

O/181/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003538205

**BY MAYFAIR ESTATE LIMITED TO REGISTER THE FOLLOWING TRADE
MARK:**



IN CLASSES 36 AND 43

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 423163 BY ISTA DEUTSCHLAND GmbH**

Background and Pleadings

1. On 28 September 2020, Mayfair Estates Limited ('the Applicant') filed an application to register the trade mark shown on the cover page of this Decision, number UK00003538205. The application was published for opposition purposes in the *Trade Marks Journal* on 11 December 2020. Registration is sought in respect of the following:

Class 36 *Property management services; property renting including student accommodation and co-living.*

Class 43 *Hotel services; temporary accommodation; restaurant services; provision of food and drink.*

2. On 10 February 2021, the application was opposed by ista Deutschland GmbH ('the Opponent') based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all of the Applicant's services. The Opponent relies on the following two earlier International Registrations for its section 5(2)(b) ground:

i) IR WO0000001112855

ista

International registration date: 19 December 2011

Designation date: 13 July 2019

Office of origin: European Union Intellectual Property Office (EUIPO)

Publication date: 28 February 2020

Date of protection of the International Registration in the UK: 29 April 2020

Relying on the following of its services only¹:

Class 36

Real estate affairs.

ii) WO0000001478942

The logo for 'ista' is displayed in a stylized, lowercase, sans-serif font. The letters are white with a grey shadow effect, giving it a 3D appearance. The 'i' and 't' have unique shapes, with the 't' having a thick vertical stem and a horizontal top bar.

International registration date: 12 March 2019

Priority date: 14 September 2018

Priority Country: Germany

Designation date: 12 March 2019

Office of origin: Germany

Publication date: 25 October 2019

Date of protection of the International Registration in the UK: 28 December 2019

Relying on the following of its services only²:

Class 36

Real estate affairs, financial affairs

3. The Opponent claims that:

- The Applicant's mark is aurally and visually similar to the Opponent's earlier marks.
- The Applicant's class 36 services are identical or highly similar to the Opponent's class 36, for both registrations, with the Applicant's *property management services* and *property renting* falling under the Opponent's broad term *real estate affairs*.

¹ The full specification for this earlier registration can be found here <https://trademarks.ipo.gov.uk/ipo-tmcase/page/Results/2/WO0000001112855>

² The full specification for this earlier registration can be found here <https://trademarks.ipo.gov.uk/ipo-tmcase/page/Results/2/WO0000001478942>

- The Applicant's class 43 services are similar to the Opponent's 'real estate affairs'.
 - The above leading to a likelihood of confusion between the respective marks under section 5(2)(b) of the Act.
4. The Applicant filed a Defence and Counterstatement in which it denies the claim against it in its entirety. I note the following:

The Applicant does not accept the claims raised by the Opponent. The Applicant considers its mark to have no similarities whatsoever to that of the Opponent's mark. Both marks are significantly different visually, aurally and conceptually.

The Opponent has stated that they consider all goods and services in the application to be identical or similar to those contained in the Opponent's earlier rights. This is not the case. The Opponent provides data-based products and services so that people can save energy costs. The application is for property management services, property rental, hotel services and for the provision of food and drink.

5. Neither party has filed evidence. Written submissions have been filed in the evidence round by the Opponent only. Neither party has requested a hearing or filed written submissions in lieu of a hearing.
6. The Opponent is represented by Edwin Coe LLP; the Applicant is represented by Francis McEntegart.
7. The following decision has been made after careful consideration of the papers before me.

Relevant dates

8. Section 6A of the Act provides that where the registration procedure of the earlier mark was completed more than 5 years prior to the application date of the applied-for mark, the Opponent may be required to prove use of the earlier mark. The Opponent's marks are earlier marks because they designated the UK for protection on 13 July 2019 and 12 March 2019, respectively; dates which fell before the filing date of the Applied-for mark on 28 September 2020.
9. In the instant case, Section 6A is not engaged because the dates upon which UK protection was conferred in respect of the two earlier registrations, both fell less

than 5 years prior to 28 September 2020, i.e. the filing date of the Applicant's mark. The Opponent is entitled to rely upon all the services that it seeks to rely upon. The relevant date for assessing the likelihood of confusion is 28 September 2020.

Decision

Section 5(2)(b) of the Act and related case law

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

“A trade mark shall not be registered if because—

(a) ...

