O/035/20

TRADE MARKS ACT 1994

<u>CONSOLIDATED PROCEEDINGS</u>

IN THE MATTER OF APPLICATIONS NOS. 3313413 AND 3313416

TO REGISTER THE FOLLOWING TRADE MARKS:

Landmark STREET FURNITURE Landmark STREET FURNITURE

(SERIES OF TWO)

AND

LANDMARK

IN CLASSES 6, 12, 19, 20, 21, 28, 35, 37 AND 42

BY LANDMARK UK HOLDINGS LIMITED

AND IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO

UNDER NOS. 414153 AND 414409

BY THE LANDMARK TRUST

BACKGROUND AND PLEADINGS

1. On 25 May 2018, Landmark UK Holdings Limited ("the applicant") applied to register the trade marks:

Landmark STREET FURNITURE Landmark STREET FURNITURE (Series of two)

Application 3313413 ("the first application")

LANDMARK

Application 3313416 ("the second application")

for a range of goods and services in classes 6, 12, 19, 20, 21, 28, 35, 37 and 42. The specifications of the marks are identical. Both applications were accepted and published in the Trade Marks Journal on 20 July 2018 and 17 August 2018, respectively.

2. On 22 October 2018, the Landmark Trust ("the opponent") opposed both trade marks on the basis of Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). Under each of these grounds, the oppositions are directed against all of the goods and services in the contested applications.

3. On 25 October 2018, the opponent was informed that the applicant had filed Forms TM21B to amend its class 12, 28 and 35 specifications. For ease of reference, the amended specification is reproduced in the Annex to this decision. The opponent having confirmed that the above amendments did not dispose of its oppositions, the proceedings continued against the specifications as amended.

4. The oppositions under Section 5(2)(b) are based on earlier UK Trade Mark no. 2294387 which was filed on 21 December 2001 and registered on 11 April 2003, for the mark THE LANDMARK TRUST. The mark is registered for a range of goods and services in classes 2, 3, 4, 6, 8, 9, 12, 14, 15, 16, 18, 20, 21, 22, 23, 24, 25, 26, 27,

28, 29, 30, 31, 32, 33, 35, 36, 39, 40, 41, 43 and 44 but the opponent relies solely on the goods and services set out below:

Class 2: *paints, varnishes, lacquers, mordants, dyes*
Class 20: *coat hangers*
Class 21: *household, domestic and kitchen utensils and containers; china; bread boards*
Class 24: *furnishing fabrics; curtain materials; upholstery materials*[1]
Class 43: *accommodation services; hotel, holiday boarding house and temporary accommodation services; accommodation letting reservation services; campground and camping services; provision of tourist homes; provision of restaurant, cafeteria and catering services*
Class 44: *provision of services for gardening and horticulture*.

5. The opponent submits that there is a likelihood of confusion because the parties' respective goods and services are identical or similar and the marks are similar.

6. With regards to its claims based upon Section 5(3) of the Act, the opponent relies upon the same UK Trade Mark No. 2294387 and claims that the mark has a reputation for *accommodation services; hotel, holiday boarding house and temporary accommodation services; accommodation letting reservation services; campground and camping services; provision of tourist homes; provision of restaurant, cafeteria and catering services* in class 43. The opponent also claims that use of the applicant's marks would take unfair advantage of, and/or be detrimental to the reputation and distinctive character of the earlier mark.

7. Under Section 5(4)(a) of the Act, the opponent claims that use of the applicant's marks is liable to be prevented under the law of passing off, owing to its goodwill attached to the sign THE LANDMARK TRUST, which it claims to have used throughout the UK since 1965, in respect of the following goods and services: *Furniture; furnishings; household items: china; property rental services; fund raising and charitable services; property renovation services: property restoration services;*

[1] This item is relied upon only in the opposition against the second application

holiday and tourism services; accommodation services. The opponent claims that use of the applicant's mark is likely to amount to a misrepresentation in the course of trade, and that such a misrepresentation is likely to cause damage to the opponent by way of dilution, tarnishment and/or loss of sales.

8. The applicant filed counterstatements denying the claims made and put the opponent to proof of use of its earlier mark.

9. The proceedings were consolidated following the filing of the applicant's counterstatements.

10. The opponent filed evidence. No evidence was filed by the applicant. No hearing was requested and neither party filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

11. Throughout the proceedings the applicant has been professionally represented by Wilson Gunn, whilst the opponent has been professionally represented by Kilburn & Strode LLP.

DECISION

12. Section 5(2)(b) of the Act states as follows:

> "5(2) A trade mark shall not be registered if because –
>
> > (a) […]
> >
> > (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

13. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

> "6(1) In this Act an "earlier trade mark" means –
>
> > (a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.
>
> (2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b) subject to its being so registered."

14. The opponent's mark qualifies as an earlier mark in accordance with Section 6 of the Act and is subject to proof of use.

The evidence

15. The opponent's evidence consists of a witness statement provided by Emma Victoria Wilson who is a trade mark attorney at Kilburn & Strode LLP. Ms Wilson's witness statement is dated 25 March 2019 and is accompanied by 33 exhibits.

16. Ms Wilson states that the opponent is a British building conservation charity. She explains that the charity was founded in 1965 and was initially aimed at preventing the loss of historic building which were not protected by the National Trust or the Ministry of Work. Today the charity rescues buildings of historical interest or architectural merit and makes them available for rent.

17. Ms Wilson states that the opponent has used the words THE LANDMARK TRUST as a trade mark since 1965. According to Ms Wilson, the first holiday rentals were in 1967 when six properties were available. At the time Ms Wilson gave her statement, the opponent had over 200 properties available to rent as holiday homes and other

properties which were undergoing restoration. The properties offered by The Landmark Trust include houses, forts, farmhouses, manor houses, miles, cottages, gatehouses, follies and towers.

18. Ms Wilson says that The Landmark Trust has a Royal Patron and high-profile supporters who act as Ambassadors, all of which contribute to raising awareness of the charity throughout the UK. Ms Wilson also states that *"The Landmark Trust's properties are well-known for their distinctive furnishings, arrangement and interior decoration"* and that *"the unique paints, utensils, china, furnishing fabrics, curtains and upholstery materials all play a significant role in THE LANDMARK TRUST properties and the brand they present to consumers"*.

