

o/0410/25

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001728473

DESIGNATING THE UK

BY CENTROTEC SE



IN CLASSES 11 AND 36

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 443795

BY RAYMOND PHILIP HARWOOD, DOREEN EVELYN HARWOOD

AND PAUL RAYMOND HARWOOD

BACKGROUND AND PLEADINGS

1. International trade mark 1728473 (“the IR”) consists of the sign shown on the cover page of this decision. The holder is CENTROTEC SE. The IR is registered with effect from 6 April 2023. With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The holder seeks protection for the IR in relation to the goods and services contained in Annex 1 of this decision.

2. The request to protect the IR was published on 28 July 2023. On 24 October 2023, Raymond Philip Harwood, Doreen Evelyn Harwood and Paul Raymond Harwood (“the opponents”) partially opposed protection of the IR in the UK based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”), and is directed against the following services:

Class 36 Financial services; private equity fund investment services; financial investments; financial management; financial advice.¹

3. Under sections 5(2)(b) and 5(3), the opponents rely upon the following trade marks:

CENTRO

UK registration no. UK00003099164

Filing date 13 March 2015; Registration date 26 June 2015.

(“The First Earlier Mark”)



¹ In an official letter dated 27 January 2024, the opponents were made aware that the holder’s class 36 specification had been limited to the above terms (with the terms “real estate services” and “financial brokerage services for real estate” removed). However, in an email dated 7 February 2024, the opponents’ maintained their opposition.


UK registration no. UK00003099166

Filing date 13 March 2015; Registration date 19 June 2015.

(“The Second Earlier Mark”)

4. Under section 5(2)(b), the opponents rely upon all of the services for which the earlier marks are registered, which are contained in Annex 2 to this decision. The opponent claims that there is a likelihood of confusion because the marks are highly similar and the parties’ services are identical or similar. They also state that their mark has acquired enhanced distinctiveness which increases the risk of confusion.

5. Under section 5(3), the opponents rely upon all of its services contained in Annex 2 to this decision. The opponents’ claim that their marks have been used extensively, and have a significant reputation in the UK, and thus the public will think there is a link between the parties’ highly similar marks. They also claim that the holder would be “able to ride on the coattails” of the opponents and gain the benefit associated with its marks, “without incurring the associated costs of developing or maintaining such a reputation”. This would mean that the holder would be taking unfair advantage of the opponents’ marks. Moreover, the opponents claim that use of the holder’s IR would be detrimental to the opponents’ reputation, for example, if the holder’s services were not of the same standard, and if the holder’s brand image is inferior in nature, it could create disparagement or a negative association to the opponents’ brand. Lastly, the opponents claim that use of the holder’s IR “may be detrimental by way of erosion or dilution of distinctiveness” of the opponents’ marks.

6. Under section 5(4)(a), the opponents rely upon their **CENTRO** and  signs which they claim to have used throughout the UK since 1997 for the management of commercial premises, management of retail premises, management of offices, provision of office and business management for commercial and residential facilities, reception services and management, the bringing together, for the benefit of others, a variety of retail outlets and services provider outlets namely entertainment, housing and business facilities, enabling customers to conveniently purchase goods and make use of such services in a built community environment, secretarial services, accounting, telephone answering, document reproduction, photocopying, word processing, typing, transcription, business information, office machines and

equipment rental, property acquisition and sale, property management and administration, property portfolio management and administration, property and capital investment, property appraisals and valuations, property brokerage, estate management, advisory and information services all relating to the aforesaid, rental of property, rental of housing accommodation, rental of retail premises, rental of offices, rental of industrial premises, rental of retail warehouses, leasing of property, leasing of housing accommodation, leasing of retail premises, leasing of offices, leasing of industrial premises, leasing of retail warehouses, arranging leases for the aforesaid, rent collection services, provision of housing accommodation, provision of retail space, provision of office space, provision of industrial space, provision of retail warehouse space, financial services, construction, maintenance, repair, renovation, supervision and assessment of buildings, alteration and renovation of buildings, development of sites for commercial, industrial and for residential purposes, real estate development, landscaping services, building management services, facilities management services, building refurbishment services, provision of maintenance services to properties being managed.

7. The holder filed a counterstatement denying all of the claims made, and put the opponents to proof of use for both earlier marks.

8. The opponents are represented by Groom Wilkes & Wright LLP and the holder is represented by Reddie & Grose LLP. The opponents filed evidence in chief. Neither party requested a hearing but both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

RELEVANCE OF EU LAW

9. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

10. The opponents' evidence consists of the witness statement of Raymond Philip Harwood dated 28 February 2024. Mr Harwood is a joint proprietor of the earlier mark, and the Chairman, Managing Director and co-founder of Centro Plc (and its subsidiary companies). Mr Harwood's statement is accompanied by 16 exhibits (RPH1-RPH16).

