

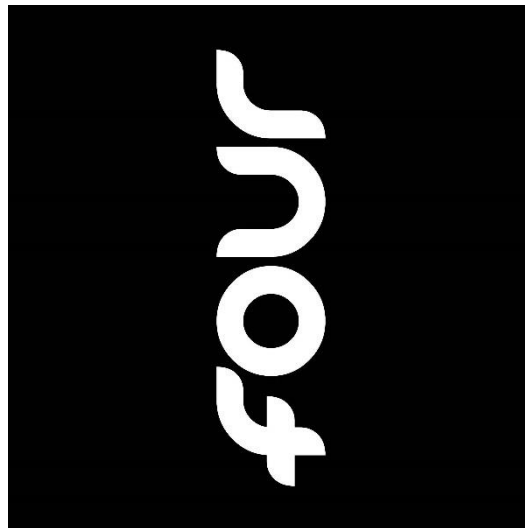
BLO/0416/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003912596

BY INTER REGIONAL PUBLIC RELATIONS LTD

TO REGISTER THE TRADE MARK:



IN CLASSES 35 AND 42

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 442809

BY FOUR AGENCY WORLDWIDE LIMITED

BACKGROUND AND PLEADINGS

1. On 17 May 2023, Inter Regional Public Relations Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 2 June 2023.

2. The applicant seeks registration for the following services under the application:

Class 35 Marketing; Advertising and marketing; Advertising and marketing services; Product marketing; Digital marketing; Advertising, marketing and promotional services; Online marketing; Marketing services; Marketing agency services; Brand creation services (advertising and promotion); Copywriting; Public relations; Public relations agency; Public relations services; Public relations consultancy; Advertising and marketing services provided by means of social media.

Class 42 Graphic design; Design and graphic arts design for the creation of web sites; Design of artwork; Brochure design.

3. The application was opposed in full by Four Agency Worldwide Limited (“the opponent”) on 1 September 2023 based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act (“the Act”).

4. Under sections 5(2)(b) and 5(3) the opponent relies upon the following trade marks:

FOUR

UK registration no. UK00003904703

Filing date 25 April 2023.

Registration date 28 July 2023.

(“The First Earlier Mark”)

four

UK registration no. UK00003904750

Filing date 25 April 2023.

Registration date 28 July 2023.

(“The Second Earlier Mark”)

5. Under section 5(2)(b), the opponent relies upon its class 35 and 42 services for which the earlier marks are registered, which are contained in Annex 1 to this decision. The opponent claims that there is a likelihood of confusion because “the application is near identical to the earlier marks” and the services are identical or highly similar in nature.

6. Under section 5(3), the opponent relies upon the same services contained in Annex 1. The opponent claims that as a result of the longstanding use of its earlier marks, they enjoy extensive goodwill and reputation, and therefore, as the marks share the common, dominant and distinctive **FOUR** element, the “application will create an immediate connection in the mind of the consumer that the services emanate from the same or economically related undertakings”. The opponent also claims that as the parties’ marks are similar, and its services are identical and highly similar in nature, it is likely to cause confusion, and that this would allow the applicant to take unfair advantage of the opponent’s extensive reputation, and that the application “would naturally dilute and lessen the brand allure, which would cause irreparable damage to the opponent’s business”. Moreover, the opponent claims that a link would be made between the two parties which would “create a diversion of trade” and it would also erode the distinctive character of the opponent’s mark, diminishing its attractive force and will “no longer serve to act as a guarantee of high-quality services”.

7. Under section 5(4)(a), the opponent relies upon its **FOUR** sign which it claims to have used throughout the UK since 2001 for the services contained in Annex 1. The opponent also relies upon its **four** sign, which it claims to have used throughout the UK since 2005 for the same services contained in Annex 1.

8. The applicant filed a counterstatement accepting that the parties' marks are similar, however, they did not accept the level of similarity submitted by the opponent. The applicant also accepts that the services applied for are "highly similar" to the opponent's services. Furthermore, the applicant states that the parties marks have co-existed since 2005, and therefore I should take into account the length of honest concurrent use and the absence of actual confusion when assessing a likelihood of confusion. In regard to sections 5(3) and 5(4)(a), the applicant denied all the claims made by the opponent.

9. The opponent is represented by Lewis Silkin LLP and the applicant is represented by Howes Percival LLP. Both parties filed evidence in chief and written submissions during the evidence rounds. The opponent also filed written submissions and evidence in reply. Neither party requested a hearing but the applicant filed submissions in lieu. This decision is taken following a careful perusal of the papers.

RELEVANCE OF EU LAW

10. 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.

EVIDENCE

11. The opponent's evidence includes the witness statement of Einir Williams dated 7 February 2024. Ms Williams is the Group Managing Director and Company Secretary for the opponent and her statement is accompanied by 17 exhibits (EW1-EW17).

12. The applicant's evidence consists of the witness statement of Paul Hutton dated 8 April 2024. Mr Hutton is the Managing Director of the Applicant and his statement is accompanied by Exhibit PH. I note that this evidence has been filed to support the applicant's honest concurrent use defence.

13. The opponent's evidence also includes the second witness statement of Einir Williams dated 10 June 2024, which was filed in reply to the applicant's evidence. Mr Williams' statement is accompanied by Exhibit EW18.

14. I have taken all of the evidence and submissions into consideration in reaching my decision and will refer to them where necessary below.

