

**O-236-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3146830  
BY T.S.S. FACILITIES LIMITED  
TO REGISTER THE TRADE MARK**



**IN CLASS 37**

**AND**

**IN THE MATTER OF OPPOSITIONS THERETO  
UNDER NO. 406596 BY ISS WORLD SERVICES A/S**

## Background

1. On 28 January 2016 T.S.S. Facilities Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the following services in class 37:

*Installation, maintenance, servicing and repair of air conditioning, refrigeration, heating, ventilation, water treatment and hygiene apparatus; information, advice and consultancy in relation to the installation, maintenance and repair of air conditioning, refrigeration, heating, ventilation, water treatment and hygiene apparatus; electrical installation services.*

2. The application was accepted and published for opposition purposes on 12 February 2016.

3. The application is opposed in full by ISS World Services A/S (“the opponent”). The opposition is based upon Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). For the purpose of its grounds based upon Sections 5(2)(b) and 5(3), ISS relies upon three earlier marks:

- i) European Union Trade Mark (EUTM) no. 1920396



Filing date: 20 October 2000

Registration date: 19 December 2002

Colours Claimed: White letters on blue background (Pantone 3015 C)

Priority date: 19 October 2000

- ii) European Union Trade Mark (EUTM) no. 014697577



Filing date: 20 October 2015

Registration date: 06 July 2016

Mark Description: White letters on a blue background (Pantone 296).

Colours Claimed: White, Blue PANTONE 296.

iii) International Registration (IR) 0968240



Date of Designation of the EU: 18 October 2007

Priority date: 28 September 2007

International registration date: 18 October 2007

Date protection granted in EU: 07 July 2009

4. In its pleadings under 5(2)(b) the opponent relies upon a range of goods and services in classes 9, 35, 37, 39, 40, 41 and 42; the specifications relied upon under each mark are listed in Annex A, which is reproduced at the end of this decision. Following the applicant's request to particularise its claim, the following services of the earlier marks were identified by the opponent as being identical to the services covered by the contested mark:

The services of Earlier Marks that are identical to the services of the oppose Application are as follows:

**001920396**

maintenance of heating and air conditioning systems, of elevators and of escalators,

cleaning of buildings, yards, facilities, property, roads, public areas, gardens, rooms and vehicles, including special cleaning;

cleaning of industrial premises;

janitorial services, including maintenance, management of energy supply and reparation;

clearing, cleaning and repair after fire and water damage;

**0968240**

Maintenance of heating and air conditioning systems, of elevators and of escalators; cleaning of buildings, yards, facilities, property, gardens and room;

janitorial services, namely maintenance, cleaning and repair of buildings;

maintenance and repair of electric installations and sanitary installations;

clearing, cleaning and repair after fire and water damage;

maintenance, inspection and minor reparations of buildings;

maintenance and repair of electric installations in buildings, mechanical installations and sanitary installations in buildings; advisory services relating to the construction, maintenance and repair of mechanical engineering structures connected with buildings.

**014697577**

Cleaning, repair and maintenance of buildings, facilities, yards, roads, property, gardens, rooms and industrial premises

installation, maintenance and repair of heating, ventilation and air-conditioning

installation, maintenance and repair of elevators and escalators; interior and exterior cleaning of buildings;

running of buildings for others including maintenance and repair of buildings and technical assistance with installations in buildings;

advice on the practical running of buildings, including optimization of building maintenance and repair;

management and optimizing of building management systems, including of energy supply systems in buildings; monitoring building management systems;

maintenance of cooling systems and steam generation systems;

plumbing and drainage services; installation, monitoring and maintenance of water treatment systems in buildings;

5. Under Section 5(3) the opponent relies on the same marks in respect of services in classes 35 and 37. The full list of services relied upon under Section 5(3) is reproduced in Annex B at the end of this decision.

6. Under Section 5(4)(a), which relates to the law of passing off, the opponent relies on signs corresponding to the above marks in respect of the same list of goods and services relied upon under Section 5(2)(b). The signs are claimed to have been used

throughout the UK since 1968. It additionally relies on use of the sign ISS since 1968, in respect of all of the goods and services listed in Annex A.

7. The opponent claims that the applied for mark is similar to the earlier marks and covers services that are identical with and/or similar to the services of the earlier marks by virtue of the fact that the services are all provided by the same facilities management businesses. It also claims that it operates a multi-million pound business under the earlier marks in the UK and that the earlier marks have acquired a reputation and enhanced level of distinctiveness in relation to the services relied upon as a result of the use of made of them since 1960. Consequently, use of the contested mark would create a likelihood of confusion and/or, without due cause, take unfair advantage of, or be detrimental to, the reputation or distinctive character of the earlier marks. Therefore, registration should be refused under Sections 5(2)(b) or 5(3) of the Act.

8. Additionally, the opponent claims that it has acquired goodwill as a result of use of the earlier marks and that use of the contested mark would constitute a misrepresentation to the public which would damage the opponent's goodwill. Consequently, registration should be refused under Section 5(4)(a) of the Act.

9. The applicant filed a defence and counterstatement, denying all the grounds of opposition and putting the opponent to proof of use, reputation, goodwill and enhanced distinctiveness claimed for the earlier marks. In relation to the similarity of services, the applicant admits that the following services in the earlier marks are identical to some of the contested services, namely *maintenance of heating and air conditioning systems* (01920396 and 0968240) and *installation, maintenance and repair of heating, ventilation and air conditioning* and *installation and maintenance of water treatment systems* (014697577) but puts the opponent to proof that the remaining services are identical. It also claims that the letters SS in the context of the services at issue function as an acronym for, inter alia, Security Services, Support System, Special Services, Service System and Service Solutions and that the opponent itself states on its website that ISS was originally short for International Service System and Integrated Service Solutions. Further, it claims that it is the owner of the trade mark registration no. 2612598 for the mark TSS Facilities Limited (stylised) which co-exists with the

earlier marks and that it has been using the element TSS in the UK for at least 17 years and, to its knowledge, there have been no instances of confusion.

10. The applicant is represented by Venner Shipley LLP. The opponent is represented by HGF Limited. Both parties filed evidence which I have read and will refer to as necessary in this decision. Neither side asked to be heard. However, I received written submissions from both parties.

## **The evidence**

### The opponent's evidence

11. This takes the form of a witness statement from Kristoffer Lykke-Olesen, together with 25 exhibits. Mr Lykke-Olesen has been Group Vice President of ISS World Services A/S since 2007. He gives an account of the commercial history of ISS (Exhibit 1), confirming that the company was founded in Denmark as a small security company and has expanded since then “to become one of the world’s largest facilities management companies with 500,000 employees around the world and a multimillion pound turnover”.

12. Mr Lykke-Olesen states that its company entered the UK in 1968 where it established itself under the name ISS and that it has expanded to employ around 47,200 people in the UK. Attached at Exhibit 4 are undated black and white copies from the ISS website with a list of its UK offices, including London, Surrey, Stoke on Trent, Livingstone and Bolton. According to Mr Lykke-Olesen, ISS’s customers in the UK include well-known businesses such as the Royal Bank of Scotland, Mondelez, Price Waterhouse Cooper, the Co-op and Heinz. The ISS logo mark appears twice on the pages and the word iss appears within the email addresses info@uk.issworld.com, central.recruitment@uk.issworld.com and uk.sales@uk.issworld.com.

13. Mr Lykke-Olesen states that ISS provide UK clients “with every facility management solution they may require” and that the services are provided under the ISS (word only) and ISS logo marks.