11. Whilst I do not propose to summarise it here, I have taken all of the evidence and the parties' submissions into consideration in reaching my decision and will refer to them where necessary below.

DECISION

Section 5(2)(b)

12. Section 5(2)(b) reads as follows:

“5(2) A trade mark shall not be registered if because –

(a)...

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

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

13. The opponents' marks qualify as earlier marks in accordance with section 6(1)(a) of the Act as their filing dates are earlier than the designation date of the holder's IR. As the opponents' marks had completed their registration process more than five years before the designation date of the IR in issue, they are subject to proof of use pursuant to section 6A of the Act.

Proof of use

14. I will begin by assessing whether there has been genuine use of the earlier mark. The relevant statutory provisions are as follows:

15. Section 6A of the Act states:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) 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.

(5)-(5A) [Repealed]

(6) 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.”

16. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier marks is the five years ending on the designation date of the holder’s IR, i.e. 7 April 2018 to 6 April 2022.

17. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky* [2008] ECR I-

9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

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

at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

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

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

Evidence of use

18. Mr Harwood confirms that Centro Services Limited, Centro Group Limited, Centro Commercial Limited and Centro Residential Sales and Lettings Limited are subsidiaries of Centro Plc, and that himself and his joint proprietors (Doreen Evelyn Harwood and Paul Raymond Harwood) have provided consent to Centro Plc and its subsidiary companies to use the opponents' First and Second Earlier Marks.

19. On this basis, Mr Harwood's evidence demonstrates that Centro and its subsidiaries have provided property consultancy and real estate services during the relevant period, via its centro.plc.uk website.² This is supported by the following revenue figures for services supplied under the CENTRO trade mark, which Mr Harwood states includes "buying, selling and investing in letting residential and commercial property, and providing management services" in the UK:³

Year	Revenue Figures (£)
2018	3,163,311
2019	3,630,346
2020	4,127,959
2021	4,152,569
2022	4,472,383
2023	4,216,481

20. **Exhibit EPH5** contains 14 invoices which are dated between 13 September 2017 and 18 March 2022. Albeit the customers details and their property locations are redacted, the address for "Centro Residential Sales and Lettings Limited" and "Centro Commercial Limited" is based in Surrey. The invoices also list the following services that have been provided by Centro to its clients:

- The exchange and completion of properties. The total of these invoices vary between £3,852.00 and £17,400.00.
- The renewal of a tenancy agreement document for £75.00.
- The initial fee to act on a clients behalf in the letting of a premises for £1,200.00.

² **Exhibit RPH3**

³ I note that this table is supported by extracts from the opponents' Annual Reports and consolidated financial statements contained in **exhibit RPH4**.

- The receiving of instructions in respect of letting a property, attending, inspecting and advising on the value of a property and the general marketing of it, “forwarding sales particulars to applicants, local and regional occupiers” and the introduction, negotiation, and agreeing a transaction price for the rental of a property amounting to £6,22.87.
- The preparation and supply of a Standard Solicitors Enquiry Pack. The total of these invoices vary between £402.00 and £456.00.
- A “registration fee” which Mr Harwood confirms is the service fee for the registering of a new client. The total of these invoices vary between £148.80 and £312.00.
- Rent, heating and service charge for March to June 2020 amounting to £25,564.64.
- Rent, heating and service charge for June to September 2021 amounting to £25,564.64.
- The work in relation to the extension of a lease amounting to £300.00.

21. I also note that the following marks are used on the above invoices:



22. **Exhibit RPH11** contains 1 example of a Centro letting form dated 5 December 2022. This is a 20 page agreement between the landlord of the property and Centro (acting as the agent). The “declaration” part of this form includes that the signee authorises one of Centro’s subsidiaries to act on their behalf in the letting and management of their property and that they will pay the rent collection and management fees where applicable. I also note that the form lists Centro’s services, which are also reflected within the “terms and conditions” pages, including that Centro will provide an initial rental assessment of the property, market and advertise the property, negotiate terms of the property, the collection of a security deposit, the collection of rent (which they pay to the landlord once they have deducted their “Tenant

find fees”), negotiating the renewal of tenancies, acting as a point between tenant and landlord, the arrangement of repairs and maintenance to the property, arranging periodic certificates to comply with regulations and negotiating deductions from a deposit at the end of the tenancy.⁴ The form also includes a “tenancy set up table” which includes the costs of writing the tenancy agreement and an inventory/check out report. Mr Harwood has drawn my attention to the section of the form headed “money laundering regulations 2007” which states that for Centro to comply with these regulations, they require proof from the landlord that they own the property. On this basis, Mr Harwood states that Centro is responsible for conducting investigations into money laundering requirements, and is thus apart of the financial services that they provide.

