

O/0025/25

TRADE MARKS ACT 1994

**IN THE MATTER OF
UK REGISTRATION NO. 3890563
IN THE NAME OF
RYAN MAHONEY
IN RESPECT OF THE FOLLOWING TRADE MARK:**



IN CLASSES 6, 14, 16, 35, 36, 39 & 45

AND

**AN APPLICATION FOR DECLARATION OF INVALIDITY
THERE TO UNDER NO. 506442
BY
RICHARD MAGUIRE**

Background & Pleadings

1. The trade mark (“**contested mark**”) shown on the front page of this decision stands registered in the name of Ryan Mahoney (“**the registered proprietor**”). The mark was applied for on 18 March 2023 in the United Kingdom and completed its registration procedure on 30 June 2023. For the purposes of this partial cancellation action the relevant services in the specification are included in paragraph 19 of this decision.
2. On 23 August 2023, Richard Maguire (“**the applicant**”) filed an application to have this trade mark declared invalid under the provisions of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”)¹, which are relevant in invalidation proceedings under Section 47 of the Act. The applicant relies upon its UK trade mark registration 3573922 for the figurative mark:



3. The mark was filed on 31 December 2020 and was registered on 7 May 2021 for Classes 35, 36 and 41. For the purposes of these invalidation proceedings, the applicant only relies on Classes 35 and 36 which are included in paragraph 19 of this decision.

¹ The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

4. In his statement of grounds, the applicant claims that there is a “major clash” between the competing services, and the marks are visually and aurally similar resulting in a likelihood of confusion.
5. The registered proprietor filed a notice of defence denying the applicant’s claims. He asserted that the services are very different and the differences between the marks are substantial preventing confusion.
6. Neither of the parties filed evidence or submissions.
7. No hearing was requested and so this decision is taken following a careful perusal of the papers.
8. In these proceedings, both parties are unrepresented.

Decision

9. Section 47 of the Act states that:

“[...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

10. The invalidation application is based specifically on Section 5(2)(b) of the Act which states that:

“A trade mark shall not be registered if because-

[...]

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

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

11. Section 5A of the Act reads as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

12. Under Section 6(1) of the Act, the applicant’s trade mark clearly qualifies as an earlier trade mark. Further, as protection of the earlier mark was completed less than five years before the registration date of the contested mark, proof of use is not relevant in these proceedings as per Section 6A of the Act.

13. The principles considered in this application for invalidity stem from the decisions of the European Courts in *SABEL BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):
 - a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

 - b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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;

- c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- g) a lesser degree of similarity between the goods or services may be offset by a 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 the Services

14. When making the comparison, all relevant factors relating to the goods or services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

“23. In assessing the similarity of the goods or services concerned [...], 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 complementary.”

15. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

“(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.”

16. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

17. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] 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.”

18. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

“In addition, 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.”

19. The competing services to be compared are shown in the following table:

Registered Proprietor's Services
<p>Class 35: Online retail services relating to jewelry; Online retail store services in relation to clothing; Online retail services relating to handbags; Business management of wholesale and retail outlets; Business management of retail outlets; Retail store services in the field of clothing; Administration of the business affairs of retail stores; Online retail store services relating to clothing; Retail services in relation to footwear; Retail services in relation to jewellery; Retail services in relation to clothing; Retail services in relation to smartphones; Retail services relating to jewelry; Retail services in relation to smartwatches; Online retail services relating to clothing; Retail services relating to clothing; Management of a retail enterprise for others; Retail services in relation to bags; Retail services in relation to metal hardware; Retail services in relation to headgear; Business management of wholesale outlets; Retail services in relation to clothing accessories; Retail services in relation to safes; Retail services connected with the sale of clothing and clothing accessories; Mail order retail services for clothing accessories.</p> <p>Class 36: Financial banking; Financial investment; Financial investments; Financial transactions; Insurance for third party liability; Asset management for third parties; Private banking; Merchant banking services; Personal financial banking services; Banking; Personal banking services; Banking and financial services; Financial banking services for the withdrawal of money; Banking services for deposit-taking; Mobile banking services; Financial and monetary services, and banking; Financial banking services for the deposit of money; Recording of inter parties transactions in respect of finance; Card accessed banking services; Online business banking services; Telephone banking services; Banking and financing services; Investment banking services; Online banking services; Electronic banking services; Bank card services; Financial management services relating to banking institutions; Property investment banking services; Internet banking services; Financial nominees services for the holding of securities; Financial intermediary services; Automated banking services relating to credit card transactions; Financial services relating to bank cards; Financial services in the field of money lending; Mortgage banking and brokerage; Bank account services; Financial transaction services; Automated banking services relating to charge card transactions; Computerised banking services; Banking</p>

services relating to the deposit of money; Financial and monetary transaction services; Investment banking; Financial management relating to banking; Investment bank services; Banking insurance; Online banking; Card operated financial services; Automated banking services; Electronic banking via a global computer network [internet banking]; Mortgage banking; Brokerage services for arranging financing by other financial institutions; Banking services in relation to the electronic transfer of funds; Electronic banking; Financial brokerage services; Providing of banking services; Internet banking; Financial lending services for personal purposes; Financial evaluations [banking]; Corporate holding of share capital services; Merchant banking; Banking services; International banking; On-line banking; ATM banking services; Banking (Home -); Home banking; Mortgage banking insurance; Mortgage banking and mortgage broking; On-line banking services; Mortgage banking and mortgage brokerage; Home banking services; Telephone banking and insurance services; Financial underwriting and securities issuance (investment banking); Paperless electronic banking services; Merchant bank (Services of a -); Investment banking consulting and advisory services; Evaluation (Financial -) [insurance, banking, real estate]; Financial evaluation [insurance, banking, real estate]; Advisory services relating to banking; Financial loans to commerce; Financial lending; Research services relating to banking; Banking services relating to travellers' cheques; Consultations relating to banking; Savings bank services; Online financial transactions; Brokerage services in financial markets; Financial brokerage; Brokerage (Financial -); Banking services relating to the transfer of funds from accounts; Computerised financial services for retail businesses; Financial investment brokerage; Banking services provided for schools; Financial transactions via blockchain; Mortgage lending and mortgage brokerage services; Providing banking information; Brokerage of financial derivatives; Corporate finance services; Corporate lending; Mortgage broking services; Financial lending against security; Information services relating to banking; Corporate finance; Securities lending; Financial credit services; Financial securities; Financial investment in the field of securities; Financial services related to the issuance of bank cards and debit cards; Organisation of trading markets for financial services; Computerised securities brokerage services; Computerised financial services relating to foreign currency dealings; Bank cheque card services; Financial investment services in relation to the printing industry; Financial investment services; Financial customs brokerage services; Mortgage broking; Brokerage services on the financial markets; Financial credit services for exporters; Financial and monetary services; Securities brokerage account services; Finance services; Consumer lending services; Financial investment management services; Financial loan services; Computerised financial services; Brokerage of financial investments in energy companies; Mortgage brokerage services; Corporate finance consultancy; Electronic financial trading services; Financial transfers and transactions, and payment services; Financial services for the management of credit cards; Insolvency services [financial]; Commercial mortgage brokerage; Computerised information services relating to banking matters; Financial management of cash accounts; Financial advisory services provided for bankers; Lending and loans services; Financial management for businesses; Real estate investment; Brokerage of real estate; Real estate brokerage; Valuations (Real estate -); Leasing of real estate; Real estate leasing; Appraisal of real estate; Rental of real estate; Real estate affairs; Lease of real estate; Real estate financing; Real estate

