights.

13. The applicant's evidence came in the form of a witness statement of Farrukh Javaid, the director of the applicant's company. Mr. Javaid's statement is accompanied by a single exhibit labelled appendix 1. Mr. Javaid's witness statement is with regard to the evidence submitted by the opponent.

14. The opponent's evidence in reply came in the form of the witness statement of Lorraine Barnes Burton and a single exhibit labelled LBB2. The evidence is in response to Mr. Javaid's witness statement.

15. I have read and considered all of the evidence of both parties and I will refer to the relevant parts at the appropriate points in the decision.

DECISION

Proof of use

16. The applicant has requested proof of use in these proceedings in respect of the opponent's earlier mark. I will begin by assessing whether and to what extent the evidence supports the opponent's statement that it has made genuine use of the mark in relation to the goods and services relied upon. In accordance with section 6A(1A) of the Act, the relevant period for this purpose is the five years ending on the filing date of the contested application: 26 March 2016 to 25 March 2021.

17. The relevant statutory provisions are set out in Section 6A of the Act, which states:

"(1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

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

(3) The use conditions are met if -

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

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

(4) For these purposes -

(a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

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

(5)- (5A) [Repealed]

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

18. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

> "7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.
>
> (2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—
>
> (a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and
>
> (b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.
>
> (3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —
>
> (a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and
>
> (b) the references in section 6A to the United Kingdom include the European Union".

19. Section 100 is also relevant, which reads:

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

20. Consequently, the onus is upon the opponent to prove that genuine use of the registered trade mark was made within the relevant territory in the relevant period, and in respect of the goods and services as registered.

21. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

> "114……The Court of Justice of the European Union ("CJEU") has considered what amounts to "genuine use" of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.
>
> 115. The principles established by these cases may be summarised as follows:
>
> > (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
> >
> > (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and

frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

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

22. Use does not need to be quantitively significant in order to be genuine, however, proven use of a mark which fails to establish that "the commercial exploitation of the mark is real" because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark" is not genuine use.[2]

Form of the mark

23. Before I move on to assess if the opponent has shown genuine use, I must first consider if I find the use of the mark as shown in the evidence to be use of the mark

[2] *Nike Innovate CV v Intermar Simanto* (*Jumpman*) O/222/16 Daniel Alexander QC sitting as the Appointed Person on appeal.

as registered. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

> "13. […] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).
>
> 14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.
>
> 15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.
>
> 16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient)

with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

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

24. The opponent's registration is for the figurative mark shown in paragraph 3 in this decision. Throughout the evidence, the opponent has used the mark in a number of ways as shown below:

25. In respect of the first variant, I acknowledge that where a registered mark is used as part of another mark or with additional matter, this may still constitute use of an acceptable variant of the mark as registered, where this element continues to act independently as an indicator of origin.[3] With this in mind, I find it likely that the average consumer will merely perceive "2018" as the year of the award ceremony and it therefore does not alter the distinctive character of the registered mark. As for the colour scheme, I note that the registration of a trade mark in black and white covers use of the mark in colour. This is because colour is an implicit component of a trade

[3] *Colloseum Holdings AG v Levi Strauss & Co.,* Case C-12/12

mark registered in black and white (as opposed to extraneous matter). Thus, a black and white version of a mark should normally be considered on the basis that it could be used in any colour, and it follows that the use of a mark registered in black and white in another colour is acceptable use of the mark as registered. I acknowledge there may be exceptions for marks used in complex colour arrangements where these alter the distinctive character of the mark as registered however, I do not consider the use of the colours as shown above to be a particularly complex colour arrangement. I consider it to be normal and fair use of the mark as registered, and in any case, it is my view that this use of colour does not alter the distinctive character of the registered mark. I find that use of mark i) is an acceptable variant use of the mark as registered.

