

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATIONS NOS 3,105,699 and 3,106,193 IN THE NAME OF BARCLAYS BANK PLC

AND IN THE MATTER OF AN APPEAL FROM THE DECISIONS OF ANN CORBETT DATED 21 MARCH 2017 (0/126/17)

DECISION

Introduction

1. This is an appeal from the decision of Mrs Ann Corbett, for the Registrar, dated 21st March 2017 in which she partially dismissed and partially upheld the opposition of Rise Construction Management Ltd, Rise Management Consulting International Limited, Rise Investment Ltd and Rise Management Consulting Limited to Barclays Bank plc's applications numbered 3,105,699 and 3,106,193. The Rise group relied on its earlier trade mark numbered 259,331.
2. The Opposition was based on sections 5(1), 5(2)(a) and (b) and 5(3) and 5(4)(a) of the Trade Marks Act 1994. However, at the Hearing below the opponent "did not focus" on section 5(1) or 5(2)(a). As these grounds were not considered or pursued before me, I take this to mean they were withdrawn. Barclays Bank now appeals and the Rise group cross-appeals.
3. Under application number 3,105,699 Barclays Bank applied to register the word RISE and under application number 3,106,193 applied to register the series mark:



4. All these marks were applied for in Classes 35 and 43 for the following services:

Class 35

Office function services; business research for emerging and start up businesses; advisory services relating to company accounts, advertising, marketing, product development and product manufacturing, in particular for emerging business, start-up businesses and small and medium

sized enterprises; assistance services relating to franchising, commercial enterprises and industrial enterprises; organisation of trade fairs for commercial or advertising purposes; appraisal and evaluation of business opportunities; advice relating to the creation of new commercial opportunities by bringing together businesses; office machines and equipment rental; organising of exhibitions and trade fairs for commercial purposes; information services relating to all of the aforesaid services; none of the aforesaid services including the provision of management consultancy or project management.

Class 43

Event facilities and temporary office and meeting facilities; hospitality services; rental of meeting rooms; rental of temporary accommodation; provision of temporary work accommodation; rental of other temporary office space; rental of furniture, linens and table settings; providing facilities for fairs, conventions, exhibitions, seminars and conferences; accommodation reservations; reservation services for meetings rooms; reservation services for other temporary office space; catering services; information services relating to all of the aforesaid services; none of the aforesaid services including the provision of management consultancy or project management.

5. The Rise group had the following earlier trade mark (No 2,593,331):



6. This mark was registered for the following services in class 35:

Class 35

Management consulting; project management; business construction management services

Standard of appeal

7. The principles applicable on appeal from the registrar were considered in *TT Education Ltd v Pie Corbett Consultancy* [2017] ETMR 26 by Daniel Alexander QC sitting as the Appointed Person. These principles have now been approved and applied by the High Court; see for instance: *Royal Mint Ltd v The Commonwealth Mint and Philatelic Bureau Ltd* [2017] EWHC 417 (Ch) at paragraph 18 and *Apple Inc v Arcadia Trading Ltd* [2017] EWHC 440 (Ch) at paragraph 11.
8. Mr Alexander summarised the position at paragraph 52 of his Decision (I made a few minor updates to this summary in *Grill'O Express* (O/140/17), paragraph 6, which I have incorporated in square brackets):

52. Drawing these threads together, so far as relevant for the present case, the principles can therefore be summarized as follows.

- (i) Appeals to the Appointed Person are limited to a review of the decision of Registrar (CPR [52.21]). The Appointed Person will overturn a decision of the Registrar if, but only if, it is wrong ([...][CPR 52.21]).
- (ii) The approach required depends on the nature of decision in question (*REEF*). There is spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision. At one end of the spectrum are decisions of primary fact reached after an evaluation of oral evidence where credibility is in issue and purely discretionary decisions. Further along the spectrum are multi-factorial decisions often dependent on inferences and an analysis of documentary material (*REEF*, *DuPont*).
- (iii) In the case of conclusions on primary facts it is only in a rare case, such as where that conclusion was one for which there was no evidence in support, which was based on a misunderstanding of the evidence, or which no reasonable judge could have reached, that the Appointed Person should interfere with it (*Re: B and others*).