DECISION

Section 5(2)(b)

15. Section 5(2)(b) reads 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.”

16. The opponent's earlier marks had not completed their registration process more than five years before the relevant date (the filing date of the mark in issue). Accordingly, the use provisions at section 6A of the Act do not apply. The opponent may rely on all of the services it has identified without demonstrating that it has used the marks.

Section 5(2)(b) case law

17. 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 great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

18. Paragraph 12 of the applicant's counterstatement states that *"it is accepted by the applicant that the services applied for are highly similar to those covered by the disputed marks"*. In its written submissions and submissions in lieu, the applicant has not re-addressed this matter, or asked to resile from or qualify its admission.

19. I shall, therefore, proceed on the basis that the applicant concedes that its services are highly similar to the opponent's.

The average consumer and the nature of the purchasing act

20. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which the services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The*

Partnership (Trading) Limited, U Wear Limited, J Fox Limited, [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

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

21. The average consumer for the services will be businesses, however, I do not discount that it could also include members of the general public. The cost of the services in question is likely to vary. The majority of the services will be purchased relatively infrequently. The average consumer will take various factors into consideration such as the cost, type of services offered and the suitability of those services to the consumer’s needs. Therefore, the level of attention paid during the purchasing process will be at least a medium degree.

22. The services are likely to be obtained from advertising, marketing and graphic design undertakings, via their websites or signage on physical premises. Alternatively, the services may be purchased following perusal of advertisements. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase through advice sought from sales assistants or word-of-mouth recommendations.

Comparison of the trade marks

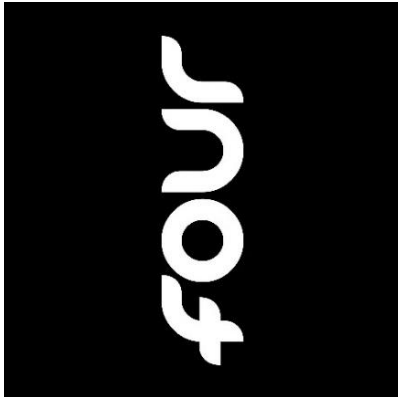
23. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade 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.”

24. 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.

25. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
FOUR (“The First Earlier Mark”) four (“The Second Earlier Mark”)	

Overall Impression

26. The First Earlier Mark consists of the word “FOUR”. There are no other elements to contribute to the overall impression which lies in the word itself.

27. The Second Earlier mark consists of the word “four” presented in a slightly stylised typeface, whereby the “f” is missing part of the horizontal line on the right hand side of the letter. Nonetheless, I find that the word “four” clearly plays a greater role in the overall impression of the mark, with the stylisation playing a lesser role.

28. The applicant’s mark consists of the word “four” presented vertically, in a slightly stylised white typeface, which allows the letter “f” to also be read as the number 4, all of which is presented against a black square background. I find that the word “four” plays a greater role in the overall impression of the mark, with the stylisation, the orientation and background playing lesser roles.

Visual Comparison

The First Earlier Mark and the applicant’s mark

29. Visually, both marks consists of the word “four”. This acts as a visual point of similarity. While the First Earlier Mark is presented in upper-case and the applicant’s mark is presented in lower-case, the First Earlier Mark is a word mark and therefore it is protected for use in any standard typeface and this extends to either upper or lower-case letters. As such, the use of different cases is of no impact to the visual comparison.

30. I bear in mind that in the applicant’s counterstatement, they accepted that the parties’ marks are similar, however, they did not accept the level of similarity submitted by the opponent, which was that the marks are “near identical”. This was on the basis that the vertical positioning of the word “four” in its mark is “visually a distinctive difference”. Moreover, the applicant states that due to the stylisation and vertical positioning, the letter “f” in its mark “also reads as the number 4 [...] and this would be the first element identified by anyone viewing the respective marks”.

31. Whilst the vertical positioning and black background in the applicant’s mark act as visual points of difference, I disagree that the number 4 would be the first element identified by the average consumer. I bear in mind that the average consumer normally

perceives a mark as a whole and does not proceed to analyse its various details.¹ I therefore find that the average consumer will read the word “four” as a whole (as the letter F precedes the letters O, U and R), before they notice that the letter “f” also acts as the number 4 as well. Regardless, I find that this element contributes as a visual point of difference, albeit not significantly.

32. I also bear in mind that in the applicant’s counterstatement, at paragraph 11, they state that:

“whilst it is accepted that there is a high degree of visual and conceptual similarity, as the application is a figurative mark the key is the visual comparison where there are key differences which mean, when assessed by reference to the overall impression, the application is not highly similar to the disputed marks.”

33. This is supported by its written submissions which also state that “when assessed by reference to the overall impression the application is not highly similar to the disputed marks”. Therefore, based on the above submissions, I find that the applicant is accepting that the shared use of the word “four” creates a high degree of visual similarity between the marks, but that due to its “key differences”, such as the presentation of the word “four” vertically on the black background, and the number “4” element, that this results in the marks not being highly similar overall. Whilst I agree that these elements do create visual points of difference, I still find that due to the shared use of the word “four” that these marks are visually similar to a high degree.

The Second Earlier Mark and the applicant’s mark

34. I consider that the same comparison applies in paragraphs 29 to 33 above. However, I note that the Second Earlier Mark also appears in a slightly stylised typeface. Nonetheless, I still find that the applicant’s mark and the Second Earlier Mark are visually similar to a high degree.

