

O/489/22

TRADE MARKS ACT 1994

TRADE MARK REGISTRATION No. 3441548

COVERING A SERIES OF SIX TRADE MARKS

REGISTERED IN THE NAME OF DER TOURISTIK UK LIMITED

AND

APPLICATION 503801

BY A&K S.A.R.L.

FOR THE TRADE MARKS TO BE DECLARED INVALID AND CANCELLED

Background and pleadings

1. This is an application by A&K S.A.R.L. (“the applicant”) to invalidate the series of six registered trade marks shown below.

Alfred&

Alfred&Asia

Alfred&Africa

Alfred&South America

Alfred&North America

Alfred&Australasia

2. The application to register the marks was filed on 4th November 2019. The marks were registered in the name of Der Touristik UK Limited (“the proprietor”) on 5th February 2021.

3. The marks are registered in relation to the services shown below.

Class 39: Travel agency services and booking services for arranging travel and tours; Holiday travel reservation services; Arranging of flights; Arranging of sightseeing tours and excursions; Conducting sightseeing tours; Arranging excursions for tourists; Arranging of day trips; Arranging tours; Organization of tours; Provision of tours; Transport services for sightseeing tours; Rental of vehicles; Providing information to tourists relating to excursions and sightseeing; Providing information about travel, via the internet.

Class 43: Arranging holiday accommodation; Hotel reservation services; Travel agency services for making hotel reservations; Travel agency services for booking temporary accommodation; Booking agency services for hotel accommodation; Hotel reservation services provided via the Internet; Provision of holiday accommodation; Providing on-line information relating to holiday accommodation reservations; Providing online information relating to hotel reservations.

4. The application to invalidate the registration of the marks was filed on 29th April 2021.

5. The grounds for invalidation are as follows:

- (i) The applicant is the proprietor of earlier trade mark 908248858, which consists of & (i.e. the ampersand symbol) and is registered for a range of travel agency and related services in class 39 and 43;
- (ii) The contested marks are similar to the earlier mark and are registered for identical and/or similar services;
- (iii) The & symbol appears within the contested marks as a separate element and, particularly in the first mark in the series, it does not perform its usual conjunctive purpose of linking two words;
- (iv) The & symbol therefore has trade mark character in the contested marks, at least so far as the first mark in the series is concerned, and there is a likelihood of confusion through association;
- (v) The earlier mark has acquired a reputation and goodwill in the UK as a result of its use since 2002;
- (vi) Use of the contested marks would cause consumers to believe that there is an economic connection with the user of the earlier mark, which would take unfair advantage of the reputation of that mark and/or be detrimental to its reputation or distinctive character;
- (vii) Use of the contested marks would constitute a misrepresentation that the user of those marks is, or is associated with, the owner of the goodwill generated under the & symbol;
- (viii) This would be particularly damaging in an industry "*where personal recommendation and word-of-mouth review are increasingly important.*"

6. The applicant therefore pleads that registration of the contested marks was contrary to sections 5(2), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act") and should now be declared invalid in accordance with section 47(2) of the Act.

7. In relation to the grounds for invalidation based on earlier trade mark 908248858, the applicant made the statement of use required under section 47(2B)(a) of the Act and Rule 41(2)(d) of the Trade Mark Rules 2008 (as amended).

8. The proprietor filed a counterstatement denying the grounds for invalidation. I note, in particular, that:

- (i) The applicant was put to proof of use of the earlier mark as a trade mark;
- (ii) The proprietor accepted that the respective goods/services in classes 39 and 43 are identical or similar;
- (iii) The proprietor denied that the contested marks are similar to the earlier mark;
- (iv) It was pointed out that during the application process for the EU trade mark on which the earlier comparable mark is based, the applicant's representatives claimed that the & symbol was distinctive when used on its own because this differentiated it from normal conjunctive use;
- (v) The proprietor denied that the & symbol constituted a separate distinctive element of any of the contested marks;
- (vi) Whilst accepting that the applicant has a reputation in the travel industry, the proprietor denied that the earlier mark has such a reputation.

9. Both sides seek an award of costs.

Representation

10. The applicant is represented by WP Thomson, trade mark attorneys. The proprietor is represented by Sweetinburgh & Windsor Ltd, who are also trade mark attorneys. A hearing took place, remotely, on 28th April 2022. Mr Jamie Muir Wood appeared as counsel for the applicant. Ms Victoria Jones appeared as counsel for the proprietor.

The evidence

11. The applicant's evidence consists of a witness statement by Kerry Golds (with 22 exhibits), who is the Managing Director of the business, and a further statement by Mr David Gill (with 4 exhibits). Mr Gill is a partner in WP Thomson.