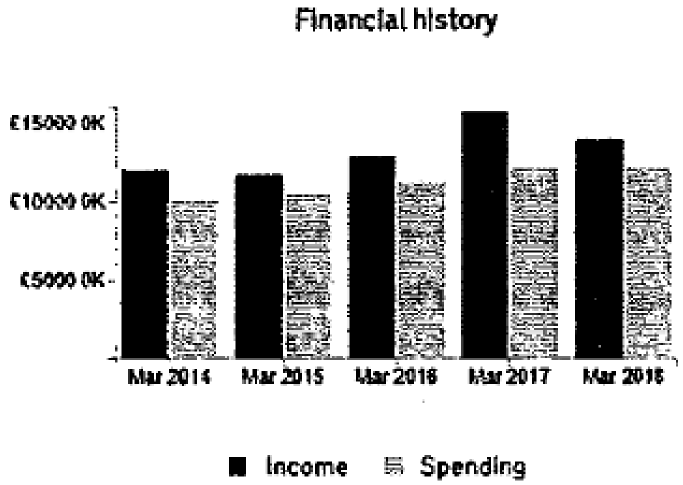
19. Ms Wilson states that the exhibits provide the following information:

> **Exhibits EVW1-2** consist of web-prints of two online articles from the website www.landmarktrust.org.uk referring to how THE LANDMARK TRUST properties are furnished. They are undated, but I note that the printing date is 25 March 2019.
>
> **Exhibits EVW3-6** comprise web-prints from the website www.landmarktrust.org.uk showing a variety of properties available for holiday rental in a number of locations in the UK. They also bear a printing date of 25 March 2019.
>
> **Exhibits EVW7-12** comprise evidence of advertising. The material includes extracts from a calendar (2019), a leaflet, a handbook and a newsletter (2019), all of which bear THE LANDMARK TRUST mark. In addition, the words 'landmarktrust' appear in an email address for booking enquires. The opponent is described in these documents as "*one of Britain's leading conservation charities"* with some of the extracts highlighting the nature (and extent) of the opponent's use. For example, it is stated, "*We give new life and purpose to historic buildings by restoring them and making them available for short breaks and holidays. The income this generates fund their preservation and ensure they never again fall into decay" and "Most of our 200 Landmarks have a*

dedicated page that summarise the building's historical importance". Ms Wilson also points out that one of the extracts reports the results of a consumer survey which revealed that *"first impressions, historical detail, quality furnishing and cleanliness were rated high by over 80% of Landmarkers".*

Exhibits EVW13-14 are web-prints from the Charity Commission's website. They show that the opponent is a registered charity and that at the end of the financial year ending 31 March 2018, the opponent had £14 million income (which includes £2.49 million from donations and legacies as well as £11.46 million from charitable activities), £12.2 million spending, 159 employees and 140 volunteers. They also show that the opponent's area of operation includes the UK, France and Italy. The aims and activities of the charity are described as *"Acquires smaller historic buildings that are at risk and in some way significant. These are restored to the highest standard of conservation using traditional materials and skills whose survival is thus also supported. Anyone can stay in the restored buildings to learn about their significance in time and place, giving them a sustainable future. Public Open Days provide further public access".*

The only financial information provided by Ms Wilson as regards the period prior to 2018 consist of the following chart:



According to Ms Wilson, the number of visitors attending Open Days hosted by the opponent were 27,000 in 2014, 27,150 in 2015, 20,000 in 2016 and 15,087 in 2017.

Exhibits EVW16-19 consist of a selection of The Landmark Trust Annual Reviews for 2014, 2015, 2016 and 2017. The following data can be extrapolated from this evidence:

- The number of guests staying at one of The Landmark Trust's properties were 68,055 in 2017, 70,000 in 2016, 56,000 in 2015 and 54,000 in 2014;
- The opponent's occupancy rate was 87% in 2016 and 85% in 2015;
- The opponent had 198 buildings available to book for holidays in Britain and a handful in Europe in 2016 and 196 in 2015;
- The average cost of a 'landmark break' was £48 in 2016 and less than £45 in 2014;
- The 2014 Annual Review shows that the opponent's letting income was £7 million in the periods 2011-2012 and 2012-2013 and £7.4 million in the period 2013-2014;
- The opponent was voted 'The Best Family Place to Stay' by The Independent newspaper in 2015 and the opponent's website had 1.4 million visitors in 2014.

Exhibits EVW20-23 are web-prints from the opponent's social media accounts, all of which were printed after the relevant date.

Exhibits EVW26-27 provide support for Ms Wilson's assertion that the work of The Landmark Trust was the subject of various television programmes including (1) *'Restoring Britain's Landmarks'*: a documentary broadcasted on Channel 4 in October 2015; (2) '*Great Britain Buildings: Restoration of the Year'*: 4 episodes broadcasted on Channel 4 in March 2017; (3) *'Farmhouse Fit for a Price'* announced by Channel 4 on 6 July 2018 and (4) *'£4 Million Restoration: Historic House Rescue'*: 2 episodes, the first one broadcasted on Channel 4 in January 2019.

Exhibits EVW32-33 consist of two articles from the Telegraph and the Independent newspapers about The Landmark Trust's properties.

Case-law

20. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

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

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

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale

and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

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

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

21. According to Section 6A(3)(a) of the Act, the relevant period in which genuine use must be established is the five-year period ending on the date of publication of the applied for marks. Consequently, the relevant periods are 21 July 2013 to 20 July 2018 (opposition no. 414153) and 18 August 2013 to 17 August 2018 (opposition no. 414409).

22. Before assessing the opponent's evidence of use, I remind myself of the comment of Mr Daniel Alexander, Q.C., sitting as the Appointed Person in *Awareness Limited v Plymouth City Council,* Case BL O/236/13, where he stated that:

"22. The burden lies on the registered proprietor to prove use.......... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

and further at paragraph 28:

"28. .... I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as "tuition services", is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to "tuition services" even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted."

23. Furthermore, in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd,* Case BL 0/404/13*,* Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

"21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

> [24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not *'show'* (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

24. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.[2]

[2] *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

25. The exhibits which supplement Ms Wilson's witness statement, confirm her evidence as regards the place, time and nature of use. Further, the opponent's evidence has not been challenged by the applicant and there is nothing that casts doubt upon it.