26. Turning to the second and third variants, I do not consider the colour schemes used to be particularly complex and so I find again that the colour schemes used above to be acceptable under normal and fair use. I consider the use of "2019" and "2020" in the examples above will be perceived as the years that the awards were granted and as such, I do not consider that they alter the distinctive character of the registered mark. I note that three of the five stars that sit at the top of the mark have been removed however, I consider this to be a minor difference that does not alter the distinctive character of the registered mark. Further, the additional wording above the marks are descriptive in nature as they appear to describe the grading of the award such as "Silver". As for the wording below the marks, this also appears descriptive in nature as it describes the category of the award that has been granted such as "Best escorted tours holiday company". I do not consider that these additions alter the distinctive character of the registered mark, and they are acceptable variant uses of the same.

<u>Use of the mark</u>

27. In her witness statement, Ms. Barnes Burton states that since 2008 the opponent has been polling public opinion on leisure travel companies. Over the last five years an average of 312,000 individuals have annually registered their votes for the best travel and travel related companies in a number of categories. Ms. Barnes Burton claims that this represents the largest poll of consumer opinion on who are the

best companies operating in leisure travel.[4] I note that in the opponent's statement of use proforma it is stated that the mark has been used throughout the UK.

28. Pages 1-6 of annex 1 display printouts from the opponent's YouTube channel. I note that the description of the 2016 awards states that "over 950 top flight guests from the travel and tourism industry" attended the award ceremony. This also appears to be the case for the 2017 awards as the YouTube video description states that the 2017 ceremony was "attended by almost a thousand travel industry people". Further, a guest list has been provided by the opponent at pages 1-2 of exhibit LBB2 showing that there were 853 attendees at the 2019 awards.

29. Turnover figures have not been provided however it is claimed that the opponent spends approximately £290,000 per year on advertising space.[5] The applicant challenges this claim regarding advertising expenditure. In the witness statement of Mr. Javaid, accounts filed at Companies House by the opponent's company Konawood Limited are exhibited in annex 1. Mr. Javaid states that the accounts exhibited do not reflect the level of expenditure claimed by the opponent. In their evidence in reply, Ms. Barnes Burton explains that each year the opponent's company gives a licence to UK Travel Awards Ltd for the rights to use British Travel Award's trade mark and to operate The British Travel Awards. It is also stated that UK Travel Awards Ltd is a sister company to the opponent and that both companies are owned by the same person.

30. Printouts from the opponent's website have been provided detailing press campaigns dated within the relevant period between 2017 and 2018.[6] By way of example, the 2019 advertising campaign states, "Our media partners at Reach Solutions promoted the 2019 awards with editorial features and columns in their eight national newspaper titles. 219 display and classified advertisements featuring Voter's Prize Draw Partners were placed across eight national and ten regional newspaper titles." The newspaper titles include British newspapers such as The Daily Mirror, The

[4] See para 4 of the first witness statement of Lorraine Barnes Burton
[5] See para 17 of the first witness statement of Lorraine Barnes Burton
[6] See exhibit LBB1 and pages 7-12 of annex 1

Express, Daily Star, Daily Record and Western Mail. Although the opponent's mark is clearly visible at the top the opponent's website for each year of the press campaign, the samples from newspaper articles are unclear and it is difficult to make out the opponent's mark in the samples provided.

31. Press articles from The Mirror have been included in annex 1 for the years 2018, 2019 and 2020. Each article reports on the awards ceremony results and includes a list of the winners from each year. The opponent's mark is visible at the top of each article. I note that in the article dated 29 November 2018 it is stated that 334,522 people cast 753,938 votes. In the article dated 28 Nov 2019 it is claimed that 402,734 people cast 867,221 votes and the article dated 14 December 2020 reports that 132,000 people cast 244,000 votes. Ms. Barnes Burton explains that the decline in the number of voters for the year 2020 was due to the impact that Covid had on the travel industry[7]. The Mirror articles from each year state that the votes are made by the British public. I also note that a map of the UK is provided at page 6 of exhibit LBB2 showing the distribution of voters within the UK for the 2017 awards.