12. The proprietor's evidence consists of a witness statement by Matthew Quinlisk, who is the Chief Financial Officer of the business, and a further statement by Katrina Peebles (with 10 exhibits). Ms Peebles is a trade mark attorney and consultant at Sweetinburgh & Windsor.

13. The relevant statutory provisions are set out below.

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

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

(2ZA) -

(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.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with 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 where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D)-(2DA) [Repealed]

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the

purposes of this section as if it were registered only in respect of those goods or services.

(2F) -

(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) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(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) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(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) -

(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.”

“5(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

(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.

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 and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark

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.

5(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.”

Proof of use

14. It is convenient to start by examining whether the applicant has provided proof of use of the earlier mark so as to entitle it to pursue the grounds for invalidation based on sections 5(2) and 5(3) of the Act. In this connection, I note that section 100 of the Act provides that where a question arises about the use of a trade mark “.. *it is for the proprietor to show what use has been made of it.*” The earlier mark is registered in relation to:

Class 39: Conducting sightseeing tours for others; arranging and providing travel tours; arranging and conducting safari tours, river tours, and expeditionary tours for others; arranging and conducting jungle and safari expeditions; travel agency and travel guide services; making reservations and bookings for transportation; arranging and providing reservations and bookings for transportation and sightseeing tours for members of a travel club; transport by boat, air, railway, and barge; operating a travellers' club.

Class 43: Hotel and reservation services; temporary accommodation services; services provided by tourist or travel agencies; equity sharing residence and destination club services; bar and restaurant services for members of a travel club.

15. The periods for which evidence of use of the earlier mark is required are:

- (i) 5th November 2014 to 4th November 2019 (five years ending on the date the application to register the contested marks was filed), and

- (ii) 30th April 2016 to 29th April 2021 (five years ending on the date the application to invalidate the marks was filed).

16. As the earlier mark is a comparable trade mark created from an EU trade mark on the date the UK exited the EU, the following provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 apply.

“Grounds for invalidity of registration of a trade mark based upon an earlier comparable trade mark (EU)

9.—(1) Section 47 applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the period of five years referred to in sections 47(2A)(a) and 47(2B) (the “five-year period”) has expired before exit day—

(a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 47 to the United Kingdom include the European Union.

(3) Where exit day falls within the five-year period, in respect of that part of the five-year period which falls before exit day—

(a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 47 to the United Kingdom include the European Union.”

17. This means that use of the earlier mark anywhere in the EU prior to 31st December 2020 counts as use in the UK.

18. In *Walton International Ltd & Anor v Verweij Fashion BV*¹ Arnold J. (as he then was) considered the case law relating to genuine use and concluded as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark:

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark:

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin:

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: Internal use by the proprietor does not suffice: Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter:

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark:

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use:

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed

¹ [2018] EWHC 1608 (Ch) at paragraph 15 of the judgment

to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule:

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use.

19. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. This is why my decision also makes some references to the case law of the EU courts.

20. Kerry Golds' evidence is that the applicant is an award winning luxury travel company. The applicant's turnover in the UK and (the rest of the) EU in 2019 was around £46m and £8m, respectively. 75% of this turnover related to travel services and 24% to accommodation. Kerry Golds provides copies of documents showing an ampersand sign appeared on the applicant's websites abercrombiekent.co.uk and akvillas.com in 2015 and 2016, respectively. There is similar evidence obtained from a web archive site showing pages from the applicant's UK website between 2014 – 2019. The page from 2017 is shown below.²



² The same mark appears on an itinerary sent to a Greek (i.e. EU) customer in 2017. See page 4 of exhibit KG7.

21. There is evidence showing use of the same mark on the applicant's holiday brochures for 2015, 2018 and 2019/20, some of which have prices shown in pounds sterling and/or UK telephone numbers and addresses for enquiries.³

22. There is evidence of the following mark in use on a holiday itinerary sent to a UK customer in 2017.⁴



23. There is also evidence of the following mark in use in 2017 on one of the applicant's winter holiday brochures, which I note has a UK telephone number for enquiries.⁵



24. The marks shown at paragraphs 20, 22 and 23 above also appeared in the applicant's biannual newsletter entitled Sundowner between 2014 and 2020.⁶ According to Kerry Golds, sales of the newsletter account for 1% of the applicant's revenue. I note that most of the examples in evidence include a UK telephone number and, in one case, a sale price in pounds sterling.

25. Exhibit KG13 includes multiple examples of the marks shown above in use in advertisements for holidays, including examples from The Daily Telegraph (from

³ See exhibit KG11

⁴ See exhibit KG8

⁵ See exhibit KG11

⁶ See exhibit KG12

2015/2017), The Sunday Telegraph (from 2018), Evening Standard (from 2018 and January 2019), and Conde Nast Traveller (from 2017 - 2019).

