

O-083-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2522369
TO REGISTER THE TRADE MARK**



BY DAVID LLOYD RESORTS

**AND IN THE MATTER OF APPLICATION NO 2553085
TO REGISTER THE TRADE MARK**

DAVID & JOHN LLOYD RESORTS

BY JULIA WRIGHT AND DAVID LLOYD

AND

**THE CONSOLIDATED OPPOSITIONS THERETO
UNDER NOS 99948 AND 101378**

**BY
DAVID LLOYD LEISURE LIMITED**

Background and pleadings

1. David Lloyd Resorts applied for a trade mark (number 2522369) on 29 July 2009:



For:

Class 35: *Advertising of holiday homes and apartments; organisation of exhibitions for commercial or advertising purposes.*

Class 36: *Insurance services relating to the purchase and ownership of overseas property; arranging of finance and loans; real estate agency, brokerage and management; leasing and rental of accommodation; information and advisory services relating to the above services.*

Class 39: *Transport of passengers by road; arranging the transport of passengers; travel agency services for booking transport by air, sea or road; tour agency services; booking agency services for travel; conducting of sightseeing; car rental; information and advisory services relating to the above services.*

Class 41: *Entertainment and instructional services, all provided for holiday makers; provision of sports and recreational facilities; organising of entertainment, sporting events and of competitions; ticket reservation services for entertainment events; arranging and conducting of conferences; information and advisory services relating to the above services.*

Class 43: *Hotel, restaurant, bar and catering services; temporary accommodation services; providing facilities for conferences; services arranging lodging at holiday camps; rental and leasing of holiday apartments and accommodation; travel agency services for booking accommodation; information and advisory services relating to the above services.*

2. The application was published for opposition purposes on 2 October 2009.

3. Julia Wright and David Lloyd applied for the trade mark DAVID & JOHN LLOYD RESORTS (number 2553085) on 15 July 2010 for the following services¹:

Class 36: *Insurance, financial affairs, monetary affairs, mortgage arrangement, real estate affairs, information services related to finance and insurance, asset management, property investment, investment services, rental of property, rent collection, provision of real estate for restaurants and retail, financial services related to property and land estate management, provision of housing accommodation,*

¹ There are several spelling mistakes within the specifications, but I have reproduced them verbatim to remain faithful to the record (the register of trade marks).

financial services, financing services, consultancy and information services related to the aforesaid.

Class 37: Property and real estate development; development of mixed use communities including business, housing, retail and hotels; repair and installation services all relating to property and real estate; property and housing maintenance; property improvement services.

Class 39: Porter and consierge services, booking of travel, consultancy and advisory services related to the aforesaid.

Class 41: Providing of training, sporting and cultural activities, including football and tennis academies; leisure facilities for resorts, hotels, main residence and holiday homes.

Class 42: Construction and design services; architectural, survey and planning services related to real estate and property development: inspection of buildings; interior design services; feasibility studies, construction and planning for real estate; advisory consultancy and information services relating to the aforesaid.

Class 43: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; creche services.

Class 44: Spas and beauty services for resorts, hotels and holiday homes.

4. The application was published for opposition purposes on 8 October 2010.

5. Both the above applications were opposed by David Lloyd Leisure Limited (“the opponent”). It became clear from the pleadings and the defence that Mr David Alan Lloyd, one of the joint applicants for DAVID & JOHN LLOYD RESORTS, is also the controlling mind behind the composite trade mark application (2522369). The two oppositions were consolidated, but not until after the opponent had filed evidence on the first opposition (the composite mark). The opponent stated that it also wished its evidence to stand for its opposition against the word only mark. Unfortunately, it is less clear whether the evidence filed by the applicants (or their representative) is also meant to stand for both oppositions. There are also gaps and anomalies in the counterstatements, when viewed alongside one another, as I shall set out below.

6. The opponent relies upon sections 3(6), 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) for both oppositions. The notices of opposition run to ninety pages apiece. The opponent relies upon twelve earlier registrations for the section 5 grounds, some of which are subject to proof of use because they had been registered for five years or more at the time when the applications were published. I have set out as an annex to this decision the earlier rights, the services relied upon and, where relevant, those which are subject to the proof of use requirements. In essence, the opponent pleads that there would be a likelihood of confusion owing to the similarity of the parties’ marks and the identical or similar services (section 5(2)(b)), and that the applicants’ use of the trade mark applications would take unfair

advantage of the opponent's reputation in its earlier marks or be detrimental to their distinctive character and reputation (section 5(3)).

7. Section 3(6) states:

“3.— (6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

The opponent pleads:

“8. The individual David Alan Lloyd, now a director and majority shareholder of the Applicant company [in relation to the composite trade mark application], concluded a Deed Relating to the David Lloyd Name (the “Name”) with the Opponent (then in its former status as a public limited company and prior to its subsequent re-registration as a private limited company) (the “Company”) on 3 March 1993. Pursuant to this Deed, and to the extent not already owned by the Company, David Alan Lloyd assigned to the Company any goodwill he owned in the Name in connection with the Business of the Company (as defined in the Deed).

9. David Alan Lloyd also undertook that he would not, during the term of the Deed, under the Name, carry on or be in anyway interested in or concerned or connected or associated with Sports Clubs (as defined) nor any business or activity for the time being carried on under or by reference to the Name by the Company or a member of its group (provided the Company was not in breach of the Deed by carrying out such business or activity). This was with certain exceptions including that he may continue to use his own name in connection with undertaking professional tennis as a player; personal one to one tennis coaching; and the running of a tennis coaching school for young tennis players intending to become professional tennis players. The Deed is still in force and the Applicant was not therefore entitled to file the Applicant's mark which we submit was therefore filed in bad faith.”

This is taken from the statement of case for the composite trade mark application. The pleading under section 3(6) for the opposition against the word only trade mark application is materially the same, save for the fact that David Alan Lloyd is one of the joint applicants for the word only trade mark.

8. David Lloyd Resorts, the applicant for the composite mark, filed a counterstatement via its trade mark attorneys, Central England Patent & Trademark Attorneys. The counterstatement requested that class 41 be deleted. For reasons which are unclear, this deletion was never performed by the Trade Mark Registry, but it is explicit and therefore I will treat the class 41 services as deleted from the application. The counterstatement also requested that the opponent provide proof of use for all services on which it had claimed to have used its marks. The vast majority of the counterstatement deals with this point and the consequences for the opponent if it cannot rely upon its earlier marks. In relation to reputation, the applicant states that any reputation that the opponent may have is as a result of identification with Mr David Lloyd, “who is the internationally well known tennis celebrity and original founder of the Opponent's Sports Clubs and gymnasiums”.

There is no explicit denial of the grounds of opposition, but the last paragraph of the counterstatement states:

“11 The Applicant seeks the following remedies:

- (a) total rejection of the opposition except in so far as concerns the deletion of Class 41;
- (b) registration of the mark in suit with the deletion of class 41;
- (c) an award of costs and damages”.

Nothing is said in the counterstatement about the likelihood of confusion; only whether or not the opponent is able to rely upon its earlier marks. Nothing at all is said in response to the allegation of bad faith, the basis of which was made clear in the notice of opposition. Notwithstanding the applicant’s silence about the specific grounds of opposition, I will take its bare statement that the opposition should be rejected in totality as a denial of the grounds. In relation to point (c), the Registrar has the power to award costs, which are based on the published scale², but has no jurisdiction in relation to damages.

9. Julia Wright and David Lloyd filed a lengthy counterstatement in relation to the application for the word only trade mark, via the same trade mark attorneys. This time the counterstatement dealt extensively with Mr David Lloyd’s career history and a denial of the section 3(6) ground. In paragraph 36, the applicants state:

“For the avoidance of doubt the Applicant has no intention, and does not seek, to protect the Class 41 service of running sports clubs in the UK because of the provisions of the Name agreement”.

This could be interpreted as there being no intention to use the mark on some of the services applied for, given the wording of the class 41 specification; however, paragraph 30 of the counterstatement proposes limiting the class 41 specification by adding the words “other than the business of running sports clubs in the UK” because the applicants deem this to be permissible under the terms of the Deed. I will come back to this later in the decision.

10. The applicants request that the opponent provide proof of use of “all goods [there are no goods, only services] that allege to conflict with the Applicants goods and services other than Class 41 services of running Sports Clubs in the UK”. The applicants state, at paragraph 29:

“For the avoidance of doubt, the Applicant wishes to make it clear that they have not challenged, and do not challenge, the validity of the opponent’s Class 41 specification of services that are restricted to the business of running sports clubs in the UK because to do so would breach the Name Agreement”.

² Tribunal Practice Notice 4/2007.

11. The applicants state that the opponent's claim that they are similar is based upon an erroneous dissection of the applicants' mark. The applicants state that any reputation that the opponent may have is as a result of identification with Mr David Lloyd.

12. At the same time as the applicants filed their counterstatement in the word only opposition, they also filed a witness statement from Keith Leaman, their attorney at Central Patent and Trademark Attorneys. The witness statement attached a copy of the Deed, referred to later in this decision. Correspondence from the Trade Mark Registry before the counterstatement was filed indicated that, once it was filed, the proceedings would be consolidated. However, Mr Leaman's witness statement was headed only for the proceedings in relation to the word only mark and no confirmation was received that it should stand for both oppositions. The witness statement addresses only the Deed, which was only explicitly referred to in the counterstatement in relation to the second (word only mark) opposition (as a defence against the bad faith ground). This is an untidy state of affairs. Given that the proceedings were formally consolidated, I have decided to treat Mr Leaman's evidence as being filed in respect of both oppositions. The only ground it goes to is section 3(6). Mr Leaman made a number of factual assertions in the counterstatements with the claim that evidence would be filed to substantiate the assertions, such as the fame of Messrs David and John Lloyd; correspondence confirming that the opponent was aware of their business activities; and evidence showing the opponent's consent to Mr David Lloyd's use of his trade marks. No such evidence was filed by the applicants.

13. At the conclusion of the evidence rounds, the Trade Mark Registry recommended that the parties attend a hearing in order for them to make oral submissions in relation to the substantive grounds. Neither party availed themselves of the opportunity and only the opponent filed written submissions in lieu of a hearing. By this point in time, the applicants in both sets of consolidated proceedings were representing themselves. I make this consolidated decision, dealing with both applications, after a careful consideration of all the papers filed.

Evidence

14. The opponent's evidence comes from Ian Harris, who is the opponent's Group Finance director. Mr Harris has filed two witness statements.

Ian Harris' first witness statement

15. Mr Harris states that the opponent was founded by David Alan Lloyd in 1981, when the first club was opened, with a particular emphasis on racquet sports. He states that Mr Lloyd played professional tennis in the 1970s and 1980s. Mr Harris states that the goodwill associated with the David Lloyd name is associated with the opponent as a result of its use by the opponent, rather than by association with David Lloyd as a tennis player whose reputation, Mr Harris states, "lies in the past". Mr Harris states:

"On 3 March 1993, David Alan Lloyd concluded a Deed relating to the David Lloyd Name. Among other things, in the Name Deed David Alan Lloyd

acknowledged that in carrying on the business under or by reference to the Name (“DAVID LLOYD” in all its forms) since October 1982 the Company had generated the goodwill attaching to the Name in connection with the Business. For the avoidance of doubt, if and to the extent that David Alan Lloyd was the owner of any goodwill in the Name in connection with the Business, in the Name Deed he assigned to the Company any goodwill he owned in the Name in connection with the Business of the Company”.

16. Mr Harris states that the conclusion of the Deed relating to the use of the David Lloyd name, which assigned to the opponent any goodwill which David Lloyd owned in the name, means that Mr Lloyd undertook that he would not,

“...during the term of the Deed, under the Name, carry on or be in any way interested in or concerned or connected or associated with Sports Clubs (as defined) nor carry on any business or activity for the time being carries on by the Company under or by reference to the David Lloyd name. David Alan Lloyd is a director and majority shareholder of the Applicant³ company and the Applicant is therefore bound by the terms of the Name Deed.”

17. The deed is exhibited at IH21 and is the subject of a confidentiality order under rule 59 of the Trade Marks Rules 2008 (“the Rules”). Consequently, I will not summarise it here, but will deal with its contents in the redacted part of this decision.

18. By 1995, there were 18 clubs and at the date of Mr Harris’ statement (4 January 2011), there were 76 clubs in the UK and 10 clubs in Europe. Mr Harris states that there are 450,000 members (this appears to be the UK figure), employing 6,000 staff, 750 of whom work in the expert health and fitness team. The opponent manages more than 350 tennis professionals. There are 12,500 exercise machines, over 150 swimming pools, 10,000 exercise classes per week, 700 tennis courts, 180 badminton courts, 140 squash courts, restaurants, bars, spas, lounges, crèches, nurseries, sports shops, meeting facilities, accommodation and holiday camps. Exhibit IH2, which is subject to a confidentiality order under rule 59 of the Trade Marks Rules 2008, shows that the opponent has a large share of the UK leisure club market:

(This part of the decision is redacted.)

19. Mr Harris gives turnover figures for the services supplied under the trade mark DAVID LLOYD (he does not differentiate between the various forms of the mark) dating back to 1981. The UK figures for the period since 2001 to the year of application of 2522369 (2009) are:

2001/2	£148,141,000
2002/3	£167,663,000
2003/4	£184,223,000
2004/5	£192,096,000
2005/6	£195,955,000

³ At the time of Mr Harris’ statement, the evidence was in support only of opposition number 99948, but was later adopted for consolidated opposition number 101378.

2006/7	£205,613,000
2008 ⁴	£213,301,000
2009	£263,153,000

20. In 2008, the opponent spent £7.1 million on promoting DAVID LLOYD services. Sample invoices⁵ in relation to corporate membership subscriptions, hotel accommodation, conferences, bar tabs and restaurant services in 2008 are headed with the trade mark:



21. Sample promotional material from the years 2005 to 2009 (exhibits IH6 and 7) show the above composite mark, the signature⁶ mark and the plain word mark DAVID LLOYD in relation to sports injury and rehabilitation clinics, exercise and healthy living classes, leisure and sports club membership, and children's school holidays activities. It is not clear where these advertisements were placed, whether they are mailshots or inserts to go inside magazines or newspapers, or whether they are information leaflets which were available upon visiting the clubs for information. In relation to children's school holiday activities, there is limited use shown in exhibit IH12, where the branding is "DL KIDS". Children's/youth soccer training is also shown under the composite mark, but this does not appear to be as part of a school holiday 'camp', because the hours shown indicate that it is an after school or evening activity. Exhibit IH13 shows information about junior tennis, squash and badminton coaching and dance classes. There is also information about adult sports coaching provided under the composite mark.

