

**O-124-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 3250330  
BY AHMED JUMRATI ADRIAN SHAZAD  
TO REGISTER THE FOLLOWING SERIES OF TRADE MARKS IN CLASS 36:**

**London Resi**

**London RESI**

**AND**

**OPPOSITION THERETO (NO. 410933)  
BY THAMES VALLEY HOUSING ASSOCIATION LIMITED**

## **Background and pleadings**

1. Ahmed Jumrati Adrian Shazad (“the applicant”) filed UK trade mark application 3250330 on 15 August 2017 to register the series of word marks shown above for a specification in class 36 (“the applied for marks”). The application was published in the Trade Marks Journal on 1 September 2017. Registration of the applied for marks is opposed by Thames Valley Housing Association Limited (“the opponent”). The opponent relies on UK trade mark 3227071, a series of 3 word marks: SO RESI, SO Resi and So Resi, registered for a specification in classes 35 and 36 (“the earlier marks”). The earlier marks were filed on 25 April 2017 and registered on 14 July 2017. The opponent relies on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) to oppose the application for registration.
2. The opponent filed a notice of opposition and statement of grounds. They also filed written submissions dated 6 April 2018, 19 October 2018 and 27 November 2018 and evidence in the form of a statement and supporting exhibits from Holly Jane Strube dated 19 October 2018.
3. The applicant filed a notice of defence and counterstatement. He filed written submissions dated 20 August 2018 and 27 November 2018 and a witness statement with supporting exhibits dated 20 August 2018.
4. Neither party requested an oral hearing. This decision is therefore taken following careful consideration of all the papers. The applicant represents himself. The opponent is represented by Pennington Manches.

## **The Evidence**

### **The applicant’s evidence**

5. The applicant’s evidence is in a statement dated 20 August 2018. The applicant explains that he is the managing director of London Resi, the trading name of London Real Estate Solutions Incorporation Limited, a limited company

incorporated on 1 July 2017. He explains that he has used [www.londonresi.com](http://www.londonresi.com) as his registered website domain name since 27 February 2014 and exhibit AS/1 evidences this.

6. The applicant further explains that London Resi provides advisory services and acts as a consultant for residential property developers in England and Wales who are seeking to develop property portfolios in the London area. He states that his business mainly advises property developers in raising debt and equity finance from UK based lenders and investors and his business plans to become a full-scale corporate finance and strategic advisory business for residential property developers. He states his business does not act for housing associations, affordable housing providers, first time buyers or shared ownership housing providers. He exhibits at AS/2 London Resi's logo, the screen shot of the result of a google search for "London Resi" and a screen shot of the home page of [www.londonresi.com](http://www.londonresi.com).
7. At exhibit AS/3 the applicant exhibits the opponent's logo, a screen shot of a google search for "So Resi" and the opponent's home page. The latter explains at page 13 that: "*So Resi is the new brand for shared ownership homes by Thames Valley Housing.*" Page 14 shows various images of the opponent's branding, in stylised form, for different locations such as "So resi Farnborough," "So resi Sydenham" etc.
8. In his statement the applicant states that the term "resi" is or has become customary in the current language of the real estate/property industry and is an accepted abbreviation of the word "residential" and frequently used in that regard. He states that a google search for "resi" returns over 133 million search results, although there is no exhibit in support of this. He states that the first result on google is "Front Yards Residential Corp", listed in the New York Stock exchange with the ticker "RESI", although again there is no exhibit filed showing this. He also says that all of the top search results include residential property related businesses and he lists 11 examples at paragraph 17 of his statement. The google search results are, however, not exhibited as evidence.

## The opponent's reply evidence

9. The opponent did not file any evidence in chief, but filed evidence in reply, namely a statement from Holly Jane Strube dated 19 October 2018. Ms Strube is a Senior Associate and solicitor at Pennington Manches LLP. Taking the citations referred to in paragraph 17 of the applicant's statement, concerning third party use of "resi", she states in reply:
- (a) Front Yard Residential Corp is a US based provider of high quality and affordable single family housing and its existence and alleged use of the ticker<sup>1</sup> does not show use of "resi" in the UK in relation to the services at issue. She annexes screen shots of the company's website at HJS1. The website is [www.frontyardresidential.com](http://www.frontyardresidential.com), although as shown in the top left hand corner of the screenshots, it also terms itself "Front Yard Residential (RESI)".
  - (b) [www.resi.co.uk](http://www.resi.co.uk) is a website where RESI is used as a mark for architectural design services. HJS2 produces extracts from their website showing they offer an online architectural platform for remodelling homes. The company name is shown as Resi Design Ltd trading as "RESI", sometimes depicted in a stylised form. HJS2 also exhibits an EU trade mark which seems to include the same stylised representation of the words RESI as part of "RESI ARCHITECTURE", albeit this EU mark is owned by Buildpath One Limited.
  - (c) [www.resi-reit.com](http://www.resi-reit.com) links to a website owned by Resi Capital Management Limited showing use of ReSI as a trade mark in relation to a real estate investment trust. Ms Strube states that the opponent is currently taking action in the UKIPO and EUIPO against Resi Capital Management Limited's use of and trade mark applications for the ReSI brand in relation to conflicting class 36 services<sup>2</sup>. Screenshots of the third party

---

<sup>1</sup> A stock ticker or stock symbol is a series of letters assigned to a stock market security for trading purposes.

<sup>2</sup> Although I note that that the opposition in the UK IPO is now concluded.

website and details of the opposed trade mark applications are exhibited at HJS3. The website states that Residential Secure Income plc is an investment company established to secure income returns by investing in the social housing sector as a real estate investment trust and is managed by ReSI Capital Management Limited. It refers to itself in various places on the website extract as “ReSI” and “ReSI Housing.”