26. Kerry Golds says that the company also organised hot air balloon trips in the Cotswolds between 2011 and 2016 on a balloon bearing a version of the mark shown at paragraph 22 above (but with the device much larger than the word element) in order to promote the applicant's services. A picture of the balloon bearing the mark is in evidence.⁷

27. On behalf of the applicant, Ms Jones attacked this evidence on the basis that:

- (i) Where the evidence shows the mark used as registered, such as on the applicant's website (i.e. as shown in exhibit KG4 and paragraph 20 above), it is decorative use, not use that would be perceived as indicating the trade origin of the services;
- (ii) The use shown of the mark against a shaded square background with the words Abercrombie & Kent below (as shown in paragraphs 22 and 23 above) does not constitute use of the registered mark, or a variant mark with the same distinctive character.

28. Ms Jones submitted that the evidence showed that the applicant's services are distinguished by the words Abercrombie & Kent and A&K. In support of this submission, Ms Jones referred me to Mr Peebles' evidence that:

- (i) Searching on an ampersand sign on the applicant's website produced no results;
- (ii) Although there is evidence that versions of the earlier mark appear on the applicant's social media sites,⁸ there is no evidence of anyone referring to the applicant by using the ampersand sign;

⁷ See exhibit KG15

⁸ See exhibit KG4

(iii) Similarly, the evidence of reviews on Trustpilot provided by the applicant only show it being referred to as Abercrombie & Kent or A&K⁹;

(iv) The earlier mark does not appear on the invoices the applicant has placed in evidence,¹⁰ except for two examples from 2018, both of which appear to have been issued to customers in the USA (i.e. outside the UK/EU).

29. Dealing first with the point about the use shown being decorative in nature, I remind myself that the correct question is whether the use shown is consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the services, i.e. that all the services sold under that sign originate from the same undertaking. Provided the use of the mark fulfils that function it does not matter if the mark is also used partly decoratively, i.e. as part of the aesthetic used to market the services.

30. An ampersand is not an obvious choice for use as decoration. It is not like a flower, which might naturally be used on a brochure or marketing material just to exploit its aesthetic appeal. The applicant's use of an ampersand on its marketing material clearly stems from its original conjunctive use in the established trade name Abercrombie & Kent. Therefore, the use of an enlarged standalone ampersand would most likely be seen as fanciful use of the sign, at least partly intended to designate the origin of the services. I therefore reject Ms Jones' submission that the use shown in paragraph 20 above would be perceived as (purely) decorative.

31. There is no dispute as to the applicable law relating to the use of a registered mark as part of, or in conjunction with, another mark. The law is set out in *Colloseum Holdings AG v Levi Strauss & Co.*,¹¹ where the CJEU found that:

"31. It is true that the 'use' through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas 'genuine use', within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, 'use' within the meaning of Article 7(3) for the purpose of registration

⁹ See exhibit KG21

¹⁰ See exhibits KG9 & 10

¹¹ Case C-12/12

may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in Nestlé, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

32. The proprietor puts forward two reasons why the use shown in paragraphs 22 and 23 above does not constitute use of the earlier mark as registered, or an acceptable variant of it under section 47(2C)(a). Firstly, it is argued that placing the ampersand within a square device alters the distinctive character of the mark by converting it from a grammatical symbol to a figurative device. In this connection, Ms Jones pointed out

that the effect of the change was that the very bottom and part of the lower left hand edge of the ampersand were lost in the figurative version of the sign. In support of this point, Ms Jones drew my attention to the judgment of the EU's General Court in *Art's Café*.¹² The court decided that the word element was lacking in distinctiveness for café-type services and that the distinctive character of the mark was therefore vested in the specific hand written font in which the mark was registered. Consequently, use of the words in plain script did not constitute use of the registered mark, or an acceptable variant of it.

33. The second reason advanced by the applicant is that there is no evidence that the ampersand sign would “*continue to be perceived as indicative of the origin of the [services]*” without the words Abercrombie & Kent. In this connection, Ms Jones pointed out that there is no evidence of anyone referring to, or relying on, the ampersand sign as a means of distinguishing the applicant's services. Ms Jones contrasted this with the evidence before the court in *Specsavers International Healthcare Limited & Others v Asda Stores Limited*,¹³ which showed some reliance on a device mark corresponding to the outline shape of two overlapping circles. This was despite the fact that the overlapping circles device appeared to have been used only as the background on which the word mark SPECSAVERS appeared.