23. The above is supported by **exhibit RPH13** which includes “Centro” headed work orders in respect of various maintenance and building works that they have commissioned and managed from 23 May 2017 to 21 June 2022. I note that these include the investigation of water ingress, the inspection of lights in a block of flats, and the extension of a sleeper by the garage area. I also note that all of these are for one set of flats based in Surrey.

24. Mr Harwood also states that that the Centro and its subsidiaries provides property management services, which encompasses day to day property management, maintenance management, company secretarial duties, debt recovery and lease extensions. Its maintenance management services includes gardening, cleaning and decorating client’s properties and facilities management, which includes the testing of emergency lights in flats, and installation of electrical and safety monitoring of equipment making sure they are in accordance with health and safety regulations. Whilst I do not have any supporting exhibited evidence to demonstrate that Centro provides these services, Mr Harwood submits that the above property management services are funded through their clients (the freeholders and lessees of the property) via Centro’s fees, ground rent, building insurance and contractors’ fees. This is done via an assessment of the required expenditure, which creates a budget, which is then

⁴ In the body of the form, these jobs are listed under the headings “find tenant service”, “rent collection” and “full management”.

sent to those who will be paying for these services. This is shown in **exhibit RPH6** which includes 16 letters sent to Centro's clients which include a draft budget for the financial year, that needs the client's approval. The letters state that once they have approval, it will enable Centro to "invoice lessees, ahead of the due date, in the usual way". I note that these example letters are dated between 24 August 2017 to 29 July 2022, and that 6 letters all dated 21 February 2024 show confirmation of "interim service charges" from 2018 to 2022 being paid. All of these letters use the "centro" marks contained in paragraph 21 above, and they show that Centro's clients are based in London, Sutton and Surrey.

25. Mr Harwood confirms that once the budget is approved, service charge statements are issued to the lessees, and at the end of the financial year, Centro "arrange for the service charge accounts to be produced by a Chartered Accountant and then sent to the freeholder and/or lessees". **Exhibit RPH7** contains 5 of these letters dated 16 March 2018 to 16 March 2022 and 6 letters all dated 21 February 2024 show confirmation of "rent", "interim service charges" and "annual insurance" from 2018 to 2022 being charged and paid. Again, these letters use the "centro" marks contained in paragraph 21 above, and are addressed to lessees based in Cambridge and Kent.

26. Mr Harwood states that Centro also arranges and provides building insurance, acting on behalf of the freeholders and lessees. I find that this is reflected in the annual "insurance charges" that are referred to in the invoices above. Mr Harwood also states that to provide this service, an insurance assessment is carried out which is tabulated into a portfolio form. At **exhibit RPH8**, I have been provided with spreadsheets illustrating the insurance assessments dated between June 2020 and June 2022 that Centro has conducted for some of their property portfolios. Under the column "insured", "Centro Group Limited" and "Centro Plc" is listed next to some of the properties, with the calculations of its premiums amounting to between £280.00 to £26,475.42. This information is supported by **exhibit RPH9** which contains 8 insurance renewal letters dated 30 May 2019 to 8 June 2022, all addressed to client's in Surrey, which contains information such as the standard policy excess being increased, and the renewal premium increasing, for example. I bear in mind that Mr Harwood states that the "procurement of the actual insurance involves a schedule of requirement in a brokerage format sent to insurance brokers who go to the market and

assess the financial contribution by way of premium to be collected across our property portfolios for the provision of insurance”. This is supported by the above exhibited insurance renewal letters which consistently refers to either Centro sticking with its “existing insurers, NIG”, or Centro’s “brokers” approaching other insurance companies for better rates. I note that these letters again use the “centro” mark contained in paragraph 21 above. Furthermore, Mr Harwood states that the above “goes beyond simply going to that of a broker [...] we negotiate an overall premium cost for the entire portfolio and then are able, with the insurer’s consent, to allocate the element of the total costs to each individual property. In that sense we carry out a direct financial brokering and underwriting activity”.

27. In his witness statement, Mr Harwood states that Centro also provides financial services relating to mortgages, as they “introduce purchasers of properties to [the] mortgage broker, AWS Financial Services Limited, with whom [they] have a partnership agreement in order to obtain a mortgage for a property purchase”.⁵ This is supported by **exhibit RPH10** which contains emails headed “financial services referral from Centro” dated between May 2019 and 10 January 2022. The body of the emails all refer to applicants who would like to arrange a meeting to discuss their mortgage requirements.⁶ This exhibit also contains a “list of clients referred to mortgage broker AWS Financial Services Ltd” from 11 May 2018 to 5 April 2022.

28. Moreover, Mr Harwood states that Centro provides legal services, such as conveyancing, because they have a partnership agreement with the Conveyancer William Michael of Taylor Rose MW solicitors. **Exhibit RPH12** contains emails headed as “solicitor referral from Centro” dated between 4 June 2019 and 2 February 2022. The emails all state that they have “details of an applicant would like to arrange a meeting to discuss their conveyancing requirements”.