- (d) [www.resiconf.com](http://www.resiconf.com) is a website, with extracts exhibited at HJS4, publicising a property related convention called “RESI Convention” which took place in September 2018 and with an advert for the 2019 event. It is stated to be a Property Week event.
- (e) [www.propertyweek.com/resi](http://www.propertyweek.com/resi) is a webpage by Property Week about residential property news and features. Extracts are exhibited at HJS4. “RESI” is one of the menu options across the top of the website page. On page 51 the website advertises the RESI convention 2018 referred to above. One of the links to an article on page 49 is headed “RESI trailblazers showcase sector’s entrepreneurialism.”
- (f) [www.resiawards.com](http://www.resiawards.com) is a website about the RESI Awards 2018 organised by Property Week and also announcing the dates for the 2019 awards. It states it celebrates the residential property market. Ms Strube states that an affiliate of the previous owner of Property Week, UBM plc, is the recorded proprietor of EU trade mark 8405599, which is a stylised mark featuring the word RESI registered in classes 9, 35 and 41. Evidence of the EU trade mark is exhibited at HJS4 together with the press release announcing the sale of Property Week print magazine and related products by UBM plc to Metropolis International. In essence the evidence tends to show that it is the same operator behind Property Week, the RESI convention and the RESI awards.
- (g) [www.primeresi.com](http://www.primeresi.com) is a link to a webpage for the Prime Resi Journal of Luxury Property. The extracts at HJS5 state that it is “*the leading news, insight & opinion resources for the UK’s prime residential sector.*”

- (h) [www.resi-safe.uk](http://www.resi-safe.uk) is a website for RESI-SAFE UK Residential Safety Services. The webpages at HJS6 state it is a business providing residential health and safety solutions such as fire safety risk assessments and health and safety risk assessments specialising in residential buildings.
- (i) [www.resiinvestment.com](http://www.resiinvestment.com) is a website for a Residential Investment Conference also referred to as “The 2018 UK Resi Investment Conference” as shown at HJS7. At page 89 it refers to the “Resi Investment Sector”, “Resi sector” and “Resi Investment Market.” [www.resifunding.com](http://www.resifunding.com) advertises an annual “Resi Development Funding Conference,” run by the same company, LD Events. The exhibited website extracts here refer to “Resi Funding Update”, “leading players in Resi Development Sector”, “Resi Market”, “Resi Investment & Debt Funding Market,” and “where Resi fits as a Property asset class.” Ms Strube states:
- “Although these webpages also include a number of references to Resi as an apparent abbreviation of “Residential” this isolated example is inconsistent with the trade mark use elsewhere on the webpage and in no way sufficient to demonstrate acceptance of the abbreviation in the relevant industry.”*
- (j) [www.resi-analysts.com](http://www.resi-analysts.com) links to a webpage, exhibited at HJS8, to a business called “Residential Analysts” providing data-led research, analysis and reporting on the UK housing market. It refers to comment and reports being provided by “Resi Analysts” and a twitter handle of “@resi\_analyst.”
- (k) [www.architectsjournal.co.uk/news/office-to-resi-conversions-producing-poor-quality-housing-report-warns/10030599.article](http://www.architectsjournal.co.uk/news/office-to-resi-conversions-producing-poor-quality-housing-report-warns/10030599.article), exhibited at HJS9, is an article on the Architect’s Journal website available by subscription only. Ms Strube comments that the article is likely to be aimed at

professional architects rather than the average consumer of the services in question.

10. In general Ms Strube states that none of this evidence shows substantial or material generic or descriptive use or otherwise, of RESI as an abbreviation of residential or otherwise in relation to the services at issue. She states it merely shows a handful of isolated instances of RESI being used as part of a third party brand name across a broad range of industries. She says the evidence is not sufficient to conclude that RESI is the industry wide accepted abbreviation of the word residential or that the term is or has become customary in the current language of the relevant industry as that abbreviation, as the applicant suggests.
11. HJS10 and HJS11 are extracts from the applicant's website exhibited to demonstrate that it states the applicant's company was established in 2017 and to show that the "Project" and "News" pages of his website were, as at that time, empty/unpopulated. Ms Strube states this evidence is relevant to the applicant's arguments about honest concurrent use.
12. I will return to the relevant parts of the evidence and the parties' wider submissions as to its relevance at the most pertinent places within my decision below.

### **Section 5(2)(b) – the principles**

13. Section 5(2)(b) of the Act states:

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

14. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:
- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
  - (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
  - (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
  - (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
  - (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
  - (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;



- (g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of services**

#### *The legal principles*

15. When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*, the CJEU stated at paragraph 23 of its judgment:

“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”.

16. Guidance on this issue has also come from Jacob J. (as he then was) in the *British Sugar Plc v James Robertson & Sons Limited* [1996] R.P.C. 281 (often referred to as the “*Treat*” case), 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;
- (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.”

17. I also remind myself of the guidance given by the courts on the correct interpretation of specifications. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated:

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

18. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) OHIM*) case T-133/05, the General Court (“GC”) stated:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II- 4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T110/01 *Vedial V OHIM France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

*The parties’ submissions*

19. The competing specifications are as follows:

<b>Opponent’s services</b>	<b>Applicant’s services</b>
<u>Class 35:</u> Advertising and marketing services all relating to property management services, sale, letting, construction and maintenance of properties.	
<u>Class 36:</u> Financial services; real estate agency services; financial services provided via the Internet; financial services related to house purchase; real estate administration, property rental and property management services; real estate affairs; real estate affairs services; administration of financial affairs relating to real estate; providing information relating to real estate affairs; real estate financing; financial services related to real estate; arranging of shared ownership of real estate.	<u>Class 36:</u> Corporate real estate advisory services.

