

O/927/22

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK REGISTRATION NO. UK00003360333

IN THE NAME OF

PENINSULA BUSINESS SERVICES LIMITED

IN CLASS 35

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY

THERE TO UNDER NO. CA000503742

Background and pleadings

1. On 12 December 2018, Peninsula Business Services Limited (“the registered proprietor”) applied to register the mark shown below. It is registered under No. UK00003360333, dated 3 May 2019.

Peninsula Face2Face

2. The mark is registered for the following services:

Class 35 Human resources consultancy; Human resources consultation; Business consultancy; Business consultancy services; Business consultancy to firms; Business consultancy to individuals; Business consultation; Business consultation services.

3. An application was made by face2faceHR Partners Limited (“the cancellation applicant”) to have the above mark declared invalid under section 47(2) of the Trade Marks Act 1994 (“the Act”) using Form TM26(I), including a statement of grounds, which was received by the Registry on 25 April 2021. The application is based upon sections 5(2)(b) and 5(3) of the Act and concerns all the services that the contested mark is registered for.
4. Under sections 5(2)(b) and 5(3), the cancellation applicant relies upon the mark No. UK00003247616 shown below which was applied for on 1 August 2017 and registered on 15 June 2018. It relies upon the services shown below and states that it had a reputation for all of those services when the later trade mark was applied for.



5. The registration covers the following services:

Class 35 Human resources consultancy; Human resources consultation;
Human resources management.

6. The registered proprietor filed a Form TM8 and a counterstatement denying the claims made, which was received by the Registry on 28 June 2021.
7. Both parties filed written submissions in lieu of a hearing.
8. Both parties filed evidence. The cancellation applicant also filed evidence in reply.
9. The cancellation applicant is a litigant in person while the registered proprietor is represented by Wilson Gunn.

Evidence

10. The cancellation applicant filed evidence in the form of a witness statement from Eleanor Deem, founder and proprietor of the cancellation applicant. The witness statement is signed and dated 2 September 2021.
11. The registered proprietor filed evidence in the form of a witness statement from Zohaib Mati, an in-house solicitor for the registered proprietor, together with Exhibit 1, which introduces some Google search results. The witness statement is signed and dated 6 May 2022.
12. The cancellation applicant filed evidence in reply in the form of a second witness statement from Eleanor Deem, signed and dated 7 July 2022, together with Exhibit 1, which introduces some Google search results.
13. The cancellation applicant's first witness statement makes reference to a previous case involving the same parties. Paragraph 3.5 says the following:

“Recognising the risk of confusion in the market between *face2faceHR* and *HRFace2Face*, a settlement agreement was entered into between *face2faceHR Ltd*, *face2faceHR Partners Limited* and *Peninsula Business Services Limited*, pursuant to which:

3.5.1 Peninsula withdrew its opposition to the *face2faceHR* mark;

3.5.2 Peninsula unconditionally surrendered its *HRFace2Face* mark;
and

3.5.3 *face2faceHR* withdrew its proposed challenge to a new mark sought by Peninsula, *Peninsula HRFace2Face*.”

14. As can be seen, the above refers to a previous dispute between the parties concerning other marks incorporating the words “HR” and “face2face”/“Face2Face”. However, at the time no decision was issued because the parties managed to settle the matter between themselves, a fact which does not assist either of the parties.

The law in relation to invalidity

15. Section 5(2)(b) of the Act has application in invalidation proceedings pursuant to Section 47 of the Act.

16. Section 47 reads as follows:

“47(1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground -

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

[...]

[...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

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

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

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

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

(2C) For these purposes –

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

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

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

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

Section 5(2)(b)

17. Sections 5(2)(b) and 5A of the Act read as follows:

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

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

18. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(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.”

19. The mark relied upon by the cancellation applicant qualifies as an earlier trade mark. Given its registration date, the earlier mark is not subject to the proof of use provisions contained in Section 47(2A) of the Act.

Section 5(2)(b) – relevant case law

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

The principles:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only

when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the trade marks


21. 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.”