26. The evidence clearly establishes that the opponent is a building conservation charity. It restores historic buildings, makes them available for self-catering holidays and use the letting income to pay for the maintenance of the buildings it restores. This emerges throughout the evidence. In particular, the 2017 Annual Review states: *"We are one of Britain's leading conservation charities. With the help of supporters and grant-making bodies we save historic buildings in danger of being lost forever. We carefully restore such 'Landmarks' and offer them a new future by making them available for self-catering holiday. The lettings income from the 200 extraordinary buildings in our care supports their maintenance and survival in our landscape, culture and society".*

27. The fact that the opponent is a charity, does not prevent a finding of genuine use. In case C-442/07, *Radetzky*, the Court of Justice of the European Union (CJEU) stated that:

> "16. With regard to the question whether a non-profit-making association, carrying on activities such as those described in paragraphs 7 and 9 of the present judgment, may be regarded as making genuine use of a trade mark within the meaning of *Ansul*, it should be pointed out that the fact that goods or services are offered on a non-profit-making basis is not decisive.
>
> 17. The fact that a charitable association does not seek to make profit does not mean that its objective cannot be to create and, later, to preserve an outlet for its goods or services.
> […]
> 20. As long as the association in question uses the marks of which it is the proprietor to identify and promote the goods or services for which they were registered, it is making an actual use of them which constitutes 'genuine use' within the meaning of Article 12(1) of the Directive.

21. Where non-profit-making associations register as trade marks signs which they use to identify their goods or their services, they cannot be accused of not making actual use of those marks when in fact they use them for those goods or services.

22. In any event, in accordance with the finding of the Court in paragraph 37 of *Ansul*, and as the Advocate General pointed out in point 30 of his Opinion, use of a trade mark by a non-profit-making association during purely private ceremonies or events, or for the advertisement or announcement of such ceremonies or events, constitutes an internal use of the trade mark and not 'genuine use' for the purposes of Article 12(1) of the directive.

23. It is for the national court to ascertain whether the BKFR has used the trade marks of which it is the proprietor to identify and promote its goods or its services to the general public or whether, on the contrary, it has merely made internal use of them.

24. In the light of the foregoing considerations, the answer to the question referred must be that Article 12(1) of the Directive is to be construed as meaning that a trade mark is put to genuine use where a non-profit-making association uses the trade mark, in its relations with the public, in announcements of forthcoming events, on business papers and on advertising material and where the association's members wear badges featuring that trade mark when collecting and distributing donations."

28. Furthermore, goods and services offered by a charity may constitute genuine use when they are offered commercially, i.e. with the intention of creating or maintaining an outlet for those goods or services in the relevant territory, as opposed to the goods or services of other undertakings[3]. In the present case, even if the opponent might offer its services to some consumers free of charge (for example, in 2017 the opponent offered 50 breaks in its properties to people who received support from other

[3] Case T-289/09, *Omnicare, Inc*. v OHIM, paragraph 68-69

charities[4]), most of the opponent's holiday letting services are purchased by customers for a price and are in competition with similar services offered by other undertakings.

29. As regards to whether the time and extent of the use is sufficient to establish genuine use within the relevant periods, the opponent has not provided a breakdown of the activities which generate its income. Although a proportion of the opponent's income will undoubtably derive from donations, legacies and fundraising activities, it is sufficiently clear that the opponent generates income from its holiday letting services. In this connection, the 2014 Annual report establishes that in the period 2013-2014 (and in the two year prior to that) the opponent's letting income was approximately £7 million. The evidence also establishes that in the period 2014-2017, the number of guests staying in one of the opponent's properties increased from 54,000 to over 68,000, that the opponent's occupancy rate was 87% and 85% in 2016 and 2015 respectively, and that the opponent's website had 1.4 million visitors in 2014.

30. Taking all of this into account, I am satisfied that the opponent made genuine use of the contested mark during the relevant period.

<u>The services for which genuine use of the mark has been shown</u>

31. I now turn to the question of an appropriate specification which fairly reflects the use shown. The correct approach to this matter was set out by Kitchen L.J. in *Roger Maier and Another v ASOS*[5]*,* as follows:

> "The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to

[4] 2017 Annual Review
[5] [2015] EWCA Civ 220. See also *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch)

allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories."

32. The trade mark THE LANDMARK TRUST is used on the opponent's website and promotional material. The evidence shows that on the same website and promotional material the opponent advertises the availability of its properties for holiday breaks. In my judgment, the following specification fairly reflects the established use:

Class 43: *Letting of restored buildings for holiday accommodation; reservation services relating to the aforesaid.*

33. The above specification falls within the opponent's *temporary accommodation services* and *accommodation letting reservation services.*

34. I have excluded the following goods and services, because there is no use of the mark in relation to these goods and services or other sub-categories of temporary accommodation services:

Class 2: *paints, varnishes, lacquers, mordants, dyes*
Class 20: *coat hangers*
Class 21: *household, domestic and kitchen utensils and containers; china; bread boards*
Class 24: *furnishing fabrics; curtain materials; upholstery materials*
Class 43: *accommodation services; hotel, holiday boarding house and temporary accommodation services; accommodation letting reservation services; campground and camping services; provision of tourist homes; provision of restaurant, cafeteria and catering services*
Class 44: *provision of services for gardening and horticulture*.

35. Although Ms Wilson refers to the opponent's properties being well-known for their distinctive furnishings and says that the *"unique paints, utensils, china, furnishing fabrics, curtains and upholstery materials all play a significant role in THE LANDMARK*

TRUST properties and the brand they present to consumers" there is no evidence that the opponent provides such goods under the earlier mark or that the mark is used to identify these goods. In this connection, the evidence produced at Exhibit EVW1 suggests that the opponent's properties are furnished with third parties' goods bought from actions or markets: *"Frequently I am asked where I source the furniture and pieces I put in Landmarks. Actions of course, but not as much as you might think – I find the process long-winded, even with the internet, and not as productive today as in the past. Some auction houses are increasingly fussy about what they accept as so much is slow to sell, preferring to concentrate on either the very good or the specialist, leaving an increasing volume to house-clearance. They can also be expensive, with between 30% and 40% of the hammer price lost in commission, so I prefer to scour the markets for goods where I can".* Even if the evidence in Exhibit EVW2 refers to the Landmark Trust's interior being designed in-house and states that *"The furniture used in Landmark's buildings is generally a mixture of carefully chosen -but rarely valuable-old pieces and new items we have either selected as appropriate, or created ourselves",* there is no evidence that the mark THE LANDMARK TRUST is used to identify these goods.