29. Mr Harwood has provided me with the following advertisements figures which were made using the Centro’s marks from 2019 to 2023 in the UK:

⁵ An undated screenshot from the opponents’ website in **exhibit RPH10** also confirms that Centro recommends “the award-winning Ashley Slade Managing Director of AWS financial services to all” of their clients.

⁶ I note that the “from email” seems to be from a “christiesworld.com” email address. However, **exhibit RPH2** is an article from 2018 which confirms that Centro brought out the estate agency “Christies”.

Year	Advertising Expenditure (£)
2019	15,819
2020	16,370
2021	17,815
2022	23,625
2023	17,290

30. The above is supported by undated photo examples of Centro's advertising contained in **exhibit RPH14**. However, in his witness statement, Mr Harwood confirms that the marketing material has been used from 2018 "to the present time". This exhibit includes photos of cars, signage on offices, business cards, headed paper (which has been used for all the documents referred to above), and property listing flyers. I also note that this exhibit includes a map of 23 Centro highway signs which have been placed in the Surrey area, supported by a photo of a sign placed at a roundabout. I note that all of the marketing material clearly uses the marks contained in paragraph 21 above.

31. Lastly, **exhibit RPH16** contains reviews from trustpilot.com. It shows that Centro has 51 reviews, with an average of 4.2 stars. The reviews are dated between 19 February and 3 May 2023, and the site confirms that all of the reviews have been made from Great Britain.

Form of the mark

32. The evidence I have outlined above includes instances of the following variants of the opponents' marks:

1. 

2. 

33. Variant 1 consists of the word “CeNTRO”, with the letter “e” presented in lower case, with the rest of the letters presented in upper case (albeit they are all same size). I also bear in mind that fair and notional use of a word only mark covers use in any standard typeface, including presenting the marks in upper and lower-case, or any customary combination of the two. I therefore find that variant 1 is acceptable use of the opponents’ First Earlier Mark.

34. Variant 2 consists of a white letter “C”, with the background in the centre of it presented in a grey, and the white word “CeNTRO” presented underneath it against a black background. I find that the only difference between variant 2 and the Second Earlier mark is the colour combination, with variant 2 being the black, grey and white version of the opponents’ Second Earlier Mark (which is presented in red, black and white). However, I find that the combination of the colours red, black and white in the Second Earlier Mark do not have distinctive character within itself, nor is the distinctive character of the Second Earlier Mark altered because the contrast of shades is clearly respected within the variant.⁷ On this basis, I consider that variant 2 is acceptable use of the Second Earlier Mark.

Assessment of genuine use

35. As I have found the mark used in the evidence to be acceptable, I will now consider an assessment of genuine use. This is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.⁸

36. As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.⁹

⁷ *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22

⁸ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

⁹ *Jumpman* BL O/222/16

37. I bear in mind that all of the exhibited invoices, forms, letters and statements to landlords and lessees determine that Centro operates from a single premise in Surrey which imposes a certain geographical constraint on the potential market. I recall the comments of Mr Daniel Alexander QC, sitting as the Appointed Person, in *Intermar Simanto v Nike Innovate CV (JUMPMAN Trade Mark)*, BL O-222-16 whereby at [23] he stated that “... *it is no objection to the continued registration of a national trade mark that the mark has only been used in a limited location.*” However, the evidence clearly shows that Centro’s clients are based in Surrey, London, Sutton, Cambridge and Kent. It also shows that its services were being purchased throughout the relevant period and by different customers/properties (this is especially highlighted by the insurance portfolio evidence). This is supported by Centro’s UK sales figures for 2018 to 2022 amounting to £19,546,558.00 and its UK advertising figures for 2019 to 2022 amounting to £73,629. I am therefore satisfied that the First and Second Earlier Marks have been put to genuine use in the UK in relation to a variety real estate services during the relevant period.

Fair Specification

38. I must now consider whether, or the extent to which, the evidence shows use of the goods relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

39. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 (“Asos”) at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.

40. Clearly, the evidence shows that Centro provides residential sales and letting services, which allows owners to either sell their properties, or landlords to rent their properties. To facilitate the rental of their properties, Centro markets them, writes tenancy agreements, collects security deposits and rent, negotiates the renewal of tenancies, arranges the of repairs and maintenance to the property, and negotiates deductions from deposit at the end of the tenancy. I bear in mind that the First and Second Earlier Marks have renting and leasing services listed in their class 36 specifications. However, based on the language used throughout Mr Harwood's witness statement and the evidence, including that Centro provides "letting services", the references to the "rental property" and its "tenants" and the "collection of rent", I find that it is reasonable to infer that Centro is a letting agent which facilitates agreements between landlords and tenants to rent residential properties. Therefore, taking all of the above into account, I find that the opponents' have shown use of its marks on the following class 36 terms in its First and Second Earlier Marks specifications: *property sale; property management and administration; property brokerage; rental of property and rent collection services*.

