O/1151/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3714434
BY RESOLUTE ASSET MANAGEMENT LLP

TO REGISTER:

RESOLUTE

AS A TRADE MARK IN CLASS 36

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 431363 BY
RESOLUTION PROPERTY IM LLP

BACKGROUND AND PLEADINGS

1. On 26 October 2021, Resolute Asset Management LLP ("the applicant") applied to register **RESOLUTE** as a trade mark in the United Kingdom in respect of the following services:

> *Class 36*
> *Financial services relating to real estate; real estate services; real estate asset management services; property management services; real estate advisory services; real estate financial strategy services; debt advisory services.*

2. On 28 February 2022, the application was opposed by Resolution Property IM LLP ("the opponent"). The opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act") and concerns all the services in the application. The claim under section 5(4)(a) was later dropped.

3. The opponent is relying on the following earlier UK trade marks ("UKTMs"):

UKTM No. 2424176

RESOLUTION

Application date: 12 June 2006
Registration date: 15 June 2012

Relying on the following services:

Class 35
Business management and administration relating to property services, financial services and asset management services relating to investment in, development or management of real property or real estate; information, advisory and consultancy services relating to the aforesaid services.

Class 36

Financial affairs relating to investment in, development or management of real property or real estate; fund management relating to investment in, development or management of real property or real estate or services directly related to real property or real estate; real estate affairs; capital investment relating to investment in, development or management of real property or real estate; asset management investment relating to property and real estate, real estate affairs.

UKTM No. 905113618

RESOLUTION

Application date: 2 June 2006
Registration date: 9 March 2012

Relying on the following services:

Class 36

Financial affairs relating to investment in, development or management of real property or real estate; fund management relating to investment in, development or management of real property or real estate or services directly related to real property or real estate; real estate affairs; capital investment relating to investment in, development or management of real property or real estate; asset management investment relating to property and real estate, real estate affairs.

UKTM No. 905160049

RESOLUTION

Application date: 9 June 2006
Registration date: 20 March 2012.

Relying on the following services:

Class 35 *Business management and administration relating to property services, financial services and asset management services relating to investment in, development or management of real property or real estate; information, advisory and consultancy services relating to the aforesaid services.*

4. The above marks all qualify as earlier marks under section 6(1) of the Act, by virtue of their earlier filing dates. As the marks had all completed their registration processes more than five years before the application date of the earlier mark, the opponent stated that it had used the marks during the five-year period before the application date.

5. Under section 5(2)(b), the opponent claims that the marks are similar and that the services covered by the marks are either identical or similar. Consequently, it claims that there exists a likelihood of confusion on the part of the relevant public in the UK.

6. Under section 5(3), the opponent claims that the three earlier marks have a reputation in the UK such that use of the contested mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character and/or reputation of these earlier marks. The claim of detriment to reputation was later dropped.

7. The applicant filed a defence and counterstatement denying the claims made and putting the opponent to proof of use of the earlier marks.

Evidence

8. The opponent's evidence in chief comes from Shaun Kirby, Chief Financial Officer of Resolution Property IM LLP. His witness statement is dated 8 August 2022 and goes to the use and reputation of the earlier trade marks. It is accompanied by three exhibits.

9. The applicant's evidence comes from Robert Martin Kingsmill, a Partner of Resolute Asset Management LLP. His witness statement is dated 6 October 2022 and goes to

the use that the applicant has made of the contested mark and provides details of other companies using the word “RESOLUTION”. It is accompanied by fourteen exhibits.

10. The opponent filed evidence in reply in the form of a second witness statement from Mr Kirby dated 6 December 2022. It is accompanied by five exhibits.

Hearing

11. The matter came to be heard by me by videolink on 6 June 2023. The opponent was represented by Jeremy Heald of Counsel, instructed by Bristows LLP; the applicant was represented by Ian Bartlett of Beck Greener LLP.

DECISION

Proof of Use

12. Section 6A of the Act is as follows:

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

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

(3) The use conditions are met if-

> (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
>
> (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

> (a) use of a trade mark includes use in a form (the 'variant form') differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and
>
> (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

[(5) Repealed]

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

…"

13. As two of the earlier marks are comparable marks, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It is as follows:

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

14. Section 100 of the Act is as follows:

> "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."

15. The case law on genuine use was summarised by Arnold J (as he then was) in *Walton International Limited v Verweij Fashion BV* [2018] EWHC 1608 (Ch):

"114. *The law with respect to genuine use.* The CJEU has considered what amounts to 'genuine use' of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundersvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816] [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W. F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally

and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

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

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

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

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

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]."[1]

16. The relevant period in these proceedings is 27 October 2016 to 26 October 2021. In the case of the earlier comparable marks, I am to consider use in the EU between 27 October 2016 and 31 December 2020 and use in the UK thereafter. The terms covered by the comparable marks are the same as those in the specification of UKTM No. 2424176. The opponent's submissions focused on the position in the UK, so I shall do likewise.