broking; Real estate agency; Real estate syndication; Real estate consultancy; Real estate management; Estate management (Real -); Management of real estate; Property (Real estate -) investment; Real estate agencies; Estate agencies (Real -); Real estate services; Property (Real estate -) finance; Real estate time-sharing; Real estate administration; Real estate consultation; Evaluation of real estate; Real estate consultations; Valuation of real estate property; Leasing of real estate property; Property (Real estate -) insurance; Valuations in real estate matters; Property (Real estate -) evaluations; Property (Real estate -) management; Real estate property management; Trusteeship of real estate property; Rental of real estate and property; Property (real estate -) appraisal [financial]; Real estate investment advice; Real estate investment planning; Investment in real estate (Services for -); Real estate investment services; Real estate assessment [financial]; Real estate equity sharing; Real estate appraisal services; Real estate investment consultancy; Real estate investment management; Financial valuation of personal property and real estate; Real estate agents services; Real estate valuation services; Real estate trustee services; Property (Real estate -) brokerage services; Consultancy in the purchasing of real estate; Capital investment in real estate; Real estate escrow services; Real estate appraisals [valuations]; Real estate acquisition [for others]; Financial evaluations [real estate]; Rental of offices [real estate]; Real estate appraisal and valuation; Real estate affairs services; Property leasing [real estate property only]; Real estate procurement for others; Arranging of leases of real estate; Real estate lending services; Real estate agency services; Real estate insurance services; Real estate acquisition services; Provision of real estate loans; Leases (arranging of -) [real estate property only]; Assisting in the acquisition of real estate; Financial brokerage services for real estate; Property (Real estate -) consultancy services; Financial services relating to real estate property; Real estate and property management services; Residential real estate agency services; Real estate management services; Accommodation bureaux (real estate property); Commercial real estate agency services; Assessment and management of real estate; Appraisal and evaluation of real estate; Arranging letting of real estate; Agency services for the leasing of real estate property; Financial management of real estate projects; Financial services for the purchase of real estate; Appraisals for insurance claims of real estate; Financial consultancy relating to real estate investment; Real estate lease surrender services; Financial services relating to real estate property and buildings; Insurance services relating to real estate; Real estate agency services for the leasing of land; Management services for real estate investment; Financial services related to real estate; Arranging of shared ownership of real estate; Provision of finance for real estate development; Real estate management services relating to housing estates; Real property letting; Real property management; Assisting in the acquisition of and financial interests in real estate; Providing real estate information relating to property and land; Provision of information relating to the property market [real estate]; Corporate real estate advisory services; Collection of debt on real estate rental; Evaluation of real property; Financing of real estate development projects; Consultancy services relating to real estate; Real estate lease renewal services; Administration of financial affairs relating to real estate; Estate management services relating to transactions in real property; Real estate agency services for the rental of buildings; Advisory services relating to real estate ownership; Advisory services relating to real estate valuations; Estate brokerage; Real property evaluation

[financial]; Provision of information relating to property [real estate]; Consultation services relating to real estate; Investment advisory services relating to real estate; Real estate services related to management of property investments; Real estate management services relating to commercial buildings; Real estate agency services relating to the purchase and sale of land; Financing services relating to real estate development; Provision of financial guarantees for bonding real estate; Real estate management services relating to residential buildings; Providing information relating to real estate appraisal; Provision of information relating to real estate; Real estate agency services relating to the purchase and sale of buildings; Research services relating to real estate acquisition; Real estate management services relating to industrial premises; Arranging the provision of finance for real estate purchase; Real estate management services relating to shopping malls; Real estate settlement services [financial services]; Computerised information services relating to real estate.

Applicant's Services

Class 35: Providing business management start-up support for other businesses; Support for employees with regard to business matters; Financial auditing; Financial marketing; Financial records management; Financial statement preparation and analysis for businesses; Accountancy; Accountancy advice relating to tax preparation; Chartered accountancy business services; Provision of information relating to accounts [accountancy]; Tax advice [accountancy]; Tax consultancy [accountancy]; Tax consultations [accountancy]; Tax planning [accountancy]; Tax return advisory [accountancy] services; Taxation [accountancy] advice; Taxation [accountancy] consultancy; Accountancy, book keeping and auditing; Business profit analysis; Business Enquiries; Business accounting advisory services; Business accounts management; Business acquisitions; Business acquisitions (Advice relating to -); Business acquisitions consultation; Business administration; Business administration and management; Business administration assistance; Business administration consultancy; Business administration for others; Business administration of employee share schemes; Business advice; Business advice and consultancy relating to franchising; Business advice relating to accounting; Business advice relating to acquisitions; Business advice relating to financial re-organisation; Business advice relating to growth financing; Business advice relating to marketing; Business advice relating to mergers; Business advisory and consultancy services; Business advisory services; Business advisory services relating to business liquidations; Business advisory services relating to company performance; Business advisory services relating to product development; Business analysis; Business analysis services; Business assistance; Business assistance relating to business image; Business auditing; Business brokerage services; Business consultancy; Business consultancy (Professional -); Business consultancy and advisory services; Business consultancy services; Business consultancy services relating to data processing; Business consultancy services relating to management of fund raising campaigns; Business consultancy to firms; Business consultancy to individuals; Business consultancy, in the field of transport and delivery; Business consultation; Business consultation relating to advertising; Business consultation services; Business consulting; Business consulting for enterprises; Business consulting services; Business consulting services in the agriculture field; Business data analysis; Business enquiry services; Business expertise; Business expertise services; Business management; Business

