

O-225-08

TRADE MARK ACT 1994

**IN THE MATTER OF APPLICATIONS NOS 2341206 AND 2341211
BY REO (POWERSTATION) LIMITED (PREVIOUSLY PARKVIEW
INTERNATIONAL LONDON PLC) TO REGISTER
TRADE MARKS IN CLASSES 25, 35, 36 AND 42**

AND

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS NOS 95150 AND
95151 BY QUORN TRAVEL SERVICES LTD**

TRADE MARKS ACT 1994

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By REO (Powerstation) Limited (previously Parkview International London Plc)
to register Trade Marks in Classes 25, 35, 36 & 42**

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**IN THE MATTER OF Consolidated Oppositions Nos 95150 and 95151 by
Quorn Travel Services Ltd**

BACKGROUND

1. On 19 August 2003 REO (Powerstation) Ltd (previously Parkview International London Plc) applied to register the following marks:

No 2341206 - The Power Station London

No 2341211 -



(series of two)

2. The applicant claimed the colours red and white as an element of the first mark in the above series. The specifications are cast in identical terms save for the underlined items in what follows. The underlined words (whether by accident or design) appear in the specification of no. 2341206 but not that of no. 2341211:

Class 25:

Clothing, footwear and headgear.

Class 35:

The bringing together for the benefit of others of a variety of clothing, footwear and headgear, food and drink products, kitchen and household goods, domestic electrical goods and domestic electronic equipment, toys, games and playthings, hardware and furniture products, flowers and stationery, garden and DIY products, jewellery and health and beauty products, enabling customers to conveniently view and purchase clothing, footwear and headgear, food and drink products, kitchen and household goods, domestic electrical goods and domestic electronic equipment, toys, games and playthings, hardware and furniture products, flowers and stationery, garden and DIY products, jewellery and health and beauty products, in an entertainment, sport, leisure, health, education and cultural complex; buying of goods for others; advisory services relating to the selection of goods.

Class 36:

Rental of space for use as retail outlets, outlets for the provision of food, drink, temporary accommodation or for use in the provision of all of the aforementioned services.

Class 42:

Design of retail stores, shopping fixtures and displays.

3. On 25 April 2007, Quorn Travel Services Ltd filed notices of opposition to these applications citing grounds under Section 3(1)(c), 3(6), 5(2)(b), 5(3) and 5(4)(a) (the grounds are the same in each case). More specifically the opponent pleads as follows:

- 3(1)(c) - that the applicant intends to use the mark in respect of services and goods offered and sold from the property development at Battersea Power Station in London and is therefore using the mark as an indication of geographical location and origin.
- 3(6) - the applicant, prior to filing the application, sought a declaration of invalidity as to the opponent's mark (relied upon in this opposition) to obtain freedom to operate under the THE POWER STATION mark. The applicant failed to obtain the declaration and the Registry in its decision of 22 July 2005, upheld the validity of the opponent's registered mark. The applicant subsequently appealed the Registry's decision but unconditionally withdrew its appeal 2 days before the hearing before the Appointed Person.

In making the application, the applicant now attempts to obtain the right to use the mark THE POWER STATION LONDON by virtue

of a registration, including the right to use a registration as a defence to infringement in accordance with Section 11(1) of the Trade Marks Act 1994. The applicant is fully aware of the existence of the opponent's conflicting earlier registration. Accordingly, the application is a misuse of the registration system to try to obtain an advantage over the opponent and its earlier right. The application has been made in bad faith since the predominant portion of the mark THE POWER STATION is the proprietary and earlier registered trade mark of the opponent and the application, if successful, will permit the applicant to trade under the opponent's mark and rely on the opponent's reputation in the mark.

5(2)(b)- in relation to this ground the opponent indicates that it is relying on the full range of services covered by its registration of the mark THE POWER STATION, that is to say services in Classes 35, 36, 39, 41 and 42 (full details appear later in the decision). The opponent further indicates that it objects to all the services covered by the applied for mark (but not the Class 25 goods).

5(3) - the opponent has submitted a lengthy set of submissions in relation to both the respective marks and services leading to claims based on both the unfair advantage and detriment limbs of Section 5(3). Again the opposition is directed at the applied for services but not the Class 25 goods.