34. As to the first point, I accept that small changes are more likely to alter the distinctive character of a weak mark than a highly distinctive mark. And for reasons I will come to later, I also accept that the earlier mark is not a highly distinctive mark. On the other hand, placing the ampersand on a square background does not appear to alter its distinctive character. After all, when used on its own the ampersand does not serve the conjunctive function it normally has as a grammatical symbol. Therefore, when used alone it is a figurative representation of an ampersand, rather than a functioning ampersand. That is the case with or without the square background. It is true that placing the ampersand sign on a contrasting square background has the effect of losing the very bottom and part of the lower left hand edge of the ampersand. However, the sign remains unmistakably an ampersand and the visual effect of the loss of the edges is minor. Therefore, in my view, the uses of the ampersand sign

¹² Case T-309/16

¹³ [2014] EWCA Civ 1294

shown in paragraphs 22 and 23 above constitute use of acceptable variants of the registered mark.

35. Do those signs cease to be acceptable variants because they are used with the words Abercrombie & Kent? I do not think it makes any difference whether the signs are used 'as part of' a composite mark including the words (as the proprietor says) or 'in conjunction with' the words (as the applicant says). This is because the same test applies irrespective of whether they are perceived as part of a composite mark or used in conjunction with the word mark i.e. the test remains whether the ampersand sign continues to be perceived as indicative of the origin of the services at issue.

36. I accept there is no evidence of the applicant's customers referring to it by reference to the ampersand. I do not attach much weight to the absence of such evidence. This is because the standalone ampersand is used as a visual mark. Consequently, customers are unlikely to verbalise the sign or use it when writing social media posts etc. It is true that there was some (albeit limited) evidence of this kind in the *Specsavers* case. It was particularly important in that case because the claimant appeared to use a device of two overlapping circles as a fancy background for the word SPECSAVERS. Further, the mark at issue was the outline and filled-in shape of the overlapping circles device, i.e. it was an abstraction of the device mark, which itself seemed to be used only as a fancy background for the word mark. This inevitably gave rise to serious doubts as to whether customers would attach any trade mark significance to the registered mark when used alone and in the form in which it was registered. By contrast, the sign under consideration is separated from the words Abercrombie & Kent. And although it was probably derived from the ampersand between those words, the standalone ampersand device will clearly make its own distinct visual impression on the applicant's customers. Even if the standalone ampersand device is part of a composite mark including the words Abercrombie & Kent, I find it has an independent distinctive role in that composite mark. Therefore, even without direct evidence from customers, I am prepared to accept that the ampersand device would "*continue to be perceived as indicative of the origin of the [services]*" if used without the words Abercrombie & Kent.

37. Ms Jones also attacked the applicant's proof of use of the earlier mark on the basis that it did not distinguish between the services offered under marks shown in

paragraphs 20, 22 and 23 above and services offered under other marks, specifically Abercrombie & Kent and A & K. Whilst accepting that the applicant was a significant trader in travel and holiday services in the UK, Ms Jones submitted that the applicant had not shown that it used the earlier mark to create or maintain its market for such services. In this connection, Ms Jones drew my attention to examples of use relied on by the applicant which were (i) outside the UK, and/or (ii) undated, and/or (iii) showed no use of the earlier mark.

38. I accept that the applicant's evidence of use includes numerous pages which do not show any qualifying use of the earlier mark in the UK (even where UK "includes" the EU). For example, there is no evidence that the earlier mark was used on the invoices in evidence, at least on those sent to UK customers. However, given the scale of the applicant's business in the UK and the evidence of relatively consistent use of the earlier mark in a great deal of its advertising and marketing material, I am satisfied that the earlier mark was used during the relevant periods to create or maintain a market for the applicant's travel and holiday services. I therefore accept that the applicant has shown genuine use of the earlier mark. The fact that the applicant has made greater use of the Abercrombie & Kent and A & K does not undermine that conclusion.

39. I turn then to a fair specification reflecting the use of the earlier mark shown in relation to services in classes 39 and 43. I take account of the guidance from *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors*.¹⁴ I find that, with the following exceptions, all the services covered by the registration would be perceived by average consumers as categories or sub-categories of the travel and holiday services shown in the evidence. The exceptions are:

Class 39: Operating a travellers' club;

Class 43: Equity sharing residence and destination club services; bar and restaurant services for members of a travel club.

¹⁴ [2016] EWHC 3103 (Ch), at paragraph 47 of the judgment

40. Kerry Golds says nothing about the provision of these services, let alone how the earlier mark is used in relation to them. I therefore conclude that the applicant has shown genuine use of the earlier mark for all the registered services in classes 39 and 43, except for the services listed in the previous paragraph.