14. According to Mr Lykke-Olesen the services offered include: facilities and property management, engineering, catering, cleaning, food and hospitality, front of house, security, waste projects and landscaping. Exhibit 5 consists of undated black and white copies from the ISS UK website. The pages feature the ISS logo mark at the top. At page 22, under the heading *property services*, it reads:

*“Managing and maintaining your essential systems. Behind every organization are systems that are essential to its operations. From power, heath, light and ventilation to security, alarms, lifts and chillers you need to know your technologies are in perfect order. ISS will free you from the burden of managing and maintaining your systems so you can concentrate on your core responsibilities. Our nationwide team comprising hundreds of specialist engineers, have the resources and expertise to take care of your system and technologies so you can always feel sure your systems will operate continuously, comply with the rules, remain safe and reduce your environment impact. At ISS we will manage everything on your behalf continually maintaining your technologies and seeking ways to reduce risks and costs through your organisation.”*

15. Black and white prints from the Wayback machine showing pages from the UK ISS website on various dates in 2011, 2012, 2013, 2014 and 2015 are provided in support (Exhibit 6). These indicate that the following services were offered under the ISS logo mark during this period: catering, change management, cleaning, energy management, facilities management, front of house, healthcare, housekeeping (hotel and leisure), landscaping, procurement, property, security, space planning, support services and transport.

16. Mr Lykke-Olesen gives details of ISS UK annual (total) turnover (not broken down by service) in the years 2011-2015. This ranges from about £890m in 2011 rising year on year to a peak of £1.3 billion in 2015. Figures are also provided for the property management sector (not broken down by country) for the same period. These indicate that ISS global turnover for the property management sector was around £1.7 billion in 2011, falling to £1.4 billion in 2014 and standing at £1.8 billion in 2015. Copies of the 2013 Annual Report (Exhibit 8 and 9) are in evidence. The pages provide global

figures broken down by country and service type. They show that the revenue generated by the UK ranges from 10% (2011) to 15% (2015) of ISS's global revenue. They also show that ISS's revenue in 2015 derives from the following services: cleaning services (50%), property services (20%), catering services (13%), support services (7%), security services (7%) and facility management (3%) and that "property services" and "facilities management" accounted for 21% and 2% respectively of ISS revenue in Western Europe in 2015.

17. Mr Lykke-Olesen points out that the property sector of the business includes "maintenance, heating, ventilation and air conditioning services" (collectively HVAC) as confirmed by a graph reproduced at Exhibit 9. According to the same graph, property services also cover "building and technical maintenance, technical services, energy management and grounds maintenance" while facilities management covers "on site management of facilities services, change management, space management and risk management".

18. Exhibits 10-15 are aimed to support Mr Lykke-Olesen's evidence that the ISS (word only) and ISS logo marks are used in relation to the relevant services. The material include black and whites copies of:

- i) 2008 ISS Branding manual (Exhibit 10);
- ii) Print-outs and press releases dated 25/09/2014 and 15/05/2015 showing use of the ISS logo mark on vans together with the words "Technical Services" or "Facilities Services" though it is not clear what the services involve. All the pages feature the ISS logo mark at the top on the left (Exhibits 11);
- iii) Press releases and print-outs featuring the ISS logo mark on staff uniforms (Exhibit 12). All the pages feature the ISS logo mark at the top on the left. The copies, taken from 2012, 2013 and 2015 Annual Reports, relate to staff whose job is described as catering assistant at Chelsea Westminster Hospital, service worker at Heinz warehouse (UK) and cleaning operator and Gatwick airport. The exhibit also includes press releases dated 5/05/2011 and 5/05/2015 about ISS Facility Services offering apprenticeship in the cleaning sector through



Newcastle College and ISS Technical Services winning an International Safety Award from the British Safety Council. However, it is not clear what services ISS Technical Services involve. Another press release dated 24/02/2014 talks about ISS Facility Services Integrated Solutions having been awarded a new contract with ASSA ABLOY under which it would provide integrated services, including engineering, security, landscaping and cleaning, across the company's sites in Wolverhampton. Other press releases dated 18/11/2013 and 7/11/2013 refer to ISS providing security services and catering services (UK);

- iv) Four invoices issued between June and October 2015 (Exhibit 13). At the top left they have the ISS logo mark with the words TECHNICAL SERVICES. The invoices, issued by ISS Facility Services Limited with an address in the UK, do not carry the names of the companies to which they were billed (they seem to have been redacted). The amounts on the invoices are £151,505.30, £5,001.34, £168.00 and £478,100.95. The invoices are for "services fee October 2015", "services fee June 2015", "back wooden gate is damage, it sound old" and "monthly services fees September 2015". Mr Lykke-Olesen does not draw any attention to these invoices neither does he explain what are the services in relation to which fees were paid.

19. Mr Lykke-Olesen states that:

*"[ISS] property management division and technical services division in the UK offer services in the UK including the installation, maintenance, repair services, including such services in connection with air conditioning, refrigeration, heating, ventilation, water treatment and hygiene apparatus. All of these services are offered under the ISS brand and logo."*

20. According to Mr Lykke-Olesen examples include:

- i) A longstanding contract renewed in 2014 with Southbank Centre in London for what are described as "engineering services including building management systems, water treatment, chillers and close control units and a wide variety of

*other repair and maintenance services*". Attached at Exhibit 16 is an undated press release featuring the ISS logo mark at the top on the left. It states that ISS was chosen by Southbank Centre to provide engineering service through its site and that Southbank Centre extended its contract with ISS in 2014. The press release also refers to ISS providing *"a full range of mechanical, electrical and building fabric services including: planning and preventive work, building management system, fire alarms and suppression systems, water treatment, standby generator and uninterrupted power supplies, low voltage power distribution, chiller and close control units, specialist lighting, fabric maintenance, including 21 acres of paved public areas, lighting control, floor moves, small work and refurbishment, grade-one listed fabric renovation"*;

- ii) The provision of *"mechanical, electrical and building fabric services"* to the Co-op for 400 retail banking premises in the UK. Attached at Exhibit 18 is an undated press release featuring the ISS logo mark at the top on the left. It states that ISS was selected by the Co-op in 2012 to provide these services;
- iii) Maintenance contracts with the Livingstone Design Outlets. Attached at Exhibit 17 is a press release featuring the ISS logo mark at the top on the left. It is dated 26/11/2015. It explains that the Livingstone site is one of the premier shopping and leisure destinations in Scotland and that ISS has been the supplier at the site in Livingstone for 8 years providing *"mechanical and electrical maintenance services including automatic doors, lifts, escalators, car park barrier, CCTV and lighting protection as well as compliance services relating to fire extinguishers, fire alarms, sprinklers, water treatment, fixed wire testing, portable appliance testing and gas certification"*;
- iv) A contract dating from 2015 for the building maintenance, cleaning and security services for the Royal College of General Practitioners (UK). A press release featuring the ISS logo mark at the top on the left and dated 27/01/2016 is provided in support at Exhibit 19;
- v) Providing maintenance services from 2014 to Edinburgh College. A press release featuring the ISS logo mark at the top on the left and dated 14/07/2014

is provided in support at Exhibit 20. It confirms that ISS provided “*cleaning, maintenance, security and landscaping services*”.

21. Mr Lykke-Olesen states that:

*“As indicated by the press releases themselves and other evidence submitted, the services provided under the contracts would be far reaching and would include services such as those listed in our trade mark registration and for which the TSS application has sought protection for, including maintenance of heating and air conditioning systems, of elevators and escalators, cleaning of building, maintenance, cleaning and repair of buildings, maintenance and repair of electronic installations in buildings, mechanical installations and sanitary installations in buildings amongst other things”.*

22. In relation to reputation and goodwill, Mr Lykke-Olesen states that ISS is recognized as being the leading service provider of facilities management. He provides in support a copy of i-FM Brands Report 2015 which it is explained is a UK Brand Survey Report dedicated to the Facilities Management sector. The report states:

*“The 2015 FM brand survey, carried out by i-FM [...] and supported by Magenta, the communication specialist for the built environment, looked at how FM service providers were perceived by their customers, competitors, advisors, employees and even potential employees. Because it focuses on the level of brand awareness rather than market share, it provides valuable insights into level of brand recognition and the preconceptions of sort of services each brand is likely to deliver”.*

23. Mr Lykke-Olesen points out that the report states that 85% of the respondents were able to identify the ISS logo though it is not clear in relation to which services. In this connection, I note that whilst the answers given to Q1 indicate that ISS may be regarded as the second top service provider in the Facility Management industry, the report suggests that it is most acknowledged as a cleaning brand with a score of 33.1%

for its cleaning services. By contrast, its mechanical and engineering services only scored 7,4%.