5(4)(a)- under this head the opponent states that THE POWER STATION has been used as a trade mark, trading style, trading name, business name and style in relation to services that are the same as those covered by its earlier trade mark. Use is claimed since May 2002 resulting in goodwill for passing off purposes.

4. The applicant filed a counterstatement denying each of the above grounds. The counterstatement includes a number of submissions in relation to the parties' marks and services and puts the opponent to strict proof as to its claimed reputation.

5. Only the opponent has filed evidence in this case. Neither side has requested a hearing and neither side filed written submissions at the conclusion of the evidence rounds. However, I note and take into account the submissions that are contained in the pleadings and the evidence filed by the opponent.

6. The oppositions were consolidated at an early stage.

Earlier proceedings involving the parties

7. On 22 July 2005 a decision was issued under O-207-05 in invalidity proceedings taken by the current applicant's predecessor in title against the current opponent in relation to the earlier trade mark (no. 2310340) relied on in this case. In the earlier case Parkview International London Plc relied on its own series of marks, THE POWER STATION AT BATTERSEA and THE POWER STATION @ BATTERSEA in its efforts to invalidate no. 2310340. There is some, but by no

means a complete, overlap between the goods and services relied on by the applicant in the earlier invalidity action and those applied for in the current application. The application for invalidation failed with the result that no. 2310340 proceeded to registration and forms the basis of the current opposition.

8. The evidence that is now before me has been filed by Darren Gilbert, the opponent's Chief Executive Officer and includes a set of the pleadings and evidence filed in the earlier case (Exhibits 1 to 5) . The remainder of Mr Gilbert's witness statement is submission and will be treated accordingly.

9. As no further evidence has been filed beyond that from the earlier case, and as no complaint is made that the hearing officer's summary in any way misrepresented the evidence, I have annexed to this decision a copy of the decision in O-207-05. The parties' evidence in chief is dealt with in paragraphs 7 to 21 thereof. The registered proprietor's evidence now forms the basis of the opponent's case here particularly in so far as Section 5(3) and 5(4)(a) are concerned.

Scope of the oppositions

10. It is clear from the statement of grounds that the Section 5(2)(b) and 5(3) objections are directed against the services of the applied for mark. It is not clear whether the other grounds are similarly restricted in scope. The opponent's evidence/submissions do not resolve the matter. My sense of the matter is that it is the applicant's services that represent the primary cause of concern but in the absence of a clear statement limiting the scope of the opposition as a whole (and bearing in mind that there is a bad faith claim) I propose to err on the side of caution and assume that the objection is against the application as a whole. I will take the objections in order.

Section 3(1)(c)

11. Section 3(1)(c) disqualifies from registration

“(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services.”

12. The public interest underlying the provision was explained in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* at paragraph 54:

“As the court has already held (*Windsurfing Chiemsee*, paragraph 25, *Linde*, paragraph 73, and *Libertel*, paragraph 52), Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that such signs or indications may be freely used by all. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.”

13. The objection as framed by the opponent is that the applicant intends to use the mark in respect of services and goods offered and sold from the property development

at Battersea Power Station in London and is, therefore, using the mark as an indication of geographical location and origin.

14. The marks are not, of course, Battersea Power Station, but the less precise The Power Station London in the forms set out above. The current applicant faced a geographical origin objection in opposition proceedings (not involving the current opponent) against the mark BATTERSEA POWER STATION (O-063-04) with the hearing officer finding:

“So even if one took the broad, literal view that Battersea Power Station could be defined as a geographical location, and one that would be known by a good many people, one then has to consider the sign BATTERSEA POWER STATION within the context of the Directive. Considered within the context of the Directive defined by the case law, I cannot see that it can be held that BATTERSEA POWER STATION is an indicator of the geographic origin of the services in the sense behind article 3(1)(c). There is no need now or in the future for other undertakings to have use of this sign for the services of the application. It is private property, owned by an undertaking. It is outside of the public domain and the public interest. This is a matter between the owners of the building and those who may wish to use it.”

15. The combination of BATTERSEA and the words THE POWER STATION may be said to lend a degree of specificity that is not present in the mark applied for. There are other existing or former power stations in or serving London. The Bankside Power Station (now the home of Tate Modern) is possibly the best known. The mark The Power Station London cannot and does not refer to or identify any particular location save for the generalised reference to London. The issue is whether the combination The Power Station London needs to be kept free for others to use because it indicates geographical origin. The context in which that question has to be considered is the goods and services applied for. In relation to those goods and services, the mark as a whole is not a geographical indication and I can see no need for other undertakings to have use of the sign any more than the opponent’s mark would give rise to such a requirement in relation to the services in respect of which it is registered.