The opponent's evidence of use

17. Mr Kirby describes the opponent's activities in the following terms:

"The Opponent acquires, refurbishes and repurposes commercial real estate and offers expertise in investing in and managing large assets and portfolios as well as infrastructure projects under the trade mark RESOLUTION."[2]

[1] Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why the decision refers to the trade mark case law of the EU courts, even though the UK has left the EU.
[2] First witness statement of Shaun Kirby, paragraph 4.

18. He states that the opponent, and its predecessor in title, have been carrying out these activities since 1998 and that, from that point until the date of the witness statement (8 August 2022), it has dealt with 77 assets in the UK and Europe, raised a total of £2 billion in capital and dealt with 42 investors.[3] Examples of the properties acquired are shown in undated printouts from the opponent's website:[4]

a. Smithson Plaza, Central London (office use; acquired in 2020);
b. Vantage, West London (office use; acquired in 2019);
c. Royal Exchange, City of London (office use; acquired in 2018);
d. Moretown, Wapping, London (mixed use; acquired in 2016);
e. The Gramophone Works, Notting Hill, London (commercial use; acquired in 2015);
f. Alphabeta, Shoreditch, London (commercial use; acquired in 2012);
g. Ampersand, Soho, London (mixed use; acquired in 2008); and
h. Hat Factory, Soho, London (residential use; acquired in 2008).

19. Further UK examples are shown in a selection of news articles from the trade press. These include Ocean Terminal, a shopping centre in Leith, Edinburgh. An article from *Estates Gazette* indicates that this was acquired in 2012 and refinanced in 2018.[5] There is also an article from the *Bristol Post* on 9 February 2018 referring to a property in the city acquired by the opponent as a refurbishment scheme.[6] Finally, an article from www.propertyfundsworld.com dated 28 June 2021 reports the development of a hotel for Hyatt Hotels at the opponent's Black Lion House site in Whitechapel, London, which it acquired in 2015.[7]

20. I can also see from the evidence that the opponent has outlet shopping centres in Denmark, Germany and France. An article from *Europe Real Estate* dated 11 April 2018 reports on a joint venture to develop an outlet shopping centre at Billund in Denmark. The site was acquired by the opponent in 2017 and by the time of the article the opponent had leased 10% of the shopping centre to a mixture of international and

[3] Paragraph 6.
[4] Exhibit SK1.
[5] Exhibit SK2, page 39.
[6] Exhibit SK2, pages 42-46.
[7] Exhibit SK2, pages 78-79.

Scandinavian retailers, with an additional 20% under advanced negotiation. The article also refers to the opponent's two other outlet centres, at Soltau in Germany and Honfleur in France.[8]

21. Mr Kirby states that the UK and EU projects are funded by investment funds and he provides the following table showing revenue attributed to these funds:[9]

Financial Year	Revenue (£)
2017/2018	7,845,457
2018/2019	7,576,694
2019/2020	6,041,921
2020/2021	6,621,440
2021/2022 (if known)	5,889,691

22. The next table shows the Assets under Management in the UK by the opponent. Mr Kirby explains that these figures represent the market value of the investments that the opponent manages on behalf of its investors and argues that they therefore represent the size of the business in the UK.[10]

Financial Year	Value of Assets under Management (£)
2017	461,616,667
2018	517,673,285
2019	543,319,776
2020	572,048,498
2021	786,794,714

23. The opponent markets its services not through traditional advertising, but by producing what it describes as *"confidential brochures and related confidential investment materials"* which are distributed to selected investors, who will then pitch for an investment in the project.[11] None of these have been provided in evidence. Exhibit SK3 contains undated screenshots from LinkedIn and Twitter (now X). Both refer to the opponent as "Resolution Property". This is also how the opponent is

[8] Exhibit SK2, page 55.
[9] Paragraph 7.
[10] Paragraph 8.
[11] Paragraph 9.

referred to in the news articles, although later mentions are sometimes shortened to "Resolution".

Has genuine use been made of the earlier marks?

24. For use to be genuine, it must have been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the services at issue in the UK during the period 27 October 2016 to 26 October 2021. In making my assessment, I am required to consider all relevant factors, including:

- the scale and frequency of the use shown;
- the nature of the use shown;
- the services for which use has been shown;
- the nature of those services and the market(s) for them; and
- the geographical extent of the use shown.