22. Mr Harris states that all the clubs offer facilities for the provision of food and drink to its members and that, additionally, the Belfast club has a restaurant open to non-members. Exhibit IH8 includes wine lists and menus which bear the composite trade mark. Catering is also a feature of the opponent's conference and meeting room rental facilities⁷ and Mr Harris states that the opponent offers hotel accommodation at its clubs in Eastbourne (since 1994), Hatfield and Dudley (the latter two being branded DAVID LLOYD since 2008). The turnover figures for hotel services for 2008 and 2009⁸ were £113,000 and £408,000, respectively.

23. In relation to 'credit services' supplied under the DAVID LLOYD marks, Mr Harris states that the opponent operates what he calls "cashless clubs" in Finchley

⁴ The figures for 2008 onwards are calendar year figures, as opposed to financial year figures.

⁵ Exhibit IH5, which is confidential for personal data protection reasons.

⁶ Although I refer throughout the decision to this mark as a signature mark, it does not, in fact, look very much like David Lloyd's signature which appears on a copy of the Name Deed, filed by the opponent.

⁷ Exhibit IH14.

⁸ Exhibit IH10.

and Exeter, where members can use their membership cards as credit cards and settle bills at the end of each month. He exhibits (IH11) a copy of the direct debit and credit agreement for the scheme.

24. In general support of the opponent's reputation, Mr Harris exhibits "Google Analytics" which he states demonstrate that web users entering DAVID LLOYD into the Google search engine are searching for the opponent⁹. The figures represent the number of unique visits to the opponent's website after typing David Lloyd (and variations thereof) into Google. There were 5,914,326 visits in 2009, of which 2,392,329 were unique visits. Mr Harris also exhibits¹⁰ statements from The Lawn Tennis Association, Fitness Industry Association, England Squash & Racketball, Badminton England, Asquith Day Nursery and The Leisure Database Company which he states attest to the goodwill and well-known character of the opponent. These 'statements' are in the form of 'To whom it may concern' letters. Fiona Young, from Badminton England, refers to the opponent as one of the top leisure providers in the UK. Adam Sage, from Asquith Day Nurseries, refers to his company operating day twenty-three nurseries at David Lloyd Leisure clubs across the UK. Mr Harris also refers to the opponent's external sponsorship arrangements with sporting personalities which he says help to raise the opponent's profile. Exhibit IH18 shows the front cover of "Health Club" magazine from 2003 with Sir Steve Redgrave holding what appears to be a flag bearing the opponent's trade mark in its signature form. An undated swing tag advertising cycling classes has a photograph of Sir Chris Hoy, in addition to the words David Lloyd Leisure and the composite mark. A sheet with "Andy Murray in club comms July 2006" handwritten in the corner shows a picture of the tennis player and "We are delighted to announce our sponsorship of the brightest new star of British Tennis – Andy Murray", although Mr Murray's shirt shows RBS and Robinsons as sponsors.

25. Mr Harris refers to the applicant's proposed activities, which he states are the provision of fractional ownership in holiday resorts which include sports and leisure facilities, and exhibits evidence relating to other providers of such facilities in order (Mr Harris says) to demonstrate that holiday resorts are similar services to the opponent's services because they operate leisure facilities.

Ian Harris' second witness statement

26. A good deal of Mr Harris' second witness statement (dated 16 April 2012) relates to the confidential Name Deed. I will therefore deal with this aspect of the witness statement in the redacted part of this decision.

27. The remainder of the witness statement concerns the opponent's evidence that there has already been confusion between the parties on the part of the public and/or the taking of unfair advantage and/or detriment to the distinctive character of the opponent's trade marks by the applicants. Mr Harris cites pages 384, 387-9, 391 and 395 of exhibit IH26 as examples of the applicants engaging in free-riding and dilution because the content implies that the applicants and the opponent are the same or from an economically linked undertaking. On page 384, there is a property

⁹ Exhibit IH15.

¹⁰ Exhibit IH7.

advert for apartments in Cyprus, parts of which have been underlined by the opponent:

“DAVID LLOYD OLYMPIA SPA RESORT David Lloyd is the founder of DAVID LLOYD Leisure, the world’s leading Leisure Empire...The fact that Olympia Spa Resort is under the umbrella of David Lloyd resorts is validation of its high standards both in the level of facilities and the development in general.”

The parts which the opponent has not underlined include “David himself personally operates “DAVID LLOYD Resorts”.

28. Page 387, relating to properties in Morocco, includes (the opponent’s underlined parts):

“The David Lloyd brand is one of the most well known in the leisure industry...The David Lloyd name ensures that the resorts are also complemented by...leisure facilities, including restaurants, pools, fitness, golf, tennis and spa facilities...David Lloyd leisure resorts...a David Lloyd managed resort”.

29. Page 389, which bears the trade mark the subject of application 2522369, and which looks ahead to the launch of the David Lloyd Resort in summer 2009:

“As I launched my first tennis and fitness club in the early eighties, some thought it exclusive and that the concept would have limited appeal. 20 years on and a network of clubs throughout the UK, Continental Europe and Australia, illustrate that people are quick to recognise a great idea.

Welcome to a new type of David Lloyd Membership, The Resorts Club, a way to enjoy my legendary facilities and services abroad. A David Lloyd Resort offers you a chance to holiday in fully managed 5 star property...The David Lloyd name ensures the resorts are also complemented by outstanding residents’ leisure facilities, including restaurants, pools, fitness, golf, tennis and spa facilities.”

30. Page 391, which is from the website fractionallife.com, and looks ahead to the first fractional ownership David Lloyd Resort opening in 2010, in Morocco:

“The resort will open in 2010 and offer fractional ownership, luxury build standards and leisure services that are associated with the David Lloyd brand.”

31. Page 395 is from a website named premierresorts.info under “Coming Soon”:

“David Lloyd famous for the health club chain in the UK is soon to launch part ownership options at a number of luxury resorts worldwide...with a variety of leisure facilities such as spa treatments, fitness area, tennis, golf, skiing, water sports and children’s activities.”

32. Mr Harris exhibits, at IH27, a print from a Facebook page about the David Lloyd Olympia Luxury Spa Resort. This is dated January 2011. The chairman of the Cyprus-base development company responsible for operating the resorts is quoted as saying:

“We are proud to be operating these resorts under an exclusive agreement with David Lloyd who is the world’s leader in leisure.”

33. Mr Harris states that in October 2010, he was approached by a businessman named Antonio R Arce from Grupo Resco in Spain who had read an article in the *Financial Times* regarding the opponent. Mr Harris states that Mr Arce mistakenly believed that David Alan Lloyd was from the same or an economically linked undertaking to the opponent and that his approach to Mr Lloyd was as a result of this misunderstanding. Exhibit IH28 is a copy of an email from Mr Arce to Mr Harris about the misunderstanding; the opponent has highlighted the part which says:

“The reason we contacted Mr Lloyd, believing he was then DLL, was because we thought that there is plenty of synergies between a fitness club and our hotel project.”

Later in the email, Mr Arce said:

“Answering your second paragraph, I am not confused, I know that David Lloyd and DLL, are not related in any way, that’s why I terminated any professional relation with Mr. Lloyd, before getting in touch with your company.”

34. Mr Harris exhibits correspondence¹¹ during 2010 from an individual in relation to a joint venture between Mr Lloyd and Absolute Group to develop a resort in Thailand featuring a sports complex. Mr Harris states that the individual is confused that Mr Lloyd is economically connected to the opponent. Exhibit IH30 is a copy of an email from trade mark attorneys acting on behalf of Mr Lloyd in Montenegro chasing payment of invoices addressed to David Lloyd Branding Limited, a company in which Mr Lloyd is a majority shareholder. Mr Harris states that the Montenegrin attorneys were confused that Mr Lloyd is from the same or from an economically linked undertaking to the opponent.

35. The opponent has also filed a witness statement (dated 15 August 2012) from Mary Broughton, a trade mark attorney at Withers & Rogers LLP, who are the opponent’s professional representatives in these proceedings. Ms Broughton’s evidence refers to two opposition proceedings brought by the opponent against David Lloyd Branding Limited before the Office for Harmonisation in the Internal Market (OHIM) concerning the latter’s Community trade mark applications, for DAVID LLOYD and the mark the subject of application number 2522369. Ms Broughton exhibits copies of OHIM’s decisions, which were upheld in classes 36, 39, 41, 43, 44 and for concierge services (class 45) under Article 8(1)(b) of the Community Trade Mark Regulations and for personal and social services in class 45 under Article 8(5), on the basis of unfair advantage. The opponent has appealed

¹¹ Exhibit IH29.

against OHIM's rejection of the oppositions in relation to class 37. It is unnecessary to go into details here, but I will refer to them if it becomes pertinent.

The applicants' evidence

36. The applicants' evidence comes from Keith Leaman, of Central England Patent and Trademark Attorneys, the applicants' representatives in these proceedings up until the conclusion of the evidence rounds. Mr Leaman has filed a witness statement dated 29 September 2011. Attached to his statement are two exhibits: KL1 and KL2. KL1 is a copy of the Name Deed; KL2 is a letter which incorporates amendments to the Name Deed. Both these exhibits were also filed by the opponent as exhibit IH21, which was ordered by the Registrar to be kept confidential (to be available only to the parties and their professional advisors in the proceedings). Mr Leaman asked¹², in his capacity as the applicants' trade mark attorney, that his witness statement be kept confidential "because of the commercial information it contains". The Trade Marks Tribunal did not accede to the request. Mr Leaman's witness statement deals only¹³ with matters pertaining to the Name Deed. Therefore, the refusal to grant confidentiality to the same exhibits, and a witness statement dealing only with those exhibits, undermines the confidentiality order obtained by the opponent with respect to its exhibit. Therefore, I will treat as confidential Mr Leaman's statement and exhibits KL1 and KL2, under rule 58(3(d) of the Trade Marks Rules 2008¹⁴. I will deal with Mr Leaman's evidence and the content of the Name Deed in the redacted part of this decision.

Decision

Section 3(6)

37. The law in relation to section 3(6) of the Act ("bad faith") was summarised by Arnold J in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch):

"130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, "Bad faith in European trade mark law" [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see Case C-

¹² Covering letter to the counterstatement, dated 10 October 2010.

¹³ With the exception of a brief submission relating to whether the opponent has made use of its earlier marks and a claim that the opponent's marks should be assigned to Mr David Lloyd.

¹⁴ Rule 58(3) states: "(3) The right of inspection under paragraph (1) does not apply to—

...(d) any document received by the Office which the registrar considers should be treated as confidential;"

529/07 *Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and Case C-192/03 *Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade*

Mark (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48)."

The Name Deed (exhibits IH21, KLI and KL2 of the parties' evidence)

(This part of the decision is redacted.)

74. The section 3(6) ground succeeds against 2522369 and 2553085: both applications were made in bad faith in respect of all the services.

Other grounds

75. In case I am found to be wrong in my findings under section 3(6), I will go on to consider the grounds under section 5 of the Act, beginning with section 5(2)(b) which 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.”

The leading authorities which guide me in relation to section 5(2)(b) of the Act 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*.

Average consumer and the purchasing process

76. 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 opponent's services are provided to the general public who will pay a reasonable amount of attention to the selection of somewhere to eat or play sport, but not the highest degree of attention. In relation to sports teaching and academy services, the choice of provider will engage a closer level of attention. The applicants' services are diverse. Some will be for the general public in the same manner as those relied upon by the opponent. Other services purchased by the public will be subject to closer scrutiny, such as the choice of holiday accommodation, financial services and ownership of overseas property. Some of the applicants' services will be provided to businesses or organisations rather than to the general public; such as, organisation of exhibitions for commercial or advertising purposes, and arranging, conducting, and providing facilities for conferences. The level of attention of the average consumer for these services is likely to be high because of the commercial importance to the purchasing consumer. Whilst there is potential for aural use of the marks during the purchasing process, such as in discussions and personal recommendations, the purchasing choice will be predominately visual, for example, via the perusal of advertisements, websites, literature, testimonials and written proposals.

Comparison of services

77. The opponent relies upon twelve earlier rights, several of which are subject to proof of use (mainly its older UK registrations). CTM 7237944 (DAVID LLOYD signature mark):

David Lloyd

is not subject to proof of use and covers wider specifications in classes 41 and 43¹⁵ than the older registrations (for which there is a proof of use requirement). The CTM may be considered on the basis of notional and fair use across the width of its specifications. I will therefore make the comparison on the basis of this earlier mark rather than the older class 41 and 42 marks. CTM 488940 (word only DAVID LLOYD mark) is not subject to proof of use, but its class 41 and 43 specifications are narrower than for CTM 7237944. If the word only aspect of the mark alters the overall finding in relation to likelihood of confusion, I will refer to the word only DAVID LLOYD CTM 488970 as necessary at that stage of the decision. CTM 8905366 is pleaded only against application 2553085 DAVID & JOHN LLOYD. Only UK registration 2144719 (class 36) is relied upon in relation to the class 36 services of application 2522369. This registration is subject to proof of use. Finally, it will be remembered that the applicant for 2522369 deleted class 41 in its counterstatement and that the applicants for 2553085 proposed a limitation to their class 41 specification of “other than the business of running sports clubs in the UK” (see paragraph 9 of this decision).

78. 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.”

79. ‘Complementary’ was defined by the General Court (“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...”

80. 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 include an assessment of the channels of trade of the respective goods or services.

¹⁵ The services were reclassified from class 42 to class 43 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

81. Goods and services can be considered as identical when the good and services of the earlier mark are included in a more general category, included in the specification of the trade mark application; as per the judgment of the GC in *Gérard Meric v OHIM* Case T-133/05. Vice versa, if the goods or services of the application are included in a more general category included in the specification of the earlier mark, they must be identical.