¹ *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97

Aural Comparison

The First Earlier Mark and the applicant's mark

35. Aurally, the black background will not be articulated in the applicant's mark. I also find that the vertical orientation and slightly stylised presentation of the word "four" in the applicant's mark will not affect its pronunciation, which includes the stylisation that allows the letter "f" to also be read as the number 4. I do not consider that the number 4 will be articulated again after reading the word "FOUR" in the applicant's mark (which would make the mark FOUR-FOUR). Instead, I consider that the average consumer will just see the number "4" as reinforcing the word "four". On this basis, I find that both marks will be pronounced as "four", making them aurally identical.

The Second Earlier Mark and the applicant's mark

36. I bear in mind that the stylisation of the Second Earlier Mark will not affect its pronunciation. I therefore consider that the same comparison applies in paragraph 35 above. The marks are aurally identical.

Conceptual Comparison

The First Earlier Mark and the applicant's mark

37. Both marks consist of the word "four", and therefore they evoke this concept. The stylisation of the letter "f" in the applicant's mark, which allows it to also be read as the number 4 reinforces the concept. Moreover, at paragraph 11 of its counterstatement, the applicant accepts that there is a high degree of conceptual similarity between all of the marks. I therefore do not need to address this issue any further.

The Second Earlier Mark and the applicant's mark

38. Whilst I find that stylisation of the Second Earlier Mark does not contribute to the conceptual meaning of it, as noted in paragraph 37 above, the applicant accepts that there is a high degree of conceptual similarity between all of the marks.

Distinctive character of the earlier trade marks

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

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

40. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

41. I will begin by assessing the inherent distinctive character of the First and Second Earlier Marks. As noted above, the marks consist of the word “FOUR”. I find that this number is neither descriptive or allusive of its services. Moreover, the slight stylisation

of this word within the Second Earlier Mark does not materially increase its distinctiveness. Therefore, the First and Second Earlier Marks are inherently distinctive to no more than a medium degree.

42. I will now assess whether the evidence filed by the opponent is sufficient to demonstrate that the earlier marks had an enhanced degree of distinctiveness at the relevant date of 17 May 2023. The relevant market for assessing this is the UK market.

43. Ms Williams describes the opponent as a leading global media, marketing and communications agency, which has been trading under its FOUR signs since 2001. The opponent is a part of a group of companies incorporated on 28 April 2004, and is a parent company of several subsidiaries (each part of the Four Group).

44. Ms Williams confirms that in the year ending 31 December 2022, the opponent and its group achieved a turnover of £71,995,896. This is supported by **Exhibit EW5** which contains the opponents annual report and financial statement for that year, confirming this turnover was achieved. The report also comments on the “Group’s adopted strategy” which was to “continue to offer an integrated communications service to clients consisting of services in digital services and content creation, media planning & buying, strategy & insight, advertising, creative and branding, event management, public relations and public affairs”.

45. Ms Williams also provides its 2004 annual turnover which was £71,991 and its annual profit, which was £30,969,² as well as the following turnover table, the figures of which were extracted from the opponent’s accounts filed at Companies House for 2005 to 2008, exhibited in **EW7**:

Year	Annual Turnover	Annual Profit
2005	£11,983,720	£77,174
2006	£16,225,081	£665,489
2007	£21,752,236	£809,666
2008	£19,024,467	£1,016,924

² Exhibit EW18

46. To support the above, Ms Williams has provided Wayback Machine screenshots from its fourcommunications.com website dated 2 December 2005 to 27 September 2010 in **Exhibit EW8**. The 2005 to 2007 examples show use of the opponent's Second Earlier Mark on its website, but does not provide any further information on the opponent. The 2010 screenshots show that the opponent introduces itself as an "international communications" agency which has "expert teams in public relations, politics, design, branding, advertising, media planning and buying, sports and arts sponsorship and the full range of digital communications". It also confirms that the opponent has 140 employees, with offices in Liverpool, Abu Dhabi and Dubai. Furthermore, a screenshot of the opponent's new website www.four.agency is provided, however, this is dated after the relevant date (7 February 2024). Regardless, I find that this evidence is of little assistance as it is not necessarily reflective of an actual level of use in the UK, because, for example, this is not supported by the number of UK visitors that have been exposed to, or used, the opponent's website.

47. **Exhibit EW9** contains a report on the opponent's social media, which includes how many followers their platforms have. However, this is dated 6 February 2024, which falls after the relevant date. **Exhibits EW10 to EW13** also contain screenshots of the opponent's social media accounts dated 5 February 2024, which, again, falls after the relevant date. Moreover, and as noted by Ms Williams, "social media networks are accessible to millions of people around the world", and the report and screenshots provided do not comment on what proportion of its followers pertained to the UK. Therefore I am unable to determine the opponent's social media reach in the UK only.

48. Alongside advertising itself on social media, the opponent uses promotional material including brochures, invitations and newsletters, which Ms Williams' confirms is shown within **Exhibit EW14**. In particular, she states that this exhibit shows a newsletter which was circulated to the opponent's clients in 2006, an invitation to "the annual Four Summer Party" on 8 June 2006 and a page from a client brochure dated 2005. I can confirm that the opponent's FOUR marks are used on these materials, however, I have not been provided with any information as to how many people or clients in the UK would have been exposed to, or received, these advertisements.