24. As regard to the methodology, the report states:

*“Participation in the survey was invited via news stories on i-FM, promotion in general emails, focused emailing and through Twitter in July, August and early September 2015.*

*In the questions with ‘top 10’ responses, participants had the option to list first, second and third choices in each case. The i-FM research team then used the following formula to create a single total weighted figure for each brand: first choice scores were tripled, second choice doubled and third taken as it is.*

*Brand have been included in the charts above where the number of mentions was ‘significant’ –generally seven or more times. In every case, many more brands were mentioned, but less frequently.” (my emphasis)*

25. It is no clear how many people were involved, but the methodology described above suggests that the number of participants is of a size which is not sufficient to produce some relevant results viewed on a statistical basis. Thus, I will say no more about this evidence.

26. At Exhibits 22-23 Mr Lykke-Olesen provides extracts from the 2015 Annual Report and points out that goodwill is tracked as an asset in ISS Financial figures. The footnotes at the bottom of the document refer to goodwill impairment.

27. Exhibit 24 is a collection of press releases which are said were published on the ISS website about a number awards won by ISS which include:

- the Gold Award 2015 Armed Force Covenant Employer Recognition Scheme (UK);


- the Premises and Facilities Management Award for Partners in Education Facilities (UK). This was awarded to ISS for its partnership with the School Food Matters charity to promote food education;
- 2015 ROSPA Awards (UK Health and Safety awards);
- the Quality Management Standard certification (UK);
- the 2015 Jaguar Land Rover Inspiring Young Talent Award (UK);
- the 2015 International Safety Award (UK);
- the 2015 Business in the Community Responsible Business Award (UK). The award celebrate businesses that take action to address social and environmental issues;
- ISS ranked Best in Class by the British Institute of cleaning services (UK);
- 2015 Cost Sector Catering Awards (UK);
- 2015 Four stars rating (the highest possible) by the International Association of outsourcing professionals

28. Finally Mr Lykke-Olesen attaches at Exhibit 25 a copy of a decision of the EUIPO (B1496280) and points out that *“the EUIPO concluded that the ISS trade mark had acquired a high degree of distinctiveness through its use on the market in relation to a broad list of services including but not limited to installation services, repair services and maintenance services generally as well as these services specifically in connection with heating, air conditioning and general machinery”*. I note that the EUIPO’s decision was based on evidence which was not UK specific and focused on use of the IR 0968240, one of the marks relied upon in these proceedings, in Denmark. Thus, it has no bearing in assessing whether the earlier marks have acquired any enhanced distinctive character in the UK and I shall say no more about it.

#### The applicant’s evidence

29. The applicant’s evidence consists of two witness statements. The first comes from Andrew James Tugwell, the Managing Director of T.S.S. Facilities Limited, a position he has held since 1995, having been employed by the company since 1981. Mr Tugwell explains that TSS provides facilities management services to owners and managers of buildings in the public and private commercial sectors and that it offers

refrigeration, air conditioning, heating, water hygiene and electrical services as well as consultancy services. Copies of TSS's website are provided in support (AJT2). Mr Tugwell states that TSS is the owner of trade mark registration number 2612598 for

the stylised marks  (series of two) and that it commenced use of those marks in 1998. According to Mr Tugwell, the applied for mark was adopted in April 2013 (AJT3 and AJT4) to update the existing logo and has been used ever since in relation to all the contested services on company literature, website, vans and staff uniforms. Mr Tugwell also provides turnover and advertising figures for its company; these amount to around 14m and 168k respectively in the years 2013-2016 with a total number of consumers during the same period of 918. The remaining evidence relates to what Mr Tugwell describes as “representative examples of [TSS]’s marketing and promotional activities” (AJT6) and includes, inter alia:

- Copies of two advertising billboards featuring the applied for mark which are said were used in relation to an outdoor advertising campaign run in June 2013. According to Mr Tugwell the billboards were positioned in a number of locations in Brighton, Eastbourne, Hastings, Hove and Brexhill, including five cinemas and a train station, and remained in place for approximately two weeks;
- Copies of pages from TSS’s website confirming that it would sponsor the Sussex County Cricket Club for the 2015-2016 seasons and it sponsored a charity screening of a James Bond film in December 2015. However, no information is given about how many people attended the events;
- Copies of what Mr Tugwell describes as “local press advertising placed on the Latest Homes magazine between July 2015 and January 2016 and the Argus (Brighton’s local daily newspaper) in February 2014;
- Copies of undated photographs featuring the contested marks on customised vans.

30. According to Mr Tugwell, TSS’s website has received on average 12,000 visits per year. Mr Tugwell concludes his statement by saying that during the course of his

association with TSS he has never come across any instances of confusion with the opponent.

31. The second witness statement comes from Camilla Sexton, a trade mark attorney employed by Venner Shipley LLP, the applicant's representative in these proceedings. Attached to her witness statement (CS1) are extracts from the UK websites of various businesses. What these businesses have in common is that they use acronyms containing the letters SS in their company name and that they operate in the field of, broadly speaking, facilities management and security related services. The etymology behind some of the acronyms is also explained. Examples includes, inter alia: CSSA (Cleaning & Support Services Association); ESS (Environmental Site Supplies); ESS (Electronic Security Services); Elite Support Services; FSS (Facilities Support Services); GSS; LSS; MSS; NSSG (National Security System Group); SSS Management Services. CS2 includes extracts from the UK websites of five businesses which also operate in the facilities management sector and accompany their company name with the phrase Support Services. CS3 consists of a copy from the opponent's website; Ms Sexton points out that the page confirms that "ISS was originally short for Intentional Service System and from 2001 short for Integrated Service Solutions but it is only used as the acronym today".

## **DECISION**

32. Section 5(2)(b) of the Act reads:

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

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

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

## **The opponent's best case**

33. Although the opponent has focused its opposition on three marks, no. 14697577 is the only mark which is not subject to proof of use and it is also the mark in respect of which the applicant accepted that a higher number of services are identical to the contested services. I shall therefore take it as my starting point.

34. An earlier trade mark is defined in Section 6 of the Act, which states:

“6.-(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

35. As this mark had not been registered for five years or more at the publication date of the opposed application, it is not subject to the proof of use provisions under section 6A of the Act. Consequently, the earlier mark may be relied upon for all of the goods and services for which it is registered without having to prove use.

## **Section 5(2)(b) - case-law**

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

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;



- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public 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**

37. 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:

“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”.

38. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- 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 services;
- 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.

39. I also bear in mind the decision in *Boston Scientific Ltd v OHIM*, Case T-325/06, where the General Court (GC) stated that “complementary” means:

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

40. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“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.”

41. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

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

unnaturally so as to produce a narrow meaning which does not cover the goods in question."