- (iv) In the case of a multifactorial assessment or evaluation, the Appointed Person should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions. In particular, where an Appointed Person has doubts as to whether the Registrar was right, he or she should consider with particular care whether the decision really was wrong or whether it is just not one which the appellate court would have made in a situation where reasonable people may differ as to the outcome of such a multifactorial evaluation (*REEF, BUD, Fine & Country and others*).
- (v) Situations where the Registrar's decision will be treated as wrong encompass those in which a decision is (a) unsupportable, (b) simply wrong (c) where the view expressed by the Registrar is one about which the Appointed Person is doubtful but, on balance, concludes was wrong. It is not necessary for the degree of error to be "clearly" or "plainly" wrong to warrant appellate interference but mere doubt about the decision will not suffice. However, in the case of a doubtful decision, if and only if, after anxious consideration, the Appointed Person adheres to his or her view that the Registrar's decision was wrong, should the appeal be allowed (*Re: B*).
- (vi) The Appointed Person should not treat a decision as containing an error of principle simply because of a belief that the decision could have been better expressed. Appellate courts should not rush to find misdirections warranting reversal simply because they might have reached a different conclusion on the facts or expressed themselves differently. Moreover, in evaluating the evidence the Appointed Person is entitled to assume, absent good reason to the contrary, that the Registrar has taken all of the evidence into account. (*REEF, Henderson and others*).

Bearing in mind the repeated reminders that different points are likely to be particularly relevant in other cases, this is not intended to be a summary of universal application for other cases where particular aspects of the approach may require different emphasis.

Question of law, fact or a mixture

9. Central to the Appellant's case was that "business construction management services" covered by its specification was wrongly construed by the Hearing Officer. This raises the issue of whether the construction of a trade mark specification is a question of law, or a question of fact, or a mixed question. It is significant because where a question is one of pure law then it is either right or wrong. The usual deference shown to Hearing Officers on appeal would not apply.
10. I gave the parties an opportunity to make written submissions on this point. Mr Hollingworth's central argument was that there is no need to address whether construction was a question of law or fact. He also suggested that while the fact/law divide might be a useful tool to decide whether the answer is right or wrong it cannot be determinative. I disagree.
11. Where a question is one of pure law there is one right answer. On appeal, any decision below should be overturned where the answer given was not that one right answer. Where the question is one of fact, there may be one or more conclusions that can be drawn from the facts and an appellate tribunal can disturb the decision only in the circumstances where it was not one of those conclusions. In the trade mark context this means that if the construction of the specification is one of pure law then the words (in this case "business management construction services") have only one meaning. If the Hearing

Officer did not give the right meaning then the Appointed Person or the Court should provide that meaning.

12. There is no clear authority on this issue in relation to trade marks. In *Omega Engineering v Omega SA* [2012] EWHC 3440 (Ch) at paragraphs [21] to [35] Arnold J provided a summary of the law of construction of trade mark specifications (he returned to the issue in *Aveda Corp v Dabur India* [2014] EWHC 589 (Ch)). While his summary explained the approach to be taken, it did not address its classification as a question of law or fact.
13. While the question of evidence was not mentioned in Arnold J’s review of the case law, there were phrases that were referred to which, Mr Hollingworth suggests, indicate the use of evidence – the admissibility of evidence being the central feature in identifying questions of fact. The phrases he refers to come from *British Sugar v James Robertson* [1996] RPC 281 at 289, namely “as a practical matter” and “regarded for the purpose of trade”. Similarly, in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1828 at paragraph 31 Aldous LJ states “the court should inform itself of the nature of the trade”.
14. Mr Hollingworth also suggests that the phrase “not purely of a legal nature” in the following passage from *Beautimatic International v Mitchell Interpretation* [2000] FSR 267 suggests that the question of claim construction is not purely a question of law:

The question therefore arises whether, as Beautimatic contends, it is appropriate for the court to determine at this summary stage that skin lightening cream and/or dry skin lotion fall within the ambit of the goods in respect of which the Beautimatic mark is registered. I accept, of course, that, when exercising its summary jurisdiction, the court should not be too ready to decide issues which are not purely of a legal nature.
15. I do not agree that this extract supports his submission. Neuberger J was considering a question of infringement, which is one of fact.
16. Mr Norris also relied on the fact that neither Floyd J in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) (at paragraphs 20 to 29) nor Amanda Michaels, sitting as an Appointed Person, in *Associated Newspapers v Bauer Radio Ltd* (O-249-15) (at paragraphs 114 to 118) considered whether the Hearing Officer was entitled to construe the specification as it had been, but rather proceeded to consider whether it was the “right” construction. This he suggests demonstrates that it is a legal question.
17. In the absence of any clear authority it is necessary to look to the more general principles of law. The appropriateness of taking this course of action is illustrated by *Altecnic Ltd’s Trade Mark Application* [2002] RPC 34 at 42, where Mummery LJ stated that:

The application is a considered statement of the applicant which, on ordinary principles of the construction of documents, has to be read as a whole to determine its meaning and effect
18. In looking at the broader legal landscape, Mr Norris pointed to the rules of patent construction and, in particular, the Court of Appeal’s decision in *Glaverbel SA v British Coal Corp* [1995] RPC 255 at 268. The Court set out the agreed propositions as to the approach to claim construction. The first of which was as follows:

The interpretation of a patent, as of any other written document, is a question of law. That does not mean that the answer to it will necessarily be found in our law books. It means that it is for the judge rather than a jury to decide, and that evidence of what the patent means is not admissible. In particular, evidence of the patentee as to what he intended it to mean should not be admitted, nor indirect evidence which is said to point to his intention. Compare the rule that the parties to a deed or contract cannot give evidence of what they intend it to mean. A patent is construed objectively, through the eyes of a skilled addressee

19. Both parties made reference to contract law. The question of whether the construction of a contract is a pure question of law has been repeatedly addressed by the highest court. Lord Diplock in *The Nema* [1982] AC 724 at 736 said that while the original reason for the rule may have long passed “it is far too late to change the technical classification”. A similar conclusion was reached by the House of Lords in *Thorner v Major* [2009] UKHL 18 (and earlier in *Carmichael v National Power* [1999] 1 WLR 2042).
20. Since the last of these cases, the Supreme Court has considered the construction of contracts a number of times, most significantly in *Rainy Sky SA v Kookmin Bank* [2011] UKSC 50 and *Arnold v Britton* [2015] UKSC 36, both of which were recently confirmed in *Wood v Capita Insurance* [2017] UKSC 24. It is now clear that the interpretation of contracts involves consideration of the factual background. Such consideration requires evidence as to what those facts might be.
21. This new approach to construction might suggest that the interpretation of a contract is now at the very least a mixed question of law and fact. Indeed, the Canadian Supreme Court in *Sattva Capital v Creston Moly* [2014] SCC 53 expressly abandoned the view that the construction of a contract is a purely legal matter. This approach has been adopted by some textbook writers (see *Chitty on Contract* (32nd Ed), paragraph 13-047) and merely noted by others (see, *Lewison: The Interpretation of Contracts* (6th Ed, 2015) at paragraph 4.01).
22. The reclassification of the question as one of fact and law does not, however, seem to have been considered by the English Courts (and those in New Zealand who have expressly considered it, have not followed it: *Commerce Commission v Harmony Limited* [2017] NZHC 1167, paragraph 48 and 49; *Todd Petroleum Mining Company Limited v Vector Gas Trading Limited* [2017] NZHC 1166, paragraph 55). Accordingly, it seems Lord Diplock’s view as to the matter remains good law.
23. However, the process is not as simple as saying the construction of a contract is a matter of law. This is because contractual construction involves two stages. This was explained long ago by Lindley LJ in *Chatenay v Brazilian Submarine Telegraph Company* [1891] 1 QB 79:

The expression “construction,” as applied to a document, at all events as used by English lawyers, includes two things: first, the meaning of the words; and, secondly, their legal effect, or the effect which is to be given to them. The meaning of the words I take to be a question of fact in all cases, whether we are dealing with a poem or a legal document. The effect of the words is a question of law.
24. This summary of the law is equally applicable to the construction of a trade mark’s specification (as well as being in line with patent construction). Accordingly, evidence

can be led by the parties as to what a particular word might *mean* in a specification but not as to what the *effect* of that meaning might be. Accordingly, the *meaning* of a word is a question of fact and so the meaning assigned by the Hearing Officer (in this case, the words mean the construction of a business) is something to which the usual appellate deference should be given. However, the effect of those words is a matter of law.