Section 3(6)

16. This provides that a trade mark shall not be registered if or to the extent that the application is made in bad faith. The relevant jurisprudence was reviewed by Geoffrey Hobbs QC, sitting as the Appointed Person, in *Melly’s Trade Mark Application (Fianna Fail and Fine Gael)* [2008] RPC 20, paragraph 49 et seq.

17. The opponent’s position is that the applicant, having failed to obtain the declaration sought in its failed invalidity action, has applied for the marks in question as a means of providing a defence to infringement within the terms of Section 11(1) in the knowledge of the opponent’s conflicting earlier registration.

18. Section 3(6) is concerned with the state of affairs that existed at the date of application (see Kerly’s Law of Trade Marks and Trade Names, Fourteenth Edition at 8-277). Events after that date are irrelevant save to the extent that they shed light

retrospectively as it were on the position (including the applicant's state of knowledge) at the relevant date.

19. It is useful at this point to set out the chronology of the parties' applications and registrations, along with the dates of the attacks on those applications and registrations. In the following I have used REO for convenience though it should be noted that, strictly speaking, at the relevant times most of the actions were undertaken in the name of REO's predecessor in title Parkview International London Plc.

- 31 May 2000 - REO applied for the mark BATTERSEA POWER STATION (under no. 2234317) in Classes 35, 39, 41 and 42. The mark was registered on 28 May 2004 after an unsuccessful opposition by a third party.
- On the same date REO applied for THE POWER STATION AT BATTERSEA (series) (under no. 2234324) in Classes 25, 35, 39, 41, 42, 43 and 45. The marks were registered on 5 April 2002.
- 11 September 2002 - Quorn applied for the mark THE POWER STATION (under no. 2310340) in Classes 35, 36, 39, 41 and 42.
- 19 August 2003 - REO filed the applications now under attack in Classes 25, 35, 36 and 42.
- 25 October 2004 - REO sought invalidation of no. 2310340
- 22 July 2005 - Hearing Officer's decision rejecting REO's application to invalidate no. 2310340
- 25 April 2007 - Quorn launches its oppositions to the marks filed by REO on 19 August 2003.

20. What this shows is that there are two undertakings with competing interests in and claims on marks consisting of or incorporating the words POWER STATION or THE POWER STATION. The sequence of applications and actions commenced with REO's filings on 31 May 2000. It is not unusual for undertakings with identical or similar marks to operate in goods and services areas that may overlap to a greater or lesser extent and to seek to protect their interests by filing trade mark applications. But that is not in itself an indication of an act of bad faith on either part. It simply points to the sort of relative grounds issues that are at the heart of most oppositions. It is true that REO has now applied for marks that are arguably closer to Quorn's but I am not prepared to infer from that that there was any dishonest intent on REO's part.

21. It is also clear from the above chronology that REO's current applications were filed prior to the launching of the unsuccessful invalidation actions against Quorn's registration no. 2310340. It also follows that the applications pre-dated the filing of Quorn's evidence of use in that case (Mr Gilbert's witness statement in that case was dated 9 March 2005) and the hearing officer's decision. REO would not therefore have known what Quorn's use position would be let alone what the hearing officer

would decide. In those circumstances it was fully entitled to protect its position. Far from it being an act of bad faith to have filed its application on 19 August 2003, it was prudent to have done so in order that the parties' relative positions could be resolved in inter partes actions if necessary. I reject any suggestion of bad faith at the relevant date of 19 August 2003.

Section 5(2)(b)

22. The relevant part of Section 5(2) of the Act is as follows:

“(2) A trade mark shall not be registered if because –

(a) –

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

23. On 27 April 2006, the European Court of Justice (ECJ) handed down a reasoned Order disposing of the appeal in Case C-235/05P *L'Oreal SA v. OHIM*. The relevant legal principles, drawn principally from the Court's earlier judgments in *Sabel* [1998] RPC 199, *Lloyd Schuhfabrik Meyer* [2000] FSR 77 and *Canon* [1999] RPC 117 are set out in that Order, the relevant part of which is re-produced below:

“34 It is settled case-law that likelihood of confusion on the part of the public must be assessed globally, taking into account all factors relevant to the circumstances of the case (see, to that effect, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 22; Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 18; and order of 28 April 2004 in Case C-3/03 P *Matratzen Concord v OHIM* [2004] ECR I-3657, paragraph 28).