36. The only registered services in relation to which the opponent has established genuine use of the earlier mark are, therefore, those identified at paragraph 32 above.

Section 5(2)(b) – case law

37. The following principles are gleaned from the decisions of the EU 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 B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P.

(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 greater degree of similarity between the marks, and vice versa;

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

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

38. In comparing the respective specifications, all the relevant factors should be taken into account. In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, (Case C-39/97), the Court stated at paragraph 23:

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

39. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(a) The respective uses of the respective goods or services;
(b) The respective users of the respective goods or services;
(c) The physical nature of the goods or acts of service;
(d) The respective trade channels through which the goods or services reach the market;
(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for

instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

40. In *Kurt Hesse v OHIM* (Case C-50/15 P), the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM,* (Case T-325/06), the General Court (GC) stated that "complementary" means:

> "...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".

41. In *Sanco SA v OHIM,* Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13*:*

> "It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes."

42. Whilst on the other hand:

> ".......it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

43. The opponent can rely on the following services:

Class 43: *Letting of restored buildings for holiday accommodation; reservation services relating to the aforesaid.*

44. Unless the goods and services are obviously similar, the opponent must state why they are similar. Aside from the general statement (contained in the opponent's statement of grounds) that the goods and services are identical or similar, the opponent made no further submission to address the similarity of the goods and services at issue.

45. The contested goods and services are in classes 6, 12, 19, 20, 21, 28, 35, 37 and 42. I shall consider each category in turn.

46. Class 6: *Metal materials for building and constructions; metal arbours; metal pipes and tubes; metal sheets; metal bins; rubbish containers; compost bins of metal; metal bollards; metal gates, fencing and railings; canopies [structures] of metal; canopies [structures] of metal incorporating fabric and waterproof coverings; walkways of metal; handrails of metal for walkways; metal bus shelters; shelters of metal; metal storage shelters; cycle shelters of metal; shelters made principally of metal; seating platforms of metal; metal studs for marking; metal anti-skate studs; metal racks [structures]; metal bicycle storage racks; tree supports, protectors and guards of metal; stakes of metal for plants or trees; metal bin storage structures; dog waste bins of metal; metal barriers; intruder barriers of metal; metal barriers for pedestrian traffic control; crash barriers of metal for roads; metal vehicle height restriction barriers; metal traffic control barriers; metal trolley shelters; transportable buildings of metal; metallic speed bumps and restrictors.* The mere fact that some of the goods listed in this class are materials for building and construction and, as such, might be used to restore the properties in relation to which the opponent offers its letting services, is not a sufficient reason to find any degree of similarity between them. The purpose, uses and trade channels are different and there is no complementarity involved, as consumers would not think that responsibility for the production of those goods and the provision of the opponent's services lies with the same undertaking. These goods are dissimilar.

47. Class 12: *Cycle and scooter stands and racks; trolleys; none of the aforementioned goods being for attachment to vehicles.* The uses, purposes and methods of use of

these goods are completely different from that of the opponent's services. They are neither complementary nor in competition. They are not normally directed at the same relevant consumer via the same distribution channels and it is unlikely that they come from the same producer. These goods are dissimilar.

48. Class 19: *Building materials non-metallic; timber, manufactured timber, lumber, roofing materials; concrete bollards; non-metallic bollards; non-metallic gates, fencing and railings; non-metallic walkways, canopies [structures] and shelters; non-metallic storage shelters; non-metallic bicycle storage racks; non-metallic tree guards, grilles and grids; non-metallic barriers, intruder barriers, barriers for pedestrian traffic control, crash barriers for roads, vehicle height restriction barriers, and traffic control barriers; seating platforms not of metal; non-metallic trolley shelters; non-metallic transportable buildings; non-metal speed bumps and restrictors.* Similar considerations to those outlined above at paragraph 46 apply to these goods. The goods are dissimilar.

49. Class 20: *Furniture; arbours; lockers; garden furniture; street furniture; seating; benches; tables; stools; chairs; seats; metal furniture; plastic furniture; moulded furniture; padded furniture; wooden planters; wooden bins; containers not of metal for storage or transport.* Although some of the items listed in this class can be used to furnish the properties in relation to which the opponent offers its letting services, the goods and services have different uses, purposes, and methods of use. Furthermore, the trade channels are different, and the goods and services are not complementary to each other or in competition. Therefore, they are dissimilar.

50. Class 21: *Plastic planters; litter bins; refuse bins; non-metal bins; fibreglass other than for insulation or textile use.* Here again, the goods and services have completely different uses, purposes, and methods of use, the trade channels are different, and the goods and services are neither complementary nor in competition. Therefore, they are dissimilar.

51. Class 28: *Games, toys and playthings, none of these goods being toy vehicles; children's playground equipment; swings; slides; climbing frames; playground buildings, bridges and play units incorporating bridges, beams and climbing frames.* Similarly to what I have already found in relation to the other categories of goods, the

goods and services have completely different uses, purposes, and methods of use, the trade channels are different, and the goods and services are neither complementary nor in competition. Therefore, they are dissimilar.

52. Class 35: *Retail and wholesale services including mail order catalogue retail services and on-line retail services in connection with the sale of, metal materials for building and constructions, metal arbours, metal pipes and tubes, metal sheets, metal bins, rubbish containers, compost bins of metal, metal bollards, metal gates, fencing and railings, canopies [structures] of metal, canopies [structures] of metal incorporating fabric and waterproof coverings, walkways of metal, handrails of metal for walkways, metal bus shelters, shelters of metal, metal storage shelters, cycle shelters of metal, shelters made principally of metal, seating platforms of metal, metal studs for marking, metal anti-skate studs, metal racks [structures], metal bicycle storage racks, tree supports, protectors and guards of metal, stakes of metal for plants or trees, metal bin storage structures, dog waste bins of metal, metal barriers, intruder barriers of metal, metal barriers for pedestrian traffic control, crash barriers of metal for roads, metal vehicle height restriction barriers, metal traffic control barriers, metal trolley shelters, transportable buildings of metal, metallic speed bumps and restrictors, cycle and scooter stands and racks not being for attachment to vehicles, trolleys not being for attachment to vehicles, building materials non-metallic, timber, manufactured timber, lumber, roofing materials, concrete bollards, non-metallic bollards, non-metallic gates, fencing and railings, non-metallic walkways, canopies [structures] and shelters, non-metallic storage shelters, non-metallic bicycle storage racks, non-metallic tree guards, grilles and grids, non-metallic barriers, intruder barriers, barriers for pedestrian traffic control, crash barriers for roads, vehicle height restriction barriers, and traffic control barriers, seating platforms not of metal, non-metallic trolley shelters, non-metallic transportable buildings, non-metal speed bumps and restrictors, furniture, arbours, lockers, garden furniture, street furniture, seating, benches, tables, stools, chairs, seats, metal furniture, plastic furniture, moulded furniture, padded furniture, wooden planters, containers not of metal for storage or transport, plastic planters, wooden bins, litter bins, refuse bins, non-metal bins, fibreglass other than for insulation or textile use, games not being toy vehicles, toys and playthings not being toy vehicles, children's playground equipment, swings, slides, climbing frames, playground buildings, bridges and play units incorporating bridges, beams and climbing frames;*