25. Finally, and for completeness, Mr Hollingworth submitted that because the construction of a trade mark specification is a matter of EU law, English decisions on whether it is a question of law or not would be of limited assistance. It is clearly right that the proper approach to the construction of a trade mark specification would be a matter of EU law. However, the approach to fact finding, evidence, and how to approach appeals is a matter of national law. Currently, the Trade Mark Directive (2008/95/EC) states at recital (6) that:

Member States should also remain free to fix the provisions of procedure concerning the registration, the revocation and the invalidity of trade marks acquired by registration. They can, for example, determine the form of trade mark registration and invalidity procedures, decide whether earlier rights should be invoked either in the registration procedure or in the invalidity procedure or in both and, if they allow earlier rights to be invoked in the registration procedure, have an opposition procedure or an ex officio examination procedure or both. Member States should remain free to determine the effects of revocation or invalidity of trade marks.

26. Indeed, even when (and now, in the case of the United Kingdom, if) the new Directive (2015/2436/EU) has to be transposed, it is indicated at recital (9) that only the general principles of procedure are to be approximated. The distinction whether something is a matter of law or fact (or both) is probably not a general principle of procedure, but a specific rule. Accordingly, it is my view that the classification of the matter will remain a matter of national law.

27. Accordingly, I will bear in mind the principles set out in paragraph 8 above and my finding as to the approach to the construction of a trade mark specification.

Appeal

Need for a core meaning

28. Barclays' appeal was based on the Hearing Officer's finding as to the similarity of the services and, in particular, the meaning of "business construction management". The essence of Mr Norris's submission was that this comparison required a two-stage test. First, the Hearing Officer should have found the "core" meaning of the relevant phrase. Secondly, a comparison of the services should have been undertaken. Accordingly, he submitted that the Hearing Officer's failure to find the core meaning, before going on to compare the services, was a material error.

29. The basis of this submission was *Avnet v Isoact* [1998] FSR 16 and *Reed Executive Plc v Reed Business Information Ltd* [2004] EWCA Civ 159, [2004] RPC 40. In *Avnet* Jacob J stated at page 19:

The answer I think depends on how widely one construes this expression "advertising and promotional services". It is not an unimportant question, because definitions of services, which I think cover six of the classifications in the respect of which trade marks can be registered, are

inherently less precise than specifications of goods. The latter can be, and generally are, rather precise, such as “boots and shoes”.

In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.

30. In *Reed v Reed*, after setting out the second paragraph from *Avnet*, Jacob LJ stated:

44. Neither side dissented from this. The proposition follows from the inherent difficulty in specifying services with precision and from the fact that a service provider of one sort is apt to provide a range of particular services some of which will be common to those provided by a service provider of another sort. Here, for instance, both sides publish advertisements for jobs and have done so for years. No-one who has looked into a Reed Employment high street shop could have missed these. Nor could anyone have missed RBI's job advertisements in their various magazines.

45. Accordingly I think that principle applies here. What one must do here is to identify the core activities which make a service provider an "employment agency."

31. Mr Norris accepted that there might be some services which are unambiguous and have a clear scope where it might not be necessary to “give much, or any consideration” to the construction of the specification. This is where his submission falls in upon itself. It cannot be a requirement in law to find a core meaning in some cases, but not in others. In any event, I think what was meant by “core” is more straightforward.

32. In *Youview TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at paragraph 12, Floyd J brings the “core” meaning of the words together with their “ordinary and natural” meaning:

There are sound policy reasons for this. 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) (IPTRANSLATOR)* [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.

33. It appears to me that what Jacob LJ was suggesting in both *Avnet* and *Reed* was that it is necessary to construe properly the specification by giving the words their ordinary meaning, rather than suggesting that there is a two-stage process which begins with identifying the core meaning. This also appears to be view that Floyd J took in *Youview*.