49. I have also been provided with press articles exhibited in **EW15** and **EW16**. I note that a Campaign article dated 14 December 2005 comments on how the opponent added “£1.55m in new business to reach a fee income of £4.55m, a raise of 55% from clients including Barclaycard, Granada Ventures (notably the licencing of Little Britian merchandise) and Sony Computer Entertainment Europe”. It also mentions a merger with “Gritti Partnership” which means that “Four now pitches itself as a mini-marketing services group”. Moreover, it lists the following projects that the opponent has worked on, being its “ongoing work to establish chip and PIN” and that “two years after the campaign started there is now 97% awareness of its existence”. Four also “ran another campaign for APACS [...] to increase consumer awareness of how to responsibly use credit cards, and organised a campaign to publicise the English Cricket Board’s grassroots work ahead of the Ashes”.

50. The other Campaign articles contained within **Exhibit EW15** are dated between 19 May 2004 and 19 December 2007, which rank different public relation consultancies. I note the following from them:

- a) In 2004, the opponent was listed at number 3 for the “TOP 10 FOR GROWTH-SMALL AGENCIES”.
- b) In 2005, the opponent was listed at 22 (out of 85) for the “TOP PR AGENCIES” and confirms they are based in London.
- c) In 2007, the opponent was number 14 for the “TOP PR AGENCIES”, and number 2 in the “TOP 5 FOR GROWTH- BIG AGENCIES”.

51. Lastly, the articles from prweek.com contained in **Exhibit EW16** contains the following information:

- 1. The article dated 21 May 2004 comments on the opponent partnering with “Gritti”, which is a marketing and brand consultancy company.
- 2. The article dated 15 July 2005 talks about how “Four Gritti Healthcare” was launched in March.
- 3. The article dated 20 October 2010 talks about inspiring and up-coming talent in the PR industry, listing Mr Alexander as the Account Director for Four, who works on clients such as APACS and Energy Retail Association.

52. I find that the opponent's above evidence encounters multiple deficiencies. Whilst I have been provided with notable turnover and profit figures for the years 2004 to 2008, and a significant turnover figure for 2022, I do not have any turnover figures for the years 2008 to 2021. Moreover, the opponent had not provided any other alternative evidence showing the use of its mark on its services during the years 2008 to 2021. This results in there being a sufficient gap in the opponent's evidence.

53. Moreover, whilst paragraph 4 of Ms William's witness statement states that the purpose of it is to set out in detail the history and use of its marks, "specifically the use *in the UK* including facts and figures and annexed materials" from its company records, the financial statements provided in **Exhibit EW7** include references to its offices in Dubai and Bahrain, for example, as follows:

In addition, our new Dubai office, headed by David Baker, opened formally in January, offering public relations in the United Arab Emirates and across the Gulf. In September, we opened an office in Bahrain, managed by Ray Eglington, serving our initial clients Gulf Air and the Bahrain Economic Development Board.

Together, these new units added more than £700,000 in gross profit in 2005. Losses were in line with our expectations, given the heavy first-year investments in senior staff and new practices and offices. Each new unit finished the year positioned strongly to contribute to group profits in 2006.

The practices in the Middle East – in Dubai and Bahrain - grew during the year and the offices worked for important clients including Sony PlayStation, Rolls Royce, IATA and the Bahrain Economic Development Board. The region accounted for some ten per cent of all Group income during the year and reinforced the strategic decision to position the Group as having a two-region focus (UK and the Gulf).

Finally, our investments in the UAE, in particular in our new office in Abu Dhabi, which opened in summer 2007, delivered immediate and growing returns. We won prestigious new clients in Abu Dhabi during the year including Abu Dhabi Finance, Abu Dhabi Music & Arts Foundation, Sorouh Real Estate, Abu Dhabi Airports Company, the Abu Dhabi Urban Planning Council, Royal Falcon and Abu Dhabi Ports Company, adding to our first client Etihad Airways, won in 2007.

These clients, coupled with our diversified client base in Dubai, helped the UAE offices to deliver more than £1.75 million of gross profit to the Group, 17 per cent of our total. In the early months of 2009, this share has grown to more than 23 per cent. The unit also delivered healthy operating profits and looks set to continue this contribution during 2009.

54. I also bear in mind that financial statements filed at Companies House, like those contained in **Exhibit EW7**, do not just relate to activity in the UK. They will encompass all of the company's financial activities including the turnover generated within and outside of the UK. The above is also supported by the website screenshot evidence which confirms that the opponent has offices in Abu Dhabi and Dubai. Therefore,

taking the above into account, I find it reasonable to assume that the turnover figures provided by the opponent does not pertain to the UK only. In light of the above, I am of the view that the evidence provided regarding the opponent's revenue is insufficiently solid as I am unable to determine what proportion pertains to the UK.

55. Furthermore, whilst Ms Williams explicitly states that the opponent has been using its FOUR signs since 2001, I bear in mind that it is a parent company of several subsidiaries, and it is not clarified within any of the opponent's witness statements whether the subsidiaries have been using the FOUR marks (and doing so with the permission of the opponent). The subsidiaries have been referred to in the **Exhibit EW7** financial statements, and in the December 2006, 2007, and 2008 accounts, it specifically states that "the consolidated accounts incorporate the accounts of the company and *all group undertakings*". On this basis, it is highly reasonable to infer that the subsidiaries' turnover is included within these accounts. However, I have no confirmation that this turnover was generated using the FOUR marks,³ nor I been provided with a breakdown of its turnover via the opponent and its subsidiary companies which would allow me to determine which turnover was made under the opponent's marks. Again, this reinforces that the revenue evidence is insufficiently solid as I am not only unable to determine what proportion pertains to the UK, but I am also unable to determine what proportion was generated under the FOUR marks.