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

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

11. The following principles are derived from the decisions of the CJEU³ in:

Sabel BV v Puma AG, Case C-251/95; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97; *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98; *Matratzen Concord GmbH v OHIM*, Case C-3/03; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C120/04; *Shake di L. Laudato & C. Sas v OHIM*, Case C-334/05P; and *Bimbo SA v OHIM*, Case C-591/12P

The principles:

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

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

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

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

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

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

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

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

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

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

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

Comparison of services

12. Similarity of services – Nice classification

Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the ‘Nice Classification’ means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

13. I must therefore be mindful of the fact that the appearance of respective services in the same class is not a sufficient condition for similarity between those

services, and neither are they to be found dissimilar simply because some services may fall in a different class.

14. I must also bear in mind the decision of the General Court ('GC') in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05:

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

15. The CJEU in *Canon*, Case C-39/97, stipulates that all relevant factors relating to a parties' goods and services must be taken into account:

“[23] “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”.

16. Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281⁴, identified the following factors for assessing similarity of the respective goods and services:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;

⁴ *British Sugar Plc v James Robertson & Sons Ltd* [1996] R. P. C. 281, pp 296-297.

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

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

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

17. Goods or services will be found to be in a competitive relationship only where one is substitutable for the other.⁵

18. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods [or services]. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

“...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”.

⁵ *Lidl Stiftung & Co KG v EUIPO*, Case T-549/14.

19. The services to be compared are as follows:

Opponent's marks:	Applied-for mark:
i) WO0000001112855 Class 36: <i>Real estate affairs.</i>	UK00003538205 Class 36: <i>Property management services; property renting including student accommodation and co-living.</i>
ii) WO0000001478942 Class 36: <i>Real estate affairs, financial affairs⁶</i>	Class 43: <i>Hotel services; temporary accommodation; restaurant services; provision of food and drink.</i>

20. The Opponent has submitted⁷ that all of the Applicant's class 36 terms are 'a subset of' the Opponent's *Real estate affairs*; and that the Applicant's class 43 services are 'similar to *real estate services* in class 36' in respect of which the earlier marks are registered. I note the following from the submissions:

⁶ Although these terms are separated by a comma, rather than a semi-colon, it is presumed that they denote separate terms.

⁷ Opponent's written submissions, page 6.

Class 36

The Opponent enjoys earlier rights in the terms “*Real estate affairs, financial affairs*”. The Applicant has filed for “*Property management services; property renting including student accommodation and co-living*”. The services for which the Applicant seeks registration in Class 36 are all a subset of “*real estate affairs*” and are therefore similar. Inevitably there is an element of “*financial affairs*” in “*property management*” of property as well as “*property renting*”, irrespective of whether it is for students / co-living or not since “*property management*” and “*property renting*” both involve taking rent, paying service fees, organising and paying for property maintenance. All of these services are at least complementary and therefore similar to the services for which the Opponent’s Marks enjoy earlier rights.

Class 43

The Applicant also seeks registration of the Contested Application in Class 43 for “*Hotel services; temporary accommodation; restaurant services; provision of food and drink*”. These services, in particular “*temporary accommodation*” are similar to “*real estate services*” in Class 36 for which the Opponent enjoys earlier rights. Indeed, *Case 0-429-19 MEERKAT ENTERPRISE LIMITED v COLIN MACKENZIE [2019]*, it was found that the term “*providing temporary housing accommodations*”, a term highly similar to the Applicant’s “*temporary accommodation*”, ...on an ordinary understanding of the words would cover letting houses or flats for occupation on a time-limited basis. Such a description would apply comparably to some of the basic services of an estate agent and to that extent those services overlap in channels of trade, share the same nature, purpose and respective users and uses, and inevitably involve competition”.

21. The Applicant has not filed any written submissions, but, has argued in its counterstatement that the respective services are neither identical nor similar. It has stated that ‘The Opponent provides data-based products and services so that people can save energy costs. The application is for property management services, property rental, hotel services and for the provision of food and drink’. Whilst this point is noted, how the parties currently use their marks are not relevant factors in the assessment of whether there is a likelihood of confusion. I must only consider the ‘notional’ use of the marks in relation to the services in their respective specifications. In my assessment, I must therefore consider all of the possible circumstances in which the mark applied for *might* be used if it were registered. Any *actual* differences between the parties’ services are irrelevant unless they are apparent from the specifications of the respective marks.

22. I compare the respective class 36 services. The Opponent's term *Real estate affairs* is a broad term which will include, inter alia, property rental and property management services. In my view, the Applicant's terms *Property management services* and *property renting including student accommodation and co-living* will be included in the Opponent's broader term *Real estate affairs*. The respective class 36 services are therefore identical according to the principle in *Meric*. If I am wrong about that, then the services are highly similar.