35 That global assessment implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between the goods or services covered. Thus, a lesser degree of similarity between those goods or services may be offset by a greater degree of similarity between the marks, and vice versa. Accordingly, it is necessary to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the assessment of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services covered (see *Canon*, paragraph 17, and *Lloyd Schuhfabrik Meyer*, paragraph 19).

36 In that regard, as the more distinctive the earlier mark, the greater the risk of confusion (*SABEL*, paragraph 24), marks with a highly distinctive character, either *per se* or because of the reputation they possess on the

market, enjoy broader protection than marks with a less distinctive character (see *Canon*, paragraph 18, and *Lloyd Schuhfabrik Meyer*, paragraph 20).

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- 40 In the first place, it is settled case-law that in order to assess the degree of similarity between the marks concerned, it is necessary to determine the degree of visual, aural or conceptual similarity between them and, where appropriate, to determine the importance to be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed (see *Lloyd Schuhfabrik Meyer*, paragraph 27).
 - 41 In addition, the global assessment of the likelihood of confusion must, as regards the visual, aural or conceptual similarity of the marks in question, be based on the overall impression created by them, bearing in mind, in particular, their distinctive and dominant components. The perception of the marks in the mind of the average consumer of the goods or services in question plays a decisive role in the global assessment of the likelihood of confusion (see *SABEL*, paragraph 23, *Lloyd Schuhfabrik Meyer*, paragraph 25, and the order in Case C-3/03 P *Matratzen Concord v OHIM*, paragraph 29).
 - 42 It follows that the distinctive character of the earlier mark cannot have the significance which the applicant argues it should be given in the comparison of the signs in question, as it is not a factor which influences the perception which the consumer has of the similarity of the signs.
 - 43 It must therefore be held that the applicant has misconstrued the concepts which govern the determination of whether a likelihood of confusion between two marks exists, by failing to distinguish between the notion of the distinctive character of the earlier mark, which determines the protection afforded to that mark, and the notion of the distinctive character which an element of a complex mark possesses, which is concerned with its ability to dominate the overall impression created by the mark.”

Comparison of services

24. The leading authorities on how to go about determining similarity between goods and services are accepted to be the *Canon* case (supra) and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the ECJ accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (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;
- (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.

25. These criteria are, of course, intended to be of general applicability but not all are equally relevant in all circumstances ((e) above being an obvious example of an inapplicable criterion where services are concerned). I also bear in mind it was held in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 that:

“.... definition of services are inherently less precise than specifications of goods. The latter can be, and generally are, rather precise, such as “boots and shoes.”

In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase”.

26. The services are as follows:

Applicant’s (No. 2341206)	Opponent’s
The bringing together for the benefit of others of a variety of clothing, footwear and headgear, food and drink products, kitchen and household goods, domestic electrical goods and domestic electronic equipment, toys, games and playthings, hardware and furniture products, flowers and stationery, garden and DIY products, jewellery and health and beauty products, enabling customers to conveniently view and purchase clothing, footwear and headgear, food and drink products, kitchen and household goods, domestic electrical goods and domestic electronic equipment, toys, games and playthings, hardware and furniture products, flowers and stationery, garden and DIY products,	Marketing services; business consultancy services; business and market research services; publicity and promotional services; statistical analysis services. (Class 42)

jewellery and health and beauty products, in an entertainment, sport, leisure, health, education and cultural complex; buying of goods for others; advisory services relating to the selection of goods. (Class 35)	
Rental of space for use as retail outlets, outlets for the provision of food, drink, temporary accommodation or for use in the provision of all of the aforementioned services. (Class 36)	Travel insurance services. (Class 36)
	Travel agency services; arranging transportation of goods, passengers and travellers; travel reservation and travel booking services; advisory and information services relating to the aforesaid. (Class 39)
	Production of corporate and promotional videos; organisation and provision of conferences, seminars and exhibitions; corporate hospitality services; educational and training services. (Class 39)
Design of retail stores, shopping fixtures and displays. (Class 42)	Creating and maintaining websites; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; art work design; brochure design; consultancy services relating to design; corporate identity, image and logo design services; design of exhibition stands; design of marketing, publicity, advertising and promotional materials, none of the aforesaid services relating to medical products. (Class 42)