The section 5(2)-based ground for invalidation

Comparison of services

41. The respective services are shown below.

Services covered by the contested mark	Services for which the earlier mark is entitled to protection
<p>Class 39: Travel agency services and booking services for arranging travel and tours; Holiday travel reservation services; Arranging of flights; Arranging of sightseeing tours and excursions; Conducting sightseeing tours; Arranging excursions for tourists; Arranging of day trips; Arranging tours; Organization of tours; Provision of tours; Transport services for sightseeing tours; Rental of vehicles; Providing information to tourists relating to excursions and sightseeing; Providing information about travel, via the internet.</p> <p>Class 43: Arranging holiday accommodation; Hotel reservation services; Travel agency services for making hotel reservations; Travel agency services for booking temporary accommodation; Booking agency services for hotel accommodation; Hotel reservation services provided via the Internet; Provision of holiday accommodation; Providing on-line information relating to holiday accommodation reservations; Providing</p>	<p>Class 39: Conducting sightseeing tours for others; arranging and providing travel tours; arranging and conducting safari tours, river tours, and expeditionary tours for others; arranging and conducting jungle and safari expeditions; travel agency and travel guide services; making reservations and bookings for transportation; arranging and providing reservations and bookings for transportation and sightseeing tours for members of a travel club; transport by boat, air, railway, and barge.</p> <p>Class 43: Hotel and reservation services; temporary accommodation services; services provided by tourist or travel agencies.</p>

online information relating to hotel reservations.	
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42. The proprietor accepts that the respective services are identical or similar. Taking account of the General Court's ruling in *Gérard Meric v OHIM*,¹⁵ that specific goods/services must be considered identical to a more general category which includes those goods/services, and vice versa, I find all the services at issue are identical, except for *rental of vehicles*. If I am wrong about, they are self-evidently highly similar services. *Rental of vehicles* is a complementary service¹⁶ to (at least) *making reservations and bookings for transportation and arranging and providing travel tours*. I find these services are similar to a medium degree.

Global assessment of the likelihood of confusion

43. 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.

The principles

(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

¹⁵ Case T- 133/05

¹⁶ Within the meaning of the case law. See, for example, *Boston Scientific Ltd v OHIM*, Case T-325/06.

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.

The average consumer and the selection process

44. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.¹⁷ The average consumer in this case is likely to be a member of the general public. The applicant says that the average consumer will pay a moderate to high degree of attention when selecting the services at issue, depending on their cost. According to the applicant, a high degree of attention will be paid when selecting an expensive luxury holiday, but only a moderate amount when selecting a cheap break. The proprietor says that average consumers will pay a high degree of attention because all holidays and travel are important purchases for the public.

45. In *Bang & Olufsen A/S v OHIM*,¹⁸ the General Court re-iterated that:

“According to the case-law, the price of the product concerned is also immaterial as regards the definition of the relevant public, since price will also not be the subject of the registration (Joined Cases T-324/01 and T-110/02 Axions and Belce v OHIM (Brown cigar shape and gold ingot shape) [2003] ECR II-1897, paragraph 36).”

46. Accordingly, the likelihood of confusion cannot be assessed purely on the basis of the use of the marks in relation to expensive luxury holidays. However, I accept that holidays, travel and tours are not cheap everyday services bought without much care. I also accept that arranging the most suitable travel, accommodation, tours etc., and getting a good price for the services, is important to the average consumer.

¹⁷ *Lloyd Schuhfabrik Meyer*

¹⁸ Case T-460/05

Accordingly, I find that the average consumer will pay an above-average level of attention (or more) when selecting the services at issue.

47. The services are likely to be selected primarily by eye from websites, brochures etc. However, word-of-mouth recommendations may also play some part in the selection process.

The distinctive character of the earlier mark

48. In *Lloyd Schuhfabrik Meyer* 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 C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, 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 promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”*

49. The applicant claims that the earlier mark has a high degree of inherent distinctiveness because it is not descriptive of the services at issue. Further, the use made of the earlier mark has further enhanced its distinctive character.

50. The proprietor disputes that the earlier mark is highly distinctive. According to the proprietor, the public do not usually regard typographical symbols as indications of trade origin. The earlier mark should therefore be regarded as having a very low degree of inherent distinctiveness. The proprietor says that the sporadic use of the mark shown in the evidence is insufficient to have enhanced the earlier mark's distinctiveness. This is particularly so because, when it is used, it is as a secondary or supporting mark to the words Abercrombie & Kent, or the letter mark A & K.

51. I accept that typographical symbols, such as an ampersand, are low in inherent distinctive character. This is because the public are not accustomed to recognising such signs as trade marks. I do not consider that this assessment is undermined by the fact that the earlier mark is not descriptive. Descriptiveness is but one reason, albeit the most common one, why a mark may lack distinctive character. I am fortified in this view by the judgment of the General Court in *JOOP! GmbH v OHIM*,¹⁹ where it was held that a representation of an exclamation mark was devoid of any distinctive character.