42. In *Gérard Meric v OHIM*, Case T- 133/05, the GC stated:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

43. Though, in its notice of opposition, the opponent relies on goods and services in classes 9, 35, 37, 39, 40, 41 and 42, in his final submissions it focuses on his class 37 services. As these services offer the best prospect of success to the opponent, I will take them as my starting point. The competing services are as follows:

Applied for services	Opponent's services include
<p><b>Class 37:</b> Installation, maintenance, servicing and repair of air conditioning, refrigeration, heating, ventilation, water treatment and hygiene apparatus; information, advice and consultancy in relation to the installation, maintenance and repair of air conditioning, refrigeration, heating, ventilation, water treatment and hygiene apparatus; electrical installation services.</p>	<p><b>Class 37:</b> Cleaning, repair and maintenance of buildings, facilities, yards, roads, property, gardens, rooms and industrial premises; installation, maintenance and repair of heating, ventilation and air-conditioning; installation, maintenance and repair of elevators and escalators; interior and exterior cleaning of buildings; cleaning within the food industry and disinfecting cleaning; industrial cleaning; cleaning and rinsing of electronic equipment, telephones and computers; cleaning and filling up various sanitary products in connection herewith of wet rooms,</p>

	<p>washrooms and toilets; installation of various sanitary products in wet rooms, washrooms and toilets; curtain, carpet, mats and upholstery cleaning; cleaning, maintenance and repair of aircrafts, ramps and runways; boiler cleaning and repair; burner maintenance and repair; dry cleaning and laundering; disinfecting and sterilization of medical systems and equipment; running of buildings for others including maintenance and repair of buildings and technical assistance with installations in buildings; advice on the practical running of buildings, including optimization of building maintenance and repair; inspection of buildings prior to maintenance and repair; maintenance and repair of electric installations and sanitary installations; clearing, cleaning and repair after fire and water damages; maintenance and repair of electric installations, mechanical installations and sanitary installations in buildings; painting interior and exterior; information and consultancy on constructions, building and installation of power rooms in buildings; constructions, building and installation of power rooms in buildings; management and optimizing of building management systems, including of energy supply systems in buildings; monitoring building</p>
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	<p>management systems; construction, building and maintenance of industrial buildings; maintenance of cooling systems and steam generation systems; plumbing and drainage services; installation, monitoring and maintenance of water treatment systems in buildings; carpentry services; critical infrastructure maintenance; maintenance of fitness club machinery; management, maintenance and supervision of critical environment in industrial premises; installation and maintenance of power distributions units and emergency power generating installations; extermination, disinfection and pest control; snow removal services; alarm, lock and safe installation, maintenance and repair; fire alarm installation and repair services; installation, maintenance and repair of computer hardware; installation, maintenance and repair of data center equipment; installation, monitoring and maintenance of fire fighting and fire prevention systems.</p>
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44. The contested *installation, maintenance, servicing and repair of air conditioning, heating and ventilation*, are self-evidently identical to the opponent's *installation, maintenance and repair of heating, ventilation and air-conditioning*.

45. As refrigeration systems are used to provide air conditioning, the contested *installation, maintenance, servicing and repair of refrigeration* encompass the opponent's *installation, maintenance and repair of air-conditioning*. These services are identical on the principle outlined in *Meric*.

46. The contested *installation, maintenance, servicing and repair of water treatment and hygiene apparatus* encompass the opponent's *installation, monitoring and maintenance of water treatment systems in buildings*. Alternatively, the contested *installation, maintenance, servicing and repair of hygiene apparatus* include the opponent's *installation of various sanitary products in wet rooms, washrooms and toilets* as well as its *maintenance and repair of sanitary installations*. These services are identical on the principle outlined in *Meric*.

47. The contested *electrical installation services* encompass the opponent's *installation and maintenance of power distributions units and emergency power generating installations*. These services are identical on the principle outlined in *Meric*.

48. Finally, the opponent's *advice on the practical running of buildings, including optimization of building maintenance and repair* is broad enough to encompass the contested *information, advice and consultancy in relation to the installation, maintenance and repair of air conditioning, refrigeration, heating, ventilation, water treatment and hygiene apparatus* so the services are identical on the *Meric* principle. Alternatively, given the relationship between the contested information, advice and consultancy services and the services to which they relate, which I found to be identical to the opponent's services, I find that there is a high degree of similarity between these services and the services covered by the earlier mark.

### **The correct approach**

49. Both parties have made references at various points in their submissions to the marks being used in relation to facilities management services. That perspective, I noted, seems to have fed into their assessment of the marks, average consumer and distinctive character of the earlier mark. Before proceeding any further, I will lay out the correct approach.

50. The phrase "facilities management" is defined in the Cambridge Online dictionary as meaning "the activity or job of looking after a company's buildings, equipment, land, etc." Whilst it may be the case that the contested services, namely, *installation, maintenance, servicing and repair of air conditioning, refrigeration, heating, ventilation,*

*water treatment and hygiene apparatus; information, advice and consultancy in relation to the installation, maintenance and repair of air conditioning, refrigeration, heating, ventilation, water treatment and hygiene apparatus; electrical installation services*, are supplied by facilities management companies as part of their services, there is a fundamental difference between supplying *installation, maintenance, servicing and repair services* as categories of building services concerned with installing and preserving technical systems and providing facilities management services. As the opponent's own evidence demonstrates, the provision of facilities management services involves, in fact, an element of strategic management (aimed to reduce risks and costs) of an organisation's facilities which a supplier of *installation, maintenance, servicing and repair services* would not provide.

51. Though the evidence shows that both parties are facilities management companies, there is nothing that ties the respective specifications to facility management services. Although this may not be fatal when it comes to proof of use (and enhanced distinctive character), as it could be argued that use of the mark in relation to specific services provided under the umbrella of "facility management services" is still use of the mark in relation to the same services, in the absence of any indication, in the specifications, that the services are facilities management services, the assessment under Section 5(2)(b) cannot be carried out from the standpoint of the average consumer of facilities management services only.

### **Average consumer**

52. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:



“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

53. In its submissions, the applicant relies on the parties’ evidence that all of the contested services fall within the umbrella of “facilities management services” and will generally be sought by businesses or entities requiring building facilities management services. Since, as I have already explained, the matter is to be approached on a notional basis, not on the basis of the parties’ current customer base, I find that the average consumer is likely to be either a member of the general public, i.e. a homeowner and/or a landlord, seeking the services in relation to domestic installations, or a business seeking the services either on an-hoc basis (in relation, for example, to new installations) or on contractual basis (in relation, for example, to maintenance, servicing and repair services). However, businesses are likely to be the most usual type of consumer at least in relation to services relating to *water treatment and hygiene apparatus*. As to the degree of attention paid during the purchase the applicant states:

*“The services applied for are specialist technical services which are usually purchased on a long term contractual basis and at relatively high cost. Because of this and also because of the risks and consequences attached to such services being inadequate or unsafe, the individual/s responsible for purchasing these services will do so only after careful consideration. Most likely they will have conducted research, have obtained comparative estimates and entered into a dialogue with the provider of these services. These services are not in the nature of low-cost, consumer goods which are purchased on an everyday basis and/or on impulse but instead will be purchased only after considerable deliberation. Bearing this in mind, the consumers’ level of attention when purchasing these services will be very high and, in such circumstances differences between marks will be noticed. Even if the public is*

*deemed to be the general public the relevant individuals within the general public would nevertheless pay a high level of attention before purchasing what are specialist technical services”*

54. The opponent, on the other side, states that there is nothing to suggest that consumers will pay an especially high degree of attention, because, it says, the services may be sought by smaller consumers for smaller value work/contract. From my experience the concerned services are not purchased frequently, are likely to be relatively expensive and must be provided by qualified installers, all of which suggest that even homeowners, landlords and small businesses are likely to pay, at least, an higher than average degree of attention when selecting them to ensure a good deal and a good level of safety and reliability.

55. The services are likely to be selected primarily by eye from brochures, presentations, internet sites etc. but word of mouth recommendations and enquiries are also likely to play a part in the selection process.