25. Mr Bartlett submitted that the evidence did not clearly show what services the opponent provided, but that it appeared to be supplying construction-related services that were proper to Class 37. I agree that the opponent's services include the refurbishment of properties, but in my view that does not cover all the services seen in the evidence. The news articles contain several references to investment funds. For example, an article entitled "Resolution seeks platform to expand" published by *Estates Gazette* on 25 April 2019 refers to the opponent's funds, including the launch of a new €200m equity fund, and its investment strategy *"to target buildings with income and room for improvement, buildings that are able [to] outlive the short term volatility that Brexit is causing"*.[12] In an earlier article dated 1 February 2018 in the same publication, the opponent is described as a fund manager. The opponent has provided me with figures showing the value of the funds invested and the market value of the investments managed in the UK. I am satisfied that the opponent is investing in property as an asset, with the aim of making a return on that investment.

[12] Exhibit SK2, page 63.

26. Mr Bartlett also criticised the scale of the activities. He submitted that even over 20 years, the numbers of clients and properties were small and argued that the assets under management figure provided little information about the extent of trading. I remind myself that there is no *de minimis* rule, and that my assessment must be based on the evidential picture as a whole: see *New Yorker SHK Jeans GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-415/09, paragraph 53. In my view, the evidence shows that the opponent invests in high-value properties through funds and has consistently made new acquisitions in the UK during the relevant period.

27. The opponent has provided no evidence, apart from undated printouts from social media accounts, to show how it markets its services. I have already noted that none of the confidential brochures it uses to attract investors have been filed. Mr Bartlett submitted that the news articles in Exhibit SK2 had been placed by PR agencies. There is no evidence to support this argument, but, even if this were the case, they show that the opponent has been supplying services during the relevant period. I did not understand Mr Bartlett to be saying that the information in the articles was inaccurate.

28. I find that the opponent has made genuine use of the UKTM for *Fund management relating to investment in, development or management of real property or real estate or services directly related to real property or real estate; capital investment relating to investment in, development or management of real property or real estate; asset management investment relating to property and real estate, real estate affairs.*

29. The extent of any activities carried out beyond this is unclear. The news articles on, for example, the shopping centres do not explain the role of the opponent beyond providing funding packages. Even if I were to take the view that the opponent is managing the properties in the sense of finding tenants, negotiating rents, and so on, there is no evidence of whether or how the mark is used for those activities. For example, none of the pictures accompanying the news articles shows the mark in use on the properties. Therefore I am unable to find that the opponent has used the marks for more general real estate management services.

30. The remaining terms in Class 36, *Financial affairs relating to investment in, development or management of real property or real estate* and *Real estate affairs*, are broad terms that would include the ones in relation to which I have already found use of the earlier marks. I must now consider whether these would be part of a fair specification for the UKTM. In *Property Renaissance t/a Titanic Spa v Stanley Dock Hotel Ltd t/a Titanic Hotel Liverpool & Ors* [2016] EWHC 3103 (Ch), Carr J summarised the relevant law as follows:

> "iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].
>
> iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].
>
> v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (*Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].
>
> vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."[13]

31. The term *Financial services relating to investment in, development or management of real property or real estate* covers the fund management and asset management services offered by the opponent but would also encompass the provision of loans for acquiring and developing property and strategic financial advice relating to investments in this sector. It is, therefore, a broad term which would include several subcategories that could be viewed independently. In my view, the average consumer would understand services such as the provision of loans to belong to a different subcategory from the fund management and asset management services of the opponent. Consequently, I find that a fair specification for the UKTM would not include that term and that the terms listed in paragraph 28 reflect the scope of the financial services for which use has been shown.

32. I consider that *Real estate affairs* is another broad term. The average consumer would understand *Real estate affairs* to include services such as those of a domestic estate or lettings agent that the average consumer would consider belong to different categories from those for which I have found the UKTM to have been used. It would also include property management services. The evidence is unclear as to whether the opponent has supplied such services under the UKTM, even in relation to the properties it has acquired. I find that a fair specification would not include this term, even if it were limited to *Commercial real estate affairs*.

[13] Paragraph 47.

33. At the hearing, Mr Heald conceded that the Class 36 services were probably *"the most pertinent to this case"*.[14] I shall, however, also consider whether use has been shown for the Class 35 services. Mr Heald referred me to extracts from the 8th edition of the Nice Classification, which had been in force when the UKTM was registered. The explanatory note for Class 35 reads as follows:

> "Class 35 includes mainly services rendered by persons or organizations principally with the object of:
>
> (1) help in the working or management of a commercial undertaking, or
> (2) help in the management of the business affairs or commercial functions of an industrial or commercial enterprise,
>
> as well as services rendered by advertising establishments primarily undertaking communications to the public, declarations or announcements by all means of diffusion and concerning all kinds of goods or services."