41. The above is also supported by the Centro lettings form mentioned in paragraph 22 above. I note that in this document, Mr Harwood drew my attention to the headed section "money laundering regulations 2007", stating that Centro conducts these investigations into money laundering requirements which is therefore apart of the financial services it provides. However, complying with the aforementioned regulations is a legal requirement when accepting money from a client, and thus I do not deem it as a financial service.

42. Whilst Centro arranges the repairs and maintenance of a property, I do not find that the opponents' have shown use of the term "construction, maintenance, repair, renovation, supervision and assessment of buildings" or "provision of maintenance services to properties being managed" in class 37. This is on the basis that the evidence is not wholly clear whether this service is being conducted by Centro or not. The lettings form, under the "full management" heading, states the Centro is to "obtain estimates and arrange routine repairs and instruct approved contractors" and under the "full management service" heading, in paragraphs 3.8 to 3.12 it states that Centro will "organise any minor repairs, maintenance or replacement to the property" and its

contents, but that Centro “does not undertake to supervise minor repairs or any other works”, “except in an emergency”. Therefore, taking all of the above into account, I consider it is reasonable to infer that Centro mainly contacts and organises for third parties to carry out the repairs and maintenance to their lettings properties (rather than providing that service themselves).

43. Mr Harwood also states that Centro arranges and provides building insurance. However, the evidence, specifically the exhibited insurance renewal letters, shows that Centro acts as facilitator, obtaining the insurance from “NIG”, which is consistently referred to as their “existing insurers”. Thus, Centro is not providing an insurance service (they only create a portfolio and negotiate costs with the insurer, who provides the insurance). Mr Harwood also states that Centro provides financial and legal services, being mortgage brokering services and conveyancing services. However, the evidence in paragraphs 27 and 28 above shows that Centro has an agreement with AWS Financial Services Limited and William Michael of Taylor Rose MW solicitors, who provides mortgage brokering and conveyancing services to Centro’s customers, respectively. Thus, as noted by the holder in its submissions in lieu, Centro “simply refer their clients to separate, economically unrelated entities who provide such services” and, consequently, the opponents’ have not shown use of these services.

44. There has been no evidence to show that the Centro has provided any of the services in its class 35 specifications. There is no evidence of them providing management specifically to commercial, retail or office premises. There is no evidence before me to show that Centro has provided reception services, secretarial services, accounting, telephone answering, document reproduction, transcription, business information or office machines and equipment rental. As there is no evidence of use of these services, the opponents’ are unable to rely upon these terms. There has also been no evidence filed to show that Centro has provided the remaining services in class 36, that being the provision of rental space, office space, industrial space and retail warehouse space. Moreover, there has been no evidence filed to show that Centro has provided the remaining services in its class 37 specifications, that being the renovation of buildings, development sites, real estate development, landscaping and building refurbishment.

45. Therefore, taking the above into account, I consider a fair specification of the First and Second Earlier Marks to be:

Class 36 Property sale; property management and administration; property brokerage; rental of property; rent collection services.

Section 5(2)(b) - case law

46. In making this decision, I bear in mind the following principles gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is

permissible to make the comparison solely on the basis of the dominant elements;

- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

47. The competing services are as follows:

Opponents' services	Holder's services
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<p><u>First Earlier Mark</u></p> <p><u>Class 36</u></p> <p>Property sale; property management and administration; property brokerage; rental of property; rent collection services.</p> <p><u>Second Earlier Mark</u></p> <p><u>Class 36</u></p> <p>Property sale; property management and administration; property brokerage; rental of property; rent collection services.</p>	<p><u>Class 36</u></p> <p>Financial services; private equity fund investment services; financial investments; financial management; financial advice.</p>
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48. When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;

- (d) The respective trade channels through which the goods or services reach the market;
- (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.

50. I bear in mind the following applicable principles of interpretation of terms within a specification from the judgement of *Sky v Skykick* [2024] UKSC 36:

“365. I agree with Sir Christopher Floyd and the other members of the Court of Appeal on this issue. The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] RPC 40, at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specifications of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case.”

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

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

Financial services.

52. I find that “financial services” is very broad term which would encompass any services that enables a person or business to manage their finances, for example, accountancy, investment banking, credit cards, mortgage loans and pension funds. I also find that financial services would be provided by financial institutions such as banks and finance brokers. Whilst I note that the opponents’ services, including the sale and acquisition of property, the rental of property and rent collection services can include financial transactions, I do not find that, at their core, they are financial services. Instead, they are real estate services (services which relate to property, making it available for potential buyers or tenants, and acting as an intermediary). Therefore the parties’ services do not overlap in nature, purpose or method of use. Moreover, the opponents’ services would be provided by real estate and letting agencies, to landlords, in order to get paid for providing accommodation. Therefore, the services do not overlap in trade channels. They are also neither in competition, nor complementary, in the way described by the case law cited above. Lastly, whilst the services may overlap in user, this is not enough on its own to establish similarity. Therefore, taking all of the above into account, I find that the parties’ services are dissimilar.