management advice; Business management advice and assistance; Business management advice relating to manufacturing business; Business management advisory services; Business management advisory services relating to commercial enterprises; Business management advisory services relating to industrial enterprises; Business management analysis; Business management and administration; Business management and consultancy; Business management and consultancy services; Business management and consultation; Business management and consultation services; Business management and consulting; Business management and consulting services; Business management and enterprise organization consultancy; Business management consultancy; Business management consultancy and advisory services; Business management consultancy services; Business management consultancy via the Internet; Business management consultancy, also via the Internet; Business management consultation; Business management consulting; Business management consulting services; Business management of professional athletes; Business management of sporting clubs; Business management of sporting facilities [for others]; Business management of sports people; Business management of sports personalities; Business management organisation; Business management organisation consultancy; Business management planning; Business management services; Business management services for footballers; Business networking services; Business organisation and management consultancy; Business organisation and management consultancy in the field of personnel management; Business organisation and management consulting; Business organisation consultancy; Business organisation consulting; Business organization advice; Business organization and management consultancy including personnel management; Business organization and management consulting; Business planning; Business planning and business continuity consulting; Business planning consultancy; Business planning services; Business planning services for enterprises; Business process management; Business promotion; Business promotion services; Acquisition (Business -) searches; Acquisition of business information relating to company activities; Acquisition of business information relating to company status; Acquisitions (Business -) consulting services; Advertising of business web sites; Advice relating to business management; Advice relating to business organization; Advice relating to the acquisition of businesses; Advice relating to the sale of businesses; Advisory services (Business -) relating to the management of businesses; Advisory services (Business -) relating to the management of public sector businesses; Advisory services for business management; Advisory services relating to business management; Advisory services relating to business management and business operations; Advisory services relating to business organisation and management; Advisory services relating to business organization; Advisory services relating to business planning; Advisory services relating to the corporate structure of businesses; Advisory services relating to the purchase of goods on behalf of business; Tax assessment [accounts] preparation; Tax assessment preparation; Tax declaration procedure services; Tax filing services; Tax preparation; Tax preparation and consulting services; Tax return preparation; Tax returns (Preparation of -); Taxation [accountancy] consultation; Accountancy advice relating to taxation; Accountancy advice relating to the preparation of tax returns; Accounting consultancy relating to taxation; Accounting services relating to tax planning; Advice on tax preparation; Advisory services

relating to tax preparation; Computerised tax assessments (preparation of -) [accounting]; Consultancy relating to tax accounting; Income tax returns (Preparation of -); Preparation and completion of income tax returns; Preparation of documents relating to taxation; Preparation of income tax returns; Preparation of tax declarations; Preparation of tax returns; Accountancy services; Accountancy services relating to accounts receivable.

Class 36: Finance (Provision of -); Finance (Raising of -); Finance services; Financial advice; Financial advice and consultancy services; Financial advice relating to employee share schemes; Financial advice relating to income tax; Financial advice relating to inheritance; Financial advice relating to investment; Financial advice relating to pensions; Financial advice relating to settlements; Financial advice relating to share option schemes; Financial advice relating to tax planning; Financial advice relating to taxation; Financial advice relating to trusts; Financial advice relating to wills; Financial advisory and consultancy services; Financial advisory and management services; Financial advisory services; Financial advisory services for companies; Financial advisory services for individuals; Financial advisory services provided for bankers; Financial advisory services provided for controllers; Financial advisory services relating to assets management; Financial advisory services relating to insolvency; Financial advisory services relating to life assurance; Financial advisory services relating to retirement plans; Financial advisory services relating to securities; Financial advisory services relating to tax; Financial affairs; Financial affairs services; Financial analyses; Financial analyses (Preparation of -); Financial analysis; Financial analysis and consultancy; Financial analysis and consultation; Financial analysis and research services; Financial analysis services; Financial analysis services relating to investments; Financial and investment consultancy services; Financial and monetary services; Financial and monetary services, and banking; Financial and monetary transaction services; Financial appraisal; Financial appraisal services; Financial assessments; Financial asset management; Financial assistance; Financial banking; Financial banking services for the deposit of money; Financial banking services for the withdrawal of money; Financial brokerage; Financial brokerage services; Financial brokerage services for real estate; Financial consultancy and advisory services; Financial consultancy and information services; Financial consultancy and insurance consultancy; Financial consultancy in relation to the buying and selling of businesses; Financial consultancy in the field of risk management; Financial consultancy relating to real estate investment; Financial consultancy services; Financial consulting; Financial consulting and advisory services; Financial consulting services; Financial forecasting; Financial fund management; Financial information management and analysis services; Financial information services; Financial intermediary services; Financial investigation services; Financial investment; Financial investment advisory services; Financial investment analysis and stock research; Financial investment brokerage; Financial investment fund services; Financial investment management services; Financial investment services; Financial investments; Financial lending; Financial loan services; Financial loss management; Financial management; Financial management advisory services; Financial management and planning; Financial management for businesses; Financial management of building occupancy expenses; Financial management of cash accounts; Financial management of companies; Financial management of current accounts; Financial

management of employee pension plans; Financial management of funds; Financial management of holding companies; Financial management of membership schemes; Financial management of pensions; Financial management of real estate projects; Financial management of risk capital, investment capital and development capital; Financial management of share accounts; Financial management relating to banking; Financial management relating to investment; Financial management services; Financial management services provided via the Internet; Financial management services relating to banking institutions; Financial management via the Internet; Financial planning; Financial planning and investment advisory services; Financial planning and management; Financial planning services; Financial planning services relating to taxation; Financial portfolio management; Financial services; Financial services for securing funds for others; Financial services provided via the Internet; Financial services related to dealing in shares; Financial services relating to investment; Financial services relating to mortgages; Financial services relating to the acquisition of property; Financial services relating to wealth management; Advisory services relating to financial asset management; Advisory services relating to financial investment; Advisory services relating to financial investments; Advisory services relating to financial matters; Advisory services relating to financial planning; Banking and financial services; Tax payment processing services; Income tax advice; Income tax advice [financial]; Payroll tax debiting services; Planning of finances relating to taxation.