34. Put another way, the reference to the core meaning is simply to avoid looking at the marketplace and pointing to examples of where a business concurrently provides services X and Y to its customers and using this fact to make Y=X (when only X is covered by the ordinary meaning of the words in the specification).

35. Thus, what the Hearing Officer was required to do was to determine the ordinary natural meaning of the phrase “business construction management services”. She was not required to go through the two-stage process outlined by Mr Norris.

Meaning of business construction management services

36. The Hearing Officer’s clearest explanation of what she considered was covered by the phrase “business construction management services” is at the end of paragraph 37 of her Decision:

...In my view, appraising and evaluating business opportunities are part and parcel of establishing a new business and growing existing ones and I consider that they are highly similar, if not identical, to (at least) business construction management services as are included within the earlier mark.

37. At the outset, I have to confess that I find “business construction management” to be a curious phrase. I do not think it has a clear meaning when looked at in isolation. The difficulty is that the meaning given to the phrase depends on whether emphasis is placed on the first two words or the last two words.
38. Mr Norris suggests that the ordinary meaning of the phrase is “construction management” relating to buildings used for business (in contrast to residential buildings). In his skeleton argument, Mr Hollingworth accepts that the phrase may well be “management services provided to businesses in connection with construction projects”.
39. Yesterday, when my judgment had been substantially written, I received a letter from the Appellant’s solicitors enclosing a Witness Statement from Gareth Stapleton. The Statement is for use in proceedings pending before the Registrar relating to the cancellation of Trade Mark No 259,331 on the grounds of non-use. In that Statement, Mr Stapleton suggests that “business construction management refers to construction management for businesses”. The Appellant suggests that the interpretation of the specification by the Respondent should be consistent between proceedings.
40. The Respondent gave its response in another letter I received today in which it stated that Mr Stapleton’s statement was consistent with the construction put forward at the appeal. I agree.
41. Accordingly, both parties, to some extent, interpret the relevant words in terms of “construction management”. Notwithstanding his own interpretation, Mr Hollingworth submits that the Hearing Officer was entitled to have a different interpretation.
42. In contrast to the parties, the Hearing Officer emphasised the first two words in the phrase, namely “business construction”. Thus, the management services related to “business construction” or the construction of businesses.
43. The difficulty with this curious phrase is that while I accept that the most coherent meaning of “residential construction” would be the “construction of residential buildings” (although the latter phrase would have been far better) and I might be willing to accept that “commercial construction” could be the “construction of commercial buildings”, I am not sure that this applies to “business construction”.

44. To give an example using a related phrase, a person who says they work in “house building” would unambiguously be understood to work in the construction industry (albeit they might call themselves a builder or some subset of that industry). A person who works in “business building” would not be taken by the ordinary reader to be someone who builds business premises, but someone who tries to make businesses more successful (by increasing turnover for example).
45. The purpose of the specification is so that “economic operators” are able to “acquaint themselves, with clarity and precision, with registrations or applications for registration made by their actual or potential competitors, and thus to obtain relevant information about the rights of third parties”: C-307/10 *Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42, paragraph 48.
46. But in this case the addressee of the specification might affect its meaning. A notional person from the construction industry might attribute one meaning to the phrase and a person from what might loosely be called the business development industry (venture capitalists etc) might give it another.
47. In choosing between these two interpretations (or addressees), it is necessary to look at the context of the words (see *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd* [2000] FSR 267 at 275). The actual use the Appellant made of the mark is not relevant. In this case, the only context that can be provided is by the other services covered by the Respondent’s specification. This is not to suggest that in general the inclusion of one good or service can limit the meaning of another good or service covered by the specification. However, in this case it is necessary to find a context and with it an addressee for the specification.
48. The other services covered by the Respondent’s specification clearly have no particular connection to the construction industry. Indeed, as Mr Norris suggests, one of the purposes of management consultancy is to enable a business to improve its performance. It seems to me that improving a business’s performance is simply a progression from developing it in the first place (or building it or constructing it). Project management has a wide meaning which does not assist greatly with the context. Accordingly, the construction of that phrase “business construction management services” by the Hearing Officer is the better one.
49. As the construction of the specification is not a pure question of fact, neither the Hearing Officer nor I were obliged to accept the parties’ agreed construction of the relevant phrase (see by analogy, *Consafe v Emtunga* [1999] RPC 154, paragraph 21). Indeed, it would have been possible to adopt a construction contrary to the evidence (see by analogy the comments of Aldous LJ in *Scanvaegt v Pelcombe* [1998] FSR 786 at 795).