23. I now compare the Applicant's class 43 services against the Opponent's class 36 *Real estate affairs*. I group together the Applicant's class 43 terms *restaurant services* and *provision of food and drink*, both being services providing food and drink. The purpose of the Opponent's services is to provide services in relation to property, whether residential or commercial. The services will cover, *inter alia*, the sale, rental or management of property. This is a different purpose to that of the Applicant's services. Methods of use will also differ. The Applicant will fulfil its services by providing the consumer with food or drink, either for consumption on its premises, for take away or for delivery to the consumer's home. The Opponent's services will be delivered by way of, for example, arrangement of transactions. Methods of use will also therefore differ. Users will overlap; users of both sets of services will comprise members of the general and professional public. Trade channels will, in my view, be distinct. The services are not in a competitive relationship, nor do I find them to be complementary. Consequently, I find the respective services to be dissimilar.

24. I now compare the Applicant's *Hotel services* against the Opponent's *Real estate affairs*. The Applicant's services relate to the provision of accommodation, in most cases short-term, which sometimes includes providing breakfast as part of a package. The respective services therefore overlap in purpose to the extent that both provide accommodation of some sort, although real estate affairs is more to do with its arrangement rather than its provision. However, whereas the Applicant's services will almost always involve short stays e.g. days or weeks, *real estate affairs* will deal with longer term accommodation e.g. selling property or offering long leases/rental periods. It is nevertheless appreciated that the Opponent's services will also include short term lets. Users will overlap;

consumers of both sets of services will comprise both the general and professional public. Trade channels will be distinct; I consider it unlikely, for example, that the same website would offer both *hotel services* and *real estate affairs* or for a real estate agent to be advertising hotel services. In my view, there is competition between the respective services in instances where a consumer seeking very short-term residential accommodation might deliberate over whether to book a hotel room or to arrange a short-term let. I do not find the respective services to be complementary. Consequently, I find the Applicant's *hotel services* to be similar to the Opponent's *real estate affairs* to a medium degree.

25. I now compare the Applicant's *temporary accommodation* to the Opponent's *Real estate affairs*. There will be an overlap in purpose to the extent that some services within the Opponent's term, e.g. short term lets, will as its end purpose to the user provide temporary accommodation. Users will overlap; consumers of both sets of services will comprise both the general and professional public. Trade channels will overlap; some websites offering real estate services may well include *temporary accommodation* in their offering. The respective services are in a competitive relationship; for a consumer seeking a short-term commercial space, or residential property, either a provider of services under *Real estate affairs* or provider of *temporary accommodation* could offer a solution. I do not find complementarity between the parties' services. Although some real estate agents might offer *temporary accommodation*, I do not consider that the average consumer would conclude that both sets of services will be provided by the same undertaking. Consequently, I find the Applicant's *temporary accommodation* to be similar to the Opponent's *real estate affairs* to a medium degree.

Average consumer and the purchasing act

26. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect. For the purpose 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 or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

27. In *Hearst Holdings Inc*⁸ Birss J. (as he then was) described the average consumer thus:




“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

28. I consider that the average consumer of the respective class 36 services will include both the general and professional public. Services relating to the purchase or lease of a commercial premises, for example, will almost always be made by a professional, whereas services relating to residential premises would more likely be engaged by the general public. Many purchases will be made after initially viewing the service provider’s website, an advertisement or the façade of the premises. The purchasing act will, therefore, in most cases, be primarily visual. These services are not ‘everyday’ purchases. Many purchases will involve entering into lengthy written contracts. I consider that most transactions would not conclude until the purchaser had discussed the potential purchase with the service-provider and, in the case of a sale or lease, inspected the property for sale/let. However, the consumer’s focus will be on the property being purchased/leased, rather than on the selection of the services offered by the estate agent handling the sale. Where the average consumer is the owner of a property that they wish to sell or let, factors affecting the choice of service will include, *inter alia*, the consumer’s particular needs; the fees for the service. The average consumer in this situation would therefore display some level of care when making their choice. I therefore find that the parties’ services will be purchased with a medium – high level of attention.

⁸ *Hearst Holdings Inc Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch).

29. I now consider the average consumer of the Applicant's class 43 services: *hotel services* and *temporary accommodation*. These services will also be purchased by both the general and professional public. I find that the purchasing act will be primarily visual, many consumers having first viewed the service-provider's website, and advertisement or the service-provider's premises itself. I recognise that a number of purchases will conclude after the consumer has sought information or advice from a member of staff. I consider that the average consumer will display some measure of care when making their purchase, although not to the same higher level as found in respect of the class 36 services. The booking of a hotel room or temporary accommodation will, in many cases, not be an infrequent purchase, and typically entails less onerous obligations⁹. Consequently, I find that the average consumer of these services will display a medium level of attention when purchasing them.