### **Comparison of marks**

56. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

57. It would be wrong, therefore, artificially to dissect the marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The respective marks are shown below:

Applied for mark	Earlier mark
 <p>The logo consists of the letters 'TSS' in a bold, purple, sans-serif font. The letters are slightly overlapping. Below 'TSS' is the word 'facilities' in a smaller, grey, sans-serif font.</p>	 <p>The logo consists of the letters 'ISS' in a white, bold, sans-serif font, set against a dark blue circular background. The letters are slightly overlapping.</p>

### Overall impression

58. The contested mark consists of the three capital letters 'TSS' presented in purple, in bold and in slightly oblique font; there is no space between the letters which overlap creating slightly darker shades where they touch each other. Below the letters 'TSS' is the word "facilities" presented in grey, in lower case and in a much smaller typeface. The opponent argues that the word "facilities" in the contested mark will be seen as descriptive, reinforcing the applicant's involvement in the same field of activity as the opponent's, i.e. facilities management, and will carry little weight in the overall impression conveyed by the mark. I have already indicated that this is not the correct approach. That said, whilst I find that the word "facilities" meaning "buildings, equipment, or services that are provided for a particular purpose", has no direct meaning in relation to the services, I also find that it will be perceived as a term somehow referring, or alluding, to the services provided and wholly subordinate to the component TSS. These letters are not pronounceable as a word and so are likely to be recognized as an abbreviation standing for the words making up the name of the undertaking providing the services. Due to its positioning and larger size, it is the component that plays the greatest role in the overall impression. The font, the colour

and the joining of the letters also bring some distinctiveness to the mark, though their relative weight in the overall impression is significantly less than that of TSS.

59. The earlier mark is made up of the three letters 'iss' presented in lower case in bold and in a slightly tilted typeface. The letters, which in my view, will likely be perceived as an abbreviation, are presented in white horizontally across the centre of a deep dark blue oval shaped background, with the dot above the letter 'i' having no borders around it. The coloured oval shaped device is part of the mark and makes a visual impression given the angle of its presentation and the way the letters are incorporated into it. Consequently it will not go unnoticed by the average consumer and it plays a part in the overall impression of the mark. However, it is the component 'iss' that plays the greater role and dominates the overall impression.

### **Visual similarity**

60. The opponent states that when printed, the colours of the respective marks are similar. It states:

- c) Colour – the Applicant's Mark is a blue/purple shade close to shade of blue used in the Opponent's Earlier Mark. In some lights, this looks almost identical in shade. The Applicant chose to adopt a similar colour, when it could have chosen an array of dissimilar colours such as red, orange green etc. that would have reduced rather than increased confusion.

It is relevant and notable that when the UK IPO record for the Application is printed, the Applicant's Mark appears in a dark blue colour, very close in shade to the Opponent's mark. An example of a database extract that has been printed is attached at Annex 1. The same is true when extracts from the Applicant's own evidence is printed that shows the Applicant's mark in use. At Annex 2, is a print out of Exhibit AJT2, which shows the Applicant's Mark in a blue shade highly similar to the shade used in EU TM 014697577 and used by the Opponent.

It is known within the print industry that the type of blue concerned will often appear purple and vice versa. Attached at Annex 3 is an article to this effect about the difficulties of printing these colours and how they will often be the same when printed.

The use of similar shade, which becomes almost identical when printed, is a relevant factor in the assessment of similarity and confusion. The relevant consumer will of course come across the Applicant's mark in printed material where it will appear identical or highly similar in colour to the Earlier Marks. This increases similarity and the likelihood of confusion.

61. The material provided by the applicant is inadmissible because it should have been filed as evidence. In any event, even if it had established the relevant facts, the colours of the marks must be considered as applied for and registered, not on the basis of the printed technologies available.

62. In term of visual similarity, the signs are of equal length, both consisting of three letters with the last two letters 'SS/ss' of each mark being the same. However, that similarity does not offset the differences between the two marks resulting from their different initial letters 'T' and 'i'. Small differences can indeed make a striking difference in short marks. That process is aided in this case by the fact that the difference occurs at the start of the three letter combination. Further, as the marks are figurative marks, the letters must be considered as they appear. In my view, whilst the marks have some similarity because of the common double 'S' at the end and the use of a similar tilted typeface, visually the letter 'T' in upper case differs greatly from the letter 'i' written in lower case. In addition, the letters TSS in the applied for mark are joined while the letters 'iss' in the earlier mark are separated. The presence of the figurative element in the earlier mark, the additional word "facilities" and the purple colour of the letters TSS in the applied for mark and the contrast created by the use of white letters against a deep dark blue background in the earlier mark, further highlight the differences between the marks. In my view, the marks are visually similar to a low degree.

### **Aural similarity**

63. So far as concerns the phonetic aspect, both marks will most likely be perceived as abbreviations or acronyms and will be pronounced by reference to each letter. The applied for mark is likely to be articulated as TI (like in tea) -ESS-ESS-FA-SI-LI-TIES and the earlier mark as A-I (like in eye) -ESS-ESS respectively. The pronunciation of the last two letters is identical but the sound of the letters 'T' and 'i' is markedly different. The contested mark also contains the additional component "facilities". In this connection, the opponent states that the word "facilities" is wholly descriptive and will not be given any weight in the mark when spoken or pronounced, although it did not submit that it will not be articulated. The applicant states that the letters 'iss' could be pronounced as a word because, it says, the average consumer is likely to recognise the word 'is' at the beginning of the earlier mark and elongate it to take into account the final letter 's'. According to the applicant, the earlier mark will be pronounced in the same way that the element 'iss' in the word 'hiss'. Whilst I agree that the average consumer may notice that, visually, the letters 'iss' resemble, in English, the well-known and largely used word 'is' (which, in turn, may aid the recollection of the mark), I have already found that the earlier mark is likely to be perceived as an abbreviation

and, on that basis, the natural tendency would be to articulate 'iss' letter by letter. In my view, there is a low to medium degree of aural similarity.

### **Conceptual similarity**

64. Conceptually, both marks are likely to be identified as abbreviations standing for the names of the underlying organisations. Neither mark has any meaning save for the word "facilities" in the applied for mark. However, any concept introduced by that word is likely to be perceived as somehow relating to the services provided by a company called TSS and is of little or no distinctive character. The conceptual position is neutral.

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

65. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated at paragraphs 22 and 23 that:

"In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of

commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

66. The applicant states that the earlier marks have a low degree of distinctive character because are short marks and because the letters ‘ss’ at the end of the marks are not particularly distinctive in the context of facility management related services. It states:

*“In the context of these services, the letters SS are commonly used as an acronym for various descriptive phrases such as support services, site supplies, security services, service solutions. Furthermore, there are many marks consisting of three or four letters and ending with SS co-existing in use in the "facilities management" sector. The Hearing Officer's attention is drawn to the Witness Statement and exhibits of Camilla Sexton in support of these claims. It is clear from this evidence that the letters SS are frequently used by many different entities in the same service sector as both the Applicant and the Opponent. This means that the letters SS are of very low distinctive character in relation to these services. The relevant public will be familiar with the use of these letters as acronyms for the descriptive phrases listed above and will not therefore see these letters as performing the function of distinguishing one service provider from another. Exhibit CS3 of this Statement shows that, in fact, the Opponent's own mark is an acronym; the Opponent was originally called International Service System, then Integrated Service Solutions before being shortened to the acronym "iss".*

67. Ms Sexon’s evidence is not pertinent. The assessment of the distinctive character of a mark must be carried out on the basis of the services as they are registered, and I have already found that there is no reference in the registered specification to the services being “facility management services”. In any event, the evidence does not establish that the letters ‘ss’ are a recognised abbreviation for the full terms "support services", “site supplies”, “security services” or "service solutions".

68. The verbal element of the earlier mark consists of the short three-letter combination ‘iss’. The applicant submits that ‘iss’ stands for *International Service*

*System or Integrated Service Solutions*, however, 'iss' does not appear in combination with these word elements. Given that the average consumer's perception must be assessed on the basis of the mark as it is registered, I cannot see how consumers could be aware of the etymology behind the earlier mark and I am not aware that it has any descriptive connotation in relation to the services concerned. That said, 'iss' does not seem to me to exhibit a particularly high degree of invention given that the letter 'i' is one of the most common letters used in the English language (as compared to, for example, letters such as Q or X) and the letters 'ss' are not uncommon repeats.