27. The opponent's statement of grounds did not expand on issues of similarity in dealing with Section 5(2). An indication of its position can, however, be obtained from the following supplementary comments lodged in support of the Section 5(3) ground:

“The opponent's registration covers services including marketing services and publicity and promotions services in Class 35. The applicant seeks to register a variety of retail services in Class 35 to be presented in an entertainment, sport, leisure, health, education and cultural complex. The applicant also seeks to register the provision of services whereby they will purchase goods for others and advise in relation to the selection of goods in Class 35. Each of the applicant's services in this class are covered by the opponent's broader specification and accordingly are very similar, if not identical, to the services for which the opponent has prior rights in the THE POWER STATION mark.

The opponent's registration also covers services including consultancy services relating to design; corporate identity, image and logo design services; design of exhibition stands; and design of marketing, publicity, advertising and promotional material in Class 42. The applicant seeks to register services for the design of retail stores, shopping fixtures and displays. Accordingly, the applicant's services in this class are very similar, if not identical, to the services for which the opponent has prior rights in THE POWER STATION mark.

The opponent's registration covers services for travel insurance services in Class 36. The applicant seeks registration of their mark for rental of space for retail outlets which could include insurance outlets. Accordingly, the services are similar to those of the opponent."

28. To that I need to add the following drawn from Mr Gilbert's witness statement:

"A non-exhaustive example of the identical or similar nature of the services is as follows:

- 24.1 The opponent is the operator of a business which provides, amongst other things, marketing and promotional services and hospitality, education and exhibition services to operations and businesses in the UK.
- 24.2 The applicant seeks to register a variety of services in Class 35. The applicant's services specified by the applicant in Class 35 are covered by the opponent's broader specification and accordingly are very similar, if not identical, to the services for which the opponent has prior rights in the opponent's mark.
- 24.3 The opponent's registration also covers services including, inter alia, consultancy services relating to design, corporate identity, image and logo design services, design of marketing, publicity, advertising and promotional material in Class 42. The applicant seeks to register services for the design of retail stores, shopping fixtures and displays. Accordingly, the applicant's services in this class are very similar, if not identical, to the services for which the opponent has prior rights in the opponent's mark."

29. Taking the objections in Class order, the applicant's retail services specification ("The bringing together for the benefit of others") is said to clash with the opponent's broader specification in Class 35. The objection is linked particularly to the provision of the retail services in an entertainment, sport, leisure, health, education and cultural complex. The opponent's Class 35 specification covers a number of business services. No further information has been given as to which of these services is considered to be identical or similar to retail services or why this should be the case. On the face of it the nature, intended purpose, channels of trade of the opponent's Class 35 services would be likely to differ. Moreover, the average consumer for retail

services (of the goods identified) would be the general public whereas the average consumer for the opponent's services would be more likely to be businesses. Nor are the respective services complementary or competitive. If the opponent is intending to suggest that the respective services are similar because retailers may be users of marketing and other business services then that fails to distinguish the relevant consumer groups or to take into account the guidance from *Avnet*. In short I can see no similarity.

30. Also included in the applicant's Class 35 specification is "buying of goods for others; advisory services relating to the selection of goods." Although these terms are somewhat vague in that they do not disclose the precise nature of the underlying commercial intention, the terms used suggest that they are or could include services provided to other businesses. If that is so they are different in kind to the preceding part of the Class 35 specification. The buying of goods for others and advisory services relating to the selection of goods would cover, for example, the services of a sourcing company. Sourcing companies are active in the business of advising on the selection and purchase of promotional and incentive gifts that traders may wish to offer as inducements to purchase their goods/services or generally to promote awareness of their business. Such services must also fall within the broad terms business services and publicity and promotional services contained in the opponent's Class 35 specification. I note too that the opponent's activities encompass incentives programmes (see the Whirlpool press release in Exhibit DG5 contained within Exhibit 3). If not identical they must be closely similar.