32. At pages 29 to 33 of annex 1, the opponent has provided printouts from the websites of recipients of the British Travel Awards. The opponent's mark is present in each of these printouts. These include:

- Sailing Holidays who won an award in 2018. They state, "We've finished our season by attending the renowned British Travel Awards! We love taking part as it is the only travel awards in the UK voted for by the great British public."
- Verdant Leisure who won an award in 2019 claiming, "We have been announced as the winner of the silver accolade in the Best UK Family Holiday Company category in the prestigious 2019 British Travel Awards."
- Neilson who won an award in 2020 stating, "The British Travel Awards, as the largest consumer-voted awards programme in the UK, are widely seen as the benchmark for excellence in travel.

[7] See para 4 of the second witness statement of Lorraine Barnes Burton

33. In terms of market share, the opponent sets out a narrative that the British Travel Awards are the largest poll of consumer opinion on who are the best companies operating in leisure travel.[8] While such a claim is noted, no supporting evidence has been provided.

34. I find that there are a number of shortcomings with the opponent's evidence. For example, the opponent has elected not to provide certain pieces of information such as turnover figures and some pages of the evidence are unclear, making it difficult to view the opponent's mark. Whilst I note the opponent's narrative that the British Travel Awards are the largest poll of consumer opinion in relation to leisure travel and deemed to be the "gold standard" of travel awards, it is unclear how the evidence provided supports these claims. However, based on the information I have before me, I am satisfied that the opponent has put their mark to genuine use in the UK. Clearly, there has been a reasonable amount of promotional activity and press coverage surrounding the awards for the years 2017 to 2020 and I note that the ceremonies took place in the UK and were attended by on average 800 travel industry professionals. Further, I note that 334,522, 402,734 and 132,000 individuals from the UK cast votes for the 2018, 2019 and 2020 awards respectively.

35. Taking all of this into account, I am satisfied that the opponent has demonstrated proof of use of its earlier mark in the UK during the relevant period. That being said, I do not consider that the opponent has demonstrated use for all goods and services for which its mark is registered, and I will now consider a fair specification in respect of the above.

Fair specification

36. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (although it equally applies to the issue of a fair specification for proof of use assessments):

[8] See para 4 of the first witness statement of Lorraine Barnes Burton

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Pl*c [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been

used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

37. I remind myself that the goods and services covered by the opponent's mark's specification are:

Class 16: Printed matter; stationery; books; brochures; magazines; photographs; posters; newspapers and periodicals.

Class 41: Entertainment services relating to the travel industry; organising, managing, conducting and hosting of award ceremonies; presentation and granting of awards; production and presentation of shows and performances; advisory, consultancy, information and management services relating to all the aforesaid services.

38. Ms. Barnes Burton claims that pages 1-17 of exhibit LBB1 and pages 7-33 of Annex 1 show evidence of use of the opponent's mark for its goods in class 16. The pages referred to by Ms. Barnes Burton are samples of newspaper articles from UK news outlets such as The Mirror and printouts from the opponent's website relating to the press campaigns for their award ceremonies. Although the opponent's mark is visible in some of the articles and press releases, this is simply the opponent advertising its own mark in print form. I therefore do not consider that this demonstrates genuine use of the goods in class 16 and as such, the opponent cannot proceed to rely on these goods.

39. In terms of the services in class 41, it is clear from the evidence that the opponent holds an annual award ceremony and grants awards to businesses within the field of leisure travel. However, I do not consider that this is sufficient to rely upon their services in class 41 at large as these include broad terms such as *entertainment services relating to the travel industry* and *production and presentation of shows and performances.* Taking the evidence into account, I find that the consumer would consider *organising, managing, conducting and hosting of award ceremonies in relation to leisure travel; presentation and granting of awards in relation to leisure*

travel to be a fair description of the services evidenced. I will therefore assess the grounds under section 5(2)(b) based on that specification.

Section 5(2)(b) of the Act

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

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

(a) […]

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

41. Section 5A states:

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

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

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

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

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

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

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components; (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

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

Comparison of goods and services

43. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union ("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".

44. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

a) The respective users of the respective goods or services;

b) The physical nature of the goods or acts of services;

c) The respective trade channels through which the goods or services reach the market;

d) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

45. The General Court ("GC") confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

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

46. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

47. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

> "… Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU

in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

48. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment, he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“…the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

49. In light of my findings above, the competing goods and services are as follows:

Opponent	Applicant
Class 41: Organising, managing, conducting and hosting of award ceremonies in relation to leisure travel; presentation and granting of awards in relation to leisure travel.	Class 9: Electronic publications; digital publications; downloadable publications and media including books, magazines, reviews, newsletters, reports, articles, podcasts, video clips, interviews, editorials, spoken word recordings; electronic databases; data, information, audio, video and other media and multimedia, made available from the Internet including by downloading; computer software; software applications; electronic licences, certificates, forms and awards; all of the aforesaid being made in the UK.
	Class 16: Printed matter; printed publications; printed forms and documents; instructional, educational and teaching materials in printed form; printed reports; educational and promotional publications; newsletters; printed matter, namely articles; magazines; leaflets; posters; photographs; tickets and passes; printed awards and certificates; stationery; all of the aforesaid being made in the UK.
	Class 41: Information relating to entertainment or education, provided on-line from a computer database or the Internet; providing on-line electronic publications; publication of electronic books and journals on-line, education; providing of training; entertainment; sporting and cultural

	activities, entertainment; social and cultural events; organising and hosting awards.

50. I first note that the applicant's specification in classes 9 and 16 include the term, "all of the aforesaid being made in the UK." This term would not have any bearing on my assessment of similarity, so I need not consider the matter any further.

Class 9

51. The applicant's *downloadable publications and media including books, magazines, reviews, newsletters, reports, articles, podcasts, video clips, interviews, editorials, spoken word recordings* differ in physical nature and purpose compared to the opponent's services. Their method of use differs, and I do not consider the competing goods and services to share a competitive relationship. The goods and services would also be available via different trade channels. Whilst I accept that coverage of award presentations would be available in electronic, digital and downloadable publications, I do not consider the respective goods and services to be important or indispensable to one another to the extent that consumers may believe that the responsibility for them lies with the same undertaking[9]. Consequently, I consider these goods and services to be dissimilar.

52. *Electronic databases* differ in nature, purpose and method of use compared to the opponent's services. I consider that users and trade channels would also differ. Further, there is no competitive nor complementary relationship to be found. I do not consider these goods and services to be similar.

53. Turning to the applicant's *data, information, audio, video and other media and multimedia, made available from the Internet including by downloading,* I find that these goods have a different physical nature and purpose compared to the opponent's services. I acknowledge that award ceremonies held by the opponent may be

[9] *Boston Scientific Ltd v OHIM,* Case T-325/06

recorded and made available via the internet as a media file however, I do not consider the respective goods and services to be important or indispensable to one another to the extent that consumers may believe that the responsibility for them lies with the same undertaking and therefore there is no complementary relationship between the same. There is no competitive relationship between the respective goods and services, and I also consider that the trade channels differ. There is no similarity between these goods and services.

54. I now consider the applicant's *computer software* and *software applications.* These goods have a different physical nature, method of use and purpose compared to the opponent's services. There is also no competitive nor complementary relationship between the same. Further, I consider that the respective goods and services would have different trade channels. Overall, I do not consider these goods and services to be similar.

55. *Electronic publications; digital publications; electronic certificates and awards* differ in purpose, nature and method of use compared to the opponent's services. To my mind, a certificate is an official piece of documentation (whether electronic or hard copy) that attests to a fact and is usually presented to an individual or entity to record the undertaking of training or as an award. I therefore accept that an undertaking that provides a service of *presentation and granting of awards in relation to leisure travel* would likely present certificates and awards. I therefore find there is some degree of complementarity however, the respective goods and services would reach the market via different trade channels. Taking these factors into account, I find there is a very low degree of similarity.

56. *Electronic forms* have a different nature, purpose and method of use compared to the opponent's services. The respective goods and services would reach the market via different trade channels and there is no competitive nor complementary relationship between these goods and services. Overall, these goods and services are dissimilar.

Class 16

57. I now consider the applicant's *printed reports; educational and promotional publications; newsletters; printed matter, namely articles; magazines; leaflets; posters; photographs.* These goods have a different nature, purpose and method of use compared to the opponent's *organising, managing, conducting and hosting of award ceremonies in relation to leisure travel.* The respective goods and services would reach the market via different trade channels. I do not find that the goods and services would enjoy a competitive nor a complementary relationship. These goods and services are dissimilar.