69. Whilst the oval device element brings some distinctiveness to the mark, it is the distinctiveness of the common element that is the key<sup>1</sup>. The slightly tilted and bold typeface has a visual impact, however, it is not particularly striking or remarkable and does not materially increase the distinctive character of the earlier mark above what I consider to be no more than modest, i.e. below average, as an unused mark. That brings me to the opponent's use that was commented upon by the applicant in the following terms:

*"The evidence filed is not solid and precise. Generally speaking, much of the evidence is undated, taken from internal sources, not independently verified and often does not show any use of the Earlier marks. It is vague and insufficiently precise in terms of showing use of the Earlier marks in relation to the specific goods/services for which use/reputation has been claimed and in terms of geographical spread. Most of the evidence is out of context and no supporting information or substantiation is provided from which meaningful conclusions can be reached. There is very little quantitative data in the evidence. It is therefore submitted that, taken as a whole, the evidence does not prove either that; i) any of the Earlier marks can benefit from enhanced distinctiveness, ii) any of the Earlier marks have a "reputation" sufficient for the purposes of Section 5(3) namely that they are known by a significant part of the relevant public across the EH or iii) that the Opponent has sufficient goodwill in any marks pleaded in the context of the claims made under Section 5(4)(a) of the Act."*

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<sup>1</sup> *Kurt Geiger v A-List Corporate Limited*, BL O-075-13



70. I agree with the applicant. Bearing in mind that the opponent's best case rests on identical (or highly similar) services, what the opponent needs to prove here is that, at the application date, i.e. 28 January 2016, the earlier mark had acquired an enhanced distinctive character through use in the UK in relation to the services at issue, namely *installation, maintenance and repair of heating, ventilation and air-conditioning; installation, monitoring and maintenance of water treatment systems in buildings; installation and maintenance of power distributions units and emergency power generating installations and advice on the practical running of buildings, including optimization of building maintenance and repair*. In my view, the evidence fails to establish that. Whilst the figures provided are not insignificant, given the wide range of services offered it is impossible to establish what proportion of the turnover relates to these services. For example, the UK annual turnover given in evidence is not broken down by services and the global annual turnover for the property management sector (within which, Mr Lykke-Olesen states, ISS "maintenance, heating, ventilation and air conditioning services" fall) is not broken down by country. Even proceeding on the assumption that the percentage of UK turnover relating to property services reflects the 21% quote given in relation to the percentage of ISS revenue generated in 2015 in Western Europe by the provision of "property services" (a fact that is not proven), which would amount to about £283m, one needs to make a further assumption to conclude that any percentage of that 283m relates to the concerned services. This is because, as shown by the evidence, the turnover generated by "property services" includes turnover generated by services other than "maintenance, heating, ventilation and air conditioning", namely "building and technical maintenance, technical services, energy management and grounds maintenance" and there is no indication of how the total is split into the various services categories. Neither do the invoices provided establish use in relation to any specific services since they all refer to "services fees" save for one invoice which appears to refer to carpentry services. As to the evidence that ISS was selected to provide a number of UK companies with a variety of services, what is striking about most of this evidence is the level of generality used in the description of the services, e.g. engineering services, mechanical, electrical and building fabric services, maintenance services, etc, which does not give a clear indication of the services being provided. In any event this evidence fails to establish the percentage of revenue generated by these contracts in relation to the provision of specific services. Finally, none of the evidence relating to the awards won by ISS relate

to the concerned services. Accordingly, I find that the earlier mark has not acquired an enhanced distinctive character in relation to the services at issue.

### **Likelihood of confusion**

71. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective services and vice versa. I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

72. There are two types of relevant confusion to consider: direct confusion (where one mark is mistaken for the other) and indirect confusion (where the respective similarities lead the consumer to believe that the respective goods and services come from the same or a related trade source). In *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 Mr Iain Purvis Q.C. sitting as the Appointed Person noted that:

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

73. Though the services are identical (or highly similar) there is only a low degree of visual similarity and a low to medium degree of aural similarity between the marks. The conceptual position is neutral. The purchase is primarily visual but aural considerations are also likely to play a part. I must also factor in that the services will be selected with, at least, a higher than average degree of attention; this mitigates strongly against imperfect recollection causing confusion. The earlier mark has only a modest degree of distinctive character and the evidence does not establish that it has acquired an enhanced distinctiveness through use in relation to the services at issue.

74. Taking all of the factors into account and adopting a global approach as the case law requires, I come to the conclusion that there is no likelihood of direct confusion. Given the higher than average degree of attention that I consider would be displayed and even allowing for imperfect recollection, the marks are simply not similar enough to cause confusion. There is no question here of the average consumer just mistaking one mark for another.

75. As to the possibility of indirect confusion, the opponent has clearly pleaded its case as a case of direct confusion. For the sake of completeness, I should add that given the low degree of similarity between the marks and the very nature of the marks, which will be perceived as abbreviations, it seems to me entirely improbable that anyone noticing the difference between the marks would think they come from the same or economically connected undertakings. **There is no likelihood of direct or indirect confusion.**

76. I should finally mention that I have given no weight to the applicant's evidence about parallel trading. Use of the applied for mark started in April 2013, less than 2 years before the application was filed and most of the use shown seems to be localised so I am not inclined to regard it as a factor in the global assessment.

77. For the reasons given above, the opposition under Section 5(2)(b) fails and is dismissed.

### Opposition under section 5(3)

78. Section 5(3) states:

“(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 the repute of the earlier trade mark.”

79. The required level of reputation was described by the CJEU in *General Motors* in the following way:

“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.”

80. The opponent claims that the earlier mark 14697577 have acquired a reputation in relation to a variety of services including services that I found to be identical (or highly similar) to the services at issue. As that mark is a EUTM, in terms of reputation, the relevant test is to establish reputation in a substantial part of the EU. However, the

necessary link must be made by the relevant section of public in the UK. Consequently, without an UK reputation it is hard to see how there will be a link and damage in the UK. In the preceding paragraphs I set out my reasons for rejecting the opponent's claim that the earlier mark had acquired an enhanced level of distinctiveness in relation to *installation, maintenance and repair of heating, ventilation and air conditioning; installation, monitoring and maintenance of water treatment systems in buildings; installation and maintenance of power distributions units and emergency power generating installations and advice on the practical running of buildings, including optimization of building maintenance and repair*. For the same reasons, I find that the earlier mark had not acquired a reputation in the UK for these services by the relevant date, i.e. date of the application.

81. Turning to the matter of whether the earlier mark had acquired a reputation in the UK for any other services, the opponent accepts in its submissions that 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. Though, in its evidence and submissions, it refers to ISS as the market leader in facilities management, I did not understand the opponent to say that its reputation in relation to facilities management services corresponds in fact to any specific services in class 35 or 37 for which its marks are registered. Whilst it may be the case that the opponent is known in the UK as a facilities management company, as the evidence shows, the term "facilities management" refers to the provision of a wide variety of support services to businesses and organisations including facilities and property management, engineering, catering, cleaning, food and hospitality, front of house, security, waste projects and landscaping. The earlier mark is a EUTM and I note that the EUIPO Examination Manual states:

#### "4.2.2 Vague terms

The same principles regarding clarity and precision as described above are applicable to all the goods and services listed in the application. Terms that do not provide a clear indication of the goods covered should be objected to. Examples of such expressions are:

*Facilities management services.”*

82. The above confirms that the phrase “facilities management” cannot be registered because it does not provide a clear indication of what services involves. It is, it seems to me, a buzz word used in the relevant sector by companies who provide a wide range of support services to businesses and organisations. However, when it comes to prove reputation (and use) in a trade mark dispute, the evidence must establish what services the reputation relates to. In my view, given:

- i) the variety of the commercial services performed by the opponent
- ii) the absence of any clear indication relating to the proportion of UK turnover generated by the specific services and
- iii) the lack of information about the opponent’s market share and the size of its investment,

The opponent’s evidence fails to do so.