20. The opponent argues that the competing class 36 services are identical as the applied for services are included/subsumed within (sub) categories of their registered services and/or they are synonymous with their registered services. Alternatively, the opponent submits the competing services are highly similar, sharing a common nature, purpose, origin and/or end consumer and are competitive or complementary. The opponent also submits its class 35 specification includes similar/ complementary services to the applicant's class 36 specification.
  
21. The applicant submits that the tribunal should not compare the services by reference to registered specifications within the NICE classification system, but should do so by reference to the evidence as to the parties' actual trading. He argues that the parties have different, opposite, and distinct classes of end users. The opponent's services are provided to homeowners and first-time buyers of residential property/ social housing. His own services are provided to residential property developers. He argues that the opponent's end-users would seldom, if ever, use, be able to use, need or encounter his own services. He similarly also argues that the uses, physical nature of the acts of service, and respective trade channels of the parties are starkly different such that the services are not identical or similar in any way. In support of his argument that the comparison should focus on the parties' actual services, the applicant relies on paragraph (f) of the guidance in the *Treat* case, set out above. He emphasises the statement that the enquiry "may take into account how those in the trade classify the services".

### *Findings*

22. I cannot adopt the approach advocated by the applicant when assessing similarity of services. This is not a case in which the opponent is required to provide proof of use of their registered mark. Until a trade mark has been registered for 5 years, it is entitled to protection in relation to all the goods/services for which it is registered. This means that the opponent's earlier mark is protected for the services for which it is registered without the opponent having to prove use of its mark for all of those services. When

comparing the services in play I must therefore compare notional and fair use across the full width of the specifications, even if the earlier mark may not, in fact, be in use across that full specification. This concept of notional use was explained in *Compass Publishing BV v Compass Logistics Ltd* ([2004] RPC 41). It was said at paragraph 22:

“It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer’s use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of the goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place.”<sup>3</sup>

23. The quote from the *Treat* case relied upon by the applicant is not an indication that the comparison of services should focus upon the specifics of actual use by the parties when trading. The factors identified in *Treat* are a guide to assist the assessment of similarity of goods or services in competing specifications. For example, in *Treat* the court found there was no similarity between jam and a dessert sauce. This was based in part, on evidence that market research companies regarded the products as falling within different sectors. The court was addressing how the trade in question as a whole would consider and classify the competing products of jam and a dessert sauce, and what the ordinary and natural meaning of those terms would be in that field of

---

<sup>3</sup> See also the decision of the Court of Appeal in *Roger Maier v ASOS* [2015] EWCA Civ 220 at [78] and [85].

trade<sup>4</sup>; not the particular trading activities and intentions of the parties to the dispute.

24. Here, applying the principle of notional fair use for the competing specifications, I find there is identity between the parties' services. The applicant's applied for services are "corporate real estate advisory services." In *AgriCapital Corp v OHIM* T-514/13 the General Court defined "real estate services" as "services connected with a property, namely, in particular, the lease, the purchase, the sale or the management of a property."<sup>5</sup> Here, the ordinary, natural meaning of the applicant's specification would, in my view, be the provision of an advice service for businesses/ commercial clients who are engaged in buying, selling, leasing or other activities relating to the ownership or management of a property.
25. The opponent's registered services include "real estate affairs" and "real estate affairs services." These are synonymous. Again, focusing on the ordinary, natural meaning of these terms, services for real estate affairs would include assisting both members of the public and business/commercial clients with their real estate needs such as buying, selling, leasing or managing a property. Such assistance would inevitably include advisory services about such activities. As such, based on the principle in *Meric* outlined above, the applicant's "corporate real estate advisory services" would be encompassed by and fall within the opponent's broader terms of "real estate affairs" and "real estate affairs services." The terms are therefore identical. The opponent's "providing information relating to real estate affairs" is likewise identical as real estate advisory services would include the provision of information relating to real estate affairs.
26. If I am incorrect then the terms would in any event be highly similar. Both have businesses/commercial clients as a group of end-users and the nature of the

---

<sup>4</sup> As was also said by Jacobs J in *Treat*: "in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade."

<sup>5</sup> Adopting the same analysis as their earlier decision in *Metropolis Inmobiliarias y Restauraciones v OHIM — MIP Metro (METRO)*, T-197/12.

services overlap as set out above. For such a group of end-users the trade channels would be the same (including face to face, online and by telephone), and the services would be considered competitive by average consumers.

27. In view of this identity/ high similarity, I do not intend to compare the applicant's applied for specification with the remainder of the opponent's class 36 and 35 specification. The identical/highly similar services identified represent the opponent's best case. The remainder of this decision addressing the opponent's opposition therefore proceeds on the basis of identity or high similarity of services between "real estate affairs" / "providing information relating to real estate affairs" and "corporate real estate advisory services."
  
28. For completeness, I note that the applicant also refers to what, as from 14 January 2019, is now section 60A of the Trade Mark Act 1994<sup>6</sup>. This provides that services are not to be regarded as similar to each other solely on the ground that they appear in the same class under the NICE Classification (or dissimilar where they appear in different classes). The applicant relies on this in support of his argument that opponent cannot simply rely upon its specification to establish similarity of services, rather than looking at the services the parties are actually providing. This provision was not in force when the opposition was launched, however, in any event, this amendment simply codifies rather than alters the existing state of the law. Section 60A confirms that services cannot be said to be similar simply because they coincide in the same class. Instead, the tribunal must undertake a comparison of the competing specifications, applying notional fair use and the case law principles. This has already been undertaken above and Section 60A does not affect the position.