58. I consider that *instructional, educational and teaching materials in printed form* would come in the form of leaflets, textbooks and instructional manuals. These goods therefore differ in terms of nature, purpose and method of use compared to the opponent's services. There is no competition between the respective goods and services, nor is there any finding of a complementary relationship. The goods and services would reach the market via different trade channels and there would be no user overlap. In light of this, I do not consider these goods and services to be similar.

59. *Printed matter; printed publications; printed forms and documents; printed awards and certificates* all differ in nature, purpose and method of use compared to the opponent's services however, there is an important and indispensable relationship between the same and I therefore find these goods and services have a complementary relationship. I consider the goods and services would be sold via different trade channels and I do not consider that they share a competitive relationship. Overall, these goods and services are similar to a very low degree.

60. The applicant's term *stationery* would encompass goods such as pens, pencils, sharpeners, notepads and envelopes. These goods are therefore different in physical nature, method of use and purpose compared to the opponent's services. I do not consider these goods and services to be complementary, nor do they enjoy a competitive relationship. Further, the respective goods and services would be

available via different trade channels. Overall, I do not find these goods and services to be similar.

<u>Class 41</u>

61. The applicant's term *organising and hosting awards* would encompass the opponent's *organising…and hosting of award ceremonies in relation to leisure travel.* These services are therefore identical on the principle outlined in *Meric.*

62. *Entertainment* is a broad term and I consider that it would encompass aspects of the opponent's specification, in particular *conducting and hosting of award ceremonies in relation to leisure travel* and therefore be identical on the principle outlined in *Meric.* Alternatively, the respective services are highly similar. Award ceremonies are a form of entertainment so there would be an overlap in terms of nature and purpose. There would also be an overlap in method of use where the services are provided on stage or television. I also consider there would be an overlap in users as audiences will watch award ceremonies as well as other forms of entertainment.

63. The purpose of *sporting and cultural activities, entertainment* and *social and cultural events* is to provide entertainment, so there will be some overlap in terms of nature and purpose with the opponent's *conducting and hosting of award ceremonies in relation to leisure travel* although I note the subject matter will differ in respect of *sporting activities*. There will be an overlap in users insofar as they will comprise members of the general public being the audience or attendees at these events. There may also be a degree of competition as users will choose between differing forms of entertainment however, I do not consider there to be any complementary relationship between these services. Overall, I find these services have a medium degree of similarity.

64. I find that *information relating to entertainment or education, provided on-line from a computer database or the Internet* is different in terms of nature and purpose compared to the opponent's services. I do not consider there to be any competition

nor a complementary relationship between the same. The respective services will also reach the market via different trade channels and there will be no user overlap. I do not consider there to be any similarity between these services.

65. As some degree of similarity between goods and services is necessary to engage the test for likelihood of confusion, this means that the opposition under section 5(2)(b) aimed against those goods and services will fail.[10] However, the opposition under section 5(2)(b) against the following goods and services may proceed:

> Class 9: Electronic publications; digital publications; Electronic certificates and awards.
>
> Class 16: Printed matter; printed publications; printed forms and documents; printed awards and certificates
>
> Class 41: Entertainment; sporting and cultural activities, entertainment; social and cultural events; organising and hosting awards.

The average consumer and the nature of the purchasing act

66. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,* [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably

[10] *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA

> well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

67. The opponent's services appear to be aimed at both business users, namely those involved in the travel industry and also the general public who will be spectators or voters for the awards ceremonies. I also consider this to be the case for the applicant's services that will also be largely aimed at the general public or business users.

68. The price of the services are unlikely to be particularly high for the purchaser, although I recognise that they will not be at the lowest end of the scale and the price could vary. However, even where the price is relatively low, various factors will still be taken into consideration such as type of performance, price and ease of access. Taking all of this into account, I consider that a medium degree of attention will be paid during the purchasing process for the services by the general public whereas business users such as those within the travel industry will pay a slightly higher degree of attention.