Comparison of services

50. Accordingly, using this construction of the phrase “business construction management services”, the Hearing Officer was entitled to make the findings she did in paragraphs 36 to 41. In this regard, in contrast to the Appellant, my reading of paragraph 39 of her

Decision is that she was comparing “office function services” to “business construction management services” and not to “project management” or at least not solely to project management (notwithstanding the extract of Mr Hollingworth’s submission). This is clear from her use of the phrase “setting up and/or operation of a business”. The word “project” suggests a particular endeavour within a business and not the whole business. Therefore, project management might relate to the operation of a business, but it would not usually be used in the context of setting up a new business (other than a subsidiary company to run a particular project).

51. Accordingly, I dismiss the appeal in relation to section 5(2).

Cross-appeal

52. The Respondent cross-appealed the Hearing Officer’s decision in relation to Class 43. There were essentially two grounds relied upon. The first was that the Hearing Officer did not properly consider the similarity of the services for the purposes of section 5(2)(b). The second was that the Hearing Officer did not properly consider the evidence as to its reputation for the purposes of section 5(3).

Section 5(2)(b)

53. Mr Hollingworth submitted that the following services were similar to the Respondent’s services in Class 35:

Event facilities and temporary office and meeting facilities; hospitality services; rental of meeting rooms; rental of temporary accommodation; provision of temporary work accommodation; rental of other temporary office space; providing facilities for fairs, conventions, exhibitions, seminars and conferences; accommodation reservations; reservation services for meetings rooms; reservation services for other temporary office space; information services relating to all of the aforesaid services; none of the aforesaid services including the provision of management consultancy or project management.

54. He did not challenge the finding under section 5(2)(b) in respect of the other services.

55. In essence, the Respondent’s case was that the Hearing Officer applied the test for identical services and then moved on to state that the services were not similar. Accordingly, it was submitted, her failure to consider the extent to which the services were similar was a material error. On appeal, the Respondent accepted that the services were not identical, but submitted that any degree of similarity would be enough for the Opposition to succeed.

56. The matter was considered by the Hearing Officer in paragraph 43:

Each of the services set out in the preceding paragraph are for (information relating to) the provision of accommodation. Management services as are included within the opponents’ earlier specification will include a number of specific services but I do not consider that the core meaning of these services will include the provision of accommodation. I note that in his witness statement Mr Stapleton’s gives evidence that the opponents’ group of companies “aim to provide our clients with...[a] complete means of project management and real estate services” which suggests that he himself considers them to be two distinct areas of trade. There is no evidence to show that other management services suppliers provide accommodation as part of their offering nor is there any evidence to show that it is a normal part of the management services industry. I find that these respective services are dissimilar.

57. I agree with Mr Hollingworth that the last sentence appears to be a jump from the discussion before it. However, the discussion repeatedly refers to “management services” simpliciter which is a more general phrase than anything covered by the specification. Thus, the wider phrase may have covered not only the services in question but also those related to it. It could have been on this basis that the Hearing Officer reached the conclusion she did.
58. In any event, my own view is that providers of accommodation services of the nature covered by the Appellant’s specification are dissimilar from “management consulting; project management; business construction management services”. While both services would attract business customers, that is really where the similarity ends. Clearly a person is not going to choose a meeting room over getting management advice or similar and so the services are simply not in any form of competition.
59. While business meetings, such as those a management consultant or project manager might have, usually take place in meeting rooms or similar accommodation that is hardly enough to make the services complimentary. Indeed, most such meetings would take place either on one or the other party’s premises (even if those premises were temporarily hired such as in the case of serviced offices). It would, I suggest, be most unusual for any business meeting with a client of the business to charge separately for the use of a meeting room where the meeting is held. The cost of any room hire would be met from the fee charged for the service provided as a general overhead. The services are therefore not complementary.
60. Accordingly, the Hearing Officer’s conclusion was right even if the reasoning could have been clearer. I therefore dismiss the cross-appeal under section 5(2).