34. The Class 35 services in respect of which use is claimed are the following: *Business management and administration relating to property services, financial services and asset management services relating to investment in, development or management of real property or real estate; information, advisory and consultancy services relating to the aforesaid services*.

35. A finding of genuine use requires these to be services that would be supplied to a third party in trade, as opposed to the day-to-day management and administration tasks involved in running one's own business. For this reason, I do not consider that any management activities involved in running the Ocean Terminal shopping centre, for instance, represent use of the mark for these services. The evidence shows a single example of the opponent working with a third party to acquire real property. This is an article dated 5 January 2021 that reports on the acquisition by Portuguese insurance

[14] Transcript, page 4.

company Fidelidade of Smithson Plaza in London.[15] It states that Fidelidade *"worked with UK asset manager Resolution Property to acquire the investment".* The exact nature of the services rendered by the opponent is not clear. On the basis of the evidence before me, I find that the opponent has not shown that it has made genuine use of the UKTM for services in Class 35. This finding applies equally to the comparable mark.

36. The services that the opponent may rely on in this opposition are as follows:

> *Class 36*
> *Fund management relating to investment in, development or management of real property or real estate or services directly related to real property or real estate; capital investment relating to investment in, development or management of real property or real estate; asset management investment relating to property and real estate, real estate affairs.*

37. The opposition proceeds on the basis of UKTM No. 2424176, which I shall from now on describe as "the earlier mark".

Section 5(2)(b)

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

> "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,

[15] Exhibit SK2, pages 72-74.

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

39. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union ("CJEU") in *SABEL BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v OHIM* (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

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

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

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

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

e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

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

Comparison of services

40. It is settled case law that I must make my comparison of the services on the basis of all relevant factors. These include the nature of the services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. Services are complementary when

"… 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."[16]

41. The services to be compared are shown in the table below:

Contested services	**Earlier services**
<u>*Class 36*</u> *Financial services relating to real estate; real estate services; real estate asset management services; property management services; real estate advisory services; real estate financial strategy services; debt advisory services.*	<u>*Class 36*</u> *Fund management relating to investment in, development or management of real property or real estate or services directly related to real property or real estate; capital investment relating to investment in, development or management of real property or real estate; asset management investment relating to property and real estate, real estate affairs.*

42. In *Sky Plc & Ors v Skykick UK Ltd & Anor* [2020] EWHC 990 (Ch), Arnold L.J. set out the following summary of the correct approach to interpreting terms in specifications:

"…the applicable principles of interpretation are as follows:

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

[16] *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82.

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

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

(4) A term which cannot be interpreted is to be disregarded."[17]

43. Mr Bartlett submitted that, to the extent that use was shown, the opponent's terms should be construed as covering highly specialised services provided to discerning customers. However, the case law is clear that I must base my comparison of the services on the literal meaning of the terms. I shall, of course, factor in the way the average consumer of the services behaves during the purchasing process later in my decision.

44. Where goods (or services) in the specification of one party are included in a broader term from the other party's specification, those goods (or services) are considered to be identical: see *Gérard Meric v OHIM*, Case T-133/05, paragraph 29. The contested *Financial services relating to real estate, Real estate services* and *Real estate asset management services* include the earlier *Asset management investment relating to property and real estate, real estate affairs*. I find that they are identical.

45. I understand *Property management services* to refer to the services involved in the administration of property. In construing this term, I am required to confine it to the core of the possible meanings of the term. In my view, the average consumer would understand it to include the administrative and management tasks required when owning a property and letting space within that property to others. Mr Heald submitted that these services were identical to the opponent's Class 35 services, but, following my findings on genuine use, it may not rely on these services. The users of *Property management services* are the owners of property, and they use the services so that a third party can manage the relationship with the tenants and deal with any issues that arise. The users of the opponent's services are individuals or institutions with capital

[17] Paragraph 56.

to invest and the purpose is to secure a return on that investment. However, the owners of large properties are likely to encounter the opponent's services if they need to secure further financing or wish to sell their property. The nature of the services is different: the opponent's services are financial services, while the applicant's are administrative. I have no evidence to suggest that the services are delivered to the market through the same, or overlapping, trade channels. They are not in competition and are not complementary. Taking all these factors into account, I consider that there is a very low degree of similarity between the services.