56. While the article evidence confirms that the opponent provides public relation services, and includes some of the names of its clients and the projects it has worked on in 2005, I have not been provided with any examples of these projects, or any other projects, evidencing the opponent's work that has been commissioned by its clients in the years 2004 and 2008 to 2023. Furthermore, I have not been provided with the number of clients, or an extensive list of client names, that they have had since 2004. As noted in paragraph 44 above, in its financial reports, the opponent lists multiple types of services that it offers, but the turnover provided in the financial reports and

³ Where the financial reports refers to Four Communications Plc and Four Gritti Communications, these names are listed within both of Ms Williams statements as being the former names used by the opponent. Therefore it can be assumed that the turnover generated by these companies were likely to be under the FOUR marks. However, the company names Gritti Partnership, Four Marketing & Media Plc, Electric Advertising Limited and Synapse Communication Limited are not referred to within Ms Williams statements. I am therefore unable to infer or conclude that the turnover generated by these companies were via the use of the FOUR marks.

the turnover table above only provides a singular turnover figure per year. Consequently, I have not been provided with a breakdown of the opponent's turnover via its services, some of which I find are sufficiently different to one another, for example, public relations services are different in nature and purpose to event management services. I am therefore unable to determine what amount of the turnover was generated in connection with its different services.⁴ More importantly, I have not been provided with any supporting invoice evidence showing what types of services the opponent has sold since 2004, or showing the geographical spread of the marks, and its clients, across the UK. Lastly, I have not been provided with any advertising figures, nor have I been provided with any evidence of the opponent's UK market share.

57. Therefore, taking all of the above into account, I do not consider the evidence sufficient to establish enhanced distinctiveness for the opponent's First and Second Earlier Marks.

Evidence of actual confusion and honest concurrent use

58. In her witness statement, Ms Williams' confirms that once the opponent became aware of the applicant around August 2022, colleagues were asked to "monitor for any confusion evidence that might" occur between the parties. The opponent also monitored for "confusion evidence more diligently" once the applicant had applied for their mark. However, the 3 examples of confusion that Ms William's provides in her witness statement all fall after the relevant date (22 June 2023, 22 July 2023 and 5 January 2024) and thus I will not be placing any weight on them in my global assessment.

59. Conversely, Mr Hutton states that the parties have been co-existing for a long time *without* any dispute or conflict, and that he has not come across any confusion between the brands. Alongside his witness statement, he has provided the following evidence in **Exhibit PH** showing the applicant's use of its mark:

⁴ A turnover which I am unable to determine what proportion pertains to the UK and what proportion was generated under the FOUR marks.

- a) In 2008, the applicant chose to rebrand, and change its name to FOUR. This is supported by a newspaper article from the Eastern Daily Press dated 1 November 2008. This states that the applicant is a creative marketing agency based in Norwich which offers agency marketing, design, advertising and PR. The photo included within this article clearly shows the applied for mark, and a booklet, which Mr Hutton provides a separate photo of (albeit I cannot read the contents of it).
- b) A photo of a fouragency.co.uk domain info printout which shows it was registered on 7 November 2008.
- c) Wayback Machine screenshots of this website dated between 21 July 2009 and 5 July 2022. It clearly lists that they provide marketing, brand consultancy, advertising and public relation services, and shows some of their clients who they have worked with (such as North Norfolk District Council and Hoseasons). The website also clearly uses the applied for mark.
- d) Screenshots of the applicant's social media pages (Instagram, X and Facebook), however, they are all undated.
- e) A photo of the front cover of two client pitch documents dated January and February 2010, which clearly uses the applicant's mark. Mr Hutton also provides photos of some portfolio files which show examples of their campaigns they have done (including with the IWM and Hoseasons), albeit no dates or further information of the projects are provided alongside this.
- f) Photos of the applicant's Four business cards, including the old Director Scott Rozier's cards, who held this position from 2010 to 2023.
- g) Mr Hutton also clarifies that he was not aware of the opponent's alleged use of the brand "FOUR", but that as he understood, the opponent had been trading as "FOUR COMMUNICATIONS" until their rebrand in 2023, which is supported by an article from prweek.com contained within this exhibit.

60. I appreciate that in proceedings before the Tribunal, such evidence is capable of being used to support a defence that there has been honest concurrent use of the marks at issue and, as a result, any likelihood of confusion may be diminished. However, taking all of the parties' evidence above into account, I do not consider that the exceptional circumstances outlined in *Budejovicky Budvar NP v Anheuser-Busch Inc*,⁵ and those factors in *Victoria Plum Ltd v Victorian Plumbing Ltd*⁶ are present in the case before me. I also note that in *Budejovicky Budvar*, paragraph 82 makes reference to the "long period of honest concurrent use between the marks", and in *Match Group, LLC & Ors v Muzmatch Ltd & Anor*⁷ Arnold LJ held use which was initially infringing could eventually cease to be infringing if the trade mark proprietor took no action, there was substantial parallel trade for a long period, and as a result the trade marks came to be understood by the relevant class of consumers as denoting the goods/services of more than one trader.