organisation, operation and supervision of loyalty programmes, loyalty card membership schemes and of sales and promotional incentive schemes; advertising, marketing and publicity services. This class covers retail and wholesale services relating to goods which I have found to be dissimilar to the opponent's services. Similarly to what I have already found in relation to the goods, the contested retail services have nothing relevant in common with the opponent's services that could justify finding a degree of similarity. I therefore find that these goods are dissimilar.

53. The contested specification in class 35 also cover *organisation, operation and supervision of loyalty programmes, loyalty card membership schemes and of sales and promotional incentive schemes; advertising, marketing and publicity services*. These are services provided by companies the purpose of which is extending the market of other companies. These services and the opponent's services do not have the same nature and purpose. They are not in competition or complementary. They are not provided by the same companies and do not have the same distribution channels. Furthermore, they do not have the same relevant public. Even if a company in the field of holiday accommodation services, such as that of the opponent, were to try to earn customer loyalty, it would be for its own services and would not constitute a separate service provided to other undertakings. Likewise, the fact that some of the opponent's services may appear in publications, such as advertisements, is insufficient for a finding of similarity. Therefore, these services are dissimilar.

54. Class 37: *Construction, Installation, maintenance and repair services in respect of furniture, street furniture, shelters and storage structures, bicycle racks, children's playground equipment, bollards, gates, fences and barriers, land vehicle storage shelters, land vehicle stands and racks, canopies and walkways, and access and traffic control fixtures and structures.* Here again, the contested services have nothing in common with the opponent's services that could justify finding any degree of similarity. Although the opponent might use some of the contested services, i.e. *construction, Installation, maintenance and repair services in respect of furniture,* to repair the items used to furnish the properties in relation to which it offers its letting services, it is insufficient for a finding of similarity. The uses, purpose, methods of use and trade channels are different and there is no complementarity in the true sense

because from the consumer's point of view, the services are unlikely to be offered by one and the same undertaking. I therefore find that these services are dissimilar.

55. Class 42: *Design services; design services in connection with furniture, street furniture, shelters and storage structures, children's playground equipment, bollards, gates, fences and barriers, land vehicle storage shelters, land vehicle stands and racks, canopies and walkways, and access and traffic control fixtures and structures.* Similar consideration to those outlined in the preceding paragraph apply here. These services are dissimilar.

56. In *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA, Lady Justice Arden stated that:

> "49........... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

57. Taking into account all of the evidence and submissions (or lack of them) of both parties and applying my own knowledge and understanding of the goods and services at issue and the relevant market place, as an average consumer of those goods and services, I find all of the contested goods and services to be dissimilar to the services in relation to which the opponent can rely, for the reasons set out above.

58. For there to be any possibility of a likelihood of confusion, there must be at least some degree of similarity between the goods and services at issue. Consequently, as the goods and services at issue have been found to be dissimilar, there can be no possibility of confusion and the oppositions fail.

Section 5(4)(a)

59. Section 5(4)(a) of the Act states as follows:

> "A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –
>
> (a) by virtue of any rule or law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
> (b) …
>
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of 'an earlier right in relation to the trade mark'."

60. It is settled law that, for a finding of passing off, three factors must be present: goodwill, misrepresentation and damage. Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law in *Jadebay Limited, Noa and Nani Limited trading as the Discount Outlet v Clarke-Coles Limited trading as Feel Good UK* [2017] EWHC 1400 IPEC:

> "56. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL) namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of those limbs.
>
> 57. In relation to deception, the court must assess whether *'a substantial number'* of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

61. The relevant date for assessing a Section 5(4)(a) claim has been discussed by Mr Daniel Alexander QC, sitting as the Appointed Person, in *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11. In this decision, he quoted with approval the following summary of the position provided by the Hearing Officer, Mr Allan James, in *SWORDERS TM*, BL O-212-06:

> "… Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made."[6]

62. The applicant has filed no evidence and there is no indication that it has used the marks prior to the applications dates. Consequently, the relevant date is the date the applications were made – 25 May 2018.

Goodwill

63. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

> "What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in customers. It is the one thing which distinguishes an old-established business from a new business at its first start."

64. The opponent claims to have acquired goodwill at the relevant date under the sign THE LANDMARK TRUST in relation to *Furniture; furnishings; household items; china; property rental services; fund raising and charitable services; property renovation*

[6] Paragraph 148.

services; property restoration services; holiday and tourism services; accommodation services.

65. Ms Wilson explains that the opponent is a building conservation charity whose primary function is to rescue buildings of historic interest and preserve them.

66. Although the law of passing-off protect primarily traders, it may also be relied on to protect goodwill enjoyed by charities. Further, a charity can sustain an action in passing-off even though it is not engaged in trading activities. The fund-raising activities of a charity, and its reputation and image, are sufficient to enable it to sustain such a claim. In *British Diabetic Association v The Diabetic Society* [1996] FSR 1 at 10-11 Walker J stated:

> "I conclude, therefore, that the scope of a passing off action is wide enough to include deception of the public by one fund-raising charity in a way that tends to appropriate and so damage another fund-raising charity's goodwill—that is, the other charity's "attractive force" (see Lord *Macnaghten in Inland Revenue Commissioners v. Muller & Co.'s Margarine Ltd* [1901] A.C. 217 , 223) in obtaining financial support from the public. That conclusion raises a number of questions which may have to be explored at some future time (though litigation of this sort will, I sincerely hope, be extremely rare). I will make some tentative comments on points which were raised, but not fully examined, in counsel's submissions.
>
> The wider the scope of passing off, the freer has to be the interpretation of some of Lord Diplock's requirements, especially the reference to "prospective customers of [a trader] or ultimate consumers of goods or services supplied by him". It is obvious that in the case of many charities, their benefactors are likely to be a class of the public quite different from that of their beneficiaries. In the case of—for instance—the NSPCC or the RNLI the "prospective customers . . . or ultimate consumers" of the charity's services will, with rare exceptions, be different from those whose generosity funds the services.