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

23. The marks are shown below:

Cancellation applicant's mark	Registered proprietor's mark
	<p data-bbox="821 1512 1340 1563">Peninsula Face2Face</p>

24. The cancellation applicant's mark is a figurative mark in blue with “face2faceHR” as all one word, but the “face2face” part is written in an all lower case stylised font as if handwritten (with the “2” in bold) and “HR” is in bold block capitals. The words are partially reproduced in faint text below as if reflected in water. There is also a green leaf above the text in between the “e” and the “H”. There is a remote possibility that the as-if-handwritten

“2” could be seen as a “Z”, but it would not be seen as such by a significant proportion of average consumers and in any event neither party regards the phrase that is common to both marks as anything other than “face2face”/“Face2Face”. The element “face2face” will be read as a unit given that it will be perceived as the well-known phrase “face to face”, while “HR” would be read as a well-known abbreviation for “Human Resources”. HR is less distinctive than “face2face” because it is descriptive of the registered services, all of which are HR services. The words in the mark play a more dominant role in the overall impression than that played by the stylisation and the decorative element.

25. The registered proprietor’s word mark is “Peninsula Face2Face”. The mark as a whole could be rendered in the same colour as that used in the cancellation applicant’s mark and the phrase “Face2Face” could be presented in all lower case. The element “Face2Face” will be read as a unit given that it will be perceived as the well-known phrase “face to face”. The words in the registered proprietor’s mark are the only things that contribute to the overall impression, but the word “Peninsula” is the marginally more dominant and distinctive element. This is because the word “Peninsula” is the first word in the mark that the average consumer, reading left to right, will see and it is more distinctive in the context of the services for which the registered proprietor’s mark is registered than the phrase “Face2Face”.
26. Visually, one mark contains stylistic and decorative elements, while the other is a plain word. The marks also differ in that, while the marks share the common phrase “face2face”/“Face2Face”, the cancellation applicant’s mark has the two letters “HR” at the end, while the registered proprietor’s mark contains the word “Peninsula” at the beginning which is absent from the cancellation applicant’s mark. The marks are of medium visual similarity.
27. Aurally, the cancellation applicant’s mark is “FACE-TUH-FACE-AITCH-AH” and the registered proprietor’s mark is “PEN-INCE-SHULA FACE-TUH-FACE”. The marks are of medium aural similarity.

28. In the cancellation applicant's mark, the beginning part of it is the phrase "face2face" which will be understood as meaning "face to face", the Collins online dictionary explaining that, "If you come face to face with someone, you meet them and can talk to them or look at them directly." Consequently, this part of the mark gives rise to the concept of meeting people and talking to them or looking at them directly. "HR" stands for "Human Resources" which are the services for which the cancellation applicant's mark is registered.
29. In the registered proprietor's mark, a "Peninsula" is "a long narrow piece of land which sticks out from a larger piece of land and is almost completely surrounded by water" while "Face2Face" gives rise to the concept of meeting people and talking to them or looking at them directly.
30. Conceptually, I find the marks to be of medium similarity.

Distinctive character of the earlier mark

31. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not

contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

32. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.
33. The phrase “face2face” in the earlier mark denotes the well-known phrase made up of the dictionary words “face to face”. While this could be seen as a mild allusion to the way the registered human resources services are delivered, that of meeting face to face, such an activity is part of many trade activities and so I view the phrase as falling in the middle of the range between those words that are directly suggestive of particular goods or services and invented words. While the “HR” element of the mark is purely descriptive, overall, I find the mark to be of medium inherent distinctive character. The additional figurative and decorative elements present in the mark do not alter this finding.
34. I bear in mind that the degree of distinctiveness of the earlier mark is only likely to be significant to the extent that it relates to the point of commonality between the marks¹, the phrase “face2face”/ “Face2Face”. To that extent, I confirm that my view is that that the phrase alone is inherently distinctive to a medium degree.

