O/0308/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004083787
BY MAP IMPACT LTD
TO REGISTER:

HeatView

AS A TRADE MARK IN CLASSES 36, 38 AND 42

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 449554
BY JEREMY BIRCH

BACKGROUND AND PLEADINGS

1. On 05 August 2024, Map Impact Ltd ("the applicant") applied to register the trade mark shown on the cover page of this decision, in the UK. The application was accepted and published in the Trade Marks Journal on 16 August 2024 in respect of the following services:

> **Class 36:** *Financial risk assessment services; Investment risk assessment services; Financial risk management services; Advisory services relating to [financial] risk management; Financial information management and analysis services; Financial risk management; Risk management [financial].*
>
> **Class 38:** *Data transmission services; Data transfer services*.
>
> **Class 42:** *Scientific risk assessment; Environmental hazard assessment; Environmental assessment services; Environmental monitoring services; Technical data analysis services.*

2. On 10 September 2024, the application was opposed in full by Jeremy Birch ("the opponent") based upon Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act").

3. Under both the Section 5(2)(b) and the Section 5(3) ground, the opponent relies on (and claims reputation for) its registered goods and services of the following trade mark:

UK00003146785

HEATVIEW

Filing date: 28 January 2016

Registration date: 22 April 2016

Class 9: *Computer software.*

Class 37: *Building construction; building repair; insulation and draught proofing installation services.*

4. By virtue of its earlier filing date, the trade mark relied upon by the opponent is an "earlier mark" in accordance with Section 6 of the Act. The opponent's earlier mark had been registered for more than five years at the filing date of the contested mark, and, as such, it is theoretically subject to the use conditions under Section 6A of the Act. However, in its counterstatement, the applicant elected not to put the opponent to proof of use - this means that the opponent can rely upon all of the goods and services it has identified without having to prove genuine use.

5. Under Section 5(2)(b), the opponent claims there is a likelihood of confusion. In particular, the opponent states that the marks share an identical name, and that both businesses use a thermal image to identify heath/energy issues in the built environment. Further, the opponent states that (a) its first use of the name 'Heatview' was in 2015 for the website www.heatview.co.uk which uses an interactive map to display thermal issues in the built environment and that the new applicant's product also uses interactive maps, (b) both the opponent and the applicant are based in Bristol and (c) both the opponent and the applicant target housing associations as potential customers.

6. Under Section 5(3), the opponent claims that its earlier mark enjoys a reputation in relation to all of the goods and services identified above. Further, the opponent states that use of the applicant's mark will be detrimental to the distinctive character or the reputation of the opponent's earlier mark, because the respective marks and products are confusingly similar.

7. The applicant filed a defence and counterstatement, denying the opponent's claims. However, most of the arguments put forward by the applicant are irrelevant. For example, the applicant says that it has developed the contested mark independently, that it has obtained registration for other trade marks in relation to its data products and services, and that all its marks follow the same structure as the mark at issue combining the word 'View' with a "lead word", such as 'BiodiversityView', 'CatchmentView', 'DroughView', and 'WildfireView'. The applicant also argues that

even though both parties might target housing associations, they offer different products, the opponent having a mark which covers software and energy efficiency surveys and advice for buildings, the applicant having a mark which covers locational heat stress data, data transmission ad environmental hazard assessment. In addition, the applicant states that it does not provide software applications or identify energy issues in buildings, and that it also targets multiple market sectors ranging from local authorities, to property search companies, and environmental report providers servicing the financial sector. In addition, the applicant argues that there is a further differentiation between the parties in their market positioning and distribution, because the applicant's main marketing and distribution is via third party resellers who have a close relationship with their customers and needs, a fact which provides further certainty that there will not be likelihood of confusion.

8. In response to the Section 5(3) claim, the applicant does not deny that the opponent's earlier mark enjoys a reputation – instead, it seems to acknowledge it to some degree. For example, the applicant states that there has been no intention to capitalise on the reputation of the opponent's mark and that the applicant's mark has been created in good faith. It also argues that although the opponent mentions that both businesses are based in Bristol, much of the opponent's activity has been focused on that specific area, and so the opponent's reputation has been limited to that extent, and the opponent's mark cannot be considered to be famous. However, contrary to goodwill, reputation is not localised as reputation requires that the mark must be known by a significant part of that relevant public for the goods and services concerned. As I will explain later in this decision, this is probably down to the applicant being unrepresented and to the lack of familiarity with the distinction between reputation and localised goodwill. On the contrary, the applicant states, its mark covers a nationwide data set, targeting a national market. Finally, the applicant states that the marks create different impressions and that before it applied for the contested mark, it conducted some searches, and was satisfied that there are sufficient differences between the parties' businesses, markets and products to justify the application.