By contrast the Association (like the average church congregation) seems to be a charity which for its financial needs depends to a high degree on self-help: the evidence suggests that diabetics and their families and friends are a major source (though not, of course, the only source) of subscriptions, legacies, in memoriam gifts (in lieu of flowers) and fund-raising activities. That reinforces my conclusion that (whatever may be the position with charities of a different character) passing off can provide a remedy in a situation such as the present, if misrepresentation is established. The Association's self-help character may also be material to the assessment of the evidence as to reputation and likely deception. That evidence shows that on occasion even long-standing supporters of the Association (including its Honorary President, Sir Harry Secombe) and also the Association's own publishers, did refer to the Association, in writing, otherwise than by its correct name."

67. I accept that Ms Wilson's evidence shows that the opponent is a long-established charity and has used the name THE LANDMARK TRUST as its organisation's name since 1965. A good deal of the evidence also shows the sign THE LANDMARK TRUST being used on promotional material and on the opponent's website. The aim of the charity is to acquire *"smaller historic buildings that are at risk and in some way significant and restore them"*. The opponent restores the buildings so that they are available to the general public for short holiday breaks. To this end, the opponent has a working website, as well as an email address and a telephone contact for booking enquiries. In addition, the opponent holds Public Open Days which provides further public access to its buildings.

68. At the end of the financial year ending 31 March 2018, the opponent was a large charity with £14 million income (including £2.49 million from donations and legacies and £11.46 million raised from charitable activities), £12.2 million spending, 159 employees and 140 volunteers. The chart provided by Ms Wilson shows that in March 2017 the income was slightly higher, and the spending more or less the same. In 2016 the opponent had 198 buildings available to book for holiday in the UK. The opponent's letting activity generated an income of around £7 million in the periods 2011-2012 and 2012-2013 and the opponent had 68,055 guests in 2017, 70,000 in 2016, 56,000 in 2015 and 54,000 in 2014. Between 2014 and 2017 the charity had over 85,000 people

attending its Open Days. The charity's activities and its buildings were also the subject of two TV documentaries broadcasted on Channel 4 before the relevant date, in 2015 and 2017.

69. On the basis of the evidence filed I find that, by the relevant date, the opponent had made extensive use, and as a result had acquired a substantial goodwill in the name THE LANDMARK TRUST as an organisation operating as a registered charity, conducting property renovation and restoration, fundraising and charitable activities and providing services in commerce consisting of letting of renovated buildings for holiday accommodation.

70. As regards the opponent's claim that it has also acquired goodwill in relation to *Furniture; furnishings; household items* and *china,* as I have already found, there is nothing in the documentation filed which indicates that the opponent uses the sign THE LANDMARK TRUST to identify and promote goods of this kind. As the earlier use by the opponent must relate to the use of the sign for the purposes of distinguishing goods or services, the opponent has not acquired any goodwill in the market for these goods.

Misrepresentation and damage

71. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

> "There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is
>
> > "is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]"

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd*. (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101."

72. And later in the same judgment:

".... for my part, I think that references, in this context, to "more than de minimis" and "above a trivial level" are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion."

73. *Halsbury's Laws of England* Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

74. Having found that the name THE LANDMARK TRUST is distinctive of the opponent's goodwill, the question I need to answer is whether the applicant's use of the applied for marks, would be likely to lead people to purchase the applicant's goods and services in the mistaken belief that they are provided by the opponent's charity.

75. The main features of this case are that:

- the opponent's charity receives legacies and donations, but also carries out normal commercial trading activities which generate about half of its annual income. In this connection, the Annual Review 2017 states: *"So much more than holidays. The passer-by might be forgiven for thinking that the landmark Trust is a holiday cottage company. But we are not! As supporters know so well we exist for good: to save important buildings and foster people's enjoyment of historic places";*
- the case does not involve competition between charities, like in *British Diabetic Association v The Diabetic Society*, but the opponent is objecting registration of two trade marks by a trader, i.e. a limited company;
- the opponent puts in passing off case in the following terms:

  > Through use of the THE LANDMARK TRUST mark throughout the UK, the Opponent has acquired goodwill in relation to furniture; furnishings; household items; china; property rental services; fund raising and charitable services; property renovation services; property restoration services; holiday and tourism services; accommodation services. The contested applications shares the identical LANDMARK element and so is similar to the earlier right. Use and/or registration of the applied for mark by the Applicant would constitute a misrepresentation as to the origin of the goods/services offered under the mark. This misrepresentation could result in damage to the Opponent by way of dilution, tarnishment and/or loss of sales.

  The pleadings seem to limit the passing-off claim to the opponent's trading activities. Strictly speaking, the opponent refers to "loss of sale" and does not claim that is seeking to protect its goodwill in the name THE LANDMARK TRUST in relation to its fundraising and charitable activities, i.e. attracting volunteers, memberships, donations and legacies.

76. Indeed, I have already considered the nature and extent of the goodwill relied upon.

77. The second point is about closeness or otherwise of the respective fields of activity in which the opponent and the applicant operate. In considering the claim under Section 5(2)(b) I have already concluded that there is no similarity between the opponent's letting services and any of the applicant's goods and services - which, translated in the language of a passing-off action, means that they are in different fields of activity. I also find that the applicant's goods and services are in a different field of activity from that of the opponent's goodwill as a charity, i.e. the goodwill that brings in financial support from the public. Finally, as regards the opponent's goodwill in renovation and restoration, it is part and parcel of its fund-raising charity's goodwill.

The opponent carries out these activities in relation to properties it acquires, restores and then makes available to the public. They can attract financial support from the public but do not represent a service which is available to the public to, say, restore buildings which are privately owned.