20. The applicant claims the following:

“The trademark is designed to say the word DEDICATED causing a major clash offering services in class 35/36.”

21. The registered proprietor claimed that:

“[...] To add to this our service for what we offer is very different. We are a luxury goods brand with links to banking investments and precious metals. We are not accountants. It is impossible to not be able to distinguish between the two.”

22. I note that differences between the services currently provided by the registered proprietor, such as particular characteristics of the services at issue, are irrelevant, except to the extent that those differences are apparent from each party's specification. I also bear in mind that the assessment I must make is based on a notional and fair use of the terms

as registered against all the potential or intended uses of the services and not necessarily the ones in which a party actually trades.

23. For the purpose of considering the issue of similarity of services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons.²

Class 35

Administration of the business affairs of retail stores; Business management of retail outlets; Business management of wholesale and retail outlets; Business management of wholesale outlets; Management of a retail enterprise for others

24. The earlier specification contains the broad terms “*Business administration; Business management; Business management advisory services relating to commercial enterprises*” which will readily encompass the contested terms. Therefore, I find them to be identical based on the guidance in *Meric*.

Online retail services relating to clothing; Online retail services relating to handbags; Online retail services relating to jewelry; Online retail store services in relation to clothing; Online retail store services relating to clothing; Retail services connected with the sale of clothing and clothing accessories; Retail services in relation to bags; Retail services in relation to clothing; Retail services in relation to clothing accessories; Retail services in relation to footwear; Retail services in relation to headgear; Retail services in relation to jewellery; Retail services in relation to metal hardware; Retail services in relation to safes; Retail services in relation to smartphones; Retail services in relation to smartwatches; Retail services relating to clothing; Retail services relating to jewelry; Retail store

² *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

services in the field of clothing; Mail order retail services for clothing accessories

25. The contested retail services concerning various goods in Class 35 are provided with the aim of selling such goods, whether online or otherwise. In the absence of particular submissions or evidence, I see no obvious similarity between the aforementioned services and any of the applicant's services. The former services are offered by a retail operator for the sale and purchase of goods by the end users, whereas the applicant's services are specialist services aiming at, for example, the provision of tax advice or support, advice and assistance in the management and operation of a company to manage its business. The respective services are directed at different publics, they do not share the same providers, they are neither complementary nor in competition and they differ in nature and purpose. Consequently, I find the competing terms to be dissimilar.

Class 36

Advisory services relating to banking; Asset management for third parties; ATM banking services; Automated banking services; Automated banking services relating to charge card transactions; Automated banking services relating to credit card transactions; Bank account services; Bank card services; Bank cheque card services; Banking; Banking (Home -); Banking and financial services; Banking and financing services; Banking services; Banking services for deposit-taking; Banking services in relation to the electronic transfer of funds; Banking services provided for schools; Banking services relating to the deposit of money; Banking services relating to the transfer of funds from accounts; Banking services relating to travellers' cheques; Brokerage (Financial -); Brokerage of financial derivatives; Brokerage of financial investments in energy companies; Brokerage services for arranging financing by other financial institutions; Brokerage services in financial markets; Brokerage services on the financial markets; Card accessed banking services; Card operated financial services; Commercial mortgage brokerage; Computerised

banking services; Computerised financial services; Computerised financial services for retail businesses; Computerised financial services relating to foreign currency dealings; Computerised information services relating to banking matters; Computerised securities brokerage services; Consultations relating to banking; Consumer lending services; Corporate finance; Corporate finance consultancy; Corporate finance services; Corporate holding of share capital services; Corporate lending; Electronic banking; Electronic banking services; Electronic banking via a global computer network [internet banking]; Electronic financial trading services; Evaluation (Financial -) [insurance, banking [...]]; Finance services; Financial advisory services provided for bankers; Financial and monetary services; Financial and monetary services, and banking; Financial and monetary transaction services; Financial banking; Financial banking services for the deposit of money; Financial banking services for the withdrawal of money; Financial brokerage; Financial brokerage services; Financial credit services; Financial credit services for exporters; Financial customs brokerage services; Financial evaluation [insurance, banking [...]]; Financial evaluations [banking]; Financial intermediary services; Financial investment; Financial investment brokerage; Financial investment in the field of securities; Financial investment management services; Financial investment services; Financial investment services in relation to the printing industry; Financial investments; Financial lending; Financial lending against security; Financial lending services for personal purposes; Financial loan services; Financial loans to commerce; Financial management for businesses; Financial management of cash accounts; Financial management relating to banking; Financial management services relating to banking institutions; Financial nominees services for the holding of securities; Financial securities; Financial services for the management of credit cards; Financial services in the field of money lending; Financial services related to the issuance of bank cards and debit cards; Financial services relating to bank cards; Financial transaction services; Financial transactions; Financial transactions via blockchain; Financial transfers and transactions, and payment services; Financial underwriting and securities issuance (investment banking); Home banking;

Home banking services; Information services relating to banking; Insolvency services [financial]; International banking; Internet banking; Internet banking services; Investment bank services; Investment banking; Investment banking consulting and advisory services; Investment banking services; Lending and loans services; Merchant bank (Services of a -); Merchant banking; Merchant banking services; Mobile banking services; Mortgage banking; Mortgage banking and brokerage; Mortgage banking and mortgage brokerage; Mortgage banking and mortgage broking; Mortgage brokerage services; Mortgage broking; Mortgage broking services; Mortgage lending and mortgage brokerage services; Online banking; On-line banking; Online banking services; On-line banking services; Online business banking services; Online financial transactions; Organisation of trading markets for financial services; Paperless electronic banking services; Personal banking services; Personal financial banking services; Private banking; Providing banking information; Providing of banking services; Recording of inter parties transactions in respect of finance; Research services relating to banking; Savings bank services; Securities brokerage account services; Securities lending; Telephone banking services

26. The above contested services in Class 36 relate at large to the provision of financial information, banking, or brokerage, including via computerised systems. In *Albingia Sa v Axis Bank Limited*, BL O/253/18, Professor Phillip Johnson, sitting as the Appointed Person, held at paragraph [50] that the term “*financial affairs*” is very broad and would cover services which would be called financial services. Bearing this in mind, I consider that the contested terms are identical with the opponent’s broad term “*financial affairs*” based on the *Meric* principle.