83. As the opponent has not shown that it had reputation in any earlier trade marks in relation to any of the services relied upon, the ground under Section 5(3) fails at the first hurdle and the opposition is dismissed.

### **Passing-off ground**

84. Section 5(4)(a) states:

“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, or

(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.”

85. 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 stated that:

“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).”

86. The opponent claims to have acquired goodwill under the earlier marks in relation to the same services relied upon under Section 5(2)(b). The evidence is sufficient to establish that the opponent has acquired a valuable goodwill as a cleaning company. This is because:

- i) the evidence shows that 50% of the opponent’s primary revenue comes from cleaning services and that the opponent is most acknowledged as a cleaning brand;
- ii) the term cleaning services is specific so it is possible to establish what are the services provided;
- iii) the evidence shows use of the earlier mark in relation to cleaning services in the UK, i.e. Gatwick airport, and there is evidence of the opponent securing a number of contracts in the UK before the relevant date involving the provision of cleaning services, i.e. Royal College of General Practitioners and Edinburgh College;
- iv) there is evidence of the opponent providing apprenticeship in the UK in the cleaning sector and being ranked Best in Class by the British Institute of cleaning services.

87. However, there is little specific evidence of sale or marketing in relation to the other services relied upon by the opponent, including the services which I found to be identical to the applied for services.

88. For the reasons I gave in my analysis under Section 5(2)(b), the contested mark is unlikely to be mistaken for the earlier marks<sup>2</sup> even where identical services are involved. Consequently, even if the opponent had established goodwill for identical services, use of the applied for mark would not constitute a misrepresentation to the public under Section 5(4)(a). This is all of the more so given the differences between the opponent's *cleaning services* and the applied for *installation, maintenance, servicing and repair of air conditioning, refrigeration, heating, ventilation, water treatment and hygiene apparatus; information, advice and consultancy in relation to the installation, maintenance and repair of air conditioning, refrigeration, heating, ventilation, water treatment and hygiene apparatus; electrical installation services*.

89. In the alternative, the opponent claims to have goodwill in the plain letters ISS. Even if the opponent had acquired goodwill under the letters ISS alone, taking into account the nature of the marks (which will be perceived as abbreviations) and the greater degree of discrimination than usual which will be needed on the part of the public, I find that the difference between ISS in plain letters form and the applied for mark is sufficient to avoid misrepresentation through deception.

90. The opposition based on Section 5(4)(a) also fails.

## **Conclusion**

91. The opposition fails in its entirety and the application may proceed to registration.

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<sup>2</sup> Though I did limit my assessment of the likelihood of confusion to the mark 14697577, the only difference between this mark and the other two marks relied upon is the colour of the oval shaped background which does not materially alter the considerations I reach in respect of the mark 14697577.



## **COSTS**

92. As the applicant has been successful, it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2 of 2016. I take account that both sides filed evidence and written submissions. The applicant requested an award of costs at the top end of the scale because the opponent's pleadings and evidence was wide-ranging and put the applicant to additional costs in reviewing it. I agree that the opponent pleadings and evidence could have been more focused so I will increase the award to a certain extent. Bearing all this in mind, I award costs as follows:

Considering other side's statement and preparing counterstatement:	£520
Preparing evidence and considering other side's evidence:	£1,300
Written submissions:	£520
Total:	£2,340

93. I order ISS World Services A/S to pay T.S.S. Facilities Limited the sum of £2,340 as a contribution towards its costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case, if any appeal against this decision is unsuccessful.

**Dated this 16<sup>th</sup> day of April 2018**

**Teresa Perks  
For the Registrar  
The Comptroller General**

**Annex A – Services relied on in the opposition Section 5(2)(b) and Section 5(4)(a)**

**International registration 001920396 (EUTM designation)**

Class 35 Employment agency services, office functions; telephone answering services; business consultancy in connection with the operation of kiosk, kiosks for selling products; data and database management, including editing of information into computer databases, compilation of information into computer databases and systemization of information into computer databases; document reproduction;

Class 37 Maintenance and repair of runways, maintenance of heating and air conditioning systems, of elevators and of escalators, outer and inner cleaning of aircrafts, cleaning of ramps and of runways; cleaning of buildings, yards, facilities, property, roads, public areas, gardens, rooms and vehicles, including special cleaning; cleaning within the food industry and disinfecting cleaning; cleaning of industrial premises; cleaning and rinsing of telephones and computer; vermin exterminating (other than for agriculture); snow removal services; janitorial services, including maintenance, management of energy supply and reparation; clearing, cleaning and repair after fire- and water damages; installation, maintenance and reparation of computer hardware, including servers.

Class 39 Transport services; removal of contaminated water;

Class 42 Supervision of hygiene and consultancy relating to environmental conditions within the foodstuff industry, including bacteriological tests; consultation in environment protection; pest control services (for agriculture)

**International registration 0968240 (EUTM designation)**

Class 35 Personnel recruitment, provision of personnel for events, provision of personnel for operation of switch boards, receptions, call centres and helpdesks, secretarial services, office space management (administration of and advice on office space for others), administration of furniture for companies; data and data base management; business management, namely advice on and providing subcontractors relating to employment, office logistics services, management of real estate, building management services, outer and inner building maintenance and cleaning, cleaning of facilities, industrial premises, public areas, roads and gardens, architectural services, building construction, clearing, cleaning and repair after fire and water damage, waste disposal services, transportation services, office messenger services, hygiene inspection and control services, engineering services, IT services and solutions, interior design services, services for providing of food and drink, gardener and gardening services for outdoor and indoor green areas, security services, pest control services and vermin exterminating; management of business processes for companies concerning outsourcing relating to employment services, office logistics services, management of real estate, building management services, outer and inner building maintenance and cleaning, cleaning of facilities, industrial premises, public areas, roads and gardens, building projects, clearing, cleaning and repair after fire and water damage, waste disposal services, transportation services, office messenger services, hygiene inspection and control services, engineering services, IT services and solutions, interior design services, services for providing of food and drink, gardener and gardening services for outdoor and indoor green areas, security services, pest control services and

vermin exterminating; business consultancy services all relating to property and estate management, projects management, cleaning, catering, security, logistics, personnel, mechanical and electrical maintenance services, communications and IT consultancy and management; office functions; business consultancy in connection with the operation of kiosks, kiosks for selling products, namely newspapers, magazines, confectionery, ice-cream, flowers, greeting cards, tooth brushes, sanitary towels, snacks, fruits, non-alcoholic beverages, personal cleaning products; employment agency services; internal mail sorting for others; document reproduction.

Class 37 Maintenance of heating and air conditioning systems, of elevators and of escalators; cleaning of buildings, yards, facilities, property, gardens and rooms; cleaning within the food industry and disinfecting cleaning; cleaning of industrial premises; cleaning and rinsing of telephones and computers; cleaning and re-filling of various sanitary products in connection with wet rooms, washrooms and toilets; installation of various sanitary products in wet rooms, washrooms and toilets; curtain, carpet, mats and upholstery cleaning; cleaning, maintenance and repair of aircrafts, ramps and runways; vermin exterminating (other than for agriculture); snow removal services; janitorial services, namely maintenance, cleaning and repair of buildings; maintenance and repair of electric installations and sanitary installations; clearing, cleaning and repair after fire and water damage; maintenance, inspection and minor reparations of buildings; property development; maintenance and repair of electric installations in buildings, mechanical installations and sanitary installations in buildings; advisory services relating to the construction, maintenance and repair of mechanical engineering structures connected with buildings.

Class 39 Transport services; transport of contaminated water; Class 40 Waste disposal services (processing and treatment); water treating.

Class 42 Quality control of hygiene and consultancy relating to environmental conditions within the foodstuff industry, including bacteriological tests; quality control; consultation in environment protection.

**EUTM No 014697577 (not subject to use requirements)**

Class 9 Recorded computer software; computer programs (downloadable software); computer software applications, downloadable; information technology and audiovisual equipment; data storage devices; audio/visual and photographic devices; fire extinguishers.