78. The third point is the similarity of the signs. The Collins English Dictionary defines ‘landmark’ as follows: *“A landmark is a building or feature which is easily noticed and can be used to judge your position or the position of other buildings or features.”* Whilst the name THE LANDMARK TRUST is intended to be an invented name that denotes a business and is not totally descriptive, it is low in distinctiveness for a building conservation charity.

79. In terms of similarity between the opponent’s sign THE LANDMARK TRUST and the applicant’s second mark consisting of the single word LANDMARK, the opponent’s sign will be perceived as a whole and will be seen, in the context of the opponent’s charity, as referring to a charitable trust called THE LANDMARK TRUST, whereas the applicant’s mark will be perceived as the single word LANDMARK. Although the signs share the word LANDMARK, the shared element does not retain an independent role in the opponent’s sign, the opponent’s sign is visibly longer and conveys the concept of a charitable trust which is absent from the contested mark. The signs are therefore visually, aurally and conceptually similar to a medium degree. The degree of visual, aural and conceptual similarity is even lower, i.e. between low and medium, in relation to the first application which is for the following logo marks, due to the addition of the figurative element and the words STREET FURNITURE:

Landmark STREET FURNITURE   Landmark STREET FURNITURE

80. In my view, taking all of the above into account, in particular the nature of the opponent’s goodwill, the distance in the parties’ field of activities, the low degree of distinctiveness of the opponent’s sign in the context of the use made and the differences in the marks, there is no risk that a substantial number of consumers of the opponent’s letting services will be confused into thinking that the applicant’s goods

and services are offered by the opponent or by an undertaking connected to it. Although it was not expressly pleaded, I also extend the same finding to those who provide financial support to the opponent's charity. My conclusion is therefore that there will be no misrepresentation. Without misrepresentation there can be no damage.

81. The opposition under Section 5(4)(a) also fails.

Section 5(3)

82. I now turn to the opposition based upon section 5(3) of the Act. Section 5(3) of the Act states as follows:

> "5(3) A trade mark which -
>
> (a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark."

83. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon,* Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:

> a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24.*
>
> (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; G*eneral Motors, paragraph 26.*

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63.*

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

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68;* whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79.*

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77.*

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

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

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure).*

84. The conditions of Section 5(3) are cumulative. Firstly, the opponent must show that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the later mark. Thirdly, assuming that the first and second conditions have been met, Section 5(3) requires that one or more of the types of damage claimed will occur and/or that the contested mark will, without due cause, take unfair advantage of the reputation and/or distinctive character of the reputed mark. It is unnecessary for the purposes of Section 5(3) that the goods or services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks. The relative date for the assessment under Section 5(3) is the date of the applications, i.e. 25 May 2018.

Reputation

85. The opponent claims that the earlier THE LANDMARK TRUST mark has a reputation for *accommodation services; hotel, holiday boarding house and temporary accommodation services; accommodation letting reservation services; campground and camping services; provision of tourist homes; provision of restaurant, cafeteria and catering services* in class 43.

86. In determining whether the opponent has demonstrated a reputation for the services in issue, it is necessary for me to consider whether its mark will be known by a significant part of the public concerned with the services. In reaching this decision, I must take all of the evidence into account including "the market share held by the trade mark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertakings in promoting it"[7].

87. The opponent has claimed a reputation only in relation to its trading activities, not as a charity. I have already found that the opponent has genuinely used the mark in relation to services consisting of letting of renovated buildings for holiday accommodation. The evidence shows that the opponent letting activities had generated an income of about £14 million in the period 2011-2013, that the opponent was voted 'The Best Family Place to Stay' by The Independent newspaper in 2015, that the opponent's website had 1.4 million visitors in 2014 and that the opponent had over 240,000 guests in the period 2014-2017. The use is long-standing, and the opponent has around 200 buildings available to rent throughout the UK. Whilst Ms Wilson's evidence refers to the restoration work carried out by the opponent being the subject of two documentaries broadcasted on Channel 4 before the relevant date, it is not clear whether the letting services provided by the opponent were also part of these documentaries and if so, what was the impact that the documentaries had on the public concerned with these services. Further, it is not clear whether the spending figures given in the evidence are money spent on restoring and maintaining the opponent's buildings or money spent on advertising, there is no indication of market share and there is little promotional evidence.

88. Although the evidence presents some gaps, taking into account all of the above, I find that the opponent had a moderate reputation in relation to the provision of services consisting of letting of restored buildings for holiday accommodation.

[7] General Motors Corp v Yplon SA, Case C-375/97

Link

89. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

- <u>The degree of similarity between the conflicting marks.</u> I found the first application to be visually, aurally and conceptually similar to a degree between low and medium to the opponent's mark and the second application to be visually, aurally and conceptually similar to a medium degree.

- <u>The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public</u>. For the reasons set out above, I consider the services in relation to which the opponent has a reputation, i.e. letting of renovated buildings for holiday accommodation, to be dissimilar to all of the applicant's goods and services.

- <u>The strength of the earlier mark's reputation.</u> The opponent's reputation is moderate.

- <u>The degree of the earlier mark's distinctive character, whether inherent or acquired through use.</u> I found the earlier THE LANDMARK TRUST mark to be inherently distinctive to a low degree in relation to the charitable activities carried out by the opponent, given their building conservation purpose. The same is true for the opponent's letting services, given the nature of the buildings in relation to which the services are provided (which are described in the opponent's literature as 'landmarks') and the way the element TRUST will be perceived, i.e. as referring to the nature of the undertaking providing the services. The opponent's reputation is not particularly strong and if it has enhanced the distinctiveness of the earlier mark it is only slightly, to a moderate degree.

- Whether there is a likelihood of confusion. I have found there to be no likelihood of confusion.

90. Notwithstanding the opponent's reputation, when all the factors I have already assessed are considered, including the similarity between the marks, the differences between the goods and services and the distinctiveness of the earlier mark, I do not consider that the relevant public will make the requisite link. The similarity created by the common presence of the word LANDMARK in the contested marks is more than offset by the differences in the respective goods and services. Further, in the opponent's mark, the word LANDMARK form part of the unit THE LANDMARK TRUST, and I consider that someone familiar with the opponent's letting services would not fail to understand that that THE LANDMARK TRUST was the name of the charity providing the services. Consequently, I consider that the consumer would view the word LANDMARK in the opponent's mark as part of the name used by the charity offering the services. On the contrary, when the word LANDMARK is used in the applications in the context of different goods and services, it will be seen as use of the ordinary dictionary word LANDMARK rather than a reference to the opponent or its trade mark. This is all of the more so given the nature of the contested goods and services, most of which relate to material which can be used in architecture and construction, outdoor furniture and goods which can be positioned on roads and in relation to which the word LANDMARK carries some obvious allusive connotation. The position is stronger for the applicant in relation to its first application, where the word LANDMARK is supplemented by the words STREET FURNITURE and the logo device, but I consider that neither applications would cause the required link. If any link is made, it would be too fleeting to give raise to any unfair advantage or detriment. The Section 5(3) claim also fails.