52. The applicant appears to have used the earlier mark for around 10 years prior to the date of filing of the contested trade mark ("the relevant date"). I noted earlier that the mark had been used with relative consistency in advertising. However, such use was by no means universal. The mark is absent from some of the marketing materials filed by the applicant itself. Ms Peebles' evidence includes more examples.²⁰ Further, as the proprietor points out, the earlier mark is almost invariably used with the distinctive words Abercrombie & Kent or the distinctive letter mark A & K. These signs are, without doubt, the primary means through which the public distinguish the applicant's services. I therefore conclude that although the distinctive character of the earlier mark has been enhanced to some extent as a result of its use as a trade mark prior to the relevant date, the mark was still possessed of only a moderate degree of distinctive character. This assessment is consistent with the applicant's apparent (and correct) acceptance that it cannot object to normal conjunctive use of the & sign as part of names used as third party trade marks. That would not be the case if the & sign was truly a highly distinctive mark.

¹⁹ Case T-75/08

²⁰ See exhibit KP8 her statement


Comparison of marks

53. It is clear from *Sabel BV v. Puma AG* that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. In *Bimbo SA v OHIM*²¹ the CJEU set out the correct approach as follows:

“.....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.”

54. It would be wrong, therefore, to dissect the trade marks artificially, 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.

55. The respective trade marks are shown below:

Earlier trade mark	Contested trade marks
	<p>Alfred&</p> <p>Alfred&Asia</p> <p>Alfred&Africa</p> <p>Alfred&South America</p> <p>Alfred&North America</p> <p>Alfred&Australasia</p>

²¹ Case C-591/12P

56. Mr Muir Wood submitted that the geographical elements in the second to sixth marks should be ignored because they are descriptive and non-distinctive. This submission appears to be contrary to the case law which requires the marks to be considered through the eyes and ears of an average consumer, i.e. as a whole. The geographical elements in the second to sixth marks may be descriptive, but they contribute to the overall impression created by those marks. The geographical names are not negligible elements that would likely go unnoticed by average consumers. On the contrary, when presented as they are, not just as geographical areas but also as the 'companions' of 'Alfred', the geographical names contribute to the trade mark character of these marks. When I asked him about the apparent conflict between his suggested approach and *Sabel v Puma*, Mr Muir Wood reminded me that in *Comic Enterprises Ltd v. Twentieth Century Fox Film Corporation*,²² Kitchen L.J. (as he then was) explained that:

"...An application for the registration of a series of trade marks is an application to register a bundle of trade marks under a single reference number. Each of the marks in the series must satisfy the requirements of the 1994 Act. If the application is accepted and any opposition proceedings have been resolved in favour of the applicant, then the series of marks will be registered, but it will remain what it always was, namely a bundle of different marks, albeit now registered under the same reference number."

Kitchen L.J. went on to say that:

"...In order to qualify as a series the trade marks must resemble each other in their material particulars. Any differences between the trade marks must be of a non-distinctive character and must leave the visual, aural and conceptual identity of each of the trade marks substantially the same. These matters must be assessed from the perspective of the average consumer of the goods or services in question."

²² [2016] EWCA Civ 41

57. According to Mr Muir Wood, this meant that the identity of the six marks registered as a series must be substantially the same. Ignoring the geographical elements was therefore consistent with the registration of the marks as a series.

58. The compatibility of the provisions in the Act governing the registration of trade marks as a series with European Directives on trade mark law was considered again by the Court of Appeal in a subsequent judgment in the same case.²³ It was suggested that the Act was incompatible with the Directives, which made no provision for the registration of series of marks. One of the reasons put forward in support of that argument was that it would be impractical to resolve an attack on a series of marks which exposed the fact that some of them were valid, but others should be revoked. Kitchen L.J. rejected this submission as follows:

“43. I have given careful consideration to the submission made by Mr Purvis for Fox that the interpretation urged by the Comptroller is unworkable. How, said Mr Purvis, are the non-use provisions of s.46 to be applied? I am not persuaded this presents any difficulty. Once it is appreciated that a registration of a series of trade marks is a registration of a series of different trade marks, each of which is registered under the same number, the non-use provisions can be applied just as they are for any registered trade mark. If some of the trade marks in the series have been used and others not, then it may be that none is susceptible to revocation as a result of the saving conferred by s.46(2) in respect of use of the mark in a form differing in elements which do not alter its distinctive character. If, however, some of the trade marks in the series which have not been used for some reason do not satisfy the s.46(2) test then the registration of those trade marks may be revoked.”

59. This makes it clear that courts and tribunals are not constrained by the registration of marks as a series to consider them all substantially the same mark. It follows that if there is a likelihood of confusion with one of the marks in the series, but not the others, then that mark may be declared invalid and the attack on the others rejected. There is

²³ [2016] EWCA Civ 455

no warrant for an 'all or nothing' approach. The focus of the applicant's attack is the **Alfred&** mark. I will therefore start by comparing the earlier mark with **Alfred&**.