Financial brokerage services for real estate

27. The above term appears in the competing specifications, and thus it is self-evidently identical.

Property (real estate -) appraisal [financial]; Property (Real estate -) finance; Property (Real estate -) investment; Property investment banking services; Provision of finance for real estate development; Provision of financial guarantees for bonding real estate; Provision of real estate loans; Real estate acquisition [for others]; Real estate acquisition services; Real estate assessment [financial]; Real estate brokerage; Real estate broking; Real estate equity sharing; Real estate escrow services; Real estate financing; Real estate investment; Real estate investment advice; Real estate investment consultancy; Real estate investment management; Real estate investment planning; Real estate investment services; Real estate lending services; Real estate services related to management of property investments; Real estate settlement services [financial services]; Real estate syndication; Real property evaluation [financial]; Research services relating to real estate acquisition; Administration of financial affairs relating to real estate; Arranging of leases of real estate; Arranging of shared ownership of real estate; Arranging the provision of finance for real estate purchase; Assisting in the acquisition of and financial interests in real estate; Assisting in the acquisition of real estate; Capital investment in real estate; Evaluation (Financial -) [[...], real estate]; Financial evaluation [[...], real estate]; Financial evaluations [real estate]; Financial management of real estate projects; Financial services for the purchase of real estate; Financial services related to real estate; Financial services relating to real estate property; Financial services relating to real estate property and buildings; Financial valuation of personal property and real estate; Financing of real estate development projects; Financing services relating to real estate development; Investment advisory services relating to real estate; Investment in real estate (Services for -)

28. All of these services strike me as financial rather than real estate services, as they are financial in nature, albeit in relation to real estate. Their purpose regards financial management, risk and investment, which is different from the purpose of real estate services per se. Therefore, I consider that the closest comparators within the earlier specification are “*Finance services; Financial advice; Financial advice and consultancy services; Financial*

investment brokerage; Financial investment fund services; Financial investment management services; Financial investment services; Financial lending; Financial loan services". The competing services overlap in their general nature and purpose, as they are designed to assist individuals and businesses in effectively managing their financial resources to achieve their financial goals in a number of areas, including real estate. There is also an overlap in users, trade channels, and providers. It is my view that there exists a degree of complementarity and competition. I find the competing services to be similar to a high degree.

Appraisals for insurance claims of real estate; Banking insurance; Insurance for third party liability; Insurance services relating to real estate; Mortgage banking insurance; Property (Real estate -) insurance; Real estate insurance services; Telephone and banking insurance services

29. I consider that the above insurance services are of a financial nature and that insurance companies are subject to licensing, supervision, and solvency rules similar to those governing banks and other institutions providing financial services. Financial services, such as banking services, offer insurance services, for example, property insurance, or act as agents for insurance companies, with which they are often economically linked. Moreover, it is not unusual to find financial institutions and insurance companies within the same commercial group. Therefore, although insurance and financial services have different purposes, they are of a similar nature, may be provided by the same or related undertakings and have the same distribution channels. Furthermore, they target the same relevant public. I do not consider that they are in competition nor are they complementary. Taking all the above into account, I consider the services to be similar to a medium degree.

Accommodation bureaux (real estate property); Advisory services relating to real estate ownership; Advisory services relating to real estate valuations; Agency services for the leasing of real estate property; Appraisal and evaluation of real estate; Appraisal of real estate; Arranging letting of real estate; Assessment and management of real estate; Collection of debt on real estate rental; Commercial real estate agency services; Computerised information services relating to real estate; Consultancy in the purchasing of real estate; Consultancy services relating to real estate; Consultation services relating to real estate; Corporate real estate advisory services; Evaluation of real estate; Financial consultancy relating to real estate investment; Lease of real estate; Leases (arranging of -) [real estate property only]; Leasing of real estate; Leasing of real estate property; Management of real estate; Management services for real estate investment; Property (Real estate -) management; Property leasing [real estate property only]; Providing information relating to real estate appraisal; Providing real estate information relating to property and land; Provision of information relating to property [real estate]; Provision of information relating to real estate; Provision of information relating to the property market [real estate]; Real estate administration; Real estate affairs; Real estate affairs services; Real estate agencies; Real estate agency; Real estate agency services; Real estate agency services for the leasing of land; Real estate agency services for the rental of buildings; Real estate agency services relating to the purchase and sale of land; Real estate agency services relating to the purchase and sale of buildings; Real estate agents services; Real estate and property management services; Real estate appraisal and valuation; Real estate appraisal services; Real estate appraisals [valuations]; Real estate consultancy; Real estate consultation; Real estate consultations; Real estate lease renewal services; Real estate lease surrender services; Real estate leasing; Real estate management; Real estate management services; Real estate management services relating to commercial buildings; Real estate management services relating to housing estates; Real estate management services relating to industrial premises; Real estate management services relating to residential buildings; Real estate

management services relating to shopping malls; Real estate procurement for others; Real estate property management; Real estate services; Real estate valuation services; Rental of offices [real estate]; Rental of real estate; Rental of real estate and property; Residential real estate agency services; Valuations (Real estate -); Valuations in real estate matters; Valuation of real estate property; Real estate time-sharing; Real property letting; Real property management; Property (Real estate -) consultancy services; Property (Real estate -) evaluations; Property (Real estate -) brokerage services; Real estate brokerage; Brokerage of real estate; Real estate broking; Real estate trustee services; Trusteeship of real estate property; Estate agencies (Real -); Estate brokerage; Estate management (Real -); Estate management services relating to transactions in real property; Evaluation of real property

30. The above services are real estate property services at large, including real estate property management and evaluation, real estate agency services, as well as the consultancy and provision of related information, which involves, *inter alia*, finding a property, making it available for potential buyers and acting as an intermediary. However, the opponent's Class 36 services "*Financial brokerage services for real estate; Financial consultancy relating to real estate investment; Financial management of real estate projects*", which I consider to be the closest comparators with the applicant's specification, are financial services at the core provided by financial institutions acting as intermediaries in property transactions, helping clients buy, sell, or lease properties, and providing financial advice and services related to real estate investments and financing. As such, these services do not have the same nature, intended purpose or the same method of use. Furthermore, I do not consider that the provider of the financial services and real estate services will be the same, and I am not of the view that consumers would attribute responsibility for both services to the same company. I do not consider that the services are in competition nor are they complementary. These services are, therefore, dissimilar even if financial services are needed for the use of real estate.