Class 35 Business assistance, business management and business administrative services; business management, namely advice on and providing subcontractors; management and administration of business processes for others; administration of facilities for others; optimization and integration of business processes for others; business management and business assistance in relation to integration of service solutions for others; business consultancy and advisory services; business management and organizational consultancy; management and administration of business projects for others; business advisory services on facilities and management of facilities for others; business advice, development and management of workplaces for others; clerical services, including operation of switch boards, receptions, call centres and helpdesks for others; human resources management and recruitment services; internal mail sorting for others; administrative data processing; business analysis, research and information services; collection, systemization, sorting, configuration and editing of business data and business information, including in databases and

online databases; data and data base management; business and organizational assessment and management of business, operational and financial data for others; monitoring, measuring, visualizing and management of business, and operational data for others, including in databases and online databases, including in real-time; loyalty, incentive and bonus program services; procurement services for others; sales promotional advisory and assistance services; commercial trading and consumer information services; advisory services on management of retail services; business reporting to management of business, operational and financial data; outsourcing services [business administration]; business management assistance; business auditing; business management services for construction projects; business management services for renovation projects; outsourced administration management for companies; business consultancy in connection with the operation of kiosks, kiosks for selling products; rental of vending machines.

Class 37 Cleaning, repair and maintenance of buildings, facilities, yards, roads, property, gardens, rooms and industrial premises; installation, maintenance and repair of heating, ventilation and air-conditioning; installation, maintenance and repair of elevators and escalators; interior and exterior cleaning of buildings; cleaning within the food industry and disinfecting cleaning; industrial cleaning; cleaning and rinsing of electronic equipment, telephones and computers; cleaning and filling up various sanitary products in connection herewith of wet rooms, washrooms and toilets; installation of various sanitary products in wet rooms, washrooms and toilets; curtain, carpet, mats and upholstery cleaning; cleaning, maintenance and repair of aircrafts, ramps and runways; boiler cleaning and repair; burner maintenance and repair; dry cleaning and laundering; disinfecting and sterilization of medical systems and equipment; running of buildings for others including maintenance and repair of buildings and technical assistance with installations in buildings; advice on the practical running of buildings, including optimization of building maintenance and repair; inspection of buildings prior to maintenance and repair; maintenance and repair of electric installations and sanitary installations; clearing, cleaning and repair after fire and water damages; maintenance and repair of electric installations, mechanical installations and sanitary installations in buildings; painting interior and exterior; information and consultancy on constructions, building and installation of power rooms in buildings; constructions, building and installation of power rooms in buildings; management and optimizing of building management systems, including of energy supply systems in buildings; monitoring building management systems; construction, building and maintenance of industrial buildings; maintenance of cooling systems and steam generation systems; plumbing and drainage services; installation, monitoring and maintenance of water treatment systems in buildings; carpentry services; critical infrastructure maintenance; maintenance of fitness club machinery; management, maintenance and supervision of critical environment in industrial premises; installation and maintenance of power distributions units and emergency power generating installations; extermination, disinfection and pest control; snow removal services; alarm, lock and safe installation, maintenance and repair; fire alarm installation and repair services; installation, maintenance and repair of computer hardware; installation, maintenance and repair of data center equipment; installation, monitoring and maintenance of fire fighting and fire prevention systems.

Class 39 Transport services; transport of contaminated water; waste disposal services (transport and storage).

Class 40 Waste disposal services (processing and treatment); water treating.

Class 41 Education; providing of training; entertainment;

Class 42 Testing and quality control of hygiene in industrial premises; consultancy relating to environmental conditions within the foodstuff and health industry; bacteriological testing; quality control; consultation in environment protection; consultation on optimizing and monitoring of environmental conditions in workplaces; software development, programming and implementation; design and development of software and databases for business, operational and financial data; maintenance and updating of software, computer programs, data and databases; IT consultancy, advisory and information services; rental of software and databases; monitoring of computer systems by remote access; architectural services and consultation; industrial analysis and research services; design of interior decor; architectural and design analysis and advice on exterior and interior design of workplaces and industrial premises; engineering services; monitoring energy supply systems in buildings; monitoring of power distributions units and emergency power generating installations.

## **Annex B – Services for which reputation is claimed**

### **International registration 001920396 (EU TM designation)**

Class 37 Maintenance and repair of runways, maintenance of heating and air conditioning systems, of elevators and of escalators, outer and inner cleaning of aircrafts, cleaning of ramps and of runways; cleaning of buildings, yards, facilities, property, roads, public areas, gardens, rooms and vehicles, including special cleaning; cleaning within the food industry and disinfecting cleaning; cleaning of industrial premises; cleaning and rinsing of telephones and computer; vermin exterminating (other than for agriculture); snow removal services; janitorial services, including maintenance, management of energy supply and reparation; clearing, cleaning and repair after fire- and water damages; installation, maintenance and reparation of computer hardware, including servers.

### **International registration 0968240 (EUTM designation)**

Class 35 provision of personnel for operation of switch boards, receptions, call centres and helpdesks, secretarial services; business management, namely advice on and providing subcontractors; management of business processes for companies concerning outsourcing relating to employment services, office logistics services, management of real estate, building management services, outer and inner building maintenance and cleaning, cleaning of facilities, industrial premises, public areas, roads and gardens, building projects, clearing, cleaning and repair after fire and water damage, waste disposal services, transportation services, office messenger services, hygiene inspection and control services, engineering services, IT services and solutions, interior design services, services for providing of food and drink, gardener and gardening services for outdoor and indoor green areas, security services, pest control services and vermin exterminating;

### **EUTM No 014697577 (not subject to use requirements)**

Class 35: business management, namely advice on and providing subcontractors; management and administration of business processes for others; administration of facilities for others; optimization and integration of business processes for others; business management and business assistance in relation to integration of service solutions for others; business advisory services on facilities and management of facilities for others; business advice, development and management of workplaces for others;

Class 37 Cleaning, repair and maintenance of buildings, facilities, yards, roads, property, gardens, rooms and industrial premises; installation, maintenance and repair of heating, ventilation and air-conditioning; installation, maintenance and repair of elevators and escalators; interior and exterior cleaning of buildings; cleaning within the food industry and disinfecting cleaning; industrial cleaning; cleaning and rinsing of electronic equipment, telephones and computers; cleaning and filling up various sanitary products in connection herewith of wet rooms, washrooms and toilets; installation of various sanitary products in wet rooms, washrooms and toilets; curtain, carpet, mats and upholstery cleaning; cleaning, maintenance and repair of aircrafts, ramps and runways; boiler cleaning and repair; burner maintenance and repair; dry cleaning and laundering; disinfecting and sterilization of medical systems and equipment; running of buildings for others including maintenance and repair of buildings and technical assistance with installations in buildings; advice

on the practical running of buildings, including optimization of building maintenance and repair; inspection of buildings prior to maintenance and repair; maintenance and repair of electric installations and sanitary installations; clearing, cleaning and repair after fire and water damages; maintenance and repair of electric installations, mechanical installations and sanitary installations in buildings; painting interior and exterior; information and consultancy on constructions, building and installation of power rooms in buildings; constructions, building and installation of power rooms in buildings; management and optimizing of building management systems, including of energy supply systems in buildings; monitoring building management systems; construction, building and maintenance of industrial buildings; maintenance of cooling systems and steam generation systems; plumbing and drainage services; installation, monitoring and maintenance of water treatment systems in buildings; carpentry services; critical infrastructure maintenance; maintenance of fitness club machinery; management, maintenance and supervision of critical environment in industrial premises; installation and maintenance of power distributions units and emergency power generating installations; extermination, disinfection and pest control; snow removal services; alarm, lock and safe installation, maintenance and repair; fire alarm installation and repair services; installation, maintenance and repair of computer hardware; installation, maintenance and repair of data center equipment; installation, monitoring and maintenance of fire fighting and fire prevention systems.