CONCLUSION

91. The oppositions fail under all grounds. The applications may proceed to registration.

Costs

92. The applicant has been successful and is entitled to a contribution towards the costs of the proceedings, based upon the scale of costs published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of £700 as a contribution towards its costs. This sum is calculated as follows:

Preparing a statement and considering the opponent's statement (X2)	£400
Considering the opponent's evidence	£300
Total	£700

93. I order The Landmark Trust to pay Landmark UK Holdings Limited the sum of £700. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 17th day of January 2020

T Perks
For the Registrar,
the Comptroller-General

Annex

Class 6: *Metal materials for building and constructions; metal arbours; metal pipes and tubes; metal sheets; metal bins; rubbish containers; compost bins of metal; metal bollards; metal gates, fencing and railings; canopies [structures] of metal; canopies [structures] of metal incorporating fabric and waterproof coverings; walkways of metal; handrails of metal for walkways; metal bus shelters; shelters of metal; metal storage shelters; cycle shelters of metal; shelters made principally of metal; seating platforms of metal; metal studs for marking; metal anti-skate studs; metal racks [structures]; metal bicycle storage racks; tree supports, protectors and guards of metal; stakes of metal for plants or trees; metal bin storage structures; dog waste bins of metal; metal barriers; intruder barriers of metal; metal barriers for pedestrian traffic control; crash barriers of metal for roads; metal vehicle height restriction barriers; metal traffic control barriers; metal trolley shelters; transportable buildings of metal; metallic speed bumps and restrictors.*

Class 12: *Cycle and scooter stands and racks; trolleys; none of the aforementioned goods being for attachment to vehicles.*

Class 19: *Building materials non-metallic; timber, manufactured timber, lumber, roofing materials; concrete bollards; non-metallic bollards; non-metallic gates, fencing and railings; non-metallic walkways, canopies [structures] and shelters; non-metallic storage shelters; non-metallic bicycle storage racks; non-metallic tree guards, grilles and grids; non-metallic barriers, intruder barriers, barriers for pedestrian traffic control, crash barriers for roads, vehicle height restriction barriers, and traffic control barriers; seating platforms not of metal; non-metallic trolley shelters; non-metallic transportable buildings; non-metal speed bumps and restrictors.*

Class 20: *Furniture; arbours; lockers; garden furniture; street furniture; seating; benches; tables; stools; chairs; seats; metal furniture; plastic furniture; moulded furniture; padded furniture; wooden planters; wooden bins; containers not of metal for storage or transport.*

Class 21: *Plastic planters; litter bins; refuse bins; non-metal bins; fibreglass other than for insulation or textile use.*

Class 28: *Games, toys and playthings, none of these goods being toy vehicles; children's playground equipment; swings; slides; climbing frames; playground buildings, bridges and play units incorporating bridges, beams and climbing frames.*

Class *35: Retail and wholesale services including mail order catalogue retail services and on-line retail services in connection with the sale of, metal materials for building and constructions, metal arbours, metal pipes and tubes, metal sheets, metal bins, rubbish containers, compost bins of metal, metal bollards, metal gates, fencing and railings, canopies [structures] of metal, canopies [structures] of metal incorporating fabric and waterproof coverings, walkways of metal, handrails of metal for walkways, metal bus shelters, shelters of metal, metal storage shelters, cycle shelters of metal, shelters made principally of metal, seating platforms of metal, metal studs for marking, metal anti-skate studs, metal racks [structures], metal bicycle storage racks, tree supports, protectors and guards of metal, stakes of metal for plants or trees, metal bin storage structures, dog waste bins of metal, metal barriers, intruder barriers of metal, metal barriers for pedestrian traffic control, crash barriers of metal for roads, metal vehicle height restriction barriers, metal traffic control barriers, metal trolley shelters, transportable buildings of metal, metallic speed bumps and restrictors, cycle and scooter stands and racks not being for attachment to vehicles, trolleys not being for attachment to vehicles, building materials non-metallic, timber, manufactured timber, lumber, roofing materials, concrete bollards, non-metallic bollards, non-metallic gates, fencing and railings, non-metallic walkways, canopies [structures] and shelters, non-metallic storage shelters, non-metallic bicycle storage racks, non-metallic tree guards, grilles and grids, non-metallic barriers, intruder barriers, barriers for pedestrian traffic control, crash barriers for roads, vehicle height restriction barriers, and traffic control barriers, seating platforms not of metal, non-metallic trolley shelters, non-metallic transportable buildings, non-metal speed bumps and restrictors, furniture, arbours, lockers, garden furniture, street furniture, seating, benches, tables, stools, chairs, seats, metal furniture, plastic furniture, moulded furniture, padded furniture, wooden planters, containers not of metal for storage or transport, plastic planters, wooden bins, litter bins, refuse bins, non-metal bins, fibreglass other than for insulation or textile use, games not being toy vehicles, toys and playthings not being toy vehicles, children's playground equipment, swings, slides, climbing frames, playground buildings, bridges and play units incorporating bridges, beams and climbing frames; organisation,* *operation and supervision of loyalty programmes, loyalty card membership schemes and of sales and promotional incentive schemes; advertising, marketing and publicity services.*

Class 37: *Construction, Installation, maintenance and repair services in respect of furniture, street furniture, shelters and storage structures, bicycle racks, children's playground equipment, bollards, gates, fences and barriers, land vehicle storage shelters, land vehicle stands and racks, canopies and walkways, and access and traffic control fixtures and structures.*

Class 42: *Design services; design services in connection with furniture, street furniture, shelters and storage structures, children's playground equipment, bollards, gates, fences and barriers, land vehicle storage shelters, land vehicle stands and racks, canopies and walkways, and access and traffic control fixtures and structures.*