¹ See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13

35. I note that Mr Mati, in filing as his Exhibit 1 evidence of Google search results using the term “face to face HR”, says that such search results are “intended to demonstrate and reflect the relatively widespread use of the term *face to face* in conjunction with *HR* within the context of providing human resources services.” The exhibit shows extracts from various websites which refers to HR services being provided “face-to-face” including the following phrases: “face-to-face meetings”, “face-to-face HR support”, “courses run remotely or face-to-face”, “flexible and hoc advice, face-to-face, by email or by phone”, “cases to be discussed face-to-face”, “face-to-face training at your location”. The first issue with this evidence is that it is undated (albeit the witness statement says that the results date from “no later than 28 April 2022”) and does not show use of the phrase “face to face” in a trade mark sense. Second, the evidence does not offer any indication of the extent to which those companies featured use the relevant terms in the course of their day-to-day business. Nor does the evidence show what significance these third-party traders have within the marketplace as a whole. There is nothing to show what impact the use of these terms will have had on the average consumer and whether they have become accustomed to seeing the phrase “face to face” in the marketplace for HR services. Consequently, the evidence does not demonstrate that the distinctive character of the element which is common to the two marks - face2face”/“Face2Face - has been weakened because of its frequent use in the field concerned at the relevant date.

Comparison of the services

36. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services

themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

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

(a) the respective uses of the respective goods or services;

(b) the respective users of the respective goods or services;

(c) the physical nature of the goods or acts of service;

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

(e) in the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) the extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

38. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market (“OHIM”)*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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”.

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

“...there is 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 *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

"... 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."

41. The competing services, all of which are in Class 35, are as follows:

Cancellation applicant's services	Registered proprietor's services
Human resources consultancy; Human resources consultation; Human resources management.	Human resources consultancy; Human resources consultation; Business consultancy; Business consultancy services; Business consultancy to firms; Business consultancy to individuals; Business consultation; Business consultation services.

42. The registered proprietor's "Human resources consultancy" is identical to the cancellation applicant's "Human resources consultancy".

43. The registered proprietor's "Human resources consultation" is identical to the cancellation applicant's "Human resources consultation".

44. I compare the registered proprietor's "Business consultancy", "Business consultancy services", "Business consultancy to firms", "Business consultancy to individuals", "Business consultation" and "Business consultation services" with the cancellation applicant's "Human resources consultancy". I consider the services to be highly similar in that they have the same nature and method of use, broad purpose, user groups, and trade channels. There may also be a degree of competition because a client might seek general business consultancy which might include advice on HR, or they may purchase HR-specific advice.

The average consumer and the nature of the purchasing act

45. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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.”

46. The average consumer will be a professional person or business in search of short-term or medium to long term support in the field of human resources and business consultancy. Short-term purchases will require consideration of terms and conditions and invoices, and medium to long term arrangements will usually involve entering into a formal contract. Cost will be a significant factor as will an analysis of quality standard, so the purchasing decision will be one over which there will be a period of deliberation. I therefore take the view that the average consumer will pay a slightly above medium degree of attention.

47. There might be a verbal element in preliminary dialogue about recommended suppliers of human resources and business consultancy. However, visual scrutiny of the applicant’s and opponent’s marks on websites and marketing literature will predominate.

Likelihood of confusion

48. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the

responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where 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 trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponents' trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

49. When compared with the cancellation applicant's mark, I have found the registered proprietor's mark to be of medium visual, aural and conceptual similarity. The services are identical, or if I am wrong in respect of the registered proprietor's business consultancy services, highly similar. The average consumer, who is a professional person or a business, will pay a slightly above medium degree of attention, with visual considerations predominating. The earlier mark is of a medium level of inherent distinctiveness.
50. The cancellation applicant's mark has the two letters "HR" at the end, while the registered proprietor's mark contains the word "Peninsula" which is absent from the cancellation applicant's mark. However, "HR" is purely descriptive and its impact in the overall impression of the mark is minimal. While "Peninsula" is marginally more dominant within the registered proprietor's mark as a whole, the shared well-known phrase "face2face"/"Face2Face" is independently distinctive and will be recollected independently from the element "Peninsula". In my view, given the identity or high similarity of the services and the presence in both marks of the identical phrase "face2face"/"Face2Face", it is likely that one mark will get tangled up with the other in the mind of the average consumer, taking into

account the principle of imperfect recollection. There is a likelihood of direct confusion.