69. The selection process for the services will primarily be selected by visual means either by viewing websites, advertisements or brochures however, I do not discount that there may be an aural element to the selection of these services as word-of-mouth recommendations may be made.

Comparison of the marks

70. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall

impressions created by the trade marks, bearing in mind their distinctive and dominant components.

71. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

73. The respective trade marks are shown below:

74. The opponent's mark is comprised of the words "The British Travel Awards" presented in a standard typeface, encompassed by a figurative laurel wreath element and five stars. All of these elements make a roughly equal contribution to the overall

impression and neither element dominates the other. Therefore, the overall impression lies in the totality of the mark.

75. The applicant's mark consists of a crest and the words "British Tourism Awards" underlined and presented in a large standard typeface. The words "Incorporating The British Mark For Tourism Excellence" are presented below in a medium sized, standard typeface. Additional wording is presented underneath, in a much smaller font which reads "The British Tourism Awards And The British Mark For Tourism Are A Standard Of Excellence, An Agreed Rating For Companies and Individuals Who Are Doing Something Exceptionally Well." The crest and the wording "British Tourism Awards" both dominate the overall impression with the smaller wording "Incorporating The British Mark For Tourism Excellence" playing a secondary role. The additional smaller wording below, though not negligible, plays an even smaller role in the overall impression due to its size, and positioning within the mark along with its descriptive nature.

76. In terms of visual similarity, the respective marks both contain the words "British" and "Awards". The remaining verbal elements of the marks differ with the applicant's mark containing additional wording that has no counterpart in the opponent's marks. The marks also have different figurative elements. Considering the overall presentation of the marks, I find they have a low degree of similarity.

77. The opponent's mark will be articulated in seven syllables using the standard English pronunciation of "The British Travel Awards". In respect of the applicant's mark, I consider that it will be pronounced in seven syllables as "British Tourism Awards". The wording below appears much smaller and longer in length so I do not find it likely that this will be articulated by consumers. Weighing up these factors, I consider the marks to have a medium degree of aural similarity.

78. The opponent's mark conveys the idea of an award ceremony or event that focuses on British travel. The remaining elements of the five stars and laurel wreath do not add much further conceptually; they reinforce the concept of an awards ceremony. The applicant's mark conveys the idea of an award ceremony or event that focuses on British tourism. The additional wording further reinforces this by referring

to “tourism excellence”. The figurative element will convey the idea of a crest. There is a conceptual overlap insofar as they both convey the idea of awards related to British tourism and travel however, the difference in the figurative elements and the additional wording in the applicant’s mark creates a point of difference. Overall, I consider the marks to have a medium to high level of conceptual similarity.

Distinctive character of the earlier mark

79. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In *Lloyd Schuhfabrik*, the CJEU stated that:

> “22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested

by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

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

81. I am of the view that the verbal element of the opponent's mark "The British Travel Awards" is descriptive of the services for which it is registered. I find that the figurative elements add a small degree of distinctiveness however this is also limited as I do not consider a laurel wreath and five stars to be particularly distinctive in relation to award ceremonies. I recognise that the validity of the earlier mark is not in issue in these proceedings, the mark must be assumed to have some distinctive character.[11] On that basis, I find that the opponent's mark possesses a low degree of inherent distinctive character.

82. I will now consider whether the evidence filed by the opponent demonstrates that the distinctiveness of the earlier mark has been enhanced through use. The relevant date for this assessment is the filing date of the contested application, 25 March 2021.

83. In respect of the enhanced distinctiveness claim, I rely on the summary of the opponent's evidence that I provided in paragraphs 27-34 above. I remind myself that I found evidence of use in relation to only some of the services, namely *organising, managing, conducting and hosting of award ceremonies in relation to leisure travel* and *presentation and granting of awards in relation to leisure travel.*

[11] *Formula One Licensing BV v OHIM,* Case C-196/11P

84. As previously stated, the opponent claims that it has used its mark in relation to its services since 2008. Whilst no turnover figures have been provided, it is claimed that the opponent has spent approximately £290,000 a year on advertising and has done so since 2008[12]. The evidence supporting this appears to only cover the years 2017 to 2020 as I note that the opponent has provided printouts from their website about their advertising campaigns for these years only. The evidence shows that coverage of the awards has appeared in several national and local newspapers.