82. 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.”

In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

"... 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."

83. I will consider the two applications separately, beginning with 2522369.

<p>CTM 7237944</p> 	<p>Application</p> 
<p>Class 41: Provision and operation of recreation and sports facilities; provision of teaching and coaching facilities for sports and recreational activities; sports training and teaching academies; organisation of sporting competitions; sport camp services; rental of sports equipment; rental of sports facilities; training; holiday camp services (entertainment).</p> <p>Class 43: Provision of food and drink; accommodation; hotel services; cafe, bar and restaurant services; holiday camp services (lodging); catering; rental of meeting rooms.</p>	<p>Deleted in counterstatement: Class 41: Entertainment and instructional services, all provided for holiday makers; provision of sports and recreational facilities; organising of entertainment, sporting events and of competitions; ticket reservation services for entertainment events; arranging and conducting of conferences; information and advisory services relating to the above services.</p> <p>Class 43: Hotel, restaurant, bar and catering services; temporary accommodation services; providing facilities for conferences; services arranging lodging at holiday camps; rental and leasing of holiday apartments and accommodation; travel agency services for booking accommodation; information and advisory services relating to the above services.</p>

84. I list below the services in the applicant's specification which are identical to services in the opponent's specification (in bold), either because the term is identical in wording or meaning, or because the services of one party fall within the ambit of a wider term featuring in the other party's specification.

(i) Hotel, restaurant, bar and catering services
hotel services; provision of food and drink; café, bar and restaurant services; catering.

(ii) temporary accommodation services
accommodation

(iii) providing facilities for conferences
rental of meeting rooms

(iv) services arranging lodging at holiday camps
holiday camp services (lodging)

(v) rental and leasing of holiday apartments and accommodation
accommodation

85. This leaves the applicant's "travel agency services for booking accommodation; information and advisory services relating to the above services". "Travel agency services for booking accommodation" are complementary to the service of providing accommodation, and share the same users and channels of trade. They are highly similar services. "Information and advisory services relating to the above services" stand or fall with the services to which they relate; they are 'parasitic' on the main services, which are identical or highly similar to the opponent's services, and so are themselves highly similar to the opponent's services.

86. In relation to Class 36 of the application:

<p>2144719</p> 	<p>Application</p> 
<p>Class 36: Credit services</p>	<p>Class 36: Insurance services relating to the purchase and ownership of overseas property; arranging of finance and loans; real estate agency, brokerage and management; leasing and rental of accommodation; information and advisory services relating to the above services.</p>

87. The earlier mark is subject to proof of use. Section 6(A) Act 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 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 period of five years ending with the date of publication.

(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 period of five years ending with the date of publication of the application 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(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.

(7) Nothing in this section affects—

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

88. The opponent has made a statement that it has used its earlier mark 2144719 on credit services. The onus is on the opponent to prove genuine use of its mark, in relation to credit services , because section 100 of the Act states:

“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.”

The relevant period during which genuine use of the mark must be shown is the five year period ending on the date of publication of the application, namely 3 October 2004 to 2 October 2009.

89. Ms Anna Carboni, sitting as the appointed person in, *PASTICCERIA E CONFETTERIA SANT AMBROEUS S.R.L. v G&D RESTAURANT ASSOCIATES LIMITED* [2010] RPC 28, summarised a set of principles from the following leading Court of Justice of the European Union (“CJEU”) cases on the issue of genuine use: *Ansul BV v AjaxBrandbeveiliging BV*, Case C-40/01, [2003] ETMR 85; *La Mer Technology Inc v Laboratoires Goemar SA*, Case C-259/02, [2004] FSR 38; and *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C-495/07, [2009] ETMR:

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

(2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(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, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating 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: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

90. An assessment as to whether there has been use of the mark on *credit services* which amounts to real commercial exploitation of the mark on the market for these services means that there must have been exploitation that is aimed at maintaining or creating an outlet for the services or a share in that market. That assessment must include consideration as to the nature of the opponent’s services and the characteristics of the market for credit services. In the opponent’s evidence, Mr Harris states that the opponent operates what he calls “cashless clubs” in Finchley and Exeter, whereby members can use their membership cards as credit cards and settle bills at the end of each month. He exhibits (IH11) a copy of the direct debit and credit agreement for the scheme. In its written submissions, the opponent says that the David Lloyd logo “is used in relation to credit services at the Opponent’s “cashless clubs” in Finchley and Exeter” and that the exhibit shows that the DAVID LLOYD logo is a “primary element of the branding of the related services literature and credit agreement”. Mr Harris also uses the word “operates” in the present tense without any reference to when such use began. The exhibit includes an undated flyer:

“Enjoy cash-free visits to the club with your membership card. Now you can enjoy the many benefits of being able to spend in-club on your membership card.

- No need to carry cash in the club
- Easy direct debit scheme to ensure you never miss a payment
- Never get caught short of go without that little extra
- No additional charges incurred
- Coming soon...cashless reward scheme – watch this space

Ask a member of staff or reception for details”

The mark relied upon is shown at the bottom of the flyer. The only other component of this exhibit is a direct debit form. There is no dating. The top of the form says “Finchley”. The top half of the form is shown below:

BB

DAVID LLOYD LEISURE LTD FINCHLEY

Member Name Membership No.



David Lloyd

This contract is between (member name) [Member] and David Lloyd Leisure Limited [the Company] and details the agreements between the parties in the Member using and the Company supplying a Club Charge Card.

1. The Member agrees to abide by terms and conditions of the scheme.
2. The Member agrees to pay on a monthly basis by direct debit, using the same bank account as that used for membership subscriptions all charges to their account for the previous month.
3. The Company agrees to supply a statement of charges incurred for every calendar month within five days of the next month and will collect the outstanding balance via direct debit on or after the fifteenth day of that month.
4. The Member agrees to report any lost or stolen cards to the club immediately.
5. The Company agrees to remove any credit on the Club Charge Card immediately upon being informed by a Member that their Charge Card has been lost or stolen.



91. It can be seen from the scanned exhibit above that there are clear spaces, represented by dotted lines, for filling in the member's name. There is also a dotted line after the words "Membership No." However, this has been obscured by a representation of the earlier mark relied upon. I am doubtful that the logo belongs on the form in this position because there is a clear intention that the dotted lines should carry the membership number, rather than the earlier mark. My observations on the opponent's evidence of use on credit services are:

- (i) Mr Harris' evidence and the opponent's written submissions both refer to the scheme in the present tense, without any indication as to when the scheme began;
- (ii) There are only two exhibits filed to prove use, and both of these are undated;
- (iii) One of the two exhibits appears flawed because the earlier mark clearly does not belong in that position.

92. One undated exhibit bearing the earlier mark is insufficient to prove use. The opponent has failed to establish genuine use of the trade mark in respect of credit services. Therefore, the opponent cannot rely upon the services in class 36 against application 2522369.

93. Moving on to application 2553085, CTM 7237944 is relied upon to attack all the services of the application under section 5(2)(b):

<p>CTM 7237944</p> 	<p>Application</p> <p>DAVID AND JOHN LLOYD RESORTS</p>
<p>Class 41: <i>Provision and operation of recreation and sports facilities; provision of teaching and coaching facilities for sports and recreational activities; sports training and teaching academies; organisation of sporting competitions; sport camp services; rental of sports equipment; rental of sports facilities; training; holiday camp services (entertainment).</i></p> <p>Class 43: <i>Provision of food and drink; accommodation; hotel services; cafe, bar and restaurant services; holiday camp services (lodging); catering; rental of meeting rooms.</i></p> <p>Class 44: <i>Hygienic and beauty care services; hairdressing; beauty salons; baths; massage; physical therapy; physiotherapy.</i></p>	<p>Class 36: Insurance, financial affairs, monetary affairs, mortgage arrangement, real estate affairs, information services related to finance and insurance, asset management, property investment, investment services, rental of property, rent collection, provision of real estate for restaurants and retail, financial services related to property and land estate management, provision of housing accommodation, financial services, financing services, consultancy and information services related to the aforesaid.</p> <p>Class 37: Property and real estate development; development of mixed use communities including business, housing, retail and hotels; repair and installation services all relating to property and real estate; property and housing maintenance; property improvement services.</p> <p>Class 39: Porter and consierge services, booking of travel, consultancy and advisory services related to the aforesaid.</p> <p>Class 41: Providing of training, sporting and cultural activities, including football and tennis academies; leisure facilities for resorts, hotels, main residence and holiday homes.</p> <p>Class 42: Construction and design services; architectural, survey and planning services related to real estate and property development: inspection of buildings; interior design services; feasibility studies, construction and planning for real estate; advisory consultancy and information services relating to the aforesaid.</p> <p>Class 43: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; creche services.</p> <p>Class 44: Spas and beauty services for resorts, hotels and holiday homes.</p>

94. CTM 8905366 is also relied upon to attack all of the services under section 5(2)(b); this CTM also covers class 36, unlike CTM 7237944. The remainder of the services covered by CTM 8905366 are identically worded (classes 41 and 44) or identical in terms of cover (class 43) to classes 41, 43 and 44 of CTM 7237944. The comparison of services between CTM 8905366 and the application is as follows:

<p>CTM 8905366</p> 	<p>Application</p> <p>DAVID AND JOHN LLOYD RESORTS</p>
<p>Class 36: Banking services; credit services; business account card services; charge card services; credit card services; debit card services; issue of tokens of value; voucher schemes; issuance of credit and debit cards; financial services; automated payment services; issue and redemption of tokens and vouchers.</p>	<p>Class 36: Insurance, financial affairs, monetary affairs, mortgage arrangement, real estate affairs, information services related to finance and insurance, asset management, property investment, investment services, rental of property, rent collection, provision of real estate for restaurants and retail, financial services related to property and land estate</p>

<p>Class 41: <i>Provision and operation of recreation and sports facilities; provision of teaching facilities for sports and recreational activities; sports training and teaching academies; organisation of sporting competitions; sport camp services; rental of sports equipment; rental of sports facilities; training; holiday camp services (entertainment).</i></p> <p>Class 43: <i>Provision of restaurant and catering facilities; provision of food and drink; accommodation; hotel services; cafe, bar and restaurant services; holiday camp services (lodging); catering; rental of meeting rooms.</i></p> <p>Class 44: <i>Hygienic and beauty care services; hairdressing; beauty salons; baths; massage; physical therapy; physiotherapy.</i></p>	<p>management, provision of housing accommodation, financial services, financing services, consultancy and information services related to the aforesaid.</p> <p>Class 37: Property and real estate development; development of mixed use communities including business, housing, retail and hotels; repair and installation services all relating to property and real estate; property and housing maintenance; property improvement services.</p> <p>Class 39: Porter and consierge services, booking of travel, consultancy and advisory services related to the aforesaid.</p> <p>Class 41: Providing of training, sporting and cultural activities, including football and tennis academies; leisure facilities for resorts, hotels, main residence and holiday homes.</p> <p>Class 42: Construction and design services; architectural, survey and planning services related to real estate and property development: inspection of buildings; interior design services; feasibility studies, construction and planning for real estate; advisory consultancy and information services relating to the aforesaid.</p> <p>Class 43: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; creche services.</p> <p>Class 44: Spas and beauty services for resorts, hotels and holiday homes.</p>
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95. Of the two CTMs, 8905366 is clearly the closer in relation to a comparison between the parties' class 36 services. The closest services of CTM 7237944 to the applicants' class 36 services are the opponent's class 43 *accommodation* services compared to the applicants' *provision of housing accommodation*. The opponent's accommodation services which fall in class 43 are temporary in nature, but could, notionally, include temporary housing, as well as the more obvious hotels and holiday accommodation. Although the applicants' provision of housing accommodation is different in nature and purpose to the opponent's cover for provision of holiday-type accommodation, the applicants' provision of housing accommodation services have a shared nature and purpose with the opponent's services in that they both cover housing services. Provision of temporary or rented housing accommodation, which is covered by the opponent's class 43 accommodation services may share channels of trade with and be in competition with the applicants' provision of housing services. The parties' services, insofar as the opponent's term accommodation covers arranging of temporary housing accommodation, are similar to a high degree.

96. The opponent's *financial services* on CTM 8905366 are identical to the applicants' *financial services* and, along with the opponent's wide term *banking services* encompass, and are therefore identical to, the following services in the applicants' class 36 specification:

Insurance, financial affairs, monetary affairs, mortgage arrangement, real estate affairs, provision of real estate for restaurants and retail, information services related to finance and insurance, asset management, property investment, investment services; financial services related to property and

land estate management, financial services, financing services, consultancy and information services related to the aforesaid.

97. This leaves the remaining services of the application in class 36 as *rental of property, rent collection, provision of housing accommodation, consultancy and information services related to the aforesaid*. These cannot be said to be financial or banking services in the ordinary and natural meaning of the term, as per *Avnet and YouView TV*. Their nature is different. The purpose of the services is to provide rented accommodation and to collect the rent. One would go to a property rental company or a private landlord for the accommodation and a landlord would use a property rental agent to collect the rent on his behalf. Therefore, the purpose and channels of trade are different to those covered by the opponent's services, including banking and financial services. The services are neither competitive nor complementary. There are no services in the opponent's class 36 specification of CTM 8905366, nor in the other classes covered by CTMs 7237944 and 8905366, which are similar to the applicants' *rental of property, rent collection, provision of housing accommodation, consultancy and information services related to the aforesaid*.

98. As the class 41, 43 and 44 specifications of the opponent's two CTMs (7237944 and 8905366) are identical (in wording and/or coverage), I will make a single comparison with the applicants' services in classes 37, 39, 41, 42, 43 and 44, but also comparing the class 36 services of CTM 8905366, which are not present in CTM 7237944. Paragraph 30 of the counterstatement proposed the addition (paragraph 9 of this decision) of the following limitation to class 41:

“other than the business of running sports clubs in the UK”.

Therefore, I will consider the applicants' class 41 specification with the addition of this limitation, which is an exclusion, although it may not, in fact, comply with the requirements set out in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] E.T.M.R. 57.

