

O/365/19

SUPPLEMENTARY DECISION

TRADE MARKS ACT 1994

**IN THE MATTER OF THE UK DESIGNATION OF INTERNATIONAL
REGISTRATIONS NOS. 1330134, 1336257 AND 1344000 BY
CENTURION CORPORATION LIMITED FOR PROTECTION OF THE
FOLLOWING TRADE MARKS IN CLASSES 36 & 43:**

**DWELL STUDENT
DWELL**



AND

**IN THE MATTER OF THE OPPOSITIONS THERETO
UNDER NOS. 410349, 410381 AND 410384 BY
COIN FURNITURE LIMITED**

1. On 9 April 2019, I issued a decision in these proceedings, the outcome of which I reproduce below:¹

Conclusion

148. Subject to the comments in paragraphs 149 to 151, the oppositions have been partially successful and the UK designation by Centurion Corporation may proceed to registration in respect of the following services:

Mark	Services
IR1330134	<u>Class 36</u> Management of real estate, apartments and buildings; real estate affairs; renting or leasing of apartments, accommodation and real estate; accommodation bureaux (apartments); real estate investment; real estate investment management; and property portfolio management.
IR1336257	<u>Class 36</u> Management of real estate, apartments and buildings; real estate affairs; renting or leasing of apartments, accommodation and real estate; real estate investment; real estate investment management; and property portfolio management.
IR1344000	<u>Class 36</u> Management of real estate, apartments and buildings; real estate affairs; renting or leasing of apartments, accommodation and real estate; accommodation bureaux (apartments); real estate investment; real estate investment management; and property portfolio management.

¹ BL O/189/18.

Revised specification

149. In the above conclusions, I have upheld the opposition against the following services – accommodation bureaux (boarding houses); agency services for the reservation of accommodation; arranging of temporary accommodation; boarding house bookings; consultancy and advisory services relating to the provision of temporary accommodation; providing information, including online, about services for providing temporary accommodation; provision of temporary accommodation; temporary accommodation reservations – on the basis of similarity to public house services. However, if the terms were to be limited then it may be possible to register the marks for student accommodation as a distinct category. Such accommodation tends to be reserved for periods of at least one academic year, making it different in character from the type of short-term accommodation offered by some public houses, which will more normally provide rooms for a few nights. Student accommodation will also provide a wider range of facilities than a public house or a hotel, such as kitchens and laundry rooms for the occupants to use.

150. In view of this, Centurion Corporation is permitted 14 days to put forward any revised terms that:

- (a) fall within the ambit of the services listed in the previous paragraph; and
- (b) are distinguishable from terms describing the more general temporary accommodation services, such as those provided by some public houses.

151. Coin Furniture will be allowed 14 days to comment on any proposed terms and I will then issue a supplementary decision in which I will decide whether any proposed terms are free from objection. If Centurion puts forward no revised terms then I will issue a supplementary decision confirming the outcome as it stands in paragraph 148 above. In the supplementary decision, I will also issue my decision on costs. The appeal period for the substantive and supplementary decisions will run from the date of the supplementary decision.

2. Centurion Corporation Limited (“the holder”) filed a revised specification for services in Class 43 on 23 April 2019 as follows:

Accommodation bureaux (boarding houses) for purpose-built student accommodation, all-inclusive student accommodation and halls of residence student accommodation; agency services for the reservation of purpose-built student accommodation, all-inclusive student accommodation and halls of residence student accommodation; arranging purpose-built student accommodation, all-inclusive student accommodation and halls of residence student accommodation; bookings for purpose-built student accommodation, all-inclusive student accommodation and halls of residence student accommodation; consultancy and advisory services relating to the provision of purpose-built student accommodation, all-inclusive student accommodation and halls of residence student accommodation; providing information, including online, about services for providing purpose-built student accommodation, all-inclusive student accommodation and halls of residence student accommodation; provision of purpose-built student accommodation, all-inclusive student accommodation and halls of residence student accommodation; reservations for purpose-built student accommodation, all-inclusive student accommodation and halls of residence student accommodation.

3. Coin Furniture Limited (“the opponent”) submitted its comments on the revised specification on 8 May 2019. The opponent submits that, as I had found that some of the holder’s services were similar to its *public house services*, it was inconsistent to permit the holder to revise its specification. Even were it to accept that a limitation is possible, it disagrees with the holder’s proposal, submitting that it broadens the specification to include the provision of food and that the proposed amendments would not remove the likelihood of confusion.
4. The holder responded on 29 May 2019, disagreeing with the opponent’s submissions.
5. The holder’s revised specification reproduces the services listed in paragraph 149 of the substantive decision, with the qualification that each of these services is limited to *purpose-built student accommodation, all-inclusive student accommodation and halls of residence student accommodation*. I shall therefore

consider these particular terms in this supplementary decision and I remind myself of the need to keep in mind “the core of [their] ordinary and natural meaning”.²

6. I shall deal first with *purpose-built student accommodation*. Terms used in specifications should be clear and precise so that third parties are able to understand the scope of the goods and services covered by the registration: see *The Chartered Institute of Patent Attorneys (Trademarks) v Registrar of Trade Marks (IP Translator)*, Case C-307/10, paragraphs 46-49. The case law on this issue was discussed in detail by Carr J in *Gap (ITM) Inc v Gap 360 Ltd* [2019] EWHC 1161 (Ch). He quoted approvingly the judgment of Sales J (as he then was) in *Total Limited v YouView TV Limited* [2014] EWHC 1963:

“... The CJEU in *IP Translator* clearly did not mean that *any* degree of uncertainty of application of a word or phrase in a classification relating to a mark would mean that registration for that trade mark would be refused. The issue is whether there is such lack of clarity and precision in the specification given as to create an unacceptable or unreasonable level of uncertainty regarding the scope of protection given by the trade mark, having regard to the context in which it is to operate.”³

Carr J stressed, however, that this should not be taken to mean that the requirements of clarity and precision should be regarded as “unimportant or ... be lightly dismissed”.⁴

7. Mr Richard Arnold QC (as he then was), sitting as the Appointed Person, commented in *MERLIN Trade Mark*, BL O/043/05, that, in his view, the CJEU’s judgment in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau (POSTKANTOOR)*, Case C-363/99, did not make it impermissible to define services in part by the recipient of those services. Following this reasoning, *student accommodation* might, in principle, be capable of acting as a term in a

² *FIL Limited and another v Fidelis Underwriting Limited and others* [2018] EWHC 1097 (Pat), paragraph 86, cited in paragraph 46 of the main decision.