61. I appreciate that the parties have clearly operated in comparable markets, providing marketing and public relation services. I also appreciate that the evidence shows that the parties started trading under their marks in 2004 and 2008, which I consider could amount to longstanding use of the marks. However, I do not have any evidence of the opponent's activity between 2008 to 2021 (which is a sufficient gap in the opponent's evidence). I also do not have physical examples of the opponent's work that they have provided since 2004, and the applicant has not provided me with any sales or marketing figures. I therefore find that the evidence provided by the parties is not demonstrative of longstanding use as it is not sufficiently solid in showing that they have been trading side by side consistently since 2008. From the evidence provided, I cannot reasonably conclude that consumers would have seen both marks on the market between 2008 to 2021. Additionally, there is no evidence that demonstrates that the marks at issue ever came into conflict during this time. For example, I have not been provided with evidence that the services of the parties were made available to consumers via the same trade channels to give rise to circumstances where they would be viewed alongside each other. The evidence is, therefore, of no

⁵ Case C-482/09, EU:C:2011:605

⁶ [2016] EWHC 2911

⁷ [2023] EWCA Civ 454 at [115] to [117]

assistance in giving rise to a defence honest concurrent use. As a result, the applicant's reliance upon this defence is dismissed.

Likelihood of confusion

62. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

63. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found all of the marks to be visually similar to a high degree.
- I have found all of the marks to be aurally identical.
- The applicant conceded that the marks are conceptually similar to a high degree.
- I have found the earlier mark to be inherently distinctive to no more than a medium degree.
- I have identified the average consumer as businesses and members of the general public, who will select the services primarily by visual means, although I do not discount an aural component.

- I have concluded that at least a medium degree of attention will be paid during the purchasing process.
- The applicant conceded that its services are highly similar to the opponent's.

64. Taking all of the above into account, considering the principle of imperfect recollection, and bearing in mind that all of the marks consist of the word "FOUR", (which plays the greater role in the overall impression of the Second Earlier Mark and the applicant's mark), I consider that there is a likelihood of direct confusion. Whilst the word "FOUR" is presented in a vertical orientation, in a slightly stylised font which allows the letter "f" to also be read as the number "4" in the applicant's mark, this would be easily overlooked or misremembered, especially as it plays a lesser role in the overall impression. I also find that the slightly stylised typeface would also be easily overlooked in the opponent's Second Earlier Mark. Furthermore, given that the average consumer rarely has the opportunity to compare marks side-by-side and will instead encounter them in different settings at different times, to my mind, the high degree of visual similarity between the marks will lead the average consumer to mistake one mark for the other, especially as the purchasing process is predominantly visual. Even where aural considerations apply, the identical pronunciation of the marks will have the same result. I also note that all of the marks evoke the concept of the number 4, meaning there is no conceptual hook to differentiate them. Consequently, I find that there is a likelihood of direct confusion.

65. I will also assess if there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C. sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10:

"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.”

66. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

67. I consider that the shared common use of the word FOUR in the parties’ marks will lead the average consumer to conclude that they originate from the same or economically linked undertakings. Whilst this word is presented in a vertical orientation and in a slightly stylised typeface which allows the letter “f” to also be read as the number “4” in the applicant’s mark, the average consumer would perceive this stylisation as being an updated presentation of the opponent’s First and Second Earlier Marks. I also consider that it is not uncommon for undertakings to re-brand themselves from time to time to accommodate changes in marketing considerations. Consequently, I find there to be a likelihood of indirect confusion.

68. The opposition based upon section 5(2)(b) succeeds.

Section 5(3)

69. Section 5(3) of the Act states:

“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.”

70. Section 5(3A) of the Act states:

“Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

71. 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, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. 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; *General 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 and *Environmental Manufacturing*, paragraph 34.

(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*).

72. The conditions of section 5(3) are cumulative. Firstly, the opponent's and applicant's marks must be identical or similar. Secondly, the opponent must show that its earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must have 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 opponent's marks being brought to mind by the later mark. Fourthly, assuming that the first, second and third conditions have been met, section 5(3) requires that one or more types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the 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 relevant date for the assessment under section 5(3) is the date of application of the applicant's mark i.e. 17 May 2023.

Reputation

73. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence

of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

74. 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."

75. I can deal with this ground relatively swiftly.

76. Earlier in my decision, I found that the distinctive character of the opponent's First and Second Earlier Marks had not been enhanced through use. I recognise that reputation is not the same as enhanced distinctive character, but the same factors are to be taken into account in both assessments. I do not intend to repeat my reasons in full here but will, instead, simply reiterate that whilst I have been provided with notable turnover figures for the years 2004 to 2008, and a significant turnover figure for 2022, I do not have any turnover figures for the years 2008 to 2021. Moreover, the opponent has not provided any alternative evidence showing the use of its marks on its services during the years 2008 to 2021, which results in there being a sufficient gap in the opponent's evidence. Furthermore, the turnover evidence is insufficiently solid as I am unable to determine what proportion of the sales relate to the UK, or were generated under the FOUR marks. While the article evidence confirms that the opponent provides public relation services, and includes some of the names of its clients and the projects it has worked on in 2005, I have not been provided with any physical examples of these projects, or any other projects, evidencing the opponent's work that has been commissioned by its clients. I have also not been provided with any supporting invoice evidence demonstrating the sale of its services, I have not been provided with a breakdown of its turnover by its services, nor have I been provided with any evidence of the opponent's marketing spend or its market share. Therefore, the evidence is, for the reasons set out above, insufficient to establish a reputation in the UK. On this basis, without having found a reputation, the opposition based upon section 5(3) fails.