99. I list below the services in the applicants' class 41 specification which are identical to services in the opponent's class 41 specifications (in bold) in the two CTMs, either because the term is identical in wording or meaning, or because the services of one party fall within the ambit of a wider term featuring in the other party's specification.

(i) Providing of training and sporting activities, including football and tennis academies;

training; sports training and teaching academies

(ii) leisure facilities for resorts, hotels, main residence and holiday homes.

provision and operation of recreation and sports facilities; provision of teaching facilities for sports and recreational activities

(iii) providing of cultural activities

holiday camp services (entertainment)

All the class 41 services of the application are identical to the class 41 services of CTMs 7237944 and 8905366.

100. In similar fashion, the following services in the applicants' class 43 specification¹⁶ are identical to those in the opponent's class 43 specifications in the two CTMs.

(i) Services for providing food and drink; restaurant, bar and catering services;

provision of restaurant and catering facilities; provision of food and drink; cafe, bar and restaurant services; catering

(ii) provision of holiday accommodation; temporary accommodation; retirement home services;

accommodation; hotel services; holiday camp services (lodging)

101. This leaves *booking and reservation services for restaurants and holiday accommodation and crèche services*. A crèche is temporary care provided for very young children while their parents are, for example, shopping or using leisure club facilities. There do not appear to be any services within the opponent's class 43 specification which coincide in a meaningful way with crèche services. However, the opponent has cover in class 41 for *provision and operation of recreation and sports facilities*, which includes leisure clubs. Such places provide crèches for the members' children¹⁷ so that the members can use the facilities while ensuring that their children are looked after for the period of time they are at the club. There is a coincidence of trade channels and an element of complementarity. There is a moderate degree of similarity between the applicants' crèche services and the opponent's *provision and operation of recreation and sports facilities*.

102. In relation to the applicants' *booking and reservation services for restaurants and holiday accommodation*, I will look at the two types of booking service separately. Booking/reserving a restaurant table and restaurant services share some similarity of nature and ultimate purpose: one will phone a restaurant to book a table in order to dine out. There is an element of complementarity in that the booking service will not exist without restaurants to book; however, this may not extend to customers thinking that the responsibility for the restaurant service and a third party booking service lies with the same undertaking. There is a low degree of similarity between the opponent's *restaurant services* and the applicants' *booking and reservation services for restaurants*. However, the opponent's *accommodation; hotel services* are closer to the applicants' *booking and reservation services for holiday accommodation* because when one books a holiday, there is often no separation between the accommodation provider and the booking service, for instance, a travel agency or a chain of motels. The users and the trade channels are identical and there is complementarity in that 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 services lies with the same undertaking. There is a good deal of similarity between the services.

¹⁶ The class 43 specifications of the two applications are different.

¹⁷ The opponent's evidence shows that it does.

103. Turning to the applicants' class 44 services, its *spas and beauty services for resorts, hotels and holiday homes* are encompassed by the opponent's terms *hygienic and beauty care services; beauty salons* and so are identical.

104. The remaining classes of the application to be considered against the opponent's services are 37, 39 and 42.

105. Class 37: *Property and real estate development; development of mixed use communities including business, housing, retail and hotels; repair and installation services all relating to property and real estate; property and housing maintenance; property improvement services.*

These services are in two camps: property development (*Property and real estate development; development of mixed use communities including business, housing, retail and hotels*) and repair, installation and property improvement services (*repair and installation services all relating to property and real estate; property and housing maintenance; property improvement services*). There are no services in the opponent's class 41, 43 or 44 specifications which are similar to these services. In relation to property and real estate development, the opponent has cover for class 36 services in CTM 8905366, which includes the wide term *financial services*. "Financial services" encompasses property-related services such as mortgages, real estate services and property investment. A property developer is seeking to attract investment in the property being developed, such as a house-building company which will develop the site, and act as an estate agent and also a mortgage arranger for, e.g. first-time buyers. The users, method of use, channels of trade will be the same; there is both a complementary and a competitive aspect to the relationship between the services. There is a reasonable degree of similarity between them.

106. The other set of class 37 services, *repair and installation services all relating to property and real estate; property and housing maintenance; property improvement services* are not similar to financial services and there are no other class 36 services in the opponent's specification which are similar within the parameters of the caselaw. The applicants' services are building repair and installation services, such as plumbing, electrical work, roofing and so on. These are different in nature, purpose, method of use, channels of trade and are not complementary or in competition with real estate or property investment services. They are not similar.

107. Class 39: *Porter and concierge services, booking of travel, consultancy and advisory services related to the aforesaid.*

The closest of the opponent's services are *accommodation; hotel services and holiday camp services (lodging)* in class 43. As above, travel agents are a 'one-stop-shop' for advising on and booking both accommodation and travel. The users and the trade channels are identical and there is complementarity in that the customer will think that the responsibility for the travel booking and the accommodation or holiday lies with the same undertaking. There is a good deal of similarity between the applicants' *booking of travel, consultancy and advisory services related to the aforesaid* and the opponent's *accommodation; hotel services and holiday camp services (lodging)*. In relation to the applicants' *porter and concierge services*,

consultancy and advisory services related to the aforesaid, porter and concierge services are provided as part of the staffing of, for example, hotels and apartment complexes (whether temporary or permanent accommodation). They are complementary to the accommodation, will share the same users and channels of trade, and the purpose of them is to service the accommodation and enhance the residents' experience of staying in the accommodation. There is a good deal of similarity between the applicants' *porter and concierge services, consultancy and advisory services related to the aforesaid* and the opponents' *accommodation; hotel services and holiday camp services (lodging) services*.

108. Class 42: *Construction and design services; architectural, survey and planning services related to real estate and property development: inspection of buildings; interior design services; feasibility studies, construction and planning for real estate; advisory consultancy and information services relating to the aforesaid*.

These are the services of architects, designers and engineers. The method of use will be different, the channels of trade will be different and there is no complementarity or competition between estate agency, financial services and the services of designers, engineers and architects. These services, although connected to real estate, are therefore further away from the opponent's cover for financial services, which includes real estate and property investment services, than the applicants' class 37 services, as analysed above. The exception may be surveying services and inspection of buildings which may be obtained as part of the provision of real estate services. Here there is a modest level of similarity, but if there is any level of similarity between the other services of the parties, it is at a low level.

Summary of the comparison of services

109. For application 2522369 (composite mark), the class 43 services *hotel, restaurant, bar and catering services; temporary accommodation services; providing facilities for conferences; services arranging lodging at holiday camps; rental and leasing of holiday apartments and accommodation* are **identical** to services in CTM 7237944 (the David Lloyd signature mark). *Travel agency services for booking accommodation; information and advisory services relating to the above services* are **highly similar** to services in CTM 7237944 (there are no other class 43 services). There are **no similar services to the class 36 services** of the application because the only earlier right pleaded against these (2144719) failed to clear the proof of use hurdle. Class 41 of the application was abandoned by the applicant in its counterstatement. Classes 35 and 39 are not opposed under section 5(2) of the Act (although class 39 is opposed under section 5(2)(b) in the other application, 2553085).

110. For application 2553085 (word-only mark), the following services are **identical** to services covered by both CTMs 7237944 (the David Lloyd signature mark) and 8905366 (the David Lloyd composite mark):

Class 41: Providing of training, sporting and cultural activities, including football and tennis academies; leisure facilities for resorts, hotels, main residence and holiday homes.

Class 43: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; retirement home services.

Class 44: Spas and beauty services for resorts, hotels and holiday homes.

111. In relation to the remaining class 43 services, the levels of similarity are:

- *Booking and reservation services for restaurants: **low similarity***
- *Booking and reservation services for holiday accommodation: **good deal of similarity***
- *Crèche services: **moderate degree of similarity.***

112. In relation to the services in Class 36, the following services of the application are **highly similar** to the opponent's accommodation services in CTM 7237944:

Provision of housing accommodation

113. The following class 36 services of the application are **identical** to class 36 services covered by the opponent's CTM 8905366:

Insurance, financial affairs, monetary affairs, mortgage arrangement, real estate affairs, provision of real estate for restaurants and retail, information services related to finance and insurance, asset management, property investment, investment services; financial services related to property and land estate management, financial services, financing services, consultancy and information services related to the aforesaid.

The remaining services in class 36, *rental of property, rent collection, consultancy and information services related to the aforesaid*, are **not similar** to any of the opponent's services.

114. There is a **reasonable degree** of similarity between the applicants' *Property and real estate development; development of mixed use communities including business, housing, retail and hotels* in class 37 and the opponent's *financial services* (Class 36) in CTM 8905366. The applicants' *repair and installation services all relating to property and real estate; property and housing maintenance; property improvement services* are **not similar** to any of the opponent's services.

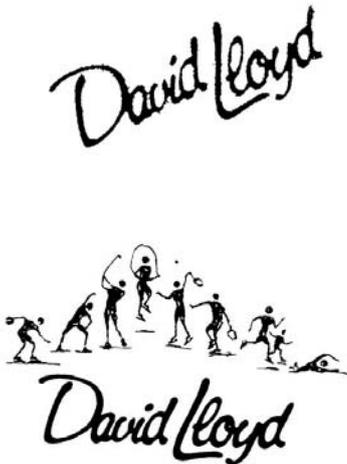
115. There is a **good deal** of similarity between the applicants' services in class 39 (*Porter and concierge services, booking of travel, consultancy and advisory services related to the aforesaid*) and the opponent's *accommodation; hotel services and holiday camp lodging*) services.

116. There is a **modest level** of similarity between the applicants' *survey services* in class 42 and the opponent's *financial services* but there is **no (or at best low) similarity** between the remainder of the applicants' services in class 42 and the opponent's earlier marks.

Comparison of trade marks

117. I will restrict my comparison of the parties' marks to the opponent's marks which I used for the comparison of services; i.e. the marks which are registered as CTMs 7237944 and 8905366. As mentioned earlier, CTM 488940 for the word only mark DAVID LLOYD is registered for narrower services than these two CTMs (although also not subject to proof of use). If it becomes necessary to factor this mark in when I reach the overall conclusion as to the likelihood of confusion, I will do so at that stage, but it is logical to conclude that the level of similarity between the opponent's CTMs and the applicants' marks will be at least equal to, if not greater, when the word only DAVID LLOYD mark is considered.

118.

Opponent's marks	Applicants' marks
	

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. Nothing turns upon the colour aspect of the composite application because none of the parties' marks are limited to colour¹⁸.

119. The distinctive character of the opponent's signature mark resides in the full name as a whole because this is how it will be perceived. Although the font is meant to look like a signature, it appears that it is based upon the real signature of David Lloyd, which appears on the Name Deed, and which is a good deal more individual in character; the mark has more the look of an artificial signature about it. The upshot of this observation is that the stylisation is unremarkable. The same signature mark forms part of the opponent's composite mark. Although the device element is

¹⁸ *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch).

at the top and extends to either side of the DAVID LLOYD element, the latter strikes the eye first because the individual figure which make up the device are small and require some degree of study to see what they are, whereas the words DAVID LLOYD are immediately recognisable and understandable. The DAVID LLOYD element is the more dominant and distinctive of the two components in the opponent's composite mark.

120. The composite application also contains the component DAVID LLOYD which is the central and largest component of the mark. The device is distinctive, comprising a bold component which leads to a fainter globe. The word RESORTS is very faint, much smaller, and appears at the bottom of the mark. The dominant and distinctive component of the composite application is DAVID LLOYD. In relation to the word-only application, the word RESORTS is not distinctive. Unlike the other three marks already considered, the remaining words do not make up one individual's full name. DAVID & JOHN LLOYD is clearly a combination of two individuals who share the surname LLOYD, but who are called DAVID and JOHN. DAVID is at the front of the mark which will obviously be read from left to right. In terms of dominance, the word DAVID has the edge over the word JOHN.

121. Comparing the opponent's signature mark with the composite application, they share a great deal of visual similarity because (i) DAVID LLOYD is the only element of the earlier mark and the stylisation is unremarkable and (ii) it is the central, dominant and immediately discernable visual element of the application. In relation to the word-only application, there is a reasonable level of visual similarity, because the DAVID LLOYD element in the application is broken up by the intervening '& JOHN' element, and there is the additional word Resorts which is absent from the opponent's signature mark. Aurally, the opponent's signature mark shares a very high degree of similarity with the composite application, the additional element which is capable of being spoken being the word Resorts (the natural place for this in speech would be after DAVID LLOYD). The opponent's signature mark shares a reasonable degree of aural similarity with the word-only application for the reasons given in the visual comparison. Conceptually, the opponent's signature mark shares a high degree of similarity with the composite application because DAVID LLOYD will immediately be recognised as the full name of an individual. The device element, although it contains a globe, is faint and does not have a concept overall; resorts has an obvious concept, but is small within the mark. It is the DAVID LLOYD component within each mark which will create an immediate and shared resonance with the average consumer. In relation to the word-only mark, there is a good deal of conceptual similarity. Both marks are obviously comprised of personal names; the only name in the earlier mark is DAVID LLOYD; although DAVID LLOYD in the application is broken by the intervening & JOHN, DAVID & JOHN LLOYD is clearly a combination of two individuals who share the surname LLOYD. The average consumer would therefore understand the message of the application as being that one of the two individuals is called DAVID LLOYD. 'Resorts' adds an obvious meaning..

122. Overall, there is a **high degree of similarity** between the opponent's signature mark and the composite application, and a **good level of similarity** between the opponent's signature mark and the word-only application.

123. Comparing the opponent's composite mark with the composite application, there is a good level of visual similarity because in each mark DAVID LLOYD is the central, dominant and immediately discernable element of the mark. Even though there are two different devices, these occupy similar positions with the marks and do not strike the eye as immediately as the central word elements. The opponent's device requires some study in order to ascertain its nature (figures engaged in various sports) and the device in the composite mark, as a whole, has no meaning; conceptually, the similarity between the marks results from the same DAVID LLOYD component. They share a good deal of conceptual similarity. Aurally, the opponent's composite mark shares a very high degree of similarity with the composite application, the additional element which is capable of being spoken being the word Resorts (the natural place for this in speech would be after DAVID LLOYD. The devices will not be referenced aurally).