---

<sup>6</sup> As inserted by regulation 29 of the Trade Marks Regulations 2018 giving effect to the EU Trade Mark Directive 2015.

## **The average consumer and the purchasing act**

29. It is necessary for me to determine who the average consumer is for the services in play. I must then determine the manner in which these services are likely to be selected by the average consumer in the course of trade. 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: *Lloyd Schufabrik Meyer, Case C-342/97*. 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), Bliss J. 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.”

30. The average consumer of the applicant's services is likely to be a business/commercial client seeking professional advisory services for a property related issue. The specification is for real estate advisory services at large (albeit for corporate customers as opposed to members of the public). Therefore, average consumers will include professional customers whose interest in the services relates to residential property (for example a commercial investment in a residential development) and those whose interest lies solely in property for commercial use (such as office blocks or retail premises). Such a professional customer is generally likely to pay an above average level of attention when selecting a service provider, bearing in mind business decisions relating to property can have a significant value and implications for a business



and also bearing in mind they are concerned with a property issue they have already decided requires specialist advice.

31. The opponent's "real estate affairs" and "providing information relating to real estate affairs" services will include services connected with a property, such as buying, selling, renting or managing a property, both for members of the general public and businesses/ commercial clients, including advisory services and information services. For business/commercial clients it will similarly cover both residential property and commercial property orientated services. Those services which are associated with large amounts of money or long-term business or personal financial decisions will be chosen with a high amount of care. The level of attention may be slightly lower for transactions with a smaller financial or more short-term impact. However, overall, for all average consumers, the level of attention will be at least above average.
32. In all cases the selection of service provider may be made visually from signage, websites, brochures, prospectuses, visual media advertisements, customer reviews and other marketing materials. However, the potential impact of aural exposure to the marks should not be ignored in a sector in which aural recommendations may well play an important role. There may be aural exposure to the mark in, for example, a bank, or via a broker, financial advisor or other intermediary whether in person or by telephone or in face to face or telephone dealings with the service provider themselves.

### **Comparison of trade marks**

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

34. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by them.

35. The series of trade marks to be compared are<sup>7</sup>:

Earlier Mark	Applied for Mark
SO RESI	London Resi
SO Resi	London RESI
So Resi	

*The parties' submissions*

36. The opponent argues that the marks are highly similar. They assert that “Resi” is the dominant and prominent element in the marks, and that it is inherently distinctive as it is not generic or descriptive of the services in question. They submit that “London” in the applicant’s marks is negligible and non-distinctive as it is descriptive of the geographical origin/characteristics of the services in question. They state that “Resi” is capable of performing the essential function of a trade mark in denoting commercial origin, whereas “London” is not and has no trade mark impact.

---

<sup>7</sup> I note that within his evidence and submissions the applicant attempts to draw a distinction between the parties’ logos which incorporate device elements. However, they are not the marks in play and are not relevant to this opposition.

37. The opponent submits that “So” should be given its natural meaning and will be perceived by the average consumer as the English adverb. They provide a dictionary definition. They state that due to its position in the earlier marks, the “So” has the effect of further emphasising the dominant/prominent “Resi” element. They argue that the “So” is not negligible in the earlier marks but is comparatively speaking less prominent than “Resi” due to its length, adverbial meaning, and emphasising effect. They advocate for a high degree of visual and aural similarity between the competing marks and submit a conceptual comparison is not possible as “Resi” has no conceptual meaning.
38. In relation to the applicant’s evidence, the opponent argues the evidence does not show any material or substantial generic or descriptive use of “Resi” as an abbreviation of residential in relation to the relevant services and there is not sufficient evidence to conclude that “Resi” is an industry wide accepted abbreviation. They state that “Resi” is not recognised as a word in the dictionary either in its own right or as an abbreviation for “residential.” They submit the applicant’s evidence and submissions about the parties’ websites and alleged activities is irrelevant and flawed.
39. The applicant argues that the opponent’s approach artificially dissects the marks as opposed to undertaking a whole mark comparison. He submits that the arguments about London being a geographical origin have no relevance to the opposition as it conflates principles from a section 3(1)(c) absolute grounds challenge with the 5(2)(b) opposition and that the Registrar must have examined his marks for such issues before publishing them in the Trade Marks Journal.
40. The applicant concedes that “London” does denote the origin from where the applicant’s services are provided and/or is a geographical indication to the area to which the services relate but that the word is not negligible, it is inseparable from the whole mark, and is capable of registration. The applicant submits that “London” hangs together with “Resi” to form a whole, and that the distinctiveness of both parties’ marks lies in their precise word combinations. He refers, in support, to the decision of the European Court in C-383/99 *Proctor*

*and Gamble v OHIM* where “baby-dry” for nappies was not prohibited from registration as being purely descriptive.

41. In relation to the opponent’s mark, the applicant argues that the average consumer would not mistake “So” for the adverb but would instead understand it to be a reference to “Shared Ownership.” The applicant argues that even an individual with no knowledge of the industry would appreciate that meaning because of the references to Shared Ownership on the opponent’s website, which are also thrown up if one undertakes a google search for “So Resi”. He argues that this would be even clearer to a reasonably well informed and reasonably circumspect and observant consumer who would further study the opponent’s services and in doing so appreciate what the “So” represents. The opponent disputes that the average consumer would perceive “So” as a reference to Shared Ownership.
42. The applicant argues that “Resi” as a single component is devoid of distinctiveness as it is the industry wide accepted abbreviation of the word residential, or is common parlance for the word residential, or is widely associated with residential real estate in the property industry, or at the very least a widely used term in relation to residential real estate across various industries. The applicant refers to the evidence in that regard and submits “Resi” is not inherently distinctive or dominant or devoid of conceptual meaning. He submits that the opponent does not have a trade mark for “Resi” alone and that to undertake a mark comparison based on that word alone, in effect, grants a monopoly to the opponent and leaves both marks devoid of distinctiveness. Overall, he submits the marks compared as a whole are not similar.