Section 5(4)(a)

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

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

aa)...

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”.

78. Subsection (4A) of section 5 of the Act states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

79. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. 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 all three limbs.

56. 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)."

Relevant date

80. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of section 5(4)(a) of the Act and stated as follows:

"43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows: '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.'"

81. The prima facie relevant date is the date of application in issue i.e. 17 May 2023.

82. However, it is also necessary to consider what the position would have been at the start of the behaviour complained about. In this case, that will be the date of the first public facing use of the applicant's mark, which appears to have been the Eastern Daily Press newspaper article dated 1 November 2008, which details the applicant's rebrand of its name to FOUR.

83. In *CASABLANCA*, BL O/349/16, Mr Thomas Mitcheson Q.C. as the Appointed Person stated that:

“34. [...] The question raised by the Opponent is whether she did so correctly and how should the earlier use be taken into account. In particular, does such use, as the Opponent submitted, have to be sufficient to generate its own goodwill?”

35. I think it is clear from the remainder of §165 of the judgment of Kitchin LJ that generation of goodwill by the applicant is not required. This is because he goes on to explain that it is the opponent who must show that he had the necessary goodwill and reputation to render that use actionable on the date that it (i.e. the applicant’s use) began.”

84. This case makes it clear that it is not necessary for the applicant to have actually acquired goodwill in order for there to be an earlier relevant date.

85. As a result of the above and bearing in mind the comments of Mr Alexander Q.C. in the case of *Advanced Perimeter Systems* (cited above), I will proceed to consider the position in respect of goodwill on 1 November 2008 (“the earlier relevant date”). In the event that goodwill exists, I will proceed to consider whether the position as at the filing date of the applicant’s mark, being 17 May 2023 (“the later relevant date”), was any different. However, in the event that no goodwill existed as at the earlier relevant date, the opponent’s claim will fail.

Goodwill

86. 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.”

87. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a *prima facie* case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; 54 evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the *prima facie* case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

88. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in

every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application."

89. Goodwill arises as a result of trading activities, and it is clear from the turnover figures provided by Ms Williams that the opponent has been trading under the FOUR signs since 2004. However, these figures are not broken down via territory, and thus, I am unable to determine what proportion of these sales relate to the UK. I am also unable to determine what proportion of its sales were generated under the FOUR signs, and I note that the figures are not broken down via the opponent's services. Whilst the article evidence confirms that the opponent provides public relation services, I have not been provided with any invoice evidence, for example, to show what types of public relation services, or their other services, have been sold to their UK consumers since 2004. I am, therefore, unable to determine the geographical spread of its marks and its clients across the UK. Furthermore, I have not been provided with any examples of the opponent's work provided to their clients from 2004 to 2023. As such, I consider the opponent's evidence of trading activities to be vague and imprecise and incapable of leading to a finding that the opponent enjoyed any protectable goodwill in its business in the UK at the first relevant date. Therefore the opponent's reliance upon 5(4)(a) of the Act fails as, without goodwill, there can be no misrepresentation or damage.

CONCLUSION

90. The opposition is successful under section 5(2)(b) and the application is refused in its entirety.

COSTS

91. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the opponent the sum of £1,500 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Filing a Notice of opposition and considering the applicant's counterstatement	£250
Preparing and filing evidence	£700
Preparing and filling submissions	£350
Official Fee	£200
Total	£1,500

92. I therefore order Inter Regional Public Relations Ltd to pay Four Agency Worldwide Limited the sum of £1,500. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 9th day of May 2025

L FAYTER
For the Registrar

ANNEX 1

The First Earlier Mark

Class 35

Advertising, marketing, promotional and public relations services; advertising, promotional, public relations and marketing communications services; reputation management services; interactive and non-interactive marketing; online and internet advertising, promotion and marketing services; virtual marketing, promotion and advertising services and campaigns; creation of advertising campaigns; PPC (Pay Per Click) advertising; online and internet advertising, promotion and marketing services; internet keyword marketing services; SEM (Search Engine Marketing); copywriting; creation of advertisements, commercial sponsorship; business trend analysis services; communications services for public relations purposes; business introduction services; creating press releases; planning, organising and managing marketing, advertising and promotional events; business management assistance and consultancy services; business administration; office functions; dissemination of advertising, marketing, endorsement, promotion, public relations and publicity materials; market research and market analysis; consumer research, consumer demographic analysis; creation, organisation, administration and consultancy and advisory services relating to consumer loyalty programs; consultancy and advisory services relating to consumer loyalty; business and brand survey, statistics, analysis and reporting services; business auditing; brand auditing for businesses; marketing, advertising and consultancy services in relation to brand strategies, brand relationships, customer relationship marketing, loyalty marketing and consumer targeting; segmentation and profiling of market data; trend analysis services for advertising and marketing purposes; production of video recordings, audiovisual recordings, and digital video and audiovisual recordings for advertising purposes, marketing purposes, publicity purposes, promotional purposes, public relations purposes; monitoring of brand value and reputation; brand name, trade names and trademark development and creation services; creation, screening, testing and evaluation of proposed brand names and trade marks; brand positioning; brand strategy, brand usage monitoring, brand identity, brand communications and research; brand placement services; information about branding provided via online blogs; corporate identity services; organisation of exhibitions and events for commercial,

advertising or marketing purposes; business exhibitions; trade shows; compilation of information into computer databases; database management; data processing; opinion polling; public opinion surveys; design of advertising logos; design of advertising material; design of advertising matter; preparation of reports relating to branding, brand usage monitoring, namely, identifying and checking the position and use of brands in the market place; brand identity, namely, formulation and development of a brand's name, visual appearance, concept and values; brand communications, namely, the promotion and advertising of brands; brand research, namely, qualitative and quantitative research of data relating to brands; advertising and marketing; provision of information, advisory and consultancy services relating to the aforesaid services.