124. There is more visual distance between the opponent's composite mark and the word-only application than between the opponent's signature mark and the word-only application because of the additional device in the opponent's mark. The point of similarity is the presence in each mark of DAVID and LLOYD. Owing to the additional device in the earlier mark and the intervening & JOHN in the application, there is a moderate degree of similarity between them visually. Aurally, the position is the same as before: there is a reasonable level of aural similarity, because the DAVID LLOYD element in the application is broken up by the intervening ' & JOHN' element, and there is the additional word Resorts which is absent from the opponent's composite mark (the device cannot be reference aurally). Conceptually, the opponent's device requires some study in order to ascertain its nature (figures engages in various sports). There is no device or reference to sport in the word-only application. Conceptually, the point of similarity between the marks results from the DAVID LLOYD component in each. Both marks obviously contain personal names. The only name in the earlier mark is DAVID LLOYD; although DAVID LLOYD in the application is broken by the intervening & JOHN, DAVID & JOHN LLOYD is clearly a combination of two individuals who share the surname LLOYD. The average consumer would therefore understand the message of the application as being that one of the two individuals is called DAVID LLOYD. Resorts adds an obvious meaning. Notwithstanding the device which is alien to the application, there is a good deal of conceptual similarity between the marks.

125. Overall, there is a **good deal of similarity** between the opponent's composite mark and the composite application, and a **reasonable level of similarity** between the opponent's composite mark and the word-only application.

Distinctiveness of the earlier marks

126. It is necessary to consider the distinctive character of the opponent's marks because the more distinctive they are, either by inherent nature or by use (nurture) the greater the likelihood of confusion¹⁹. 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

¹⁹ *Sabel BV v Puma AG* [1998] RPC 199.

public²⁰. Mr Harris gives substantial turnover figures in the opponent's evidence (£263,153,000 in 2009), but does not differentiate between the word only, signature and composite DAVID LLOYD marks. Having said that, the opponent's exhibits do show the three types of marks in use, sometimes on their own and sometimes in combination. The confidential exhibit IH2 shows the opponent as possessing a large proportion of the overall UK market for leisure club services. On balance, it is fair to say that the opponent is entitled to an enhanced level of distinctive character in the three types of DAVID LLOYD marks, but only in relation to certain of its class 41 services. The reputation is not proven in relation to training, other than sports training, and it is not proven in relation to holiday camp services. The word only and signature marks already possess a good level of inherent distinctive character for all the services because although DAVID and LLOYD are common names, the purpose of names, particularly full names, is to identify individuals. Names form one of the earliest methods of differentiating one's goods or services from those of another and consumers are accustomed to their use as natural tools of differentiation. The composite mark is more inherently distinctive, owing to the configuration of the device.

Likelihood of confusion

127. 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.*). Similarity between marks cannot, however, compensate for absence of similarity between services²¹. Consequently, where there is no similarity between the parties' services, there is no likelihood of confusion. The Section 5(2)(b) opposition therefore fails in respect of the class 36 services in the composite application (2522369) and *rental of property, rent collection, consultancy and information services related to the aforesaid* (in Class 36), *repair and installation services all relating to property and real estate; property and housing maintenance; property improvement services* (Class 37) and *construction and design services; architectural and planning services related to real estate and property development: inspection of buildings; interior design services; feasibility studies, construction and planning for real estate; advisory consultancy*

²⁰ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

²¹ 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."

and information services relating to the aforesaid (Class 42) of the word-only application (2553085).

128. I also bear in mind the whole mark comparison. I should guard against dissecting the marks so as to distort the average consumer's perception of them. The average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind.

129. One of the factors to consider in the global appreciation is the weight which I should attach to the type of purchasing process. In *New Look Ltd v OHIM* Joined cases T-117/03 to T-119/03 and T-171/03, the GC stated:

“49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

The relevance of this point is that sometimes the characteristics of the purchasing process for some goods and services are more aural than visual. In the current proceedings, more weight is to be attributed to the visual aspect of the purchasing process than aural because the purchasing process is more visual than aural (e.g. via the perusal of advertisements, websites, literature, testimonials and written proposals). However, aural perception of the mark is not without importance; DAVID LLOYD is the only verbal element in the opponent's marks and is the main verbal element in the composite application ('Resorts' being non-distinctive). Aural perception is also of some relevance in the members-only leisure club market, for instance, one may decide to investigate a club's facilities on the recommendation of friends and family. It does not outweigh the visual and conceptual similarities, but must be factored in as part of the global assessment²².

²² CJEU, Case C-206/04 P *Mülhens GmbH & Co KG v OHIM*: “21 It is conceivable that the marks' phonetic similarity alone could create a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see, in respect of Directive 89/104, *Lloyd Schuhfabrik Meyer*, paragraph 28). However, it must be noted that the existence of such a likelihood must be established as part of a global assessment as regards the conceptual, visual and aural similarities between the signs at issue. In that regard, the assessment of any aural similarity is but one of the relevant factors for the purpose of that global assessment.”

²² Therefore, one cannot deduce from paragraph 28 of the judgment in *Lloyd Schuhfabrik Meyer* that there is necessarily a likelihood of confusion each time that mere phonetic similarity between two signs is established.”

130. 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,²³ but the overall impression conveyed to the relevant public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components. In relation to the composite application and the earlier marks, the overall impression is dominated by the DAVID LLOYD component. A factor which I should consider in relation to the word-only application is the ‘beginnings of marks’ rule of thumb. It is exactly that, a rule of thumb, but it is important here because words DAVID and LLOYD are broken up by the intervening & JOHN. DAVID is at the beginning of the mark and there is an undoubted conceptual perception will be that there is a personal name DAVID LLOYD in the mark. So, DAVID is more dominant in the mark than JOHN, DAVID is at the beginning of the mark, and it will be understood immediately that LLOYD belongs to DAVID as much as to JOHN. These all combine to counteract the fact that DAVID and LLOYD are separated in the word-only application.

131. In *El Corte Inglés, SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-39/10*, the GC held:

“—54 As the applicant asserted in its pleadings, according to the case-law, the Italian consumer will generally attribute greater distinctiveness to the surname than to the forename in the marks at issue (Case T-185/03 Fusco v OHIM – Fusco International (ENZO FUSCO) [2005] ECR II-715, paragraph 54). The General Court applied a similar conclusion concerning Spanish consumers, having established that the first name that appeared in the mark in question was relatively common and, therefore, not very distinctive (Case T-40/03 Murúa Entrena v OHIM – Bodegas Murúa (Julián Murúa Entrena) [2005] ECR II-2831, paragraphs 66 to 68).

55 Nevertheless, it is also clear from the case-law that that rule, drawn from experience, cannot be applied automatically without taking account of the specific features of each case (judgment of 12 July 2006 in Case T-97/05 Rossi v OHIM – Marcorossi (MARCOROSI), not published in the ECR, paragraph 45). In that regard, the Court of Justice has held that account had to be taken, in particular, of the fact that the surname concerned was unusual or, on the contrary, very common, which is likely to have an effect on its distinctive character. **Account also had to be taken of whether the person who requests that his first name and surname, taken together, be registered as a trade mark is well known** (Case C-51/09 P Becker v Harman International Industries [2010] ECR I-5805, paragraphs 36 and 37). Likewise, according to the case-law cited in the previous paragraph, the distinctive character of the first name is a fact that should play a role in the implementation of that rule based on experience.” (emphasis added).

132. Mr Lloyd contends in his counterstatement on the word-only application that he is famous; such a claim would operate against his favour in that, notwithstanding the

²³ *Shaker di Laudato & C. Sas v OHIM*.

intervening JOHN in the word-only application, owing to his alleged fame, the average consumer would still perceive the name DAVID LLOYD within the mark. However, the applicants filed no evidence substantiating the claim to Mr Lloyd (David or John) being famous, so this has no bearing upon the global evaluation of the likelihood of confusion.

133. There is a good deal of conceptual similarity between the opponent's earlier marks and the word-only application which also counteracts the lesser degree of visual and aural similarity between them. In the case of the composite application compared to both of the opponent's earlier marks, DAVID LLOYD is the conceptual hook to which the perception of the average consumer will be attached immediately; in the case of the word-only application, it will be less immediate.

134. Bearing in mind that the devices are different, and so are the length of the word marks, I think it unlikely that the parties' marks would be directly confused with one another. Although the matter which is not dominant (such as the devices) may not be perfectly recalled, I consider that the average consumer will recognise that there are differences, while at the same time picturing in their mind the words DAVID LLOYD. He or she will make a connection between the marks, even though they may not be recalled in their entirety. Even though the marks may not be mistaken for one another directly, I have to consider whether the common element between them, DAVID LLOYD, will give rise to a belief or an expectation upon the part of the average consumer that the services emanate from a single undertaking or related undertakings because the point of similarity will lead to association. As stated in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, if the association between marks causes the public wrongly to believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion. This is often called 'indirect confusion', but it is, nevertheless, confusion within the meaning of section 5(2)(b) of the Act. Mr Iain Purvis QC, sitting as the appointed person in *L.A. Sugar Trade Mark* BL O/375/10²⁴ explained indirect confusion in the following terms:

"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:

²⁴ All BL-prefixed decisions are available for viewing on the Intellectual Property Office's website.

(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).”

135. The italicised part describes the problem for both sets of applicants: their marks are different to the opponent’s marks, but they all have in common the dominant distinctive element DAVID LLOYD, which in the opponent’s case is inherently distinctive to a good level and particularly so, on the basis of use, in relation to the opponent’s class 41 services. That element is the sole element of one of the earlier marks. Although it gives rise to varying levels of visual and aural similarity, there is close conceptual similarity. There is a spectrum of attentiveness levels on the part of the average consumer and a spectrum of similarity between the services.

136. In relation to the composite application, with the exception of the class 36 services which are not similar, I found that the services attacked under section 5(2)(b) in class 43 were either identical or highly similar (class 41 was deleted by the applicant and classes 35 and 39 are not opposed under this ground). There is a likelihood of confusion and the opposition to this application therefore succeeds under section 5(2)(b) in respect of the class 43 services:

Hotel, restaurant, bar and catering services; temporary accommodation services; providing facilities for conferences; services arranging lodging at holiday camps; rental and leasing of holiday apartments and accommodation; travel agency services for booking accommodation; information and advisory services relating to the above services.

137. In relation to the word-only application, there is a likelihood of confusion where the services are similar with the opponent’s signature mark; the opposition succeeds in relation to:

Class 36: Provision of housing accommodation.

Class 41: Providing of training, sporting and cultural activities, including football and tennis academies; leisure facilities for resorts, hotels, main residence and holiday homes.

Class 43: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; crèche services.

Class 44: Spas and beauty services for resorts, hotels and holiday homes.

138. There is a likelihood of confusion between the word-only application and the opponent's composite mark in relation to *Class 39: Porter and concierge services, booking of travel, consultancy and advisory services related to the aforesaid* because, balancing the similarities and differences between the marks, the inclusion of 'Resorts' in the application points towards these services, which are a good deal similar to the opponent's services.

139. There is no likelihood of confusion in relation to the applicants' *property and real estate development; development of mixed use communities including business, housing, retail and hotels* (Class 37) and *survey services* (Class 42). The comparison here is only with the opponent's composite mark (CTM 8905366) where there is the combination of only a reasonable level or moderate level of similarity with the opponent's financial services. The high level of attention which will be paid to the purchase of such services, including the fact that such services are commonly provided by undertakings using personal names and so the average consumer is more used to differentiating between them on that basis, means that there is no likelihood of confusion. That this reasoning also applies to the class 36 services (with the exception of *provision of housing accommodation*).

140. The other earlier marks relied upon do not put the opponent in any better a position because the word only earlier marks do not cover services which are similar to those for which the opposition has failed under section 5(2)(b).

Section 5(2)(b) outcome

141. Application 2522369

The opposition under section 5(2)(b) **succeeds** in relation to the whole of class 41, which the applicant deleted via its counterstatement, and the whole of class 43.

Application 2553085

142. The opposition under section 5(2)(b) **succeeds** in relation to the following services:

Class 36: Provision of housing accommodation.

Class 39: Porter and concierge services, booking of travel, consultancy and advisory services related to the aforesaid (the whole of the class 39 specification).

Class 41: Providing of training, sporting and cultural activities, including football and tennis academies; leisure facilities for resorts, hotels, main residence and holiday homes (the whole of the class 41 specification).

Class 43: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; crèche services (the whole of the class 43 specification).

Class 44: Spas and beauty services for resorts, hotels and holiday homes (the whole of the class 44 specification).

143. The opposition under section 5(2)(b) **fails** in relation to:

Class 36: Insurance, financial affairs, monetary affairs, mortgage arrangement, real estate affairs, information services related to finance and insurance, asset management, property investment, investment services, rental of property, rent collection, provision of real estate for restaurants and retail, financial services related to property and land estate management, financial services, financing services, consultancy and information services related to the aforesaid.

Class 37: Property and real estate development; development of mixed use communities including business, housing, retail and hotels; repair and installation services all relating to property and real estate; property and housing maintenance; property improvement services (the whole of the class 37 specification).

Class 42: Construction and design services; architectural, survey and planning services related to real estate and property development: inspection of buildings; interior design services; feasibility studies, construction and planning for real estate; advisory consultancy and information services relating to the aforesaid (the whole of the class 42 specification).

Section 5(3)

144. 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.”

145. 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, *Adidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L'Oreal v Bellure* [2009] ETMR 55. The law appears to be as follows:

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

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*; 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 is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*: whether this is the case must also be assessed globally, taking account of all 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*.

146. The opponent's signature mark (CTM 7237944) is relied upon to attack all of the services of both applications, so I will limit my assessment to this mark in relation to the applications. In *PAGO International GmbH v Tirolmilch registrierte Genossenschaft mbH*, case C-301/07, the CJEU stated:

"Article 9(1)(c) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark must be interpreted as meaning that, in order to benefit from the protection afforded in that provision, a Community trade mark must be known by a significant part of the public concerned by the products or services covered by that trade mark, in a substantial part of the territory of the European Community, and that, in view of the facts of the main proceedings, the territory of the Member State in question may be considered to constitute a substantial part of the territory of the Community."