### *Overall Impression*

43. Each party relies on a series of word marks which apply differing capitalisation patterns to the same words. A word trade mark registration protects the words themselves written in any normal font and irrespective of capitalisation or

highlighting in bold<sup>8</sup>. As such the differences in either parties' series is immaterial for the purposes of this opposition. In this decision I will therefore refer to the parties' marks as "So Resi" and "London Resi", but my decision applies equally to all the marks in the parties' respective series.

44. The earlier mark consists of two words: "So Resi." The first word "So" in the earlier mark will be understood as the standard English word. I do not agree the average consumer will understand it to be a reference to "Shared Ownership." I am concerned here with notional use of the mark across the full width of "real estate affairs" and not just shared ownership services. Further, there is no evidence before me that even a reasonably circumspect and observant average consumer would always search for the opponent's mark on google, before deciding which service provider to instruct, let alone that they would unpick that meaning from further research on the opponent's website.
45. Some average consumers would perceive "Resi" to be a reference to "residential", which, in such a context is of low distinctiveness. The "So" serves to intensify or emphasise the "Resi" such that the overall impression is of the mark's owner providing a service specialising in residential property in some way. The words form a unitary phrase. Neither word dominates the other or is negligible in the overall impression formed which rests in the whole mark.
46. Other average consumers may see "Resi" as an invented word with greater distinctiveness. Their overall impression is a unitary phrase, albeit a somewhat mysterious one, with the "So" emphasising or intensifying the "Resi", which itself has no meaning. Again, the overall impression rests in the phrase and neither word dominates the other or is negligible.
47. The applied for mark consists of two words: "London Resi." For average consumers who perceive "Resi" as a reference to residential, the combination will mean residential services in London. Both components individually and in

---

<sup>8</sup> See the decision of the Appointed Person in 0-158-17 *Bentley Motors Limited* and the case law referred to therein at paragraph [16].

combination in such a context will have low distinctiveness. However, neither word is negligible or dominates the other. Both words play roughly an equal role in hanging together to give an overall mental image of a business specialising in residential property operating out of, or serving clients in, the city of London.

48. For average consumers who do not perceive “Resi” to have a meaning, London will be seen as a geographical descriptor and “Resi” as the more distinctive element with no obvious overarching unitary meaning. Despite being the first word, “London” will therefore carry less weight in the overall impression formed by these average consumers. However, it will not be completely overlooked and it is not negligible. “Resi” will play a greater role in the overall impression.

#### *Visual and Aural Comparison*

49. The visual and aural similarity lies in the common second component “Resi.” The visual and aural differences are created by the marks having first words that look and sound very different from each other. Aurally the marks would be enunciated in full, notwithstanding the fact that “So” is a short relatively common word, or that “London” may be geographically descriptive. The first words are also visually and aurally of differing lengths (2 letters / 1 syllable for “So” and 6 letters / 2 syllables for “London”) which creates a further difference. It is a general rule of thumb that the beginning of word marks make more of a visual and aural impression than their endings. This is, however, not always the case and each must be assessed on its own facts<sup>9</sup>. Here, I find this applies more to “London” than “So” given the respective length of those words and that of the second component “Resi”. That provides a further point of difference between the marks.
50. However, visually and aurally the “Resi” component will still be noticed in both marks in terms of the overall impression created. The differences therefore do not completely outweigh the similarity caused by the common second

---

<sup>9</sup> See for example the judgment of the General Court in *CureVac GmbH v OHIM* case T-80/08

component. Overall there is a medium degree of visual and aural similarity between the marks.

### *Conceptual comparison*

51. I am assessing here the opponent's best case of identical/highly similar services of "corporate real estate advisory services" against "real estate affair" and "providing information relating to real estate affairs." Conceptually the parties dispute whether the average consumer will perceive "Resi" as an abbreviation or reference to "residential."
52. The evidence filed (placing to one side that which relates to the US), shows "Resi" being used in the branding of various services related to residential property. Some, are targeted at the general public. Others, are targeted far more widely. For example, the conferences, awards and online residential property journals would be targeted at a mix of professionals involved in the residential property industry including property/land agents, landlords, financiers, insurers, architects, developers, housing providers, housebuilders, lawyers, investors, planners, building managers, and lettings managers. I do not place significant weight on the evidence or any particular part of it. However, the evidence as a whole does at least confirm what is my own view that "Resi" is a word that particularly some professional/business individuals involved in or exposed to the residential property industry would perceive as a reference to the word 'residential'. Many of the professional individuals identified above could be seeking real estate affairs services, the provision of information relating to real estate affairs or corporate real estate advisory services and therefore fall within the pool of average consumers.
53. The evidence, however does not, in my view, establish that all average consumers, both the general public and professional customers, would have that understanding. As set out above, the notional services in play relate to real estate at large which covers both commercial and residential property services. Some business/commercial customers may therefore operate in the commercial property market alone, which may limit their knowledge and

understanding. A small business looking for one off assistance with a short lease for their business premises, for example, may not be exposed to information that would, in some way, cause them to understand that “Resi” may be a reference to “residential.” Further, some customers from the general public seeking advice/assistance with domestic housing related issues are unlikely to appreciate the reference, notwithstanding they may be seeking advice or assistance with a residential property issue.

