

**O/0666/25**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NO. UK00003673198**

**IN THE NAME OF HOTPATCH LIMITED**

**FOR THE FOLLOWING TRADE MARK:**

**PATCH**

**IN CLASSES 9, 35,42 & 43**

**AND**

**AN APPLICATION FOR A DECLARATION OF INVALIDITY**

**UNDER NO. 505863**

**BY PATCH PLACES LTD**

## BACKGROUND AND PLEADINGS

1. Hotpatch Limited (“the proprietor”) is the proprietor of the trade mark on the cover page of this decision. The proprietor’s mark was filed on 26 July 2021 and entered into the register on 17 September 2021. It stands registered for the following goods and services:

**Class 9:** *Software application that facilitates the provision of information, peer-to-peer interaction and transactions, and the booking of temporary workspaces; software platform that facilitates the provision of information, peer-to-peer interaction and transactions, and the booking of temporary workspaces; downloadable software applications that facilitates the provision of information, peer-to-peer interaction and transactions, and the booking of temporary workspaces; None of the aforementioned goods being temporary solutions for dealing with broken software and/or viruses.*

**Class 35:** *Provision of ratings, reviews and recommendations for commercial purposes posted by users via a website; Provision of ratings, reviews and recommendations of workspaces for commercial purposes posted by users via a website; providing online business directories; providing online business directories featuring workspaces.*

**Class 42:** *Providing a web site featuring the ratings, reviews and recommendations for commercial purposes posted by users; providing a web site featuring the ratings, reviews and recommendations of workspaces for commercial purposes posted by users.*

**Class 43:** *Rental of workspaces; rental of meeting rooms and offices; rental of workshops; rental of temporary workspaces, salons and offices.*

2. On 28 February 2023, Patch Places Ltd (“the cancellation applicant”) applied to have the contested mark declared invalid under section 47 of the Trade Marks

Act 1994 (“the Act”). The invalidity is based on section 5(2)(a) of the Act and is directed at the proprietor’s mark in its entirety.

3. The cancellation applicant relies on the following mark:

## Patch

UKTM 3613716; date of entry in register 21 March 2021. <sup>1</sup>

Following a successful opposition, it can rely on the following services:

**Class 37:** *Office machine maintenance; Cleaning of offices; Office machine repair; Office equipment maintenance; Office cleaning services; Office equipment installation; Office machine installation; Building of offices; Repair of office machinery; Repair of office machines; Contract cleaning of offices; Interior fitting-out of offices; Contract cleaning of clubs.*

**Class 41:** *Entertainment club services; Health club services; Club education services; Club entertainment services; Club services [entertainment or education]; Provision of sporting club facilities; Provision of club entertainment services; Club recreation facilities (Provision of -); Social club services for entertainment purposes; Country clubs providing sporting facilities; Club sporting facilities (Provision of -); Providing health club and gymnasium services; of entertainment halls.*

**Class 42:** *Office furniture design; Planning [design] of offices; Office layout design services; Design of office space; Design of layouts for offices.*

4. The cancellation applicant submits that there is a likelihood of confusion because the marks are identical to its own mark and the respective goods and services

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<sup>1</sup> The cancellation applicant’s 3613716 was subject to opposition proceedings. The outcome of these proceedings was published on 13 December 2023 in BL O/117/23. The proceedings were against some of the cancellation applicant’s services in classes 35,36 and 41. The opposition succeeded in its entirety, and accordingly, those services subject to opposition were refused; however, the registration proceeded for classes 37, 41 and 42, which did not form part of the proceedings. These are the services that can be relied upon in the invalidity action.

are similar. The proprietor filed a defence and counterstatement admitting the identity of the marks and denying the similarity of the goods and services.

5. Neither party filed evidence. No evidence in reply was filed, however, the proprietor filed written submissions dated 23 September 2024. The cancellation applicant filed submissions in lieu of a hearing. The cancellation applicant is represented by Swindell & Pearson Limited. The proprietor is represented by Withers & Rogers LLP. I do not intend to summarise the submissions at this stage, but will refer to them, where necessary, throughout the decision; however, I have taken them all into consideration in reaching my decision.

6. 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.

## **DECISION**

7. Section 5(2)(a) of the Act has application in invalidation proceedings because of the provisions of section 47 of the Act, which states as follows:

“47. (1) [...]

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

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

(b) [...]

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

(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).

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

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

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

(c) the use conditions are met. [...]

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) [...]

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently

distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) [...]

(3) [...]

(4) [...]

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

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

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

8. Section 5(2)(a) of the Act reads as follows:

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

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

[...]

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

9. Given its filing date, the cancellation applicant's mark qualifies as an earlier trade mark pursuant to section 6 of the Trade Marks Act. The cancellation applicant's mark did not complete its registration process more than five years before the filing date of the applicant's mark. The condition of use, therefore, does not apply to the registration. Consequently, the cancellation applicant can rely on all the services in its registration.