Consequently, both *General Motors* and *Pago* require that the opponent's CTM must be known by a significant part of the public concerned for the services covered by the marks, in a substantial part of the EU. In these proceedings, the relevant territory includes, but is not limited to, the UK. As I found above, in relation to the distinctiveness of the CTM, the confidential exhibit IH2 shows the opponent as possessing a large proportion of the overall UK market for leisure club services. In *PAGO*, the member state found to be a sufficient part of the territory was Austria. Given the size of the UK and given the size of the UK market which the opponent enjoys, it is fair to say that the opponent has the requisite level of reputation in the mark, but only in relation to certain of its class 41 services. The reputation is not proven in relation to training, other than sports training, and it is not proven in relation to sports or holiday camp services. The opponent's reputation lies in its *provision and operation of recreation and sports facilities; provision of teaching facilities for sports and recreational activities; sports training and teaching academies; organisation of sporting competitions*.

147. Having established reputation, the next requirement is to establish that the average consumer would make a link between the opponent's mark and the applications. Even if a link is found, there is a further requirement still; that the link leads to one (or more) of the pleaded heads of damage. 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.

148. There is a clear link between the parties' marks, in respect of the applications in classes 41 (bearing in mind the voluntary deletion of class 41 of the composite application). In relation to class 43 of the applications, they are not very far away from the opponent's services, as the evidence of the applicants' business plans has shown. Sports and leisure facilities are a feature of holiday accommodation, as are childcare services and holiday clubs. Bars and restaurants are part of the package in visiting a leisure club and holiday accommodation. In relation to travel agency services, there may be a link because of the existence of specialist sports travel agency services. There is a link with the applicants' services in class 43, with the exception of retirement home services. In relation to class 44, the services are closely related to sports services; spas and beauty services are part and parcel of leisure clubs and sports and recreational facilities. There is a link between the opponent's services and the class 44 services (only applied for in the word-only mark). As there is a link in relation to travel agency services in class 43, which are closely related to the class 39 services of the applications, there is a link also between the opponent's mark and the class 39 services of both applications.

149. The other services of both applications which are attacked under this ground fall in classes 35 and 36 in the case of the composite application; and in classes 36, 37 and 42 of the word-only application. The factors in the opponent's favour are the similarities between the marks and that its mark has a substantial reputation in the UK for the services identified above. Against the opponent is the fact that there is quite some distance between sports and recreational activities and facilities and the services falling in classes 35, 36, 37 and 42 for which the applications have been filed. A factor related to this is that for some of the services, it is hard to envisage an overlap in the identity of the average consumer; it is the general public for the opponent's services, but in relation to, e.g. organising exhibitions, asset management, property development and planning, these are commercial or business services, with a different customer base. It is hard to see a link being made between a mark with a reputation for sports and leisure services and any of the applicants' services in classes 35, 36, 37 and 42. Where there is no link, the section 5(3) ground cannot succeed and therefore it fails in relation to:

Composite application

Class 35: Advertising of holiday homes and apartments; organisation of exhibitions for commercial or advertising purposes.

Class 36: Insurance services relating to the purchase and ownership of overseas property; arranging of finance and loans; real estate agency, brokerage and management; leasing and rental of accommodation; information and advisory services relating to the above services.

Word-only application

Class 36: *Insurance, financial affairs, monetary affairs, mortgage arrangement, real estate affairs, information services related to finance and insurance, asset management, property investment, investment services, rental of property, rent collection, provision of real estate for restaurants and retail, financial services related to property and land estate management, provision of housing accommodation, financial services, financing services, consultancy and information services related to the aforesaid.*

Class 37: *Property and real estate development; development of mixed use communities including business, housing, retail and hotels; repair and installation services all relating to property and real estate; property and housing maintenance; property improvement services.*

Class 42: *Construction and design services; architectural, survey and planning services related to real estate and property development: inspection of buildings; interior design services; feasibility studies, construction and planning for real estate; advisory consultancy and information services relating to the aforesaid.*

Class 43: *retirement home services;*

150. I have found a link in relation to classes 39, 41, 43²⁵ and 44 of the applications. The main thrust of the opponent's evidence is in relation to detriment to distinctive character ("dilution") and the taking of unfair advantage. The ground will succeed if one of these heads of damage is shown. In relation to unfair advantage, in *L'Oreal* the CJEU stated, at paragraph 50:

"In the light of the above, the answer to the fifth question is that Article 5(2) of Directive 89/104 must be interpreted as meaning that the taking of unfair advantage of the distinctive character or the repute of a mark, within the meaning of that provision, does not require that there be a likelihood of confusion or a likelihood of detriment to the distinctive character or the repute of the mark or, more generally, to its proprietor. The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of the mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image."

151. In my summary of Mr Harris' second witness statement (paragraphs 27 to 31), I recorded the exhibits which go to the opponent's claim of unfair advantage. Of particular note is the following, the wording of which is clearly endorsed by Mr Lloyd²⁶:

²⁵ With the exception of retirement services in the word-only application.

²⁶ Page 389 of exhibit IH26, about the launch of the David Lloyd Resort in summer 2009.

“As I launched my first tennis and fitness club in the early eighties, some thought it exclusive and that the concept would have limited appeal. 20 years on and a network of clubs throughout the UK, Continental Europe and Australia, illustrate that people are quick to recognise a great idea.

Welcome to a new type of David Lloyd Membership, The Resorts Club, a way to enjoy my legendary facilities and services abroad. A David Lloyd Resort offers you a chance to holiday in fully managed 5 star property...The David Lloyd name ensures the resorts are also complemented by outstanding residents' leisure facilities, including restaurants, pools, fitness, golf, tennis and spa facilities.”

152. The emboldened text demonstrates an unequivocal attempt by the applicants of both applications (Mr Lloyd is the controlling mind of the applicant for the composite application) to link together in the mind of the purchasing public the success of the opponent and Mr Lloyd's services. This is an intention to ride on the coat-tails of the opponent's marks “in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image.”

153. As I said at the beginning of this decision, the counterstatement in relation to the composite application was brief with, apart from putting the opponent to proof, only a bare denial of the opposition. The counterstatement in relation to the word-only application dealt exclusively with a rebuttal of the section 3(6) ground. However, it is clear throughout the lengthy counterstatement that the applicants feel an entitlement to use the name DAVID LLOYD because it is David Lloyd's personal name. This includes, as is clear from the exhibit referred to above, use of the name in relation to accommodation which includes leisure and spa facilities. In case 'use of the name because it is his name' this could be construed as a due cause defence, I will deal with it briefly here. The counterstatement stated, with my emphasis:

“When he entered into the agreement in 1993 Mr. Lloyd retained all the goodwill that generated in his fame and in him as a famous personality, tennis player, and business man. **He has always retained the right to use his name, and signature and the goodwill that is attached to his fame throughout the UK and the world, and other than the limited goodwill in running sports clubs in the UK has never surrendered that.** An appropriate analogy is that David Lloyd came to the table with a cake representing the whole of the goodwill that attached to him as a famous person. He cut from that cake a very small slice that equates to the goodwill in the UK related solely to “the Business” ...and gave that slice to David Lloyd Leisure PLC. This left Mr David Lloyd with the remaining cake representing all the goodwill that he did not transfer to David Lloyd Leisure PLC under Clause 2 of the Name Agreement. The Opponent would have one believe that they took the whole of the cake and neutralised Mr David Lloyd's ability to

use his name and the fame he generated for anything ever again. This of course would be a complete infringement of Mr David Lloyd's human rights!”

154. As can be seen from my analysis of the Name Deed, the slice of the cake which was handed over by Mr Lloyd to the opponent was not such a small slice as he claims. Mr Lloyd was content to the limitation on his rights to use (not to register as a trade mark) his name in connection with a very limited range of activities: playing professional tennis, one to one tennis coaching and the running of a tennis coaching school for young players who are or who are training to become professional tennis players. Consequently, any due cause defence fails in relation to classes 39, 41, 43 and 44.

Outcome

155. The applications are to be refused because the oppositions have been completely successful under section 3(6) against both applications in their entireties.

156. For the sake of completeness, I will record the partially successful outcomes under sections 5(2)(b) and 5(3), as follows:

Composite application 2522369

- The opposition under section 5(2)(b) **succeeds** in relation to the whole of class 41, which the applicant deleted via its counterstatement, and the whole of class 43.
- The opposition under section 5(3) **succeeds** in relation to the whole of classes 39, 41 and 43.

Word-only application 2553085

- The opposition under section 5(2)(b) **succeeds** in relation to *provision of housing accommodation* in class 36 and the whole of classes 39, 41, 43 and 44.
- The opposition under section 5(3) succeeds in relation to the whole of classes 41 and 44, and for the following services in class 43 (it failed for retirement home services):

Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; ~~retirement home services~~; creche services.

Costs

157. The opponent has been successful in both of its oppositions. However, there are two different sets of applicants so two different costs awards must be made. I have taken into account that there were certain economies brought about by the consolidation and the repetitious grounds of opposition. However, there is also the fact of the lengthy counterstatement filed on the word-only application to bear in

mind. I have decided to split the evidence award and the written submissions award across the two oppositions, because both oppositions were successful and the evidence went to the same issues in both oppositions. I award costs on the following basis, following the scale of costs in Tribunal Practice Notice 4/2007, published on the website of the Intellectual Property Office:

Composite application 2522369 (the lead opposition)

Preparing a statement and considering the other side's counterstatement	£450
Opposition fee	£200
Preparing evidence (no evidence was filed by the applicant)	£600
Written submissions (split between the two oppositions)	£250
Total	£1500

Word-only application 2553085

Preparing a statement (essentially a repetition of the lead opposition) and considering the other side's lengthy counterstatement	£450
Opposition fee	£200
Preparing evidence and considering the applicants' evidence	£600
Written submissions (split between the two oppositions)	£250
Total	£1500

158. The costs orders are as follows:

(i) **I order David Lloyd Resorts to pay David Lloyd Leisure Limited the sum of £1500.** This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

(ii) **I order Julia Wright and David Lloyd to pay David Lloyd Leisure Limited the sum of £1500.** This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21st day of February 2013

Judi Pike
For the Registrar,
the Comptroller-General

REDACTED

ANNEX

Relevant details of earlier marks relied upon²⁷ and services opposed prior to each notice of defence. Where different services are opposed under each ground, a note in the column indicates the extent of the difference. Services relied upon for section 5(3) as well as for section 5(2)(b) are italicised. Services which are subject to a statement of use, and therefore proof of use²⁸, are emboldened.

Earlier marks and relevant dates	Services relied upon	Services opposed application number 2522369 	Services opposed application number 2553085 DAVID & JOHN LLOYD RESORTS
<p>1528213</p> <p>DAVID LLOYD</p> <p>Filing date: 26 February 1993</p> <p>Registration date²⁹: 14 July 1995</p>	<p><i>Class 41: Provision and operation of recreation and sports facilities; provision of teaching facilities for sports and recreational activities; all included in Class 41.</i></p>	<p><u>N.B. All services are opposed under section 5(3). Only those underlined are opposed under section 5(2)(b).</u></p> <p>Class 35: Advertising of holiday homes and apartments; organisation of exhibitions for commercial or advertising purposes.</p> <p>Class 36: Insurance services relating to the purchase and ownership of overseas property; arranging of finance and loans; real estate agency, brokerage and management; leasing and rental of accommodation; information and advisory services relating to the above services.</p> <p>Class 39: Transport of passengers by road; arranging the transport of passengers; travel agency services for booking transport by air, sea or road; tour agency services; booking agency services for travel; conducting of sightseeing; car rental; information and advisory services relating to the above services.</p> <p><u>Class 41: Entertainment and instructional services, all provided for holiday makers; provision of sports and recreational facilities; organising of entertainment, sporting events and of competitions: ticket</u></p>	<p><u>N.B. All services are opposed under section 5(3). Only those underlined are opposed under section 5(2)(b).</u></p> <p>Class 36: Insurance, financial affairs, monetary affairs, mortgage arrangement, real estate affairs, information services related to finance and insurance, asset management, property investment, investment services, rental of property, rent collection, provision of real estate for restaurants and retail, financial services related to property and land estate management, provision of housing accommodation, financial services, financing services, consultancy and information services related to the aforesaid.</p> <p>Class 37: Property and real estate development; development of mixed use communities including business, housing, retail and hotels; repair and installation services all relating to property and</p>

²⁷ The opponent also relied upon earlier right 2320287A in opposition number 99948, but later deleted it from its grounds of opposition at its evidence in chief stage.

²⁸ 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.

²⁹ All references to the registration date mean the date on which the registration procedure was completed.