54. Therefore some average consumers are likely to perceive “Resi” as a reference to or an abbreviation of “residential” and some will not, and will perceive it as an invented word.
55. For those average consumers who understand “Resi” to be a reference to the word ‘residential’, both marks share the concept of a business specialising in residential property, with the added concept of residential property in London, in the case of the applied for mark. There is a high degree of conceptual similarity.
56. For average consumers who do not consider “Resi” to have a meaning, for the earlier mark, the limited concept offered at best is a vague, mysterious one, of a service provider focussing on or specialising in “Resi”, whatever that may be. For the applied for mark, to the limited extent that any concept is offered, it would be the notion of a London version or branch of “Resi”, whatever that may be. Neither mark creates a definite, cohesive concept in the minds of the average consumer. A conceptual comparison is therefore not possible.
57. The opponent points out that “Resi” could be an acronym for part of the name of the applicant’s limited company: London **R**eal **E**state **S**olutions Incorporation Limited [my emphasis]. I consider that requires a level of unpicking that the average consumer would not undertake.



## **Distinctive character of the earlier trade mark**

58. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of general use made, the greater the likelihood of confusion (see *Sabel BV v Puma AG*, paragraph 24). 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 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).”

57. The opponent did not file evidence of use and does not claim enhanced distinctiveness through use so I need only consider the inherent position. The opponent submits that the earlier mark is not descriptive and that the “Resi” component is an invented word, giving the mark a high degree of inherent distinctiveness. The applicant submits that “Resi” will be understood as

referring to “Residential” and that it is descriptive for many of the opponent’s services. He states that the “So” only serves to intensify this, such that the mark is not distinctive.

58. It is a general rule of thumb that invented words usually have the highest level of distinctiveness; words which are allusive of the goods usually have less. For average consumers who understand “Resi” to refer to the word ‘residential’, as a component “Resi” has low distinctiveness as it is at least highly allusive for some of the property services in play. The addition of “So” and the interplay between the two components adds to the distinctiveness of the mark as a whole, raising it to an above low, but less than average degree of distinctiveness. For those average consumers who see Resi as an invented word, the earlier mark will, as a whole (and indeed the “Resi” component), have a high degree of inherent distinctiveness.

### **Likelihood of confusion**

#### *The legal principles*

59. The factors considered above have a degree of interdependency (*Canon* at [17]), so that a higher degree of similarity between the services may offset a lower degree of similarity between the marks, and vice versa. I must make a global assessment of the competing factors (*Sabel* at [22]), considering them from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).
60. Confusion can be direct or indirect. In *L.A. Sugar Limited v By Back Beat Inc*; Case BL O/375/10 Mr. Iain Purvis Q.C., sitting as the Appointed Person, explained these types of confusion as follows:

“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 recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

61. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/1 the Appointed Person emphasised that the examples given by Mr Purvis in *L.A. Sugar* were intended to be illustrative in the context of that case, and not to impose rigid rules.<sup>10</sup> The categories of case where indirect confusion may be found are not closed. Each case must be assessed on its own facts and the assessment must take account of the overall impression created by the marks. The Appointed Person emphasised the importance of envisaging the instinctive reaction in the mind of the average consumer when encountering the later mark with an imperfect recollection of the earlier. Ultimately, the assessment is whether the average consumer will make a connection between the marks and assume that the goods or services in question are from the same or economically linked undertakings. He stressed that a finding of indirect confusion should not be made simply because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

#### *The parties' submissions*

62. The opponent submits there is a strong likelihood of confusion. They say that "London" is devoid of trade mark impact and only "Resi" functions as an indicator of trade origin in the applicant's mark when viewed as a whole. The opponent further submits that due to the generic nature of the geographic descriptor "London", there is a strong likelihood that consumers will be confused into believing that the applicant's mark is a sub brand of, or otherwise associated with the opponent's brand. They refer to their operations and activities in London and that these have recently increased significantly following their partnering with another London based housing association; Metropolitan Housing Trust. They provide a website link which they state contains further information.
63. The applicant argues that direct confusion is unlikely because "London" and "So" do not play a negligible role in their respective marks and that the average

---

<sup>10</sup> See Paragraphs [81] to [82]

consumer will perceive the marks as a whole and notice the differences. He submits the average consumer will also not confuse the marks because “Resi” will be understood as referring to residential real estate. He argues the inherent distinctiveness of both marks derives from the whole marks and the different combinations of words used. He submits that the opponent cannot enjoy the protection of exclusive use of “Resi”, as that is not their registered mark, or argue that any use of it will give rise to a likelihood of confusion.

64. The applicant further submits that indirect confusion is also highly unlikely as the nature of the parties’ services and the end users are different. He argues that the opponent always uses “So” as part of their branding variants, which would be noticeably missing from his applied for mark. He submits that this, together with the fact that “Resi” is descriptive and commonly used in the industry means that the average consumer would not confuse London Resi as being a sub brand of So Resi. He refers by analogy to an Irish Patent Office case of *Smullen v Gourmet Burger Kitchen* [2011] E.T.M.R. 27 in which it was held “Gourmet Burger Kompany” would be differentiated by the average consumer from “Gourmet Burger Kitchen.” The applicant argues that the average consumer here will likewise not think that the parties are economically linked undertakings or sub-brands and that any mere association (if at all) between the marks as a result of the “Resi” component is not sufficient to find a likelihood of confusion.