Comparison of the marks

Opponent's (earlier) marks	Applicant's (contested) mark
<p>1) WO0000001112855</p>  <p>2) WO0000001478942</p> 	

30. It is clear from *Sabel BV v Puma AG* (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

⁹ It is nevertheless appreciated that the booking of temporary accommodation might entail signing a contract.

impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

32. The Opponent’s submissions on the comparison of the marks can be summarised as follows:

- That the dominant and distinctive element of the Applicant’s mark is ‘VISTA’ by virtue of its positioning at the top of the mark, the gold-coloured font and size of the lettering relative to ‘Residences’. The Opponent argues that ‘Residences’ is descriptive and non-distinctive.
- That the dominant and distinctive element of the contested application, VISTA, ‘is highly visually similar to the Opponent’s marks, ISTA and in particular to registration WO0000001112855 for ISTA’ where the stylisation is very slight.
- That the respective marks are aurally ‘closely similar’. The Opponent argues that the soft pronunciation of the ‘v’ of ‘VISTA’ results in a high level of aural similarity between the respective marks.
- That no conceptual comparison can be made because the Opponent’s marks have no meaning.

33. The Applicant has stated in its Counterstatement that the marks are 'significantly different visually, aurally and conceptually', but has not elaborated on this assertion.
34. The Opponent's mark, registration WO0000001112855, is a word-only mark consisting of the single element 'ista', in a plain black font, with all characters in lower case. The overall impression of the mark therefore resides in the mark in its entirety, the word ista.
35. The Opponent's mark, registration WO0000001478942, also consists of a single word element 'ista', with all characters in lower case. The letters are italicised and have a white infill. Grey shadowing has been added to the letters to give the impression that they are 3-dimensional. It is this shadowing which enables the white lettering to stand out and be seen. There is some stylisation to the word in that the middle characters, and part of the final character, appear to have a horizontal 'slice' taken out of them. This missing 'slice' is a continuation of the space between the post and the tittle¹⁰ of the letter 'i' running almost the entire length of the word, but, stops short of bisecting the vertical post of the letter 'a'. The overall impression of the mark resides in the mark in its entirety, although the word itself will have more significance compared to the stylisation.
36. The Applicant's mark is a word-only mark comprising the words 'Vista' and 'Residences'. Both words are set against a black background. 'Vista' appears in a standard sans-serif font, in large ochre-coloured lettering, all in upper case. The word 'Residences' is arranged below 'Vista' in a much smaller white sans-serif font, all in upper case. The overall impression resides in the mark in its entirety, with the 'Vista' element dominating the mark strongly, owing to its relative size and the fact that the word 'Residences' is descriptive. Although the word 'Residences' is not negligible, it has lesser weight in the overall impression.

¹⁰ The dot of an 'i'.

37. Visual comparison

The respective marks share the letters 'ista', in that order. Points of difference are:

- The presence of the letter 'V' at the beginning of the Applicant's mark, absent from the Opponent's marks;
- The presence of the word 'Residences' in the Applicant's mark, absent from the Opponent's marks;
- The stylisation in the earlier mark WO0000001478942, absent from the Applicant's mark, which itself includes a (small) degree of stylisation.

38. Bearing in mind the overall impressions that I have described, together with the fact that the main difference in the most dominant aspects of the marks (i.e. VISTA/ista) is at the beginning of those words means that, in this case, the difference is more noticeable.¹¹ I therefore find the level of visual similarity between the Applicant's mark and each of the Opponent's marks to be low – medium. I accept that there is slightly more of a difference between the Applicant's mark and the Opponent's *stylised* mark (registration WO0000001478942), but not to the extent that it alters my overall assessment of visual similarity.

39. Aural comparison

Each of the Opponent's marks will be articulated as 'ISS-TUH', with the emphasis on the first syllable. The Applicant's mark will be articulated as 'VISS-TUH RES-ID-UN-SIZ', with the emphasis on the first and third syllables. The Opponent's marks have two syllables as compared to the Applicant's mark's six syllables. It is recognised that the first two syllables of the respective marks are highly similar. However, overall, I find that the marks are aurally similar to a low degree.