46. The applicant's *Real estate advisory services* are services providing advice on all real estate issues. These would include investment in real estate. The users of the opponent's and the applicant's services would be the same, or significantly overlap, and there would be some overlap in purpose and trade channels. The services are not in competition, but there is a degree of complementarity as real estate investment services are essential for the provision of advisory services relating to investment in real estate and it is my view that the average consumer would believe the services came from the same undertaking. I find that there is at least a medium degree of similarity between the services.

47. Mr Heald submitted that the applicant's *Real estate financial strategy services* were identical to the opponent's services *"on the basis that all are real-estate focussed financial services"*.[18] I understand that the applicant's services are likely to involve a process of understanding the client's needs and goals and formulating a package of services to meet those needs. The opponent's *Capital investment relating to investment in, development or management or real property or real estate* and *Asset management investment relating to property and real estate, real estate affairs* are also included in this broader term and so are identical. If I am wrong in this, they are highly similar.

48. The final services to be considered are *Debt advisory services.* Mr Heald submitted that these services are identical to *Financial affairs relating to investment in, development or management of real property or real estate*, but I found that the

[18] Skeleton argument, paragraph 21(e).

opponent could not rely on these services. I shall therefore compare the applicant's services to the opponent's services listed in the table above. The services will be targeted towards the same users. The purpose is similar to an extent, in that both are concerned with the financial position of the client. However, the similarity is at a very general level. The applicant's services are in the nature of advice, while the opponent's are financial services; however, I accept that there may be an element of advice provided as part of the opponent's services. There may be some shared trade channels. The services are not in competition or complementary. I find them to be similar to a low degree.

49. The applicant had provided a fallback specification, as follows (with the additions underlined and the deletions in strike-through):

> *Class 36*
> ~~*Financial services relating to real estate; real estate services;*~~ *real estate asset management services; property management services; real estate advisory services; real estate financial strategy services; debt advisory services; all the aforesaid services provided to financial institutions, public sector organisations, private equity and institutional investors.*

50. Unsurprisingly, Mr Heald had no objections to the deletions, but considered that the underlined limitation was contrary to the decision of the CJEU in *Koninklijke KPN Nederland BV v Benelux-Merkenbureau*, Case C-363/99 (*"POSTKANTOOR"*), as it sought to restrict the specification by characteristic, which, Mr Heald submitted, included the type of customer. Mr Bartlett submitted that the situation in these proceedings was different from the one in *POSTKANTOOR* and that the limitation was entirely proper. However, even if the limitation were acceptable, it would not help the applicant as I would still make the same findings on the similarity of the services. The opponent's services could equally be provided to the customers listed in the fall-back specification.

Average consumer and the purchasing process

51. The average consumer is deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: see *Lloyd Schuhfabrik*, paragraph 26.

52. The average consumer of the opponent's services and most of the applicant's services is likely to be an institution or individual wishing to invest in property. The exceptions among the contested services are *Real estate services; property management services; real estate advisory services; debt advisory services*. The average consumer of the first three of these could also be a property owner, whether an individual (including a member of the general public) or an organisation. The average consumer of *Debt advisory services* would be a member of the general public or an organisation. As all the services are related to finance or property, I consider that the average consumer will be paying a high degree of attention during the purchasing process, whether they are a member of the general public, a professional or an organisation.

53. The average consumer will choose the services after viewing promotional material online or in print. The purchasing process will, to my mind, largely be visual. However, the average consumer is likely also to receive word-of-mouth recommendations, including from consultants and advisors, and so the aural aspects of the mark are also relevant.

Comparison of marks

54. It is clear from *SABEL* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. It would be wrong,

therefore, artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks: see *Bimbo*, paragraph 34.

55. The respective marks are shown below:

Contested mark	**Earlier mark**
RESOLUTE	**RESOLUTION**

56. Both marks consist of a single word and so there are no other elements that could contribute to the overall impressions of the marks which lie in the words **RESOLUTE** and **RESOLUTION** respectively.

57. The earlier mark has ten letters, while the contested mark has eight. The first seven of these are identical. The beginnings of words tend to have more impact on the average consumer than the ends: see *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, paragraph 81. I consider that would be the case here. I find that the marks are visually highly similar.

58. Both marks are standard English words and would be pronounced in the usual way. The earlier mark has four syllables and the contested mark three. The first two of these are identical and the third begins in the same way ("LU-"). As with the visual comparison, I find that the beginning of the words would have more impact and so the marks are aurally similar to a high degree.