### *Decision*

65. I have found the opponent’s best case lies with its “real estate affairs” and “providing information relating to real estate affairs” services compared against the applicant’s “corporate real estate advisory services”. These are identical or highly similar services and therefore have the capacity to off-set a lower degree of similarity between the marks. The services will be selected with a higher degree of attention than the norm, which could mitigate to some extent, the effect of imperfect recollection. I have found the selection process will have both visual and aural considerations.

66. I have identified two types of average consumer (1) the general public and (2) professional customers. Within each category I have found some average consumers would perceive that “Resi” refers to ‘residential’ used in relation to property services and some would not. For those average consumers who do not perceive “Resi” to have a meaning the earlier mark has a high degree of distinctiveness. For those average consumers who do appreciate the meaning of “Resi” the earlier mark, as a whole, has an above low but less than average degree of distinctiveness. However, for these average consumers, the “Resi” component itself has low distinctiveness. As the Appointed Person explained in *Kurt Geiger v A-List Corporate Limited*, BL O-075-1 when assessing the likelihood of confusion, it is the distinctive character of the common element that of most importance. It was said:

“...if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

*Likelihood of confusion for those average consumers who understand “Resi” to have a meaning*

67. For those average consumers who perceive “Resi” as referring to residential, “Resi” is a weak element in both marks. I take into account that confusion may still be likely on the basis of a shared weak element.<sup>11</sup> However, as Arnold J. noted in *Whyte and Mackay*<sup>12</sup>:

---

<sup>11</sup>See *L’Oreal SA v Office for the Harmonisation of the Internal Market (Trade Marks and Designs) (OHIM) Case C-235/05 P* at [45] and *Zero Industry Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) Case T-400/06* at [71] to [75].

<sup>12</sup> *Whyte and Mackay Limited v Origin Wine UK Limited* [2015] EWHC 1271 (Ch) and as approved in *Nicoventures Holdings Limited v The London Vape Company* [2017] EWHC 3393 (Ch)

“what can be said with confidence is that, if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.”

68. Each case must ultimately be assessed on its own facts, weighing all the interdependent factors. Here, I do not consider there is a likelihood of direct confusion for such average consumers. Even taking into account imperfect recollection and the fact that average consumers rarely have the chance to compare marks side by side, the respective marks look and sound too different for such average consumers paying an above average degree of attention to mistake or misremember the marks. In the applied for mark, whilst “London” itself is descriptive, “Resi” is also at least highly allusive for some of the services and both components have low distinctiveness. In the earlier mark, the “So” acts as an intensifier of the allusive “Resi” element which again has low distinctiveness as a component. For both marks, the average consumer is therefore unlikely to rely on one particular component alone when forming a mental image of marks that contain elements with low distinctiveness. The overall impression of both marks therefore incorporates the noticeably different first words of “So” and “London”. The high conceptual similarity found would not outweigh the visual and aural differences when the concept itself is at least highly allusive and resides in a common component with low distinctiveness.
69. Turning to indirect confusion, I likewise do not consider that such an average consumer will make an assumption of shared economic origin on the basis of a component that has little distinctiveness. Those who see a descriptive or allusive meaning to “Resi” would not attach trade origin significance to that word alone in the context of either mark as a whole. The average consumer will, in my view, believe that the two marks are the responsibility of two separate residential property related undertakings who have chosen to make use of the allusive word. The average consumer will put any similarity down to coincidence and not to economic connection.

*Likelihood of confusion for those average consumers who do not understand “Resi” to have a meaning*

70. For those average consumers who see “Resi” as an invented word, I likewise consider that there is no likelihood of direct confusion. Notwithstanding that “Resi” is for such consumers, is a highly distinctive common element, the visual and aural differences between the marks, caused by the differing first word components, is sufficient to mean that the such an average consumer is unlikely to mistake or miss-recall one for the other. This is the case despite the fact that in the applied for mark “London” has low distinctiveness and “Resi” plays the greater role. If the average consumer has an overall impression in mind which takes account to some degree the other non-negligible component (as I have found for “London”, particularly bearing in mind that it is the first word and a long word compared to “Resi”) then they will notice the differences sufficiently to prevent direct confusion arising.
71. However, I do consider there is a likelihood of indirect confusion. For both marks such an average consumer, whilst noticing the whole, will see “Resi” as important in indicating trade origin. The instinctive reaction will be that the respective marks are variants or sub-brands or that overall the services in question are from economically linked undertakings and that the sharing of “Resi” is indicative of a same stable service provider. The change of first component from “So” to “London” will be seen as logical and consistent with the development of a regionalised London “Resi” branch, and an associated marketing decision to drop the “So.” The average consumer will not engage in extended thought processes about how a trade mark might be developed for variant brands, however, their instinctive reactions are influenced by their experiences and anticipations, which here would be that service providers in the real estate service market do branch out into specific geographic regions. The fact that “So Resi” may be perceived as a unitary mark would not prevent such a reaction amongst average consumers in circumstances where the “So”s function in the mark is to emphasise the “Resi” component.



72. I note the applicant's argument the parties' end users are different and would not cross over. The difficulty for the applicant is that, as set out at paragraphs 30, 31, 52 and 53 above, the services in play on a fair and notional basis relate to the real estate market at large which includes both residential and commercial property services. For both parties the average consumer base includes professional/business customers. I have found, for the reasons set out above, that not all professional/business customers would appreciate "Resi" to be a reference to "residential", particularly those, for example, who are seeking services in the commercial property arena. I can see no reason for concluding that such consumers, exposed to the opponent's mark in the course of trade could not also be exposed to the applicant's mark when later seeking a provider for corporate real estate advisory services (or vice versa). Hence the potential for confusion could arise amongst a sufficiently significantly sized proportion of the total average consumer base and a finding for such a proportion is sufficient for the opposition to succeed. The absence of a likelihood of confusion for other groups of average consumers cannot change that overall outcome<sup>13</sup>.