85. Although I note the opponent's assertions that the British Travel Awards are the largest poll of consumer on who are the best companies operating in leisure travel, there is little in the way of evidence to support this. The number of attendees to the award ceremonies has been at most 950 individuals from the travel industry. In terms of wider coverage, in the opponent's printouts of its YouTube page it is shown that the most popular video has amassed 20 views in total. I consider these numbers to be minimal and I am unable to ascertain how many of the views would have been from within the UK. Further, I remind myself that the number of public voters for the years 2018, 2019 and 2020 are 334,522, 402,734 and 132,000 people respectively. I am not convinced that these numbers would account for a significant proportion of the relevant public.

86. While the evidence provided was sufficient to demonstrate genuine use of the opponent's mark, I remind myself that the test for enhanced distinctiveness is considerably more onerous. Taking into account the shortcomings in the opponent's evidence, I am not willing to find that the distinctiveness of the mark has been enhanced beyond the inherent position. To confirm, the inherent position applies, namely that the opponent's mark possesses a low degree of distinctive character.

Likelihood of confusion

87. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors

[12] See para 17 of the first witness statement of Lorraine Barnes Burton

need to be borne in mind. One such factor is the interdependency principle, i.e., a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be mindful that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

88. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis K.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

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

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

90. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the

average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

91. Earlier in this decision I concluded that:

- The parties' respective services are identical or at least similar to a very low degree;

- The average consumer will consist of both the general public and professionals who will pay at least a medium degree of attentiveness during the selection process;

- The purchasing process will be predominantly visual in nature, though aural considerations will not be discounted;

- The earlier mark has a low degree of inherent distinctive character which has not been enhanced through use;

- The earlier mark is visually similar to the contested mark to a low degree;

- The earlier mark is aurally similar to the contested mark to a medium degree;

- The earlier mark is conceptually similar to the contested mark to a medium to high degree.

92. The only elements shared between the respective marks are the words "British" and "Awards". Although I considered that this renders the marks conceptually similar to a medium to high degree, I found earlier in my decision that visual considerations would dominate the purchasing process. I also found these elements to be low in inherent distinctive character in relation to the services which points away from confusion. There is a clear difference in the marks when taking into account their overall get-up and in this case, I find that these differences will not go unnoticed. I do not find that the opponent's mark will be mistaken for the applicant's even for the

services that I have found to be either highly similar or identical. As such, I do not consider there to be any likelihood of direct confusion.

93. I now go on to consider indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).
>
> (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example.)

94. These examples are not exhaustive but provide helpful focus.

95. I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.[13] The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a “proper basis” for finding indirect confusion.[14]

96. As previously stated, I note that the respective marks overlap through use of the words “British” and “Awards” and the fact that the I have found some of the respective services to be similar to a high degree or identical is a factor weighing in the opponent’s favour. Nonetheless, I have carefully considered if the marks may be perceived as a sub brand or brand extension of one another, or for them to be considered to represent economically linked undertakings and I can see no logical reason for this. Earlier in my decision, I found that the shared element in both marks contributed to the earlier mark possessing a low degree of inherent distinctive character. With this in mind, I find that should the consumer notice the common element shared between the marks, they would regard this as a coincidence. Accordingly, I see no reason why the average consumer would believe that the marks originate from the same or economically linked undertakings. I therefore do not consider there to be a likelihood of indirect confusion.

97. The opponent’s section 5(2) ground fails.

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[13] *Duebros Limited v Heirler Cenovis GmbH,* Case BL O/547/17

[14] *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

Section 5(4)(a) of the Act

98. The other ground of opposition is under section 5(4)(a). Under this ground, the opponent relies upon its unregistered right "The British Travel Awards". The opponent pleads that the mark has been used throughout the UK since as early as 2003 in relation to the following goods and services:

> Printed matter; stationery; books; brochures; magazines; photographs; posters; newspapers and periodicals.
>
> Entertainment services relating to the travel industry; organising, managing, conducting and hosting of award ceremonies; presentation and granting of awards; production and presentation of shows and performances; advisory, consultancy, information and management services relating to all the aforesaid services.