Financial management.

53. Financial management refers to the organising and controlling of an undertakings or an individual’s finances. For some undertakings, the primary goal of financial management will be to maximise profit. Nonetheless, I find that these services do not overlap in nature, method of use or purpose with any of the opponents’ services, all of which relate to real estate. The services do not overlap in trade channels because the holder’s services would be provided by an undertaking which specialises in financial management, whereas the opponents’ services are provided by real estate and letting agencies. The services are neither in competition, nor complementary, and whilst the

services may overlap in user, this is not enough on its own to establish similarity. On this basis, I find that the parties' services are dissimilar.

Private equity fund investment services; financial investments.

54. The holder's above services pertain to the investment of money (for profit). I therefore do not consider that these services are similar to the opponents' services, all of which relate to real estate. Whilst I note that the opponents' services, including the sale and acquisition of property, could include transactions made by users who want to invest their money into property, I do not find that, at their core, they are investment services. I therefore find that these services do not overlap in nature, method of use or purpose. The holder's services would be provided by investment specialists, and therefore do not overlap in trade channels with the opponents' services. The services are also neither in competition, nor complementary, in the way described by the case law cited above. Whilst the services may overlap in user, this is not enough on its own to establish similarity and therefore, I find that the parties' services are dissimilar.

Financial advice.

55. The holder's above services provides users with advice based on their financial situations. These services would be provided by financial advisers and therefore do not overlap in trade channels with the opponents' services, all of which relate to real estate. Whilst I note that the applicant's services could include advice to individuals such as to how to get a mortgage, these services, at their core, are not real estate services. I find that these services do not overlap in nature, method of use or purpose. They are also neither in competition, nor complementary, in the way described by the case law cited above. Whilst the services may overlap in user, this is not enough on its own to establish similarity. Consequently, the parties' services are dissimilar.

Conclusion of the services comparison

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

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

57. As established in the case law above, for there to be a likelihood of confusion between the marks under section 5(2)(b), there has to be a finding of similarity between the services. Since I have determined that they are not similar, the opposition under section 5(2)(b) fails here.

Section 5(3)

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

“5(3) A trade mark which –

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

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

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

60. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

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

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

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

(f) Detriment to the distinctive character of the earlier mark occurs when the mark’s ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that

this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

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

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

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

61. The conditions of section 5(3) are cumulative. Firstly, the opponents' and holder's marks must be identical or similar. Secondly, the opponents must show that its earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must have established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the opponents' marks being brought to mind by the later mark. Fourthly, assuming that the first, second and third conditions have been met, section 5(3) requires that one or more types of damage claimed will occur. It is unnecessary for the purposes of section

5(3) that the services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks. The relevant date for the assessment under section 5(3) is the designation date of the holder's IR, i.e. 6 April 2023.

Reputation

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

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

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

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

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

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

64. The opponents submit that their earlier marks have a reputation. This means that it must be known by a significant proportion of the relevant public, which includes institutions and individuals with capital to invest in property. However, in my view, the evidence has a number of shortcomings in this regard.

65. The opponents' strongest evidence is its revenue figures provided for 2018 to 2022 which amount to £19,546,558.00, albeit I have not been provided with a breakdown to show the proportion of turnover that can be attributed to each of Centro's services. I note that the services which are evidenced within the exhibited invoices and letters shows that Centro facilitates the exchange and completion of properties and provides property management and letting services (including acting on behalf of, and receiving instructions from landlords, drawing up renewal tenancy agreements and rent and service charges). I find that all of these can be categorised as real estate services. I bear in mind that some of these services are relatively expensive (as highlighted by the invoice amounts), and although I have not been provided with Centro's market share, based on the revenue figure above, I consider that it would only amount to a small proportion of the real estate market (which is a very large sector). Moreover, I note that the majority of the exhibited letters and invoices were sent to Surrey (where Centro's offices are based) and therefore the geographical spread of the mark across the UK is clearly very limited. I also bear in mind that some of Centro's invoices and letters have redacted its clients names, and I have not been provided with the number of clients that Centro has had since 2017. Therefore, I have been given no indication as to the number of clients who were aware of Centro's marks and using their real estate services.

66. Centro's UK advertising figures for 2019 to 2022 amounts to £73,629, which is notable, albeit this is only supported by undated photos of their advertisements such as business cards, signage for offices and highway signs. Whilst Mr Harwood states this marketing material been used from 2018, I have, nevertheless, not been provided with any evidence to confirm, for example, how many business cards were distributed to customers (existing and potential), and I bear in mind that all 23 highway signs were placed in the Surrey area, again, showing that use of the marks were not geographically spread.