		<p><u>reservation services for entertainment events; arranging and conducting of conferences; information and advisory services relating to the above services.</u></p> <p>Class 43: Hotel, restaurant, bar and catering services; temporary accommodation services; providing facilities for conferences; services arranging lodging at holiday camps; rental and leasing of holiday apartments and accommodation; travel agency services for booking accommodation; information and advisory services relating to the above services.</p>	<p>real estate; property and housing maintenance; property improvement services.</p> <p>Class 39: Porter and concierge services, booking of travel, consultancy and advisory services related to the aforesaid.</p> <p><u>Class 41: Providing of training, sporting and cultural activities, including football and tennis academies; leisure facilities for resorts, hotels, main residence and holiday homes.</u></p> <p>Class 42: Construction and design services; architectural, survey and planning services related to real estate and property development: inspection of buildings; interior design services; feasibility studies, construction and planning for real estate; advisory consultancy and information services relating to the aforesaid.</p> <p><u>Class 43: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; creche services.</u></p> <p><u>Class 44: Spas and beauty services for resorts, hotels and holiday homes.</u></p>
<p>1528217</p> <p><i>David Lloyd</i></p> <p>Filing date: 26 February 1993</p> <p>Registration date: 7 April 1995</p>	<p>Class 41: Provision and operation of recreation and sports facilities; provision of teaching facilities for sports and recreational activities; all included in Class 41.</p>	<p><u>N.B. All services are opposed under section 5(3). Only those underlined are opposed under section 5(2)(b).</u></p> <p>Class 35: Advertising of holiday homes and apartments; organisation of exhibitions for commercial or advertising purposes.</p> <p>Class 36: Insurance services relating to the purchase and ownership of overseas property; arranging of finance and loans; real estate agency, brokerage</p>	<p><u>N.B. All services are opposed under section 5(3). Only those underlined are opposed under section 5(2)(b).</u></p> <p>Class 36: Insurance, financial affairs, monetary affairs, mortgage arrangement, real estate affairs, information services related to finance and insurance, asset management, property investment, investment</p>

		<p>and management; leasing and rental of accommodation; information and advisory services relating to the above services.</p> <p>Class 39: Transport of passengers by road; arranging the transport of passengers; travel agency services for booking transport by air, sea or road; tour agency services; booking agency services for travel; conducting of sightseeing; car rental; information and advisory services relating to the above services.</p> <p><u>Class 41: Entertainment and instructional services, all provided for holiday makers; provision of sports and recreational facilities; organising of entertainment, sporting events and of competitions; ticket reservation services for entertainment events; arranging and conducting of conferences; information and advisory services relating to the above services.</u></p> <p>Class 43: Hotel, restaurant, bar and catering services; temporary accommodation services; providing facilities for conferences; services arranging lodging at holiday camps; rental and leasing of holiday apartments and accommodation; travel agency services for booking accommodation; information and advisory services relating to the above services.</p>	<p>services, rental of property, rent collection, provision of real estate for restaurants and retail, financial services related to property and land estate management, provision of housing accommodation, financial services, financing services, consultancy and information services related to the aforesaid.</p> <p>Class 37: Property and real estate development; development of mixed use communities including business, housing, retail and hotels; repair and installation services all relating to property and real estate; property and housing maintenance; property improvement services.</p> <p>Class 39: Porter and consierge services, booking of travel, consultancy and advisory services related to the aforesaid.</p> <p><u>Class 41: Providing of training, sporting and cultural activities, including football and tennis academies; leisure facilities for resorts, hotels, main residence and holiday homes.</u></p> <p>Class 42: Construction and design services; architectural, survey and planning services related to real estate and property development: inspection of buildings; interior design services; feasibility studies, construction and planning for real estate; advisory consultancy and information services relating to the aforesaid.</p> <p><u>Class 43: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation;</u></p>
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			<p>retirement home services; creche services.</p> <p>Class 44: Spas and beauty services for resorts, hotels and holiday homes.</p>
<p>1528214</p> <p>DAVID LLOYD</p> <p>Filing date: 26 February 1993</p> <p>Registration date: 14 July 1995</p>	<p>Class 42: Provision of restaurant and catering facilities; all included in Class 42.</p>	<p><u>N.B. All services are opposed under section 5(3). Only those underlined are opposed under section 5(2)(b).</u></p> <p>Class 35: Advertising of holiday homes and apartments; organisation of exhibitions for commercial or advertising purposes.</p> <p>Class 36: Insurance services relating to the purchase and ownership of overseas property; arranging of finance and loans; real estate agency, brokerage and management; leasing and rental of accommodation; information and advisory services relating to the above services.</p> <p>Class 39: Transport of passengers by road; arranging the transport of passengers; travel agency services for booking transport by air, sea or road; tour agency services; booking agency services for travel; conducting of sightseeing; car rental; information and advisory services relating to the above services.</p> <p>Class 41: Entertainment and instructional services, all provided for holiday makers; provision of sports and recreational facilities; organising of entertainment, sporting events and of competitions; ticket reservation services for entertainment events; arranging and conducting of conferences; information and advisory services relating to the above services.</p> <p><u>Class 43: Hotel, restaurant, bar and catering services; temporary accommodation services; providing facilities for conferences; services arranging lodging at holiday camps; rental and leasing of holiday apartments and accommodation; travel agency services for booking accommodation; information and advisory services relating to the above services.</u></p>	<p><u>N.B. All services are opposed under section 5(3). Only those underlined are opposed under section 5(2)(b).</u></p> <p>Class 36: Insurance, financial affairs, monetary affairs, mortgage arrangement, real estate affairs, information services related to finance and insurance, asset management, property investment, investment services, rental of property, rent collection, provision of real estate for restaurants and retail, financial services related to property and land estate management, provision of housing accommodation, financial services, financing services, consultancy and information services related to the aforesaid.</p> <p>Class 37: Property and real estate development; development of mixed use communities including business, housing, retail and hotels; repair and installation services all relating to property and real estate; property and housing maintenance; property improvement services.</p> <p>Class 39: Porter and consierge services, booking of travel, consultancy and advisory services related to the aforesaid.</p> <p>Class 41: Providing of training, sporting and cultural activities, including football and tennis academies; leisure facilities for resorts, hotels, main residence and holiday homes.</p> <p>Class 42: Construction and design services; architectural, survey and</p>

			<p>planning services related to real estate and property development: inspection of buildings; interior design services; feasibility studies, construction and planning for real estate; advisory consultancy and information services relating to the aforesaid.</p> <p><u>Class 43: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; creche services.</u></p> <p>Class 44: Spas and beauty services for resorts, hotels and holiday homes.</p>
<p>1528218</p> <p><i>David Lloyd</i></p> <p>Filing date: 26 February 1993</p> <p>Registration date: 16 December 1994</p>	<p>Class 43: Provision of restaurant and catering facilities.</p> <p>Re-classified from class 42 on 8 January 2010.</p>	<p><u>N.B. All services are opposed under section 5(3). Only those underlined are opposed under section 5(2)(b).</u></p> <p>Class 35: Advertising of holiday homes and apartments; organisation of exhibitions for commercial or advertising purposes.</p> <p>Class 36: Insurance services relating to the purchase and ownership of overseas property; arranging of finance and loans; real estate agency, brokerage and management; leasing and rental of accommodation; information and advisory services relating to the above services.</p> <p>Class 39: Transport of passengers by road; arranging the transport of passengers; travel agency services for booking transport by air, sea or road; tour agency services; booking agency services for travel; conducting of sightseeing; car rental; information and advisory services relating to the above services.</p> <p>Class 41: Entertainment and instructional services, all provided for holiday makers; provision of sports and recreational facilities; organising of entertainment, sporting events and of competitions; ticket</p>	<p><u>N.B. All services are opposed under section 5(3). Only those underlined are opposed under section 5(2)(b).</u></p> <p>Class 36: Insurance, financial affairs, monetary affairs, mortgage arrangement, real estate affairs, information services related to finance and insurance, asset management, property investment, investment services, rental of property, rent collection, provision of real estate for restaurants and retail, financial services related to property and land estate management, provision of housing accommodation, financial services, financing services, consultancy and information services related to the aforesaid.</p> <p>Class 37: Property and real estate development; development of mixed use communities including business, housing, retail and hotels; repair and installation services all relating to property and</p>

		<p>reservation services for entertainment events; arranging and conducting of conferences; information and advisory services relating to the above services.</p> <p><u>Class 43: Hotel, restaurant, bar and catering services; temporary accommodation services; providing facilities for conferences; services arranging lodging at holiday camps; rental and leasing of holiday apartments and accommodation; travel agency services for booking accommodation; information and advisory services relating to the above services.</u></p>	<p>real estate; property and housing maintenance; property improvement services.</p> <p>Class 39: Porter and consierge services, booking of travel, consultancy and advisory services related to the aforesaid.</p> <p>Class 41: Providing of training, sporting and cultural activities, including football and tennis academies; leisure facilities for resorts, hotels, main residence and holiday homes.</p> <p>Class 42: Construction and design services; architectural, survey and planning services related to real estate and property development: inspection of buildings; interior design services; feasibility studies, construction and planning for real estate; advisory consultancy and information services relating to the aforesaid.</p> <p><u>Class 43: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; creche services.</u></p> <p>Class 44: Spas and beauty services for resorts, hotels and holiday homes.</p>
<p>1589260</p>  <p>Filing date: 25 October 1994</p> <p>Registration date: 17 November 1995</p>	<p>Class 41: Provision and operation of recreation and sports facilities; provision of teaching facilities for sports and recreational activities; all included in Class 41.</p>	<p><u>N.B. All services are opposed under section 5(3). Only those underlined are opposed under section 5(2)(b).</u></p> <p>Class 35: Advertising of holiday homes and apartments; organisation of exhibitions for commercial or advertising purposes.</p> <p>Class 36: Insurance services relating to the purchase and ownership of overseas property; arranging of finance and loans; real estate agency, brokerage</p>	<p><u>N.B. All services are opposed under section 5(3). Only those underlined are opposed under section 5(2)(b).</u></p> <p>Class 36: Insurance, financial affairs, monetary affairs, mortgage arrangement, real estate affairs, information services related to finance and insurance, asset management, property investment, investment</p>

		<p>and management; leasing and rental of accommodation; information and advisory services relating to the above services.</p> <p>Class 39: Transport of passengers by road; arranging the transport of passengers; travel agency services for booking transport by air, sea or road; tour agency services; booking agency services for travel; conducting of sightseeing; car rental; information and advisory services relating to the above services.</p> <p><u>Class 41: Entertainment and instructional services, all provided for holiday makers; provision of sports and recreational facilities; organising of entertainment, sporting events and of competitions; ticket reservation services for entertainment events; arranging and conducting of conferences; information and advisory services relating to the above services.</u></p> <p>Class 43: Hotel, restaurant, bar and catering services; temporary accommodation services; providing facilities for conferences; services arranging lodging at holiday camps; rental and leasing of holiday apartments and accommodation; travel agency services for booking accommodation; information and advisory services relating to the above services.</p>	<p>services, rental of property, rent collection, provision of real estate for restaurants and retail, financial services related to property and land estate management, provision of housing accommodation, financial services, financing services, consultancy and information services related to the aforesaid.</p> <p>Class 37: Property and real estate development; development of mixed use communities including business, housing, retail and hotels; repair and installation services all relating to property and real estate; property and housing maintenance; property improvement services.</p> <p>Class 39: Porter and consierge services, booking of travel, consultancy and advisory services related to the aforesaid.</p> <p><u>Class 41: Providing of training, sporting and cultural activities, including football and tennis academies; leisure facilities for resorts, hotels, main residence and holiday homes.</u></p> <p>Class 42: Construction and design services; architectural, survey and planning services related to real estate and property development: inspection of buildings; interior design services; feasibility studies, construction and planning for real estate; advisory consultancy and information services relating to the aforesaid.</p> <p><u>Class 43: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation;</u></p>
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			<p>retirement home services; creche services.</p> <p>Class 44: Spas and beauty services for resorts, hotels and holiday homes.</p>
<p>Community Trade Mark ("CTM") 488940</p> <p>DAVID LLOYD</p> <p>Filing date: 13 March 1997</p> <p>Registration date: 13 April 2006</p>	<p>Class 41: <i>Provision and operation of recreation and sports facilities; provision of teaching facilities for sports and recreational activities.</i></p> <p>Class 42: <i>Provision of restaurant and catering facilities.</i></p>	<p><u>N.B. All services are opposed under section 5(3). Only those underlined are opposed under section 5(2)(b).</u></p> <p>Class 35: Advertising of holiday homes and apartments; organisation of exhibitions for commercial or advertising purposes.</p> <p>Class 36: Insurance services relating to the purchase and ownership of overseas property; arranging of finance and loans; real estate agency, brokerage and management; leasing and rental of accommodation; information and advisory services relating to the above services.</p> <p>Class 39: Transport of passengers by road; arranging the transport of passengers; travel agency services for booking transport by air, sea or road; tour agency services; booking agency services for travel; conducting of sightseeing; car rental; information and advisory services relating to the above services.</p> <p><u>Class 41: Entertainment and instructional services, all provided for holiday makers; provision of sports and recreational facilities; organising of entertainment, sporting events and of competitions; ticket reservation services for entertainment events; arranging and conducting of conferences; information and advisory services relating to the above services.</u></p> <p><u>Class 43: Hotel, restaurant, bar and catering services; temporary accommodation services; providing facilities for conferences; services arranging lodging at holiday camps; rental and leasing of holiday apartments and accommodation; travel agency services for booking accommodation; information and advisory services relating to the above services.</u></p>	<p><u>N.B. All services are opposed under section 5(3). Only those underlined are opposed under section 5(2)(b).</u></p> <p>Class 36: Insurance, financial affairs, monetary affairs, mortgage arrangement, real estate affairs, information services related to finance and insurance, asset management, property investment, investment services, rental of property, rent collection, provision of real estate for restaurants and retail, financial services related to property and land estate management, provision of housing accommodation, financial services, financing services, consultancy and information services related to the aforesaid.</p> <p>Class 37: Property and real estate development; development of mixed use communities including business, housing, retail and hotels; repair and installation services all relating to property and real estate; property and housing maintenance; property improvement services.</p> <p>Class 39: Porter and consierge services, booking of travel, consultancy and advisory services related to the aforesaid.</p> <p><u>Class 41: Providing of training, sporting and cultural activities, including football and tennis academies; leisure facilities for resorts, hotels, main residence and holiday homes.</u></p> <p>Class 42: Construction and design services; architectural, survey and</p>