60. The applicant says the ampersand will not go unnoticed by average consumers when they see the **Alfred&** mark. Mr Muir Wood further submitted that as a non-alphabetical sign, the ampersand is liable to be considered separately and to have its own distinctive character within **Alfred&**.

61. The proprietor says that **Alfred** will be seen as the dominant and distinctive element of the contested mark. It denies that the **&** has an independent distinctive role in the mark.

62. I accept that average consumers will not overlook the ampersand attached to the end of **Alfred**. This is partly because the ampersand does not link to a second word, which makes it stand out more than it normally would. However, that sign is but one of seven characters making up the contested mark. It also appears at the end of the contested mark where it has less visual impact than if it appeared (say) at the beginning. I therefore find that the marks are visually similar to only a low degree.

63. The applicant submits that the contested mark will be spoken as 'Alfred and' and the earlier mark as 'and'. According to the applicant, this creates at least a medium degree of aural similarity between them. The proprietor says that to the extent that the earlier mark is capable of being pronounced, it will be spoken as 'and' or 'ampersand'. By contrast, the contested mark will be pronounced as 'Al-Fred And'. Accordingly, even assuming the earlier mark is verbalised, there is difference of three syllables to one.

64. In my view, the proprietor's doubts as to whether the earlier mark will find aural expression amongst average consumers are well founded. After all, the applicant's evidence reveals no aural use of the earlier mark. This is probably because when used on its own an ampersand ceases to function as an 'and' and becomes just a visual sign. However, even if that is wrong, the proprietor is right to point out that there is a difference of three syllables to one, and the common syllable is at the end of the contested mark where it will make the least aural impact. I therefore find that there is, at most, only a low degree of aural similarity between the marks.

65. According to the applicant, the conceptual meaning of the earlier mark is 'and' whereas the conceptual meaning of the contested mark is 'Alfred and'. Both meanings are said to allude to travelling with someone else. Consequently, the marks are claimed to be conceptually similar.

66. The proprietor accepts that, to the extent that the earlier mark has a conceptual meaning, it is 'and' or ampersand. According to the proprietor, the contested mark will be perceived as meaning someone called Alfred in addition to something else, with that 'something else' left as an open suggestion. On behalf of the proprietor, Ms Jones submitted that it was absurd to suggest that the marks were conceptually similar just because the contested mark contained an ampersand. Setting the bar that low would mean there was conceptual similarity with multiple other trade marks that looked and sounded very different.

67. I accept that the earlier mark has the conceptual meaning of 'and'. I do not consider that the contested mark has any clearly recognisable conceptual meaning. A personal name is not a concept. If the average consumer stopped to carefully analyse it, he or she would probably come up with something like 'a person and an unidentified something else'. However, I doubt that an average consumer (even one paying an above average degree of attention) would get beyond the general impression that the contested mark is quirky because it deliberately leaves something unsaid. I accept the proprietor's submission that the mere fact that both marks convey (in different ways) the general idea of 'and' is not enough to create any material conceptual similarity between them.

68. As to the comparison between the earlier mark and the second to sixth marks in the series, I consider that the extent of the visual and aural differences between the parties' respective marks, coupled with the absence of any conceptual similarity between them, means that average consumers would not notice any similarity at all. In reaching this conclusion I have not overlooked the fact that the contested marks incorporate the whole of the earlier mark. This would usually mean there is at least a low degree of similarity between the marks. However, this case illustrates why such rules of thumb should not be elevated to rigid rules.²⁴ The 'similarity' between an

²⁴ There is no such rule. See *Vedial v OHIM, France Distribution*, CJEU, Case C-106/03P

ampersand on its own and **Alfred&Asia** (or any of the third to sixth marks in the series) simply would not register with relevant average consumers. This is because such consumers are highly accustomed to using, and to seeing others use, ampersands for purely conjunctive purposes without attaching any further significance to the symbol. Indeed, the proprietor has provided evidence of four other established companies in the travel industry, including Hayes & Jarvis, using marks including an ampersand without any evidence of confusion.²⁵ It follows that regardless of the position on the other relevant factors in the required global assessment, there is no possibility whatsoever of confusion between the earlier mark and the second to sixth marks in the series. This is because these marks are not similar in any material way.

Likelihood of confusion

69. My finding in the previous paragraph is sufficient to reject the section 5(2)(b) based ground for invalidation so far as the second to sixth marks in the series are concerned.

70. Returning to the comparison between the earlier mark and the first mark in the series, it is not suggested that the similarity between the marks is sufficient to create a likelihood of direct confusion. Rather, the case advanced at the hearing by Mr Muir Wood was that there is a likelihood of indirect confusion.