9. Both parties are unrepresented.

10. Both parties filed evidence with the opponent also filing evidence in reply. The applicant's evidence was also accompanied by written submissions dated 27 January 2025. Neither party requested a hearing, but the applicant filed submissions in lieu of a hearing. I make this decision having taken full account of all the papers, referring to them as necessary.

Relevance of EU Law

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

EVIDENCE

12. The opponent's evidence-in-chief came in the form of a witness statement from Jeremy Birch, the opponent himself, dated 29 November 2024. Mr Birch's witness statement is accompanied by 11 exhibits (being those labelled JB1-JB11). His evidence consists mostly of legal submissions, containing hardly any evidence of use of the earlier mark. In addition to his evidence in chief, Mr Birch filed reply evidence consisting of a second witness statement dated 10 February 2015.

13. The applicant's evidence-in-chief came in the form of a witness statement from Stephen Keohane dated 25 January 2025. Mr Keohane is co-founder and company director of the applicant's company, and his evidence is accompanied by 11 exhibits being those labelled SK1-SK11. His evidence mainly expands on the arguments contained in the applicant's counterstatement.

14. I do not intend to summarise the evidence (or submissions) in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

Preliminary issue

15. Before I proceed any further, I should explain why most of the applicant's arguments are not pertinent.

16. First, as regards the comparison of the goods and services, it must be conducted based on the specification of the goods and services as they are registered and applied for, respectively. This means that differences in the parties' businesses, and/or in the products offered by the parties in practice must be disregarded insofar as they are not reflected in the specifications. This is because the opponent's mark not being subject to proof of use in these proceedings, it is entitled to protection against a likelihood of confusion with the applicant's mark based on the 'notional' use of the opponent's mark for the goods/services on which the opponent relies for the purposes of this opposition. Consequently, the extent to which the opponent has used the registered mark is only of any relevance to the opponent's claim for additional legal protection based on the claimed reputation, which is said to result from the use of the mark in the UK. So far as the applicant's use of its mark is concerned, in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*,[1] the Court of Justice of the European Union ("CJEU") stated at paragraph 66 of its judgment that when assessing the likelihood of confusion in the context of registering a new trade mark, it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. Consequently, I must include consideration of the likelihood of confusion if both parties (and their successors in title to the marks) decide to target the same segment of the market. Therefore, the fact that the parties target different market segments and/or that their distribution model is different in practice, is irrelevant where the goods/services at issue are fundamentally the same or similar.

17. Furthermore, the fact that the applied-for mark was developed independently from the opponent's mark and that the applicant applied for the mark in good faith is wholly

[1] Case C-533/06, paragraph 66.

irrelevant, as the likelihood of confusion must be assessed from the average consumer's point of view.

18. Having clarified why the applicant's arguments are not pertinent, I will return briefly to them when dealing with the comparison of goods and services.

Section 5(2)(b)

19. Section 5(2)(b) of the Act reads as follows:

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

20. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25:

> (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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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; and
(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 goods and services

21. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

22. 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 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.

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

24. In *Sanco SA v OHIM,* Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that responsibility for the goods and services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited,* BL O/255/13*:*

> "It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes."

25. Whilst on the other hand:

> "[…] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

26. In *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05, the GC stated that:

> "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."

27. The competing goods and services are as follows:

The applicant's services	**The opponent's goods and services**
	Class 9: *Computer software.*
Class 36: *Financial risk assessment services; Investment risk assessment services; Financial risk management services; Advisory services relating to [financial] risk management; Financial information management and analysis services; Financial risk management; Risk management [financial].*	
	Class 37: *Building construction; building repair; insulation and draught proofing installation services.*
Class 38: *Data transmission services; Data transfer services*.	
Class 42: *Scientific risk assessment; Environmental hazard assessment; Environmental assessment services; Environmental monitoring services; Technical data analysis services.*	

28. Before I proceed to compare the parties' goods and services, I shall clarify how I intend to approach the comparison.