31. Turning to Class 36, the submission here is that rental of space for retail outlets (the applicant's service) could include the provision of that service to a supplier of travel insurance services (the opponent's service) and there is thus similarity. If that was the case then rental of space for retail outlets would be likely to clash with all or any specification for goods and services that were to be provided from such an outlet. That cannot be right. The business of trading in goods or services from a retail outlet is quite different in character from that of renting premises. Applying the *Canon/Treat* criteria, the uses, the purpose, the nature of the act of service and channels of trade would differ. The respective services are neither complementary nor competitive. If, as the opponent appears to suggest, there could be overlapping consumers because an insurer may find itself renting premises from another undertaking with a similar mark, that is no more than the sort of occasional coincidence that is likely to arise from time to time. It does not point to the average consumer being the same and in any case there would be no confusion on the part of the parties themselves in the sort of circumstances postulated above.

32. The third category of services to be considered is the applicant's design services in Class 42. Specifically, they relate to the design of retail stores, shopping fixtures and displays. Here, there is a clash with the various categories of design services contained in the opponent's Class 42 specification. In particular, the applied for services are either the same as or closely similar to the design of publicity, advertising and promotional materials along with consultancy services relating to design (the opponent's specification is unrestricted in this respect save for the exclusion relating to medical products). In coming to that view, it should be said that the evidence before me (in particular Exhibit DG5 contained within Exhibit 3) suggests that the opponent is engaged in corporate marketing and communications issues rather than

retail design services. Nevertheless, its specification does not restrict the design of promotional materials etc in this way. As a consequence I find the applicant's Class 42 design services to be similar to those of the more broadly based design services and consultancy services relating to design in the opponent's specification.

33. The position reached in relation to the respective services is that "buying of goods for others; advisory services relating to the selection of goods" (Class 35) and "design of retail stores, shopping fixtures and displays" (Class 42) are identical or similar. The balance of the applicant's specification covers dissimilar services.

Comparison of marks

34. The opponent's evidence/submissions have sought to distinguish between the marks at issue in the earlier invalidity action and the marks in this case. At the heart of its submissions is the claim that THE POWER STATION AT BATTERSEA (the mark of the earlier proceedings between the parties) created an immediate conceptual association with a particular power station whereas the current marks do not share that point of differentiation. The applicant's counterstatement denies that THE POWER STATION is more dominant and distinctive than the element LONDON and suggests that, taken as a whole, its mark is visually and aurally dissimilar to the opponent's registration.

35. It is well established that assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; Case C-120/04 *Medion AG v Thomson multimedia Sales Germany & Austria GmbH*.

36. Furthermore it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; Case C-334/05P *Shaker di L. Laudato & C.Sas v OHIM*.

37. The applicant's submission in relation to the contribution made to its mark by the element LONDON does not accord with how consumers are likely to perceive the component elements. The element LONDON will inescapably be seen as a geographical indication which in turn focuses attention on THE POWER HOUSE as the dominant and distinctive element of the applied for marks. Nor can it be seriously suggested that the colour claim attaching to the first mark in the series of No. 2341211 affects that finding.

38. Once that point is reached it does not require a detailed analysis of the visual, aural and conceptual similarities to determine that the competing marks are very closely similar.

Distinctive character of the earlier trade mark

39. This falls to be assessed independently of the issues of the distinctive character which an element of a mark possesses and the similarity between the marks (the

L'Oreal case referred to above at paragraph 43). In relation to the services that are most relevant to this opposition, the earlier trade mark does not act as a descriptor. On the contrary it appears to be a mark of reasonable distinctiveness. The opponent has not specifically claimed an enhanced distinctive character acquired through use of its mark. Suffice to say that on the evidence before me any such claim would be bound to fail on the basis of the limited use that had taken place by the relevant date in these proceedings and the difficulty in establishing the level of market recognition that the mark had achieved (see *Steelco Trade Mark*, O-268-04 at paragraph 17).

The average consumer

40. I have referred at various points above to the average consumer. There is no single or homogenous group of consumers for the services at issue. There will be a mixture of business users and ordinary members of the public (the latter particularly in the case of the applicant's retail services). Some of the services (travel insurance services for instance) will find both corporate and private users. It is fair to say, however, that in relation to the services I have found to be similar the relevant public will predominantly be business users. They can be expected to exercise a reasonable degree of care in selecting the services concerned.