67. Therefore, taking the above into account, I find that the evidence is not persuasive in showing that a significant part of the relevant public knew of the First and Second Earlier Marks at the relevant date. I consider that the evidence is therefore insufficient to establish a reputation in the UK, and, consequently, the opposition based upon section 5(3) falls at the first hurdle.

68. However, if I am wrong in my above finding, and the opponents' evidence is enough to establish a reputation, I find that due to the deficiencies listed above, at most it would only establish a limited reputation. I therefore find that this, in combination with the dissimilarity of the parties' services, means that the relevant public would not make a link between the parties' marks. The services are entirely different in nature, purpose, method of use and trade channels. Notwithstanding the fact that the services may overlap in user, I find that the parties' services are far too removed from one another, and the opponents' limited reputation would not be strong enough to bridge the gap between them.

69. As I have also found there to be no link, the opposition based upon section 5(3) is dismissed.

Section 5(4)(a)

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

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

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

aa)...

b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

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

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

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

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

Relevant date

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

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows: ‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’”

74. As the holder has filed no evidence of use, I have only the prima facie relevant date to consider i.e. 6 April 2023.

Goodwill

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

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

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

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the

enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97* as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; 54 evidence as to the manner in which the goods are traded or the services supplied; and so on.

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

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

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

78. Goodwill arises as a result of trading activities, and it is clear from the turnover figures provided, that Centro has been trading under its signs since 2017.

79. Although I have not been provided with a breakdown of its sales figures by its real estate services, I have been provided with UK sales for 2018 to 2022 which amounts to £19,546,558.00. I note that the majority of the opponents' evidence relates to property brokerage, including property sale, property management and administration,

and the rental of properties (including collecting rent). It is therefore likely that a significant proportion of its above turnover figure will relate to these services.

80. In terms of the opponents' remaining services, which are contained in Annex 2 to this decision, there is little to no evidence pertaining to them. As noted in paragraphs 42 and 43 above, the evidence which pertains to maintenance work, insurance, mortgage brokering and conveyancing services only shows that Centro uses third parties to provide these services; they do not provide them themselves. I have not been provided with any evidence pertaining to the management of commercial, retail or office premises, nor is there any evidence in regard to reception services, secretarial services, accounting, telephone answering, document reproduction, transcription, business information or office machines and equipment rental. I also have not been provided with evidence of Centro providing office space, industrial space and retail warehouse space, or that they renovate buildings, or that they provide landscaping and building refurbishment. Consequently, due to the lack of evidence, I do not consider that the opponents have demonstrated goodwill for the remaining services at the relevant date.

81. Taking the evidence as a whole into account, I am satisfied that Centro has a modest degree of goodwill prior to the relevant date in relation to property brokerage, property sale, property management and administration, rental of property and rent collection services, which are all terms the opponents' rely upon under section 5(4)(a). Examples have been provided of the marks being used on invoices and letters, and in light of this, I am satisfied that the Centro signs were distinctive of that goodwill at the relevant date.

Misrepresentation and damage

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

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]”

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

And later in the same judgment:

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

83. I recognise that the test for misrepresentation is different from that for likelihood of confusion in that it entails “deception of a substantial number of members of the public” rather than “confusion of the average consumer”.

84. However, as recognised by Lewison L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that to be the case here.

85. I have found that the services for which Centro has shown goodwill, which can be categorised as real estate services, are dissimilar to the holder's “financial services”, “private equity fund investment services”, “financial investments”, “financial management” and “financial advice”. I note that, per *Harrods Limited v Harrodian*

School Limited,¹⁰ this does not preclude a successful section 5(4)(a) claim. However, I also bear in mind that in *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that;

‘even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.’

In the same case Stephenson L.J. said at page 547:

‘...in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, **is a heavy burden**; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. **When the alleged “passer off” seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.**’ ” (my emphasis)

86. Therefore, taking all of the above into account, I consider that the differences between the parties' services would be sufficient to avoid misrepresentation occurring. This is on the basis that the fields of activity that the opponents operate in is not close enough to the fields of activity that the applicant operates in. Consequently, I consider

¹⁰ [1996] RPC 697 (CA)

that these differences are sufficient to avoid a substantial number of members of the relevant public purchasing the holder's services in the mistaken belief that they are provided by the opponents' business (which only has a modest degree of goodwill). As there is no misrepresentation, there can be no damage.

87. The opposition under section 5(4)(a) fails.

CONCLUSION

88. The opposition is unsuccessful, and the application may proceed to registration.

COSTS

89. The holder has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the holder the sum of **£600** as a contribution towards the costs of the proceedings.