59. In his submissions on the conceptual comparison, Mr Bartlett argued that:

> "RESOLUTION is a noun referring to the act of settling a dispute or a problem. RESOLUTE is an adjective meaning bold, steady and determined. RESOLUTION is an abstract term in the context of the services the Opponent asserts, alluding nebulously, it is assumed, to the Opponent's

> conciliatory and problem-solving ethos. RESOLUTE on the other hand, says something express and concrete about the bold, uncompromising and forthright approach of the Applicant."[19]

60. He then referred me to the decision of Mr Iain Purvis QC, sitting as the Appointed Person, in *JT International SA v Argon Consulting*, BL O-049-17, in which he reviewed the guidance from the judgment of the CJEU in *Ruiz-Picasso & Ors v OHIM*, Case C-361/04. Mr Purvis said:

> "38. The case law of the European Union has recognised the self-evident proposition that where marks evoke particular, different concepts, this tends to counteract any visual or aural similarities between them and reduce the likelihood of confusion. This may be the case even where only one of the marks conveys a particular concept, and the other is concept-free."

61. Mr Bartlett submitted that the visual and aural similarities between the marks were outweighed by conceptual differences between them.

62. At this point, it is helpful to quote precisely what the CJEU said in *Ruiz-Picasso*:

> "20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law."

63. I am not persuaded by Mr Bartlett's submissions because, in my view, it is not clear how the average consumer would understand the word "RESOLUTION". It has more than one meaning. One of these is *"the act of settling a dispute or a problem"*; another is a firm intention to do something, as in the common phrase "New Year's resolution".

[19] Skeleton argument, paragraph 23.

This latter meaning is close to that of “RESOLUTE”. I find that there will be at least some consumers for whom the marks are conceptually highly similar, even if there are others who find the marks to be conceptually dissimilar. I am not required to identify a single meaning for the marks: see *Soulcycle Inc v Matalan Ltd* [2017] EWHC 496 (Ch), paragraphs 27-28. I shall return to this point later in my decision.

Distinctive character of the earlier marks

64. Distinctive character is a measure of how strongly a mark distinguishes the goods or services of one undertaking from those of others. The factors that I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer*:

> “23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered, the market share held by the mark, how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark, the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking, and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

65. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

66. “RESOLUTION” is a commonly used word and does not allude to a characteristic of the opponent’s services. This would suggest that it has a medium level of inherent distinctive character. Mr Bartlett submitted that the existence of other businesses in the same sector using the word “RESOLUTION” would reduce the inherent distinctiveness of the earlier marks. In his evidence for the applicant, Mr Kingsmill has

provided printouts from the websites of four businesses whose names begin with the word “RESOLUTION” and two with names beginning with the word “RESOLVE”.[20] In addition, he also presents the results of a search for “resolution” on the register of businesses regulated by the Financial Conduct Authority. It produced 60 hits.[21] This “state of the register” evidence gives no indication of how many of the businesses are active on the market and so whether they might have an impact on the ability of the earlier marks to distinguish the services of the opponent. There is little information on the six highlighted businesses, but most appear to be operating in different parts of the financial services sector and there is no indication as to how active they are on the market. I find that the evidence does not show that the inherent distinctiveness of the earlier mark has been decreased for the specific services the opponent may rely on in this opposition.

67. The opponent claims that the inherent distinctiveness of the earlier mark has been enhanced through the use made of them. However, the number of clients is small and the opponent has said that it does not undertake any traditional advertising; rather, it approaches potential investors directly. Mr Kirby does not say how many are approached each time funding is required. The selection of articles contains a good deal of repetition, with the same wording sometimes being used across several publications. Exhibit SK3 contains some printouts from the opponent’s LinkedIn and Twitter/X accounts. The numbers of followers are 1,295 and 763 respectively. These printouts are undated, and it is not clear where the followers are located. While the evidence was sufficient for me to find use for some of the services covered by the earlier marks, it falls short of what would be required to satisfy me that the distinctiveness of the earlier marks has been enhanced.

The global assessment of likelihood of confusion

68. There is no arithmetical formula to apply in determining whether there is a likelihood of confusion. It is a global assessment where a number of factors need to be borne in mind. I must also take account of the interdependency principle, i.e. that a

[20] Exhibits RK8-RK13.
[21] Exhibit RK14.

lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services or vice versa. I keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them they have in their mind.