### **Final remarks**

73. For completeness I will confirm my view on the following arguments from the parties' submissions.

(a) The applicant emphasised in his submissions that "London Resi" hangs together as a unit with its distinctiveness resting in the phrase as a whole. As set out above, in my view for those average consumers who do not perceive "Resi" to have a meaning "Resi" will have independent distinctiveness as a component. For completeness, however, I note that even if I accept the applicant's contention that they form a unitary phrase evoking, for example, a

---

<sup>13</sup> The test as set out by the Court of Appeal in *Interflora Inc v Marks and Spencer plc* [2014] EWCA Civ. See also *SoulCycle Inc v Matalan Ltd* [2017] EWHC 496 (Ch) where Mr. Justice Mann similarly found that confusion could be considered in relation to a proportion of the class of average consumer by reference to their perceptions of the marks, subject to them representing a significant proportion of the total relevant public.

London branch of “Resi” it would not change my conclusion that a sufficient proportion of the average consumer base would consider they are economically linked undertakings, for the reasons already given.

- (b) The applicant placed into evidence the opponent’s use of variant branding that incorporates the “So”, arguing that this points against a likelihood of confusion as the average consumer would expect the “So” to be included in any variant branding. This evidence does not affect my conclusions as to indirect confusion and I have not taken it into account. I must assess on a notional basis the average consumer’s likely instinctive reaction to the registered and applied for marks across the specifications in play. The various logos shown for the opponent are not the earlier mark that I am concerned with and the opponent has not pleaded reliance on a family of marks. Moreover, any actual use of variant branding, does not mean that on a notional assessment the average consumer would require the “So” to be present to conclude that the marks are from economically linked undertakings. In my view, they would not. Likewise, the opponent’s submission (which was unsupported by evidence) as to their activities in London with the Metropolitan Housing Trust are irrelevant to my assessment and have not been taken into account.
- (c) The applicant states that he is not aware of any instances of confusion between the marks at issue. In *Roger Maier and Another v ASOS* [2015] EWCA Civ 220, Kitchen L.J. stated that:

“80. [...] the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent

or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur”.

In my view the latter observations are applicable here. There is very limited evidence regarding use of either mark as registered/applied for. Moreover, it does not mirror the notional use assessment that must be made in these proceedings. Overall the evidence does not allow me to determine whether there has been a real opportunity for confusion to occur. The argument therefore does not assist the applicant.

- (d) The applicant also relies on honest concurrent use. The opponent argues the applicant has not evidenced use on a substantial scale and for a substantial period of time and it is not demonstrated by mere incorporation of his company and registration of a domain name. They argue that the applicant’s own website states that he was established in 2017 and no evidence has been filed of past or present commercial activity. The main thrust of this defence is that longstanding concurrent use has led to a situation in which there will no longer be any (or at least a reduced) adverse impact upon the essential distinguishing function of the trade mark<sup>14</sup>. It requires, amongst other things, evidence that the parties have traded in circumstances where the relevant public has shown itself able in fact to distinguish between services bearing the marks in question i.e. without confusing them as to trade origin. The evidence filed falls far short of demonstrating this. On the applicant’s best evidence, he has been trading since 2014, a period of at most 4 years. The geographical extent of use by the parties is unclear but the level of use that I am aware of will have had little, if any, impact on the likelihood of confusion and would not remove or reduce the potential adverse effect on the essential distinguishing function. Further, the nature of use shown of the marks does not reflect the notional test before the tribunal. Again, the argument does not assist the applicant.

---

<sup>14</sup> See for example *Budejovicky Budvar NP v AnheuserBusch Inc*, Case C-482/09 and *Victoria Plum Limited (trading as “Victoria Plumb”) v Victorian Pluming Limited and others* [201] EWHC 2911 (Ch)

- (e) Reference has been made in both parties' submissions as to the distinctiveness of the other's mark and their validity. The applicant has indicated he could bring invalidity proceedings which are not in train. The opponent refers to section 3(1)(c) of the Act where an absolute ground for refusal of registration can be where a trade mark consists exclusively of a sign or indication which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or rendering of services, or other characteristics of goods or services. The pleaded opposition was, however, brought under section 5(2)(b) alone. My decision is based on that ground alone and my comments and conclusions above about how either of the marks or component of a mark may be perceived (or indeed my conclusions about distinctiveness) relate only to that assessment of a likelihood of confusion. I make no findings under section 3 of the Act as it is not the pleaded case before me.

## **Conclusion**

74. The opposition to trade mark application number 3250330 therefore succeeds and registration is refused.

## **Costs**

75. The opponent has succeeded in its opposition and is entitled to a contribution towards its costs. Applying Tribunal Practice Note (TPN) 2/2016 I award the following contribution:

- |  |      |
|--|------|
| • Official fees  | £100 |
| • Preparing a statement and considering the other side's statement               | £200 |
| • Preparing evidence and considering and commenting on the other side's evidence | £500 |
| • Preparation of submissions   | £300 |

- **Total** **£1100**

76. I order Ahmed Jumrati Adrian Shazad to pay Thames Valley Housing Association Limited the sum of £1100 as a contribution towards its costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case, if any appeal against this decision is unsuccessful.

**Dated 4 March 2019**

**Rachel Harfield**  
**For the Registrar**