51. If I am wrong in my finding of direct confusion, it now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

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

52. I am also conscious of the examples referred to in the *L.A. Sugar* case:

“17. Instances where one may expect the average consumer to reach such a conclusion [that the later mark is another brand of the owner of the earlier mark] tend to fall into one or more of three categories:

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

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

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

53. The identical element “face2face”/“Face2Face” stands out as performing an independent distinctive role within the respective marks which are registered for identical or highly similar services. Notwithstanding the presence of the distinctive element “Peninsula” at the beginning of the registered proprietor’s mark, the common element “face2face”/“Face2Face” is likely to fix itself in the average consumers’ minds and act as an important hook in prompting their recall of the competing marks. In my view even if the relevant public were able to distinguish the marks, the similarities between them are such that they are likely to lead the average consumer to perceive the later mark as a sub-brand or extension of the earlier mark or that it came from a connected undertaking. My conclusion is therefore that there is a likelihood of indirect confusion.

54. Although I found a likelihood of confusion based on my notional assessment, I will briefly mention that the cancellation applicant has filed evidence of actual confusion. This evidence takes the form of Ms Deem’s first witness statement which cites examples of clients contacting the cancellation applicant’s company thinking that they are in contact with the registered proprietor’s company. Some of the examples relate to individuals neglecting to use the full “Peninsula Face2Face” brand name, but examples of the full brand name having been used are also cited and the cancellation applicant maintains that its evidence shows that the presence of the phrase “face2face”/“Face2Face” in both parties’ marks causes actual confusion. Although I have not given much weight to this evidence, it corroborates my conclusion that there is a likelihood of confusion between the marks. For

the sake of completeness, I should say that I would have reached the same conclusion had that evidence not been filed.

Section 5(3)

55. Section 5(3) states:

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

56. I must consider the cancellation applicant’s case under s 5(3). However, while likelihood of confusion has been demonstrated under s5(2)(b), for this ground to succeed, the cancellation applicant needs to show that its mark has a reputation in the United Kingdom.

57. I need to assess whether, as per *General Motors v Yplon* [1999] E.T.M.R. 950 (“Chevy”), the earlier mark is known by a significant part of the public concerned. I 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.”

58. In 2.6 of the cancellation applicant’s witness statement, it says the following:

“At the time the Proprietor's mark was entered onto the register, the face2faceHR mark had been used throughout all aspects of the business of face2faceHR. In its present form (with the leaf logo) the mark has been used (initially unregistered) since April 2010; it has been our website

address since that time, it is used in our social media; and has been in the legal name of the business since 2002. Rather than simply describe a service or a way of working, face2faceHR has become a distinctive brand in the market and has a significant profile in the HR industry. Put simply, we are face2faceHR and we are known as such in the market.”

59. However, other than providing some evidence of the duration of use, the cancellation applicant simply asserts that the mark has a reputation rather than showing that it does. There is no evidence offered in respect of market share or turnover, nor of the intensity and geographical extent of the mark’s use, nor of the size of the investment made by the undertaking in promoting it.

60. In paragraph 25 of its submissions, the cancellation applicant makes another assertion, that: “Given the history of proceedings before the IPO, which led to the Earlier Mark being granted, the Owner has accepted that face2faceHR has a reputation in the UK (it would not have surrendered its HRFace2Face mark if that were not the case).” It does not follow from this statement that the registered proprietor accepts that the cancellation applicant’s mark has a reputation. Indeed, the registered proprietor seeks dismissal of the section 5(3) ground.

61. The cancellation applicant has not shown that the earlier mark has a reputation in the United Kingdom and the section 5(3) ground is dismissed.

CONCLUSION

62. The cancellation application has been successful. Subject to appeal, the contested registration will be declared invalid in its entirety.

COSTS

63. The cancellation applicant has been successful in this case. The cancellation applicant is unrepresented and no Cost Pro Forma has been received, so they are entitled only to the official fee for the cancellation application. I award the cancellation applicant the following:

Official fees:	£200
Total:	£200

64. I order Peninsula Business Services Limited to pay face2faceHR Partners Limited £200. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 25th day of October 2022

JOHN WILLIAMS
For the Registrar