69. Mr Bartlett submitted that it was relevant that there had been no instances of actual confusion in the market and referred me to the decision of the High Court in *Compass Publishing v Compass Logistics* [2004] EWHC 520 (Ch), where the court identified two factors which may negate such evidence: use on only part of the specification, or small-scale use. Mr Bartlett argued that neither of these pertained in the instant case and so I could infer from the lack of examples that there was no likelihood of confusion. The Court of Appeal considered the same issue at a later date in *Roger Maier & Anor v ASOS & Anor* [2015] EWCA Civ 220. Kitchen LJ said that:

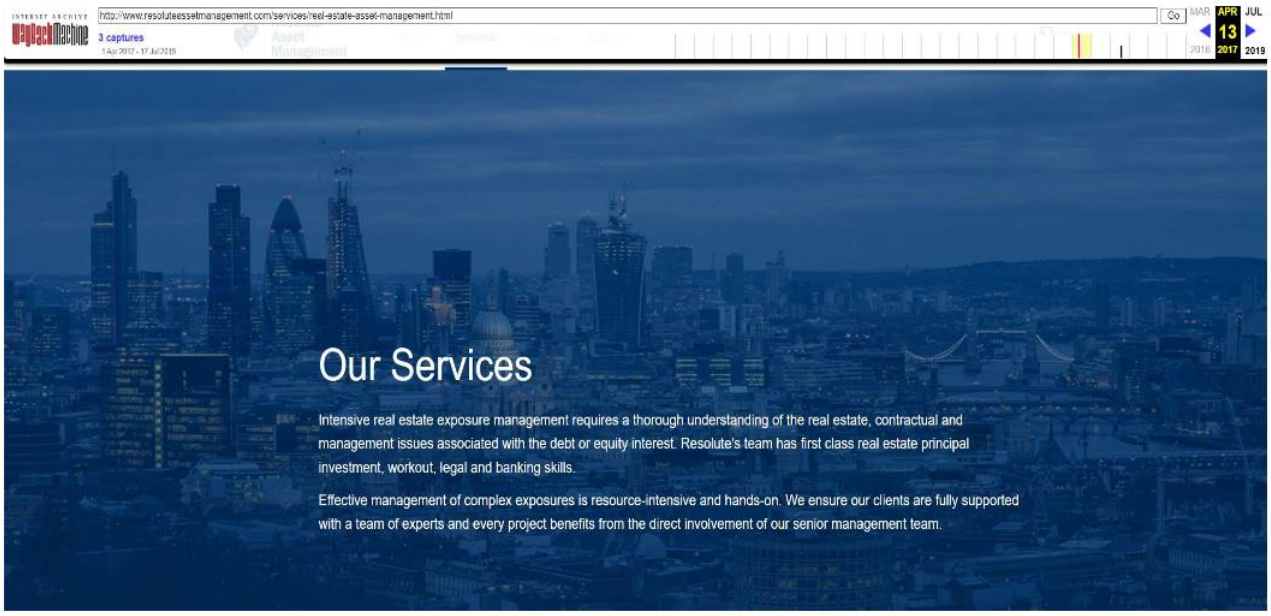
> "80. … the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur."

70. To the two factors identified in *Compass*, Kitchen LJ added a third: that use was such that there was no possibility that the consumer would mistake one party's mark for that of the other.

71. In his evidence for the applicant, Mr Kingsmill states that his business is, and has always been, known to its clients as “RESOLUTE” and that this is how it refers to itself, even though the full name of the business is “RESOLUTE ASSET MANAGEMENT” and the trade mark it currently has registered is a composite mark containing a ram’s head device. He has adduced a selection of website screenshots, some of which have been obtained through the Wayback Machine. These are dated from 18 April 2010 to 21 July 2021, with a further screenshot dated 31 May 2022.[22] None of the dated evidence shows “RESOLUTE” used without the composite mark below:

Resolute
Asset
Management

Even in the screenshot below from 13 April 2017, where the word “RESOLUTE” is used *solus*, the composite trade mark can be made out faintly at the top of the screen underneath the address bar. It seems to me that “RESOLUTE” is used here as shorthand on a page where other indications of origin are also used.



[22] Exhibit RK5.

72. On the basis of the evidence before me, I do not consider that I can draw any inferences from the absence of instances of actual confusion.

73. There are two types of confusion that may occur. Direct confusion is where the average consumer mistakes one mark for the other, while indirect confusion is where the average consumer recognises that the marks are different, but for some reason assumes that the later mark also identifies the goods or services of the owner of the earlier mark, or that the two undertakings are related: see *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, paragraph 16.

74. Earlier in my decision, I found some of the contested services to be identical to services on which the opponent could rely. The rest were similar to between at least a medium to a very low degree. I found the marks to be visually and aurally highly similar, and that there would be a group of consumers for whom they were also conceptually highly similar. I also found the earlier marks to have a medium degree of inherent distinctive character that had not been enhanced through use.