71. In the now well-known case of *L.A. Sugar Limited v By Back Beat Inc.*,²⁶ Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the

²⁵ See exhibit KP7 to Ms Peebles statement

²⁶ Case BL O/375/10

earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. *Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:*

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).*
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.).*
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (‘FAT FACE’ to ‘BRAT FACE’ for example)”.*

72. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*,²⁷ Arnold L.J. referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria*,²⁸ 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 L.J. 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.

73. Mr Muir Wood put his case for indirect confusion like this:

“We say the average consumer will notice the very odd combination of ALFRED and ampersand and the lack of a concluding part to it, and in those

²⁷ [2021] EWCA Civ 1207

²⁸ BL O/219/16

circumstances we say that the ampersand element of the later mark does have independent distinctive character. The average consumer will look at it and will wonder if ALFRED& is in some way a sub-brand of the ampersand brand. So we say in those circumstances, absent the 'Y' in the 'X&Y', being left 'X&', there is a likelihood of confusion because of that unusual combination of ampersand and the word ALFRED.”

74. The suggestion that the ampersand in **Alfred&** has an independent distinctive role in that mark invokes the point made in the judgments of the CJEU in *Medion AG v. Thomson* and *Bimbo SA v OHIM*, which is summarised in paragraph 42(f) above. Essentially this is that a non-dominant element of a composite mark may give rise to a likelihood of confusion with another mark consisting of that element (or a similar sign) where the common element retains an independent distinctive role in the composite mark.

75. The proprietor denies that the ampersand has an independent distinctive role in **Alfred&**. Ms Jones also drew my attention to the decision of Phillip Johnson, as the Appointed Person, in *Lions Gate Entertainment Inc. v Telegraph Media Group*²⁹ in which it was pointed out that (i) *Medion* is just a structured way of assessing the likelihood of indirect confusion, (ii) showing that an element in a trade mark has an independent distinctive role in that mark may assist in establishing a likelihood of indirect confusion, but does not necessarily mean that there is such a likelihood, and (iii) there is less likelihood of indirect confusion where the common element is low in distinctive character.

76. I do not accept that the ampersand has an independent distinctive role within **Alfred&**. On the contrary, it forms a unit with the name Alfred. It is the combination of the two which suggests a missing word.

77. In any event, I see no proper basis for finding that average consumers would expect **Alfred&** to be a sub-brand of **&**. Far from being “*so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all*” the earlier mark is only

²⁹ [2019] FSR 16

moderately distinctive. 'Alfred' is hardly a non-distinctive addition to &. I see no other proper basis on which average consumers paying an above-average (or even an average) level of attention would reasonably assume that **Alfred&** is a sub-brand of & (or vice versa), even if they are used in relation to identical services.

78. I therefore reject the applicant's case based on the likelihood of indirect confusion.

79. The ground for invalidation based on section 5(2)(b) of the Act fails accordingly.

80. In reaching this conclusion I have not overlooked Mr Gill's evidence that one of the websites currently operated by the proprietor, i.e. alfredand.kuoni.co.uk, uses a small sign in the heading section on some the webpages corresponding to an ampersand on a square dark background.³⁰ That is not one of the registered marks covered by these proceedings. Therefore, it has had no bearing on my decision.

The grounds for invalidation based on sections 5(3) and 5(4)(a) of the Act

81. The applicant's case under section 5(3) is based on the pleading that use of the contested marks would cause consumers to believe that there is an economic connection with the user of the earlier mark. This is essentially a claim that there is a likelihood of unfair advantage/detriment because of a likelihood of confusion. I have already examined and rejected that proposition. It follows that the section 5(3) ground also fails because the type of link the applicant's case depends on does not exist.

82. The applicant's case under section 5(4)(a) depends on the proposition that use of the contested marks would constitute a misrepresentation to the public that the proprietor is connected to the applicant. In order for use of the contested marks to be a misrepresentation to the public, a substantial number of the proprietor's customers or potential customers would have to be liable to be deceived when the contested marks are used.³¹ For the same reasons I have given in relation to the likelihood of confusion, I reject the applicant's case that use of the contested marks will constitute a misrepresentation to the public. The applicant's case based on section 5(4)(a) of the Act therefore also fails.

³⁰ See page 3 of exhibit DG4 to Mr Gill's statement

³¹ See, for example, *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407

Overall outcome

83. The grounds for invalidation under section 47(2) of the Act have failed. The application is therefore rejected. This means that the contested series of marks will remain on the register.

Costs

84. The application has failed. The proprietor is therefore entitled to a contribution towards its costs. I assess this as follows:

£400 towards the cost of considering the application and filing a counterstatement;

£1400 towards the cost of considering the applicant's evidence and filing evidence in response;

£1100 towards the cost of the hearing, including preparing a skeleton argument.

85. I therefore order A&K S.A.R.L. to pay Der Touristik UK Limited the sum of £2900. This sum to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated this 7th day of June 2022

Allan James

For the Registrar