³ Paragraph 57.

⁴ Paragraph 41.

trade mark specification. However, in this particular case, I see two problems with the term *purpose-built student accommodation*. The first is that, to my mind, it is insufficiently distinguishable from the temporary accommodation services provided by public houses. It is a general term, qualified by a reference to the intended users of the service. Students may live in many types of accommodation. Secondly, “purpose built” is a characteristic of the services provided that may, in the words of Mr Geoffrey Hobbs QC, sitting as the Appointed Person in *Croom’s Application*, BL O/120/04, “be present or absent without changing the nature, function or purpose”⁵ of those services. For both these reasons, it appears to me that the scope of protection of the mark would not be easily discernible. Consequently, I find that *purpose-built student accommodation* would not be an acceptable limitation to avoid a likelihood of confusion.

8. I turn now to *all-inclusive student accommodation*. I consider that here the opponent’s submissions have some merit. The holder submits that the term describes an arrangement in which the rent paid includes utility bills. However, it seems to me that a significant proportion of average consumers will have encountered the term *all-inclusive* in the context of package holidays, where the customer’s meals and drinks are included in the price they pay for the package. These customers are, in my view, likely to be confused, given that the opponent’s services include *services for providing food and drink; restaurant, bar and cafeteria services; catering services; public house services*. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ said that a court may find infringement if a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court. The principles he set out apply equally to opposition cases. Furthermore, simply being *student accommodation* does not in and of itself change the nature of the accommodation and the similarity I found in my main decision. Consequently, I find that *all-inclusive student accommodation* is not an acceptable limitation to avoid a likelihood of confusion.

⁵ Paragraph 30.

9. A *hall of residence* is a building containing rooms or flats in which university or college students live during the course of their studies. These buildings would typically include shared facilities, such as laundry rooms and kitchens. In my view, it is, in principle, possible to use *halls of residence student accommodation* as a term in a trade mark specification. I find it is sufficiently clear and precise that third parties would be able to understand the scope of the services covered by the registration.

10. The opponent submits that *halls of residence student accommodation* is identical to, or encompassed by, the term *provision of temporary accommodation*, which I found to have some similarity with the opponent's *public house services*. The opponent submits that it therefore follows that *halls of residence student accommodation* is similar to *public house services* and:

“applying the principle set out in *Gerard Meric v OHIM* (referred to at paragraph 53 of the Decision), ‘*student accommodation*’ should be seen as a broad general term which incorporates and is therefore identical to the Opponent’s ‘*public house services*’.”

11. The term that I am construing is not *student accommodation*, which I accept is a broad term, but *halls of residence student accommodation*, which is, as I have noted, a particular type of accommodation and differs from the rooms provided by some public houses. It is the case that rooms in halls of residence may be let to members of the general public for short stays, particularly during vacations, and so may be considered to be in competition with the temporary accommodation provided by public houses. However, this is an ancillary use that is not, to my mind, covered by the ordinary and natural meaning of the term. I find that *halls of residence student accommodation* is an acceptable limitation to avoid a likelihood of confusion.

12. The opponent notes that paragraph 149 of the Decision does not deal with the term ‘*boarding houses*’ and requests clarification. A boarding house is a house in which rooms are let for one or more nights and sometimes for extended stays. At least some meals would also be provided. They are, in my view, a specific type of

accommodation and distinct from what the consumer would understand as student accommodation. It seems to me that the proposed limitation *Accommodation bureaux (boarding houses) for ... halls of residence student accommodation* is not an acceptable limitation as it confuses these two types of accommodation and so does not possess the required clarity and precision.

Outcome

13. I find that the following revised terms are free from objection:

Agency services for the reservation of halls of residence student accommodation; arranging halls of residence student accommodation; bookings for halls of residence student accommodation; consultancy and advisory services relating to the provision of halls of residence student accommodation; providing information, including online, about services for providing halls of residence student accommodation; provision of halls of residence student accommodation; reservations for halls of residence student accommodation.

14. The UK designations by Centurion Corporation (IR1330134, IR1336257 and IR 1344000) may proceed to registration in respect of the following services:

Class 36

Management of real estate, apartments and buildings; real estate affairs; renting or leasing of apartments, accommodation and real estate; accommodation bureaux (apartments); real estate investment; real estate investment management; and property portfolio management.

Class 43

Agency services for the reservation of halls of residence student accommodation; arranging halls of residence student accommodation; bookings for halls of residence student accommodation; consultancy and advisory services relating to the provision of halls of residence student accommodation; providing information, including online, about services for

providing halls of residence student accommodation; provision of halls of residence student accommodation; reservations for halls of residence student accommodation.

Costs

15. Both parties have achieved a measure of success. The opponent was successful in relation to some of the services in Class 43 and the holder was asked to propose a revised specification. In the circumstances, I order each party to bear its own costs.

Dated 1 July 2019

**Clare Boucher
For the Registrar
The Comptroller-General**