Section 5(3): The services in respect of which a reputation is claimed

61. The Respondent also cross-appealed the finding in relation to section 5(3). Firstly, the Respondent criticised the Hearing Officer’s assessment of the services which form the grounds of its claim under section 5(3). Secondly, the Respondent submits that the Hearing Officer did not consider all the evidence put forward supporting the claimed reputation.

62. In the first half of paragraph 74 of her Decision the Hearing Officer said:

In setting out a claim under this ground, an opponent should clearly state the specific goods and/or services on which it claims to have used the mark and on which it relies. The use of the phrase “but not limited to” as set out above, is not, therefore appropriate. The only services which are specifically relied on are project management consultancy, construction management and the provision of temporary accommodation and facilities.

63. Mr Hollingworth submits that on the Respondent’s Form TM7, in Section B, in respect of Questions 1 and 2 the box “All goods and services” was marked. Accordingly, the relevant text in the attachment to TM7 (set out in paragraph 72 of the Decision) should not limit the basic extent of the claim set out based on the boxes marked.

64. Conversely, Mr Norris suggests that the Hearing Officer was entitled to read the marked box in conjunction with the text attached as the attachment forms part of TM7. The difficulty with this submission is that the attachment is incorporated only by reference in Questions 3 to 6. The question as to the services in respect of which a reputation is claimed is Question 1 and only the box is marked and no further text is provided in respect of that question.
65. Accordingly, it is apparent that the reputation should have been considered in respect of all the services covered by the Opposition, namely “Management consulting; project management; business construction management services”. Nevertheless, the Hearing Officer did specifically address “project management consultancy services”. As is clear from her statements in respect of these services, the Hearing Officer considered this amalgamated phrase to be “management consultancy” and “project management”. She also considered “construction management” by which she must have meant “business construction management” (as in the construction of businesses) to be consistent with paragraph 36 of her Decision.
66. In paragraph 73 of her Decision, the Hearing Officer stated that she did not need to consider “project management consultancy services” as the Opponent had been successful under section 5(2)(b).
67. As Mr Hollingworth suggests, this is a confusing indication. Where a Hearing Officer has already found that some of the Applicant’s services are unregistrable by reason of an objection under section 5(2), there is no need to consider whether those services are also objectionable under section 5(3). However, if the Opponent’s services were similar to some of the Applicant’s it does not preclude those same services being the basis for objections under section 5(3) in respect of services which are not similar.
68. However, the Hearing Officer might also have meant that the services “project management consultancy services” had been found to lack enhanced distinctive character (see paragraph 56) in her assessment under section 5(2)(b) and by reason of that finding they could not have the higher degree of reputation needed for protection under section 5(3). Even if the Hearing Officer meant what Mr Hollingworth suggests, the mistake could not have been material as this earlier finding would preclude her from finding that “project management consultancy services” had a sufficient reputation for the purposes of section 5(3).

Failure to consider evidence

69. This brings us to Mr Hollingworth’s central challenge to the Decision, namely that the Hearing Officer did not properly consider the evidence of reputation. The Hearing Officer set out her summary of the evidence of the Opponent (now Respondent) between paragraphs 6 and 16. She did not include in that summary any mention of the Respondent’s work in relation to Bow Street Magistrates’ Court, the UK Pavilion at the Madrid Expo, the Royal Opera House, or Kidzania. Mr Hollingworth goes on to criticise the Hearing Officer’s failure to refer to favourable press coverage, such as articles in trade journals including *Construction Manager*, *Building*, *Architect’s Journal* as well as

government websites (he set out a full list in his Skeleton Argument albeit confusingly referring to the Milan, rather than Madrid, Expo).