31. The likelihood of confusion does not arise in relation to the contested services which are dissimilar to the earlier mark's services.³ **The invalidation action cannot succeed against dissimilar services and, therefore, is dismissed insofar as it concerns the following terms:**

Class 35: Online retail services relating to clothing; Online retail services relating to handbags; Online retail services relating to jewelry; Online retail store services in relation to clothing; Online retail store services relating to clothing; Retail services connected with the sale of clothing and clothing accessories; Retail services in relation to bags; Retail services in relation to clothing; Retail services in relation to clothing accessories; Retail services in relation to footwear; Retail services in relation to headgear; Retail services in relation to jewellery; Retail services in relation to metal hardware; Retail services in relation to safes; Retail services in relation to smartphones; Retail services in relation to smartwatches; Retail services relating to clothing; Retail services relating to jewelry; Retail store services in the field of clothing; Mail order retail services for clothing accessories.

Class 36: Accommodation bureaux (real estate property); Advisory services relating to real estate ownership; Advisory services relating to real estate valuations; Agency services for the leasing of real estate property; Appraisal and evaluation of real estate; Appraisal of real estate; Arranging letting of real estate; Assessment and management of real estate; Collection of debt on real estate rental; Commercial real estate agency services; Computerised information services relating to real estate; Consultancy in the purchasing of real estate; Consultancy services relating to real estate; Consultation services relating to real estate; Corporate real estate advisory services; Evaluation of real estate; Financial consultancy relating to real estate investment; Lease of real estate; Leases (arranging of -) [real estate property only];

³ Case C-398/07, *Waterford Wedgwood plc v OHIM*; and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, para 49.

Leasing of real estate; Leasing of real estate property; Management of real estate; Management services for real estate investment; Property (Real estate -) management; Property leasing [real estate property only]; Providing information relating to real estate appraisal; Providing real estate information relating to property and land; Provision of information relating to property [real estate]; Provision of information relating to real estate; Provision of information relating to the property market [real estate]; Real estate administration; Real estate affairs; Real estate affairs services; Real estate agencies; Real estate agency; Real estate agency services; Real estate agency services for the leasing of land; Real estate agency services for the rental of buildings; Real estate agency services relating to the purchase and sale of land; Real estate agency services relating to the purchase and sale of buildings; Real estate agents services; Real estate and property management services; Real estate appraisal and valuation; Real estate appraisal services; Real estate appraisals [valuations]; Real estate consultancy; Real estate consultation; Real estate consultations; Real estate lease renewal services; Real estate lease surrender services; Real estate leasing; Real estate management; Real estate management services; Real estate management services relating to commercial buildings; Real estate management services relating to housing estates; Real estate management services relating to industrial premises; Real estate management services relating to residential buildings; Real estate management services relating to shopping malls; Real estate procurement for others; Real estate property management; Real estate services; Real estate valuation services; Rental of offices [real estate]; Rental of real estate; Rental of real estate and property; Residential real estate agency services; Valuations (Real estate -); Valuations in real estate matters; Valuation of real estate property; Real estate time-sharing; Real property letting; Real property management; Property (Real estate -) consultancy services; Property (Real estate -) evaluations; Property (Real estate -) brokerage services; Real estate brokerage; Brokerage of real estate; Real estate

broking; Real estate trustee services; Trusteeship of real estate property; Estate agencies (Real -); Estate brokerage; Estate management (Real -); Estate management services relating to transactions in real property; Evaluation of real property.

Average Consumer and the Purchasing Act

32. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J (as he then was) described the average consumer in these terms:

“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.”

33. The average consumer for the services will be either businesses or professionals, for example, in the financial sector, without excluding entirely members of the general public. The consumers will select such services by looking through brochures, websites, or signs on a physical property, so the visual element will be important. However, I do not discount the aural element, as word-of-mouth recommendations may influence consumers’ decisions. The cost of the services will be relatively significant, contributing to the selection process of the service provider. Given the more specialist nature of the services in play, especially those selected by business users, I consider that members of the general public

will pay a slightly higher than medium degree of attention, with business users and professionals paying a higher degree of attention in choosing the service provider to ensure that the services meet their particular needs, both in terms of immediate cost and future expectations. Typically, for all the above services, prior consultation or research is conducted before purchase.

Comparison of Trade Marks

34. 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 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.”

35. 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.

36. The marks to be compared are:

Earlier Mark	Contested Mark
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Overall Impression

37. The contested mark consists of the word element “D3DICATED” presented in a standard typeface and a gradient yellow uppercase font set against a black background. I also consider that the number ‘3’ will be perceived as a replacement for the letter ‘E’, resembling the word “DEDICATED”. Thus, the verbal element will have the greatest weight in the overall impression, with the stylisation playing a minimal role.
38. The earlier mark consists of a dotted sphere device followed by the verbal element “DEDICATED”, which is presented in uppercase and a standard typeface. Both elements appear in white against a blue background. I note that the word element “DEDICATED” will be more distinctive as the eye will be drawn to the verbal element of the mark as the average consumer more easily refers to marks by the word than by describing a figurative element.⁴ Therefore, the word element has the greatest weight in the overall impression, whereas the device has some but less weight, with the stylisation playing a minimal role.

⁴ *Wassen International Ltd v OHIM (SELENIUM-ACE)*, Case T-312/03, paragraph 37.

Visual comparison

39. The competing marks share all letters apart from the one in position two, i.e. DEDICATED/D3DICATED. The marks also differ in their presentation. The earlier mark appears in a white font on a blue background, while the contested mark has a gradient yellow font set against a black background. Further, there is no counterpart of the sphere device in the contested mark. Taking into account the above factors, including the overall impression of the competing marks, I find that the marks are visually similar to between a medium and a high degree.

Aural comparison

40. I consider that the average consumer will naturally replace the number '3' in the contested mark with the letter 'E', as the verbal element of the mark resembles the word "DEDICATED", which is known to them. Therefore, both the competing marks will be articulated as "DED-UH-KAY-TUHD". Further, I do not consider that the average consumer will attempt to articulate the device in the earlier mark. Consequently, I find them to be aurally identical.