40. Conceptual comparison

The word 'ista' will, in my view, be perceived by the average consumer as an invented word. There will therefore be no concept for the mind to fix upon. The word 'vista' on the other hand will, in my view, be understood by the average

¹¹ It is nevertheless appreciated that this is a rule of thumb rather than an absolute rule.

consumer as meaning a view (e.g. of a sweeping landscape), particularly a panoramic or extensive one. 'Residences' will simply be understood as structures which are dwellings. The Applicant's mark will, in my view, conjure the notion of residences in pleasant surroundings e.g. offering fine views. Consequently, I find the respective marks to be conceptually different. In reaching this view, I have borne in mind that the average consumer cannot be presumed to know the meaning of every word in the English language.¹² However, in this case, I consider that the word 'vista' is reasonably well known and that the average consumer will appreciate its meaning.

Distinctive character of the earlier mark

41. *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark

¹² Ms Anna Carboni, as the Appointed Person in *Chorkee Ltd v Cherokee Inc* Case BL O/048/08 urged caution 'not to assume that one's personal experience, knowledge and assumptions are more widespread than they are.' Despite it being a fact that the word Cherokee denotes the name of a tribe indigenous to North America, the Hearing Officer was not entitled to attribute this knowledge to the relevant average consumer.

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).

42. The word 'ista' will be perceived by the average consumer as an invented word. It therefore neither describes nor alludes to the services upon which the Opponent relies in its opposition. Consequently, I find that both of the earlier marks have a high level of inherent distinctive character.

43. The Opponent has not adduced any evidence to enhance the level of inherent distinctive character.

Likelihood of confusion

44. Confusion can be direct or indirect. Mr Iain Purvis Q. C., as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v By Back Beat Inc*¹³. Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*¹⁴, the CJEU recognised that the average consumer rarely encounters the two marks side by side but must rely on the imperfect picture of them that they have kept in mind. Direct confusion can therefore occur by imperfect recollection when the average consumer sees the later mark but mistakenly matches it to the imperfect image of the earlier mark in their 'mind's eye'. Indirect confusion occurs when the average consumer recognises that the competing marks are not the same in some respect, but the similarities between them, combined with the goods/services at issue, leads them to conclude that the goods/services are the responsibility of the same or economically linked undertaking.

¹³ Case BL O/375/10 at [16].

¹⁴ *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].

45. I must keep in mind that a global assessment is required taking into account all of the relevant factors, including the principles a) – k) set out above at [11]. When considering all relevant factors ‘in the round’, I must bear in mind that a greater degree of similarity between goods/services *may* be offset by a lesser degree of similarity between the marks, and vice versa.

46. I consider that, despite the fact that some of the respective services are identical, the net effect of the visual, aural and conceptual differences is sufficient to overcome the visual and aural similarities that I have identified. Notwithstanding the principle of imperfect recollection, the average consumer will, in my view, notice that the dominant element of the Applicant’s mark comprises the word ‘VISTA’, whereas the dominant element of the Opponent’s marks does not. I acknowledge that a conceptual difference does not necessarily rule out a likelihood of confusion¹⁵. However, in the instant case, given that the key visual difference between the elements VISTA/ista is at the beginning of the respective marks, and will not escape the attention of the average consumer during the purchasing process with the level of attention described, I find that the conceptual difference points away from a finding of likelihood of confusion. I find this to be the case even though I have found the earlier marks to have a high degree of inherent distinctive character.

47. I now consider whether there is a likelihood of indirect confusion.

48. In my view, the average consumer will notice that one mark is based on ‘VISTA’ whereas the other mark is based on ‘ista’. I can see no reason why the average consumer would presume that the same or economically linked undertaking is responsible for the relevant services. The instant case does not fall within any of

¹⁵ In *Nokia Oyj v OHIM*, Case T-460/07, the General Court stated that:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

the categories identified in *L.A. Sugar Limited v By Back Beat Inc*¹⁶, and I can see no other mental process by which the average consumer would arrive at a conclusion indicative of indirect confusion.

Conclusion

49. The Opposition fails. Subject to any successful appeal against this Decision, the application may proceed to registration.

¹⁶ Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (‘FAT FACE’ to ‘BRAT FACE’ for example)”.

COSTS

50. I award the Applicant the sum of **£200** as contribution towards its costs, calculated as follows¹⁷:

Consideration of the Opposition and preparation of Defence and Counterstatement	£200
Total:	£200

51. I therefore order ista Deutschland GmbH to pay to Mayfair Estates Limited the sum of £200. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 3rd day of March 2022

Mx N. R. Morris
For the Registrar,
the Comptroller-General

¹⁷ Based upon the scale published in Tribunal Practice Notice 2/2016.