90. The sum is calculated as follows:

Considering the Notice of opposition and preparing a counterstatement	£250
Preparing and filing written submissions in lieu of a hearing	£350
Total	£600

91. I therefore order Raymond Philip Harwood, Doreen Evelyn Harwood and Paul Raymond Harwood to pay CENTROTEC SE the sum of £600. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 2nd day of May 2025

L FAYTER

For the Registrar

ANNEX 1

Class 11

Apparatus for heating, steam generating, refrigerating, drying, ventilating and air conditioning; air ionisation apparatus; gas scrubbing apparatus; air filtering installations; airconditioning systems, including for vehicles; boiler pipes (tubes) for heating installations; heating exhaust gas conduits; chimney flues; regulating accessories for water or gas apparatus and pipes; chimney blowers; heat pumps and heat regenerators; heat accumulators; heat exchangers; parts for the aforesaid goods, included in this class; solar collectors and parts therefor.

Class 36

Financial services; private equity fund investment services; financial investments; financial management; financial advice.

ANNEX 2

The First Earlier Mark

Class 35

Management of commercial premises; management of retail premises; management of offices; provision of office and business management for commercial and residential facilities; reception services and management; the bringing together, for the benefit of others, a variety of retail outlets and services provider outlets namely entertainment, housing and business facilities, enabling customers to conveniently purchase goods and make use of such services in a built community environment; secretarial services; accounting; telephone answering; document reproduction, photocopying, word processing, typing, transcription; business information; office machines and equipment rental.

Class 36

Property acquisition and sale; property management and administration; property portfolio management and administration; property and capital investment; property appraisals and valuations; property brokerage; estate management; advisory and information services all relating to the aforesaid; rental of property; rental of housing accommodation; rental of retail premises; rental of offices; rental of industrial premises; rental of retail warehouses; leasing of property; leasing of housing accommodation; leasing of retail premises; leasing of offices; leasing of industrial premises; leasing of retail warehouses; arranging leases for the aforesaid; rent collection services; provision of housing accommodation; provision of retail space; provision of office space; provision of industrial space; provision of retail warehouse space; financial services.

Class 37

Construction, maintenance, repair, renovation, supervision and assessment of buildings; alteration and renovation of buildings; development of sites for commercial, industrial and for residential purposes; real estate development; landscaping services; building management services; facilities management services; building refurbishment services; provision of maintenance services to properties being managed.

The Second Earlier Mark

Class 35

Management of commercial premises; management of retail premises; management of offices; provision of office and business management for commercial and residential facilities; reception services and management; the bringing together, for the benefit of others, a variety of retail outlets and services provider outlets namely entertainment, housing and business facilities, enabling customers to conveniently purchase goods and make use of such services in a built community environment; secretarial services; accounting; telephone answering; document reproduction, photocopying, word processing, typing, transcription; business information; office machines and equipment rental.

Class 36

Property acquisition and sale; property management and administration; property portfolio management and administration; property and capital investment; property appraisals and valuations; property brokerage; estate management; advisory and information services all relating to the aforesaid; rental of property; rental of housing accommodation; rental of retail premises; rental of offices; rental of industrial premises; rental of retail warehouses; leasing of property; leasing of housing accommodation; leasing of retail premises; leasing of offices; leasing of industrial premises; leasing of retail warehouses; arranging leases for the aforesaid; rent collection services; provision of housing accommodation; provision of retail space; provision of office space; provision of industrial space; provision of retail warehouse space; financial services.

Class 37

Construction, maintenance, repair, renovation, supervision and assessment of buildings; alteration and renovation of buildings; development of sites for commercial, industrial and for residential purposes; real estate development; landscaping services; building management services; facilities management services; building refurbishment services; provision of maintenance services to properties being managed.

ANNEX 2

Management of commercial premises; management of retail premises; management of offices; provision of office and business management for commercial and residential facilities; reception services and management; the bringing together, for the benefit of others, a variety of retail outlets and services provider outlets namely entertainment, housing and business facilities, enabling customers to conveniently purchase goods and make use of such services in a built community environment; secretarial services; accounting; telephone answering; document reproduction, photocopying, word processing, typing, transcription; business information; office machines and equipment rental; property portfolio management and administration; property and capital investment; property appraisals and valuations; estate management; advisory and information services all relating to the aforesaid; rental of housing accommodation; rental of retail premises; rental of offices; rental of industrial premises; rental of retail warehouses; leasing of property; leasing of housing accommodation; leasing of retail premises; leasing of offices; leasing of industrial premises; leasing of retail warehouses; arranging leases for the aforesaid; provision of housing accommodation; provision of retail space; provision of office space; provision of industrial space; provision of retail warehouse space; financial services; construction, maintenance, repair, renovation, supervision and assessment of buildings; alteration and renovation of buildings; development of sites for commercial, industrial and for residential purposes; real estate development; landscaping services; building management services; facilities management services; building refurbishment services; provision of maintenance services to properties being managed.