Conceptual comparison

41. The registered proprietor claims the following:

"[...] The wording for one, for my registered trademark, is entirely made up and not even listed in the English dictionary. [...]"

42. As mentioned above, although the letter 'E' being substituted with the number '3', the average consumer will understand the verbal element in the contested mark to be the word "DEDICATED". Thus, the competing marks will be perceived as conveying the notion of being 'devoted to a cause, ideal, or purpose', imparting a laudatory connotation in relation to the quality of the services provided. However, the presence/absence of the

sphere device will add to the conceptual difference between the marks. Taking all of this into account, I conclude that the respective marks still share a high level of conceptual similarity.

Distinctive Character of the Earlier Trade Mark

43. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

“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).

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

44. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent

distinctive character, such as invented words which have no allusive qualities.

45. The applicant has not shown use of his mark and thus cannot benefit from any enhanced distinctiveness. In this respect, I have only the inherent distinctiveness of the applicant's mark to consider. The applicant's mark consists of the dictionary word "DEDICATED" which has a laudatory significance in relation to the services for which the mark is registered. Taking into account the presentation together with the device, I consider that the mark is inherently distinctive to a medium degree at best.

Likelihood of Confusion

46. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa.⁵ It is essential to keep in mind the distinctive character of the opponent's trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.⁶
47. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.

⁵ See *Canon Kabushiki Kaisha*, paragraph 17.

⁶ See *Lloyd Schuhfabrik Meyer*, paragraph 27.

48. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis QC (as he then was), sitting 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).”

These examples are not exhaustive. Rather, they were intended to be illustrative of the general approach.⁷

49. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, the Court of Appeal dismissed an appeal against a ruling of the High Court that trade marks for the words EAGLE RARE registered for whisky and bourbon whiskey were infringed by the launch of a bourbon whiskey under the sign "American Eagle". In his decision, Lord Justice Arnold stated that:

"13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Mr Mellor went on to say that, if there is no likelihood of direct confusion, "one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion". I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

50. Earlier in this decision I have concluded that:

- the services at issue range from identical to similar to a high and medium degree;
- the average consumer is either businesses or professionals, without excluding entirely members of the general public. The selection process is predominantly visual without discounting aural considerations. The members of the general public will pay a slightly higher than medium degree of attention, with business users and professionals paying a higher degree;

⁷ See *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.

- the marks are visually similar to between a medium and a high degree, aurally identical, and conceptually similar to a high degree;
 - the earlier mark is inherently distinctive to a medium degree at best.
51. Taking into account the above factors, I am persuaded that there is a likelihood of direct confusion for those services that I have found to be identical. I find that the visual and conceptual similarities together with the aural identity between the verbal elements of the respective marks, having the greatest weight in the overall impressions, would cause the marks to be misremembered or mistakenly recalled, especially because of the shared letters, length, and the identity of the services. It is my view that the difference in the second character “DEDICATED/D3DICATED” will not prevent the average consumer from mistakenly recalling one mark for the other, as the verbal element will be remembered as the word “DEDICATED” in both marks. The device element in the earlier mark, playing a less prominent role, may well be lost due to the principle of imperfect recollection.
52. Even if the average consumer recalls that one mark consists of a device element and the other not, I still consider that the marks would be indirectly confused for identical services, with “DEDICATED/D3DICATED” being imperfectly recalled as each other and with the difference in device element put down to the use of a brand variant.
53. The above findings extend to the competing services which I found to be similar at any degree.

Outcome

54. Part of the application for invalidation has been successful. **The registered trade mark is declared invalid, subject to an appeal against this decision, with effect from 18 March 2023 for the following services:**

Class 35: Administration of the business affairs of retail stores; Business management of retail outlets; Business management of wholesale and retail outlets; Business management of wholesale outlets; Management of a retail enterprise for others.

Class 36: Advisory services relating to banking; Asset management for third parties; ATM banking services; Automated banking services; Automated banking services relating to charge card transactions; Automated banking services relating to credit card transactions; Bank account services; Bank card services; Bank cheque card services; Banking; Banking (Home -); Banking and financial services; Banking and financing services; Banking services; Banking services for deposit-taking; Banking services in relation to the electronic transfer of funds; Banking services provided for schools; Banking services relating to the deposit of money; Banking services relating to the transfer of funds from accounts; Banking services relating to travellers' cheques; Brokerage (Financial -); Brokerage of financial derivatives; Brokerage of financial investments in energy companies; Brokerage services for arranging financing by other financial institutions; Brokerage services in financial markets; Brokerage services on the financial markets; Card accessed banking services; Card operated financial services; Commercial mortgage brokerage; Computerised banking services; Computerised financial services; Computerised financial services for retail businesses; Computerised financial services relating to foreign currency dealings; Computerised information services relating to banking matters; Computerised securities brokerage services; Consultations relating to banking; Consumer lending services; Corporate finance; Corporate finance consultancy; Corporate finance services; Corporate holding of share capital services; Corporate lending; Electronic banking; Electronic banking services; Electronic banking via a global computer network [internet banking]; Electronic financial trading services; Evaluation (Financial -) [insurance, banking, real estate]; Finance services; Financial advisory services provided for bankers; Financial and monetary services; Financial and monetary services, and banking; Financial and monetary transaction services;

Financial banking; Financial banking services for the deposit of money; Financial banking services for the withdrawal of money; Financial brokerage; Financial brokerage services; Financial credit services; Financial credit services for exporters; Financial customs brokerage services; Financial evaluation [insurance, banking, real estate]; Financial evaluations [banking]; Financial intermediary services; Financial investment; Financial investment brokerage; Financial investment in the field of securities; Financial investment management services; Financial investment services; Financial investment services in relation to the printing industry; Financial investments; Financial lending; Financial lending against security; Financial lending services for personal purposes; Financial loan services; Financial loans to commerce; Financial management for businesses; Financial management of cash accounts; Financial management relating to banking; Financial management services relating to banking institutions; Financial nominees services for the holding of securities; Financial securities; Financial services for the management of credit cards; Financial services in the field of money lending; Financial services related to the issuance of bank cards and debit cards; Financial services relating to bank cards; Financial transaction services; Financial transactions; Financial transactions via blockchain; Financial transfers and transactions, and payment services; Financial underwriting and securities issuance (investment banking); Home banking; Home banking services; Information services relating to banking; Insolvency services [financial]; International banking; Internet banking; Internet banking services; Investment bank services; Investment banking; Investment banking consulting and advisory services; Investment banking services; Lending and loans services; Merchant bank (Services of a -); Merchant banking; Merchant banking services; Mobile banking services; Mortgage banking; Mortgage banking and brokerage; Mortgage banking and mortgage brokerage; Mortgage banking and mortgage broking; Mortgage brokerage services; Mortgage broking; Mortgage broking services; Mortgage lending and mortgage brokerage services; Online banking; On-line banking; Online banking services; On-line banking services; Online business banking services; Online financial transactions;