70. Mr Hollingworth also suggests that the exclusion of the evidence of industry awards was inappropriate (see paragraph 16 of the Decision). The fact they were awarded after the relevant date is immaterial he says because they were awarded for conduct before the date. This is at least partially true.
71. For example, the Oscars are awarded in January in relation to films released during the preceding year. Accordingly, they mark past excellence in relation to films which may be well-known to the public. The reputation of the film may well have developed when the work was in the cinema. However, the Oscars also attract greater attention to the winning films, actors and crew thereby increasing their reputation further.
72. Thus, an industry award can be used to show some notable achievement before the date of the award. Whether this is the case will depend on the award; a “most successful company 2015” award clearly indicates success during 2015 even if the award is presented in 2016.
73. It appears that the Respondent won the Construction News, Construction Consultancy of the Year Award on 30th June 2015 and a second award as SME of the Year 2015 for London and the South East from Constructing Excellence on 2nd July 2015. The evidence also includes material showing the Respondent was a finalist for certain awards in 2016. There was no indication of the specific activities which led to the award being given or what the cut off period was for consideration of its achievements. Therefore, it would have been wrong for the Hearing Officer to speculate as to the extent to which qualifying achievements took place before or after the relevant date. This is the case even though the relevant date was only a little over two months before the award was given. Accordingly, without more evidence as to eligibility and so forth it is difficult to know what weight should be attached to such an award.
74. Nevertheless, before the relevant date, Nazma Uddin won the project manager of the year award from the Construction Youth Trust Young Achiever Scheme 2015 and she was shortlisted for Woman of the Year in the Building Awards 2015. Beyond the fact that Ms Uddin worked for the Respondent there was no evidence to suggest that these awards added to its reputation (although they clearly added to hers). Finally, the Respondent was shortlisted for the 100 staff or fewer construction consultant award by Building Awards 2014. This would clearly have added something to the business’s reputation, but without evidence as to the standing of the awards or more general publicity given within the industry to shortlisting it is difficult to ascertain the extent to which reputation attaches.
75. In any event, one of the awards given to the Respondent was “SME of the Year” for London and the South East (and many of the other accolades were for smaller businesses). I would not go as far as to suggest that a small or medium enterprise could not have reputation for the purposes of section 5(3), but it would clearly be difficult for something seen as a smaller business by the industry to have also an enhanced reputation

for the purposes of section 5(2), let alone sufficient reputation for the purposes of section 5(3).

76. Even if the Hearing Officer had considered all the evidence of other successful management projects (Bow Street Magistrates' Court, the UK Pavilion at the Madrid Expo, the Royal Opera House, or Kidzania) and the attendant publicity as well as given some (possibly) very little weight to the awards it would have made no material difference. None of this material addresses the fundamental difficulties faced by the Respondent namely that there was no evidence presented as to market share, no evidence from trade bodies or from people with standing in the industry, and no evidence of the market in which the reputation was claimed.
77. In respect of this final point, at the end of the Hearing, I asked Mr Hollingworth in what market the Respondent claimed reputation. He said the "construction industry" and that his client was known as a project manager in that industry. There was no evidence presented as to the size of the construction industry market (a further problem for Mr Hollingworth identified by the Hearing Officer: see paragraph 56). Nevertheless, I can take notice of the fact that the industry is worth many tens of billions of pounds and employs well over a million people. The Respondent's turnover (which as the Hearing Officer pointed out, does not break down between UK and overseas: paragraph 12) is at most £8million and the number employed nearly 100.
78. While the requirement for a reputation is "not onerous" (see *Enterprise Holdings, Inc v Europcar Group UK Ltd & Anor* [2015] EWHC 17 (Ch) at paragraph 120) and there was possibly more evidence the Hearing Officer should have considered to make her determination, none of the missing evidence could have materially changed her conclusion that "RISE has positive connotations of moving upwards" (paragraph 56) and that the Respondent did not have the necessary reputation in relation to construction management (paragraph 73). Furthermore, once the relevant market was identified by Mr Hollingworth as the behemoth that is the construction industry, the Hearing Officer's statement might even appear generous. Accordingly, I dismiss the cross-appeal in relation to section 5(3).

Conclusion

79. The appeal and cross-appeal are dismissed. The application can proceed to registration in relation to the services set out in paragraph 75 of the Hearing Officer's decision. As both parties both won and lost on appeal, I make no order as to costs.

PHILLIP JOHNSON
THE APPOINTED PERSON
8th December 2017

Representation:

For Appellant: Andrew Norris instructed by Bird & Bird;

For Respondent: Guy Hollingworth instructed by CMC Cameron McKenna Nabarro Olswang LLP.