10. 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 impression 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 might wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

## **COMPARISON OF THE MARKS**

11. The cancellation applicant submits that the marks are identical, and the registered proprietor admits that this is the case. A mark is considered to be identical where it reproduces, without any modification or addition, all the elements constituting

the mark or where, as viewed as a whole, it contains differences so insignificant that they may go unnoticed by the average consumer.<sup>2</sup> I agree with the parties and consider that the marks are identical.

## **COMPARISON OF THE GOODS AND SERVICES**

12. The proprietor's goods and services are listed in paragraph 1 above. The cancellation applicant's services are listed in paragraph 3.

13. When making the comparison, all relevant factors relating to the goods and services in the specifications 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 that:

"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."

14. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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;

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<sup>2</sup> *S.A. Société LTJ Diffusion v. Sadas Verbaudet SA*, Case C-291/00

(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.

15. 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 the responsibility for those goods lies with the same undertaking.”

#### Class 9

16. I note that all of the goods in this class are limited by *“none of the aforementioned goods being temporary solutions for dealing with broken software and/or viruses”*. This limitation is noted and has been taken into account in relation to the comparisons below. I recognise that in its submissions in lieu, the cancellation applicant submits that the proprietor’s class 9 goods are similar to its services in classes 37, 41 and 42. They submit that this is on the basis that the goods and services share the same end users and are complementary to each other. Further, they submit that the goods and services are similar because *“the means as to how information on the cancellation applicant’s services in these classes, as well as the arranging of the provision of these services, take place via ‘software applications’.”*<sup>3</sup> The submissions provided by the cancellation applicant were rather generic and did not provide me with a best case. It is the cancellation applicant’s duty to adequately particularise the opposition and provide appropriate comparators to enable the Hearing Officer to best assess the similarity between the parties’

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<sup>3</sup> Cancellation applicant’s submissions in lieu, paragraph 10

specifications.<sup>4</sup> Where the opponent fails to do this, Mr Iain Purvis K.C, sitting as the Appointed Person, found that:

“If it fails to identify a particular combination, it cannot expect the Hearing Officer to do the job for it. [This] approach [...] would place an intolerable burden on Hearing Officers in cases of this nature in which there will be thousands of potential combinations of goods which could be relied on, and for each combination a slightly different argument for similarity could be made. Furthermore, such an approach would be unfair on the Applicant for the mark, since they will have had no opportunity to address points on similarity taken by the Hearing Officer if those points are not first raised by the Opponent.”

Whilst this decision was in relation to an opposition, the principle established is to be applied to cancellations as well.

*Software application that facilitates the provision of information, peer-to-peer interaction and transactions, and the booking of temporary workspaces; software platform that facilitates the provision of information, peer-to-peer interaction and transactions, and the booking of temporary workspaces; downloadable software applications that facilitates the provision of information, peer-to-peer interaction and transactions, and the booking of temporary workspaces.*

17. I recognise that there is a distinct possibility that, given modern advancements in technology and an increased reliance on applications, platforms and software to access services, the cancellation applicant’s services may be accessed using those goods. However, I note that the proprietor’s goods are not for software applications, platforms and software generally, but rather they are specifically for “*the provision of information, peer-to-peer interaction and transactions, and the booking of temporary workspaces*”. Due to this, I believe that it moves the goods and services further apart and there is no longer any general overlap in relation to how these services might be accessed.

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<sup>4</sup> *Abus August Bremicket Sohne KG v Muhammad Ali* (O/0911/24)

18. I do not consider that the proprietor's goods would be used to access any of the cancellation applicant's services, even for something like "*repair of office machinery*" which is one of the closest comparators I was able to identify from the cancellation applicant's specification. As per *Raleigh International*,<sup>5</sup> I do not consider that the proprietor's goods and the cancellation applicant's services are self-evidently similar. The proprietor's goods are specific in nature and use, and without evidence to the contrary, I see nothing which suggests to me an overlap in nature, purpose or method of use with the cancellation applicant's services. I do not consider the goods and services to be either in competition or complementary. Whilst it is possible for there to be a low level of overlap with the users and trade channels, any such overlap between the goods and services would not be enough to support a finding of similarity. Pragmatically, taking into account the guidance of Iain Purvis, KC in *Unicorn Studio*,<sup>6</sup> I find the proprietor's goods to be dissimilar to the cancellation applicant's services.

### Class 35

19. The cancellation applicant submits that the proprietor's class 35 and 42 services are similar to its services in classes 37, 41 and 42 on the basis that they have the same end user, being a user who uses "*a rate and review website before finding a business to provide these services*".<sup>7</sup> I note that, other than the comparison above, no specific comparison between selected terms has been provided. Further, the cancellation applicant submits that the services are all workspace/office-based or related services and therefore share a similar nature and intended purpose.