Organisation of trading markets for financial services; Paperless electronic banking services; Personal banking services; Personal financial banking services; Private banking; Providing banking information; Providing of banking services; Recording of inter parties transactions in respect of finance; Research services relating to banking; Savings bank services; Securities brokerage account services; Securities lending; Telephone banking services; Financial brokerage services for real estate; Property (real estate -) appraisal [financial]; Property (Real estate -) finance; Property (Real estate -) investment; Property investment banking services; Provision of finance for real estate development; Provision of financial guarantees for bonding real estate; Provision of real estate loans; Real estate acquisition [for others]; Real estate acquisition services; Real estate assessment [financial]; Real estate brokerage; Real estate broking; Real estate equity sharing; Real estate escrow services; Real estate financing; Real estate investment; Real estate investment advice; Real estate investment consultancy; Real estate investment management; Real estate investment planning; Real estate investment services; Real estate lending services; Real estate services related to management of property investments; Real estate settlement services [financial services]; Real estate syndication; Real property evaluation [financial]; Research services relating to real estate acquisition; Administration of financial affairs relating to real estate; Arranging of leases of real estate; Arranging of shared ownership of real estate; Arranging the provision of finance for real estate purchase; Assisting in the acquisition of and financial interests in real estate; Assisting in the acquisition of real estate; Capital investment in real estate; Financial evaluations [real estate]; Financial management of real estate projects; Financial services for the purchase of real estate; Financial services related to real estate; Financial services relating to real estate property; Financial services relating to real estate property and buildings; Financial valuation of personal property and real estate; Financing of real estate development projects; Financing services relating to real estate development; Investment advisory services relating to real estate; Investment in real estate (Services for -); Appraisals for insurance claims of real estate; Banking insurance; Insurance for third party liability;

Insurance services relating to real estate; Mortgage banking insurance; Property (Real estate -) insurance; Real estate insurance services; Telephone and banking insurance services.

55. Part of the application for invalidation has been unsuccessful. **The registered trade mark will remain registered, subject to an appeal against this decision, for the following services:**

Class 35: Online retail services relating to clothing; Online retail services relating to handbags; Online retail services relating to jewelry; Online retail store services in relation to clothing; Online retail store services relating to clothing; Retail services connected with the sale of clothing and clothing accessories; Retail services in relation to bags; Retail services in relation to clothing; Retail services in relation to clothing accessories; Retail services in relation to footwear; Retail services in relation to headgear; Retail services in relation to jewellery; Retail services in relation to metal hardware; Retail services in relation to safes; Retail services in relation to smartphones; Retail services in relation to smartwatches; Retail services relating to clothing; Retail services relating to jewelry; Retail store services in the field of clothing; Mail order retail services for clothing accessories.

Class 36: Accommodation bureaux (real estate property); Advisory services relating to real estate ownership; Advisory services relating to real estate valuations; Agency services for the leasing of real estate property; Appraisal and evaluation of real estate; Appraisal of real estate; Arranging letting of real estate; Assessment and management of real estate; Collection of debt on real estate rental; Commercial real estate agency services; Computerised information services relating to real estate; Consultancy in the purchasing of real estate; Consultancy services relating to real estate; Consultation services relating to real estate; Corporate real estate advisory services; Evaluation of real estate; Financial consultancy relating to real estate investment; Lease of real estate; Leases (arranging of -) [real estate property only]; Leasing of real

estate; Leasing of real estate property; Management of real estate; Management services for real estate investment; Property (Real estate -) management; Property leasing [real estate property only]; Providing information relating to real estate appraisal; Providing real estate information relating to property and land; Provision of information relating to property [real estate]; Provision of information relating to real estate; Provision of information relating to the property market [real estate]; Real estate administration; Real estate affairs; Real estate affairs services; Real estate agencies; Real estate agency; Real estate agency services; Real estate agency services for the leasing of land; Real estate agency services for the rental of buildings; Real estate agency services relating to the purchase and sale of land; Real estate agency services relating to the purchase and sale of buildings; Real estate agents services; Real estate and property management services; Real estate appraisal and valuation; Real estate appraisal services; Real estate appraisals [valuations]; Real estate consultancy; Real estate consultation; Real estate consultations; Real estate lease renewal services; Real estate lease surrender services; Real estate leasing; Real estate management; Real estate management services; Real estate management services relating to commercial buildings; Real estate management services relating to housing estates; Real estate management services relating to industrial premises; Real estate management services relating to residential buildings; Real estate management services relating to shopping malls; Real estate procurement for others; Real estate property management; Real estate services; Real estate valuation services; Rental of offices [real estate]; Rental of real estate; Rental of real estate and property; Residential real estate agency services; Valuations (Real estate -); Valuations in real estate matters; Valuation of real estate property; Real estate time-sharing; Real property letting; Real property management; Property (Real estate -) consultancy services; Property (Real estate -) evaluations; Property (Real estate -) brokerage services; Real estate brokerage; Brokerage of real estate; Real estate broking; Real estate trustee services; Trusteeship of real estate property; Estate agencies (Real -); Estate brokerage; Estate management

(Real -); Estate management services relating to transactions in real property; Evaluation of real property.

Costs

56. The applicant has enjoyed a greater degree of success and is entitled to a contribution towards his costs. The applicant was not professionally represented and had to submit a completed cost proforma to the Tribunal, outlining the number of hours spent on these proceedings. In an official letter to the parties, dated 25 April 2024, the Tribunal stated that “*if the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded.*” As the applicant elected not to complete a costs pro-forma, the only costs he is entitled to is in respect of the official fee for filing his invalidation.
57. I, therefore, order Ryan Mahoney to pay to Richard Maguire the sum of £200. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 14th day of January 2025

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General