<u>Legislation</u>

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

> "(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-
>
> > (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
> >
> > (aa) […]
> >
> > (b) […]
>
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

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

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

General principles

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

> "55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.
>
> 56. In relation to deception, the court must assess whether *"a substantial number"* of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

102. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

> "Establishing a likelihood of deception generally requires the presence of two factual elements:
>
> (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation[1] 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 indicium 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 two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which 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 claimant and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the claimant;

(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 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."[15]

[15] Para 636, with footnotes omitted

Relevant Date

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

> "43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:
>
> > 'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.' "

104. As the applicant's mark does not have a priority date and there is no evidence that the applicant's mark was used prior to the application date, the relevant date for assessment of the opponent's claim under section 5(4)(a) of the Act is the date of the application for registration, being 25 March 2021.

Goodwill

105. The first hurdle for the opponent is that it needs to show that, at the relevant date, it had the necessary goodwill in its business and that the sign relied upon was distinctive and/or associated with that goodwill. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

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

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

> "27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent that the enquiry under s.11 of the 1938 Act (see Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.
>
> 28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur."

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

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

108. I have given consideration to the opponent's evidence in respect of its trading activities previously throughout this decision, namely in considering genuine use and enhanced distinctiveness. Though I note this assessment was in relation to the opponent's registered composite mark, the evidence previously referred to also includes use of the words "The British Travel Awards". The case law surrounding passing off claims set out that small businesses which have more than a trivial goodwill can protect signs which are distinctive of those businesses under the law of passing off even though the goodwill and reputation may be small.[16] On that basis, I am satisfied that the opponent has shown that it had a protectable goodwill at the relevant date for *organising, managing, conducting and hosting of award ceremonies in relation to leisure travel; presentation and granting of awards in relation to leisure travel.*

Misrepresentation

109. The relevant test was set out by Morritt LJ in *Neutrogena Corporation & Anor v Golden Limited & Anor* [1996] RPC 473 at [493]:

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

[16] *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590

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

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

110. Although the test for misrepresentation is different from that for likelihood of confusion in that it entails “deception of a substantial number of members of the public” rather than “confusion of the average consumer”, it is unlikely, in the light of the Court of Appeal’s decision in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, that the difference between the legal tests will produce different outcomes. I believe that to be the case here. I accept that the words “British” and “Awards” in both the earlier sign and the contested mark will not be overlooked and are identical, however, they are of no (or low) distinctive character due to their descriptive nature i.e., they describe (or at least heavily allude to) goods and services that cover award ceremonies and the granting of awards relating to British travel and tourism. On this point, I bear in mind the case of *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* [1946] 63 RPC 39 wherein Lord Simonds found that the differences between *Office Cleaning Services* and *Office Cleaning Association* were sufficient to preclude a finding of misrepresentation between those signs. In that case, the differences were ‘Services’ and ‘Association’, which themselves are not particularly distinctive elements. In my view, the public will assume that the presence of the words “British” and “Awards” in both the earlier sign and the contested mark is a reflection of its allusiveness and will not be deceived.

111. The section 5(4)(a) ground fails.

CONCLUSION

67. The opposition has failed. Subject to any successful appeal, the application will proceed to registration in the UK for all the specified goods and services.

COSTS

68. The applicant has been successful in this case and is therefore entitled to a contribution towards its costs. Awards of costs in proceedings commenced on or after 1 July 2016 and before 1 February 2023 are governed by Annex A of Tribunal Practice Notice ('TPN') 2 of 2016. Using that TPN as a guide, I award the applicant the sum of £700 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side's statement:	£200
Preparing evidence and considering other side's evidence:	£500
Total:	**£700**

69. I therefore order Konawood Limited to pay the sum of £700 to Omnicom Holdings Ltd. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 27th day of July 2023

Catrin Williams
For the Registrar