*Provision of ratings, reviews and recommendations for commercial purposes posted by users via a website; provision of ratings, reviews and recommendations of workspaces for commercial purposes posted by users via a website; providing*

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<sup>5</sup> In *RALEIGH INTERNATIONAL* Trade Mark [2001] RPC 11,[24] Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, observed that when the goods are not identical or self-evidently similar, the opposition should be supported by evidence as to their similarity

<sup>6</sup> In *Unicorn Studio Inc v Veronese Case* CH-2023-000214, Iain Purvis, KC, sitting as a deputy High Court judge, stated that any finding of similarity (between the goods) requires the exercise of common sense.

<sup>7</sup> Cancellation applicant's submissions in lieu, paragraph 10

*online business directories; providing online business directories featuring workspaces.*

20. Firstly, I note that all of the services at issue do not relate to workspace/office-based or related services; the cancellation applicant's services in class 41 do not encapsulate any of those industries/fields of operation; rather, they are entertainment services. Taking this into account and focusing on a comparison between the class 37 and 42 services, I consider that the services differ in purpose. This is on the basis that the proprietor's services are to provide recommendations, reviews and ratings and the provision of business directories. Whereas the cancellation applicant's services are for office cleaning, installation, repair and maintenance services (in class 37) and office layout and design (class 42). I have discussed the class 41 services above. I consider that the specific users of the services will differ. In addition, I am of the view that the method of use of the services will differ. It is not my view that there will be an overlap in the trade channels. I do not consider that the services will be in competition, nor do I find them to be complementary. Taking all of the above into account, I do not consider that there is any similarity between the services. The services are dissimilar.

#### Class 42

*Providing a web site featuring the ratings, reviews and recommendations for commercial purposes posted by users; providing a web site featuring the ratings, reviews and recommendations of workspaces for commercial purposes posted by users.*

21. The cancellation applicant's submissions in relation to class 42 are outlined above in paragraph 19. Applying the reasoning above in the comparison of class 35 services with the cancellation applicant's services, I consider the services to be dissimilar.

#### Class 43

22. The cancellation applicant submits that the proprietor's services are similar to its services in classes 37 and 42. The cancellation applicant submits that the services will have the same end users, being *“those who manage offices/workspaces or want to access an office (temporarily or permanently) as office equipment, furniture and layout all need to be provided and used too in an office/workspace”*. Further, they submit that temporary offices and workspaces will also need to be cleaned after a rental period has ended. In addition, it is submitted that as they are all workspace/office-based services they will have a similar nature and intended purpose.

*Rental of workspaces; rental of meeting rooms and offices; rental of workshops; rental of temporary workspaces, salons and offices.*

23. I have compared all of the proprietor's services collectively, as they all relate to the rental of workspaces. I consider that the purposes will differ, as the proprietor's services are for rental of workspaces, whereas the cancellation applicant's services are for office cleaning, installation, repair and maintenance services (in class 37) and office layout and design (class 42). I also consider that the nature of the services will differ. I also consider that the methods of use for the services will differ. The services are not in competition, nor do I consider that they are complementary. In addition, I am unable to identify any overlap in trade channels, and no evidence has been provided to support me in my comparison. Whilst I recognise that the services all relate to offices and that there may be a very general overlap in users, I do not consider that this is sufficient to substantiate similarity. Therefore, I consider that these services are dissimilar.

## **CONCLUSION**

24. As some degree of similarity between the goods is necessary to engage the test for a likelihood of confusion, my findings above mean that the cancellation aimed against those goods and services I have found to be dissimilar will fail.<sup>8</sup> For ease of reference, the cancellation under section 5(2)(a) fails against all of the goods and

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<sup>8</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

services in the proprietor's specification. Subject to any appeal of this decision, the mark will remain registered in the UK for all of its services, against which the cancellation application has been unsuccessful.

## **COSTS**

25. The proprietor has been successful, it is entitled to a contribution towards its costs based on the scale published in Tribunal Practice Notice 1/2023, as the proceedings commenced after 1 February 2023. The proprietor submitted that it should be awarded off scale costs as the cancellation applicant maintained its cancellation application when there was no "real prospect of success". The cancellation applicant submitted that there was no unreasonable behaviour. It is my view that the cancellation applicant maintaining its existing cancellation application, following the conclusion of the related opposition proceedings (427136), does not amount to unreasonable behaviour. It is not uncommon, in the course of proceedings, for cancellation actions to be maintained following the conclusion of related opposition proceedings. I do not consider that this cancellation was maintained by the cancellation applicant in an effort to delay, frustrate or unreasonably increase the costs or burden on the proprietor. In the circumstances, I award the proprietor £550 as a contribution towards the costs of the proceedings. The award is calculated as follows:

Preparing a statement and considering the other side's statement	£250
Filing submissions and considering the other sides submissions in lieu	£350
<b>Total</b>	<b>£550</b>

26. I therefore order Patch Places Ltd to pay Hotpatch Limited the sum of £550. 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 21<sup>st</sup> day of July 2025**

**A Klass**

**For the Registrar,**

**The Comptroller-General**