			<p>planning services related to real estate and property development: inspection of buildings; interior design services; feasibility studies, construction and planning for real estate; advisory consultancy and information services relating to the aforesaid.</p> <p><u>Class 43: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; creche services.</u></p> <p><u>Class 44: Spas and beauty services for resorts, hotels and holiday homes.</u></p>
<p>CTM 488999</p> <p><i>David Lloyd</i></p> <p>Filing date: 13 March 1997</p> <p>Registration date: 13 April 2006</p>	<p>Class 41: <i>Provision and operation of recreation and sports facilities; provision of teaching facilities for sports and recreational activities.</i></p> <p>Class 42: <i>Provision of restaurant and catering facilities.</i></p>	<p><u>N.B. All services are opposed under section 5(3). Only those underlined are opposed under section 5(2)(b).</u></p> <p>Class 35: Advertising of holiday homes and apartments; organisation of exhibitions for commercial or advertising purposes.</p> <p>Class 36: Insurance services relating to the purchase and ownership of overseas property; arranging of finance and loans; real estate agency, brokerage and management; leasing and rental of accommodation; information and advisory services relating to the above services.</p> <p>Class 39: Transport of passengers by road; arranging the transport of passengers; travel agency services for booking transport by air, sea or road; tour agency services; booking agency services for travel; conducting of sightseeing; car rental; information and advisory services relating to the above services.</p> <p><u>Class 41: Entertainment and instructional services, all provided for holiday makers; provision of sports and recreational facilities; organising of entertainment, sporting events and of competitions; ticket</u></p>	<p><u>N.B. All services are opposed under section 5(3). Only those underlined are opposed under section 5(2)(b).</u></p> <p>Class 36: Insurance, financial affairs, monetary affairs, mortgage arrangement, real estate affairs, information services related to finance and insurance, asset management, property investment, investment services, rental of property, rent collection, provision of real estate for restaurants and retail, financial services related to property and land estate management, provision of housing accommodation, financial services, financing services, consultancy and information services related to the aforesaid.</p> <p>Class 37: Property and real estate development; development of mixed use communities including business, housing, retail and hotels; repair and installation services all relating to property and</p>

		<p><u>reservation services for entertainment events; arranging and conducting of conferences; information and advisory services relating to the above services.</u></p> <p><u>Class 43: Hotel, restaurant, bar and catering services; temporary accommodation services; providing facilities for conferences; services arranging lodging at holiday camps; rental and leasing of holiday apartments and accommodation; travel agency services for booking accommodation; information and advisory services relating to the above services.</u></p>	<p>real estate; property and housing maintenance; property improvement services.</p> <p>Class 39: Porter and consierge services, booking of travel, consultancy and advisory services related to the aforesaid.</p> <p><u>Class 41: Providing of training, sporting and cultural activities, including football and tennis academies; leisure facilities for resorts, hotels, main residence and holiday homes.</u></p> <p>Class 42: Construction and design services; architectural, survey and planning services related to real estate and property development: inspection of buildings; interior design services; feasibility studies, construction and planning for real estate; advisory consultancy and information services relating to the aforesaid.</p> <p><u>Class 43: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; creche services.</u></p> <p><u>Class 44: Spas and beauty services for resorts, hotels and holiday homes.</u></p>
<p>CTM 2197994</p> <p>DAVID LLOYD</p> <p>Filing date: 27 April 2001</p> <p>Registration date: 20 August 2002</p>	<p>Class 41: Provision and operation of recreation and sports facilities; provision of teaching facilities for sports and recreational activities.</p>	<p><u>N.B. All services are opposed under section 5(3). Only those underlined are opposed under section 5(2)(b).</u></p> <p>Class 35: Advertising of holiday homes and apartments; organisation of exhibitions for commercial or advertising purposes.</p> <p>Class 36: Insurance services relating to the purchase and ownership of overseas property; arranging of finance and loans; real estate agency, brokerage</p>	<p><u>N.B. All services are opposed under section 5(3). Only those underlined are opposed under section 5(2)(b).</u></p> <p>Class 36: Insurance, financial affairs, monetary affairs, mortgage arrangement, real estate affairs, information services related to finance and insurance, asset management, property investment, investment</p>

		<p>and management; leasing and rental of accommodation; information and advisory services relating to the above services.</p> <p>Class 39: Transport of passengers by road; arranging the transport of passengers; travel agency services for booking transport by air, sea or road; tour agency services; booking agency services for travel; conducting of sightseeing; car rental; information and advisory services relating to the above services.</p> <p><u>Class 41: Entertainment and instructional services, all provided for holiday makers; provision of sports and recreational facilities; organising of entertainment, sporting events and of competitions; ticket reservation services for entertainment events; arranging and conducting of conferences; information and advisory services relating to the above services.</u></p> <p>Class 43: Hotel, restaurant, bar and catering services; temporary accommodation services; providing facilities for conferences; services arranging lodging at holiday camps; rental and leasing of holiday apartments and accommodation; travel agency services for booking accommodation; information and advisory services relating to the above services.</p>	<p>services, rental of property, rent collection, provision of real estate for restaurants and retail, financial services related to property and land estate management, provision of housing accommodation, financial services, financing services, consultancy and information services related to the aforesaid.</p> <p>Class 37: Property and real estate development; development of mixed use communities including business, housing, retail and hotels; repair and installation services all relating to property and real estate; property and housing maintenance; property improvement services.</p> <p>Class 39: Porter and consierge services, booking of travel, consultancy and advisory services related to the aforesaid.</p> <p><u>Class 41: Providing of training, sporting and cultural activities, including football and tennis academies; leisure facilities for resorts, hotels, main residence and holiday homes.</u></p> <p>Class 42: Construction and design services; architectural, survey and planning services related to real estate and property development: inspection of buildings; interior design services; feasibility studies, construction and planning for real estate; advisory consultancy and information services relating to the aforesaid.</p> <p><u>Class 43: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation;</u></p>
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			<p>retirement home services; creche services.</p> <p>Class 44: Spas and beauty services for resorts, hotels and holiday homes.</p>
<p>CTM 7237944</p> <p><i>David Lloyd</i></p> <p>Filing date: 17 September 2008</p> <p>Registration date: 14 July 2009</p>	<p>Class 41: <i>Provision and operation of recreation and sports facilities; provision of teaching and coaching facilities for sports and recreational activities; sports training and teaching academies; organisation of sporting competitions; sport camp services; rental of sports equipment; rental of sports facilities; training; holiday camp services (entertainment).</i></p> <p>Class 43: <i>Provision of food and drink; accommodation; hotel services; cafe, bar and restaurant services; holiday camp services (lodging); catering; rental of meeting rooms.</i></p> <p>Class 44: <i>Hygienic and beauty care services; hairdressing; beauty salons; baths; massage; physical therapy; physiotherapy.</i></p>	<p><u>N.B. All services are opposed under section 5(3). Only those underlined are opposed under section 5(2)(b). Only classes 41 and 43 of the earlier mark are relied upon under section 5(2)(b).</u></p> <p>Class 35: Advertising of holiday homes and apartments; organisation of exhibitions for commercial or advertising purposes.</p> <p>Class 36: Insurance services relating to the purchase and ownership of overseas property; arranging of finance and loans; real estate agency, brokerage and management; leasing and rental of accommodation; information and advisory services relating to the above services.</p> <p>Class 39: Transport of passengers by road; arranging the transport of passengers; travel agency services for booking transport by air, sea or road; tour agency services; booking agency services for travel; conducting of sightseeing; car rental; information and advisory services relating to the above services.</p> <p><u>Class 41: Entertainment and instructional services, all provided for holiday makers; provision of sports and recreational facilities; organising of entertainment, sporting events and of competitions; ticket reservation services for entertainment events; arranging and conducting of conferences; information and advisory services relating to the above services.</u></p> <p>Class 43: <u>Hotel, restaurant, bar and catering services; temporary accommodation services; providing facilities for conferences; services arranging lodging at holiday camps; rental and leasing of holiday apartments and accommodation; travel agency services for booking accommodation; information and advisory services relating to the above services.</u></p>	<p><u>N.B. All three classes of the earlier CTM (41, 43 and 44) are relied upon to attack all of the services of the application under both sections 5(2)(b) and 5(3).</u></p> <p><u>Class 36: Insurance, financial affairs, monetary affairs, mortgage arrangement, real estate affairs, information services related to finance and insurance, asset management, property investment, investment services, rental of property, rent collection, provision of real estate for restaurants and retail, financial services related to property and land estate management, provision of housing accommodation, financial services, financing services, consultancy and information services related to the aforesaid.</u></p> <p><u>Class 37: Property and real estate development; development of mixed use communities including business, housing, retail and hotels; repair and installation services all relating to property and real estate; property and housing maintenance; property improvement services.</u></p> <p><u>Class 39: Porter and concierge services, booking of travel, consultancy and advisory services related to the aforesaid.</u></p> <p><u>Class 41: Providing of training, sporting and cultural activities, including football and tennis academies; leisure facilities for resorts, hotels, main residence and holiday homes.</u></p>

			<p><u>Class 42: Construction and design services; architectural, survey and planning services related to real estate and property development; inspection of buildings; interior design services; feasibility studies, construction and planning for real estate; advisory consultancy and information services relating to the aforesaid.</u></p> <p><u>Class 43: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; creche services.</u></p> <p><u>Class 44: Spas and beauty services for resorts, hotels and holiday homes.</u></p>
<p>2046691</p>  <p>Filing date: 28 November 1995</p> <p>Registration date: 30 August 1996</p>	<p>Class 43: Provision of restaurant and catering facilities.</p> <p>Re-classified from class 42 on 5 July 2006.</p>	<p><u>N.B. All services are opposed under section 5(3). Only those underlined are opposed under section 5(2)(b).</u></p> <p>Class 35: Advertising of holiday homes and apartments; organisation of exhibitions for commercial or advertising purposes.</p> <p>Class 36: Insurance services relating to the purchase and ownership of overseas property; arranging of finance and loans; real estate agency, brokerage and management; leasing and rental of accommodation; information and advisory services relating to the above services.</p> <p>Class 39: Transport of passengers by road; arranging the transport of passengers; travel agency services for booking transport by air, sea or road; tour agency services; booking agency services for travel; conducting of sightseeing; car rental; information and advisory services relating to the above services.</p> <p>Class 41: Entertainment and instructional services, all provided for holiday makers; provision of sports and</p>	<p><u>N.B. All services are opposed under section 5(3). Only those underlined are opposed under section 5(2)(b).</u></p> <p>Class 36: Insurance, financial affairs, monetary affairs, mortgage arrangement, real estate affairs, information services related to finance and insurance, asset management, property investment, investment services, rental of property, rent collection, provision of real estate for restaurants and retail, financial services related to property and land estate management, provision of housing accommodation, financial services, financing services, consultancy and information services related to the aforesaid.</p> <p>Class 37: Property and real estate development; development of mixed use communities including business, housing, retail and</p>

		<p>recreational facilities; organising of entertainment, sporting events and of competitions; ticket reservation services for entertainment events; arranging and conducting of conferences; information and advisory services relating to the above services.</p> <p><u>Class 43: Hotel, restaurant, bar and catering services; temporary accommodation services; providing facilities for conferences; services arranging lodging at holiday camps; rental and leasing of holiday apartments and accommodation; travel agency services for booking accommodation; information and advisory services relating to the above services.</u></p>	<p>hotels; repair and installation services all relating to property and real estate; property and housing maintenance; property improvement services.</p> <p>Class 39: Porter and consierge services, booking of travel, consultancy and advisory services related to the aforesaid.</p> <p>Class 41: Providing of training, sporting and cultural activities, including football and tennis academies; leisure facilities for resorts, hotels, main residence and holiday homes.</p> <p>Class 42: Construction and design services; architectural, survey and planning services related to real estate and property development: inspection of buildings; interior design services; feasibility studies, construction and planning for real estate; advisory consultancy and information services relating to the aforesaid.</p> <p><u>Class 43: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; creche services.</u></p> <p>Class 44: Spas and beauty services for resorts, hotels and holiday homes.</p>
<p>2144719</p>  <p>Filing date: 10 September 1997</p> <p>Registration date: 28 August 1998</p>	<p>Class 36: Credit services.</p> <p>(No section 5(3) ground.)</p>	<p><u>Class 36: Insurance services relating to the purchase and ownership of overseas property; arranging of finance and loans; real estate agency, brokerage and management; leasing and rental of accommodation; information and advisory services relating to the above services.</u></p>	<p><u>Class 36: Insurance, financial affairs, monetary affairs, mortgage arrangement, real estate affairs, information services related to finance and insurance, asset management, property investment, investment services, rental of property, rent collection, provision of real estate</u></p>

			<p>for restaurants and retail, financial services related to property and land estate management, provision of housing accommodation, financial services, financing services, consultancy and information services related to the aforesaid.</p>
<p>CTM 8905366</p>  <p>Filing date: 23 February 2010</p> <p>Registration date: 18 August 2010</p>	<p>Class 36: Banking services; credit services; business account card services; charge card services; credit card services; debit card services; issue of tokens of value; voucher schemes; issuance of credit and debit cards; financial services; automated payment services; issue and redemption of tokens and vouchers.</p> <p>Class 41: <i>Provision and operation of recreation and sports facilities; provision of teaching facilities for sports and recreational activities; sports training and teaching academies; organisation of sporting competitions; sport camp services; rental of sports equipment; rental of sports facilities; training; holiday camp services (entertainment).</i></p> <p>Class 43: <i>Provision of restaurant and catering facilities; provision of food and drink; accommodation; hotel services; cafe, bar and restaurant services; holiday camp services (lodging); catering; rental of meeting rooms.</i></p> <p>Class 44: <i>Hygienic and beauty care services; hairdressing; beauty salons; baths; massage; physical therapy; physiotherapy.</i></p>	<p>Not attacked on the basis of CTM 8905366, which has a later filing date than the application.</p>	<p>Class 36: Insurance, financial affairs, monetary affairs, mortgage arrangement, real estate affairs, information services related to finance and insurance, asset management, property investment, investment services, rental of property, rent collection, provision of real estate for restaurants and retail, financial services related to property and land estate management, provision of housing accommodation, financial services, financing services, consultancy and information services related to the aforesaid.</p> <p>Class 37: Property and real estate development; development of mixed use communities including business, housing, retail and hotels; repair and installation services all relating to property and real estate; property and housing maintenance; property improvement services.</p> <p>Class 39: Porter and concierge services, booking of travel, consultancy and advisory services related to the aforesaid.</p> <p>Class 41: Providing of training, sporting and cultural activities, including football and tennis academies; leisure facilities for resorts, hotels, main residence and holiday homes.</p> <p>Class 42: Construction and design services; architectural, survey and planning services related to real estate</p>

			<p><u>and property development; inspection of buildings; interior design services; feasibility studies, construction and planning for real estate; advisory consultancy and information services relating to the aforesaid.</u></p> <p><u>Class 43: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; creche services.</u></p> <p><u>Class 44: Spas and beauty services for resorts, hotels and holiday homes.</u></p>
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