Likelihood of confusion

41. This is a matter of global appreciation. In relation to those services that I have found to be identical or similar, the use of such closely similar marks is bound to lead to confusion in the marketplace. Accordingly, the opposition succeeds in relation to the services identified above but fails in relation to the balance of the specification.

Section 5(3)

42. Section 5(3) as amended by The Trade Marks (Proof of Use, etc) Regulations 2004 (SI 2004 No. 946) giving effect to the judgments of the ECJ in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* (C- 292/00) and *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* (C-408/01) of the Act reads as follows:

“5-(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark,

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

43. One of the underpinning requirements for success under this provision is that the earlier trade mark has a reputation. The accepted test for reputation is to be found in *General Motors Corp v Yplon SA (Chevy)* [1999] E.T.M.R. 122 and [2000] RPC 572.

“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 service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

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.

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.

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.

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."

44. The only evidence of reputation that is before me is that contained in the material from the previous proceedings between the parties as summarised in the annexed copy of the decision in that case. In essence, the position is described in paragraphs 16 and 17 of that decision. The use amounted to just over one year's trading prior to the material date in the current action of 19 August 2003. The use is described as being "in respect of the services covered by registration No. 2310340". If that is so then the turnover of £920,921 (or just over that sum by the relevant date) has been spread across five service classes but no disaggregated trading figures have been supplied that would enable me to gauge the position in relation to particular services within the broad scope of the specification of No. 2310340. It is inherently unlikely that the trade was spread uniformly across the range of services. But beyond that I am left to speculate as to what recognition has been achieved in relation to any particular service.

45. Exhibit DG5 (contained in Exhibit 3) sheds some light on the opponent's business. A consistent theme of the exhibited promotional and testimonial material is that the opponent is active in the following broad areas:

- strategic planning and business development
- integrated marketing and communications
- market intelligence and research
- customer acquisition
- benchmarking, performance trading and customer feedback

46. These are in themselves broad areas of business services. There are likely to be very many players in each of these fields. In terms of this sort of criteria identified in the above passage from the *Chevy* case I simply have no way of judging the

opponent's position in this broad marketplace. Even allowing for the fact that the *Chevy* considerations should not be read in an overly prescriptive fashion it is abundantly clear that the opponent has failed to establish the sort of reputation that is necessary to be successful in an action under Section 5(3). This ground must fail.

Section 5(4)(a)

47. The relevant part of the statute, Section 5(4)(a), reads as follows:

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

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

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

48. The requirements for a passing off action can be summarised as being:

- (1) that the opponent's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicant are goods or services of the opponent; and
- (3) that the opponent has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the applicant's misrepresentation.

49. The first matter is to establish whether the opponent can claim goodwill and if so what the nature and extent of that goodwill is. For the reasons given above in relation to Section 5(3) , the opponent's evidence has not been presented in a way that enables me to assess actual trade against the generality of the claim covering five classes of services (the opponent's claim under Section 5(4)(a) is co-extensive with the services of its registration).

50. Exhibit DG5 contains a company profile for the opponent, press releases relating to work done for client companies and what I take to be a copy of a corporate brochure. The latter includes a client list including some well known names such as Bentley, Zurich, De La Rue, Royal London, etc. Much of the material is either undated or refers to dates that would place the reported activities outside the relevant period. The activities appear to be concentrated in the field of marketing and communications initiatives, customer acquisition programmes and incentive programmes. However, I am not satisfied that sufficient supporting detail has been

provided for me to be satisfied as to the nature and extent of any goodwill that existed as at 19 August 2003 bearing in mind the guidance in paragraphs 27 and 28 of *Reef Trade Mark* [2002] R.P.C. 19.

51. If I am wrong in that and the opponent is entitled to claim goodwill, it is likely to relate to the business areas I have identified above. That being so it would not improve the opponent's position in any way over and above the case already considered under Section 5(2)(b). In conclusion the oppositions succeed under Section 5(2)(b) in relation to:

“Buying of goods for others; advisory services relating to the selection of goods” (Class 35)

and

“Design of retail stores, shopping fixtures and displays” (Class 42)

but fail in relation to the balance of the applicant's specification and fail in relation to the other grounds.

Costs

52. As both parties can claim a measure of success I do not propose to favour either side with an award of costs.

Dated this 8th day of August 2008

**M REYNOLDS
For the Registrar
the Comptroller-General**