75. During the purchasing process, the average consumer would be paying a high degree of attention. Mr Bartlett submitted that this level of attention implied that the role played by imperfect recollection would be *"vanishingly unimportant"*.[23] I agree that it is likely to be less of a factor than in less considered purchasing decisions, but I must still remember that the average consumer is unlikely to see the marks side by side and so imperfect recollection cannot be completely ignored. Mr Bartlett also argued that conceptual differences between the marks would aid their accurate recollection, but, as I have already noted, I found there to be a group of consumers who would find the marks conceptually highly similar. It is my view that these consumers would mistake one mark for the other where the services are similar to at least a medium degree, and that this would be a proportion that is significant enough to warrant the intervention of the tribunal. There is a likelihood of direct confusion for the following services:

[23] Transcript, page 27.

Class 36

Financial services relating to real estate; real estate services; real estate asset management services; real estate advisory services; real estate financial strategy services.

76. Where the similarity between the services is low or very low, I consider that the high degree of attention paid by the average consumer would make such a mistake unlikely. There is no likelihood of direct confusion for the following services:

Class 36

Property management services; Debt advisory services.

77. Having found no likelihood of direct confusion for these services, I shall go on to consider whether there is a likelihood of indirect confusion. Should the average consumer recognise the differences between the marks, I can see no reason why they would assume that the marks belong to the same owner. “RESOLUTE” is not an obvious brand extension or sub-brand of “RESOLUTION”.

78. The opposition under section 5(2)(b) is successful for the services listed in paragraph 75 above and unsuccessful for the services listed in paragraph 76 above.

Section 5(3)

79. Section 5(3) of the Act is as follows:

“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 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."

80. The relevant case law can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case C-408/01), *L'Oréal SA & Ors v Bellure & Ors* (Case C-487/07), *Interflora Inc & Anor v Marks and Spencer plc & Anor* (Case C-323/09) and *Environmental Manufacturing LLP v OHIM* (Case C-383/12 P). 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.

c) It is necessary 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 Salomon*, paragraph 29, and *Intel*, paragraph 63.

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

e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or that 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 relevant factors; *Intel*, paragraph 79.

f) The more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oréal*, paragraph 44.

g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods and/or 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 and/or services for which the earlier mark is registered, or a serious risk that this will happen in the future; *Intel*, paragraphs 76 and 77, and *Environmental Manufacturing*, paragraph 34.

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

i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L'Oréal*, paragraph 40.

j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark 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. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation; *Interflora*, paragraph 74, and the court's answer to question 1 in *L'Oréal.*

81. I have already found the marks to be similar.

Reputation

82. In *General Motors Corp v Yplon SA*, Case C-375/97, the CJEU held that:

> "24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or services marketed, either the public at large or a more specialised public, for example traders in a specific sector.
>
> 25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.
>
> 26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.
>
> 27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use and the size of the investment made by the undertaking in promoting it.
>
> 28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

83. The relevant public for the opponent's services includes institutions and individuals with capital to invest in property. The factors that I must consider here are the same as those that were relevant when assessing the claims to enhanced distinctiveness of

the earlier mark. Mr Heald submitted that this was a field where reputation could be established by a comparatively small number of high value transactions.[24] I accept that there are sectors where this would hold, but I would expect to see a larger volume of media coverage or advertising to create a reputation and keep it alive at the relevant date. I accept that the opponent promotes its business in a different way, by directly approaching potential clients. However, it has given me no indication of the numbers of potential clients, who may be aware of the mark even if they themselves have not invested in the opponent's projects. The only indication I have that might indicate the extent of awareness of the mark is some limited coverage in the press and 42 investors between 1998 and 2022. I find that the evidence falls short of what would be required to show that the earlier marks have a reputation and so the opposition fails under section 5(3).

OUTCOME

84. The opposition is partially successful, and Application No. 3714434 is refused registration for the following services:

> *Class 36*
> *Financial services relating to real estate; real estate services; real estate asset management services; real estate advisory services; real estate financial strategy services.*

85. It may proceed to registration for the following services:

> *Class 36*
> *Property management services; debt advisory services.*

COSTS

86. Both parties have enjoyed a measure of success with the greater part going to the opponent. In the circumstances, the opponent is entitled to a contribution towards the

[24] Transcript, page 13.

costs of these proceedings in line with the scale set out in Tribunal Practice Notice No. 2/2016. In the circumstances, I award the opponent £1150 which has been calculated as follows and reflects the relative success:

Preparing a statement and considering the other side's statement: £150
Preparing evidence and considering and
commenting on the other side's evidence: £500
Preparing for and attending a hearing: £400
Official fees (successful ground): £100
TOTAL: £1150

87. I therefore order Resolute Asset Management LLP to pay Resolution Property IM LLP the sum of £1150. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 4th day of December 2023

Clare Boucher,
For the Registrar,
Comptroller-General