Class 42

Design services; computer services; product design and development; editing services for computer programs; art work design; industrial design services; design of packaging; styling agencies (industrial design); graphic arts designing; interior design services; fashion design; architectural services; research and development of new products for others (product development); development of computer systems in the field of graphic arts; design (creation) and development of market research tools; creation of virtual and interactive images; software design and development, computer programming services, hosting of computer sites (web sites); design and development of computer software; updating and maintenance of computer software; installation of computer software and computer programs; development of systems for the storage of data; rental of computer software; services of an application service provider, namely, installation, electronic storage, rental, and maintenance of application software that allows users to play and program music and entertainment-related audio, video, text and other multimedia content; computerised data storage services; search engine services; hosting, developing, managing and maintaining non-downloadable software for consultancy and management purposes; software-as-service and provision of online platforms for tracking, monitoring and reporting on media, press, social media, trends, popularity and reputation; website design services; software-as-service services for advertising, marketing, promotional, public relations purposes; hosting of digital content, namely on-line journals, forums and blogs; designing online journals, forums and blogs for discussion; managing and monitoring online journals,

forums and blogs for discussion (computer services); information, advisory and consultancy services for all the aforesaid services.

Second Earlier Mark

Class 35

Advertising, marketing, promotional and public relations services; advertising, promotional, public relations and marketing communications services; reputation management services; interactive and non-interactive marketing; online and internet advertising, promotion and marketing services; virtual marketing, promotion and advertising services and campaigns; creation of advertising campaigns; PPC (Pay Per Click) advertising; online and internet advertising, promotion and marketing services; internet keyword marketing services; SEM (Search Engine Marketing); copywriting; creation of advertisements, commercial sponsorship; business trend analysis services; communications services for public relations purposes; business introduction services; creating press releases; planning, organising and managing marketing, advertising and promotional events; business management assistance and consultancy services; business administration; office functions; dissemination of advertising, marketing, endorsement, promotion, public relations and publicity materials; market research and market analysis; consumer research, consumer demographic analysis; creation, organisation, administration and consultancy and advisory services relating to consumer loyalty programs; consultancy and advisory services relating to consumer loyalty; business and brand survey, statistics, analysis and reporting services; business auditing; brand auditing for businesses; marketing, advertising and consultancy services in relation to brand strategies, brand relationships, customer relationship marketing, loyalty marketing and consumer targeting; segmentation and profiling of market data; trend analysis services for advertising and marketing purposes; production of video recordings, audiovisual recordings, and digital video and audiovisual recordings for advertising purposes, marketing purposes, publicity purposes, promotional purposes, public relations purposes; monitoring of brand value and reputation; brand name, trade names and trademark development and creation services; creation, screening, testing and evaluation of proposed brand names and trade marks; brand positioning; brand strategy, brand usage monitoring, brand identity, brand communications and research; brand placement services; providing branding information via an online blog;

corporate identity services; organisation of exhibitions and events for commercial, advertising or marketing purposes; business exhibitions; trade shows; compilation of information into computer databases; database management; data processing; opinion polling; public opinion surveys; design of advertising logos; design of advertising material; design of advertising matter; preparation of reports relating to branding, brand usage monitoring, namely, identifying and checking the position and use of brands in the market place; brand identity, namely, formulation and development of a brand's name, visual appearance, concept and values; brand communications, namely, the promotion and advertising of brands; brand research, namely, qualitative and quantitative research of data relating to brands; advertising and marketing; provision of information, advisory and consultancy services relating to the aforesaid services.

Class 42

Design services; computer services; product design and development; editing services for computer programs; art work design; industrial design services; design of packaging; styling agencies (industrial design); graphic arts designing; interior design services; fashion design; architectural services; research and development of new products for others (product development); development of computer systems in the field of graphic arts; design (creation) and development of market research tools; creation of virtual and interactive images; software design and development, computer programming services, hosting of computer sites (web sites); design and development of computer software; updating and maintenance of computer software; installation of computer software and computer programs; development of systems for the storage of data; rental of computer software; services of an application service provider, namely, installation, electronic storage, rental, and maintenance of application software that allows users to play and program music and entertainment-related audio, video, text and other multimedia content; computerised data storage services; search engine services; hosting, developing, managing and maintaining non-downloadable software for consultancy and management purposes; software-as-service and provision of online platforms for tracking, monitoring and reporting on media, press, social media, trends, popularity and reputation; website design services; software-as-service services for advertising, marketing, promotional, public relations purposes; hosting of digital content, namely on-line journals, forums and blogs; designing online

journals, forums and blogs for discussion; managing and monitoring online journals, forums and blogs for discussion (computer services); information, advisory and consultancy services for all the aforesaid services.