29. Whilst, as I have anticipated in my previous remarks, the opponent is entitled to rely on the specification for which the earlier mark is registered, which includes

computer software at large, I will not go beyond the points of similarity that the opponent has pleaded. There is no need for me to consider doing otherwise. The basis of it is that it would be unfair to the applicant for me to do so since the applicant would have no opportunity to address points on similarity which I think might subsist if those points were not first raised by the opponent, either in its statements of grounds or subsequently via written submissions.[2] However, as all of the opponent's arguments appear to focus on its software, which is its strongest comparator, I shall focus on this, bearing in mind the relevant criteria set out by the case law.

30. Accordingly, I will limit my findings of similarity (or dissimilarity) based on the arguments the opponent has raised.

31. One of the points of similarity argued by the opponent is that both the opponent's product and the applicant's product use thermal imaging software to identify issues in the built environment. The opponent also argues that both products have been marketed to local authorities and housing associations, and have been used in association with maps. In this connection, the opponent explains that it has used the name 'HeathView' in relation to a software which examines the heat loss for houses.

32. Whilst the opponent's registered term *computer software* is sufficiently broad to cover any type of software, including the software sold by the opponent, that is where the relevance of the opponent's submission ends. As I have explained, the comparison of the goods and services must be conducted on a notional basis, looking at the terms as they are registered and applied for, disregarding any similarity deriving from the parties' businesses and products, insofar as they are not included in the in the realm of notional, not actual, use of the goods and services at issue.

33. This takes me to the next submission advanced by the opponent which refers to other trade mark applications filed by the opponent and to the fact that those other applications cover software in class 9. The opponent states:

[2] The correctness of this approach was confirmed by Mr Iain Purvis KC, sitting as the Appointed Person, in SMARTX, BL-O/0911/24 at paragraphs 28-31

"Further to the consistency and non-conflict claims, the other trademarks registered by the Applicant (all of which date from considerably after the registration of our own trademark) all specify class 9 (software) with the sole and conspicuous exception of the current application for HeatView. If the current application covers a product that is consistent with their previous BiodiversityView product which states it is software (class 9) then so must the current application, and hence it directly conflicts with our product which is registered with class 9. If the applicant's new product does not use software, then there is no need for it to be consistent and so it does not need to use a similar name."

34. Once again, goods covered by trade mark applications other than the one at issue are wholly irrelevant for the purpose of the assessment I am required to make – therefore this submission does not assist the opponent. In this case, the application at issue does not include goods in class 9. It follows from this that the opponent's claim that *"the Applicant's HeatView product is a piece of software and thus the use of that name in association with a piece of software is a violation of our trade mark"* is also misconceived, because the applicant did not apply for software and the fact that it sells software (under the same or other marks) is irrelevant. Lastly, although it is noted that the opponent alleges that *"the anomalous lack of "class 9" in the current application when compared with their other applications (with which it is meant to be consistent) also indicates a lack of good faith"* that is irrelevant too, because the opponent did not plead that the application was made in bad faith under Section 3(6).

35. Having clarified that the above points do not raise any valid argument upon which I can base a finding of similarity, I now turn to the actual comparison.

Class 36

Financial risk assessment services; Investment risk assessment services; Financial risk management services; Advisory services relating to [financial] risk management; Financial information management and analysis services; Financial risk management; Risk management [financial].

36. The closest clash I have identified is with the opponent's *computer software* in class 9. I say this because the other services for which the opponent's mark is protected are *Building construction; building repair; insulation and draught proofing installation services* in class 37, and I cannot see any obvious similarity between the opponent's building services which involve the construction, repair and maintenance of buildings and related infrastructure and the applicant's services in class 36 which are types of financial services. The same goes for the applicant's data transmission services in class 38.

37. Turning to the comparison between the applicant's financial risk assessment and financial risk management services and the opponent's computer software, whilst the opponent has not made the point, it is self-evident that the applicant might use a software in order to provide its financial services to consumers. However, that does not create any meaningful similarity. I say this because, if that was the case, any service which use the provision of a software, would be similar to the opponent's software. That is all of the more so since the opponent's registered term is very broad and covers any conceivable type of software which means that the opponent's computer software would be similar to most services because nowadays most services use a computer software.

38. Accordingly, even if the applicant uses a computer software to provide its financial services, that would be internal use, i.e. use by the financial service provider, not use by the consumer of financial services. Further, there is no evidence that the same undertaking provides both risk assessment and risk management services as well as risk assessment and risk management software as an alternative to their services. It follows that the goods and services clearly do not overlap in trade channels. They also target different users, have different uses, nature, purpose and methods of use and are neither complementary nor in competition. These goods are dissimilar.

Class 38

Data transmission services; Data transfer services.

39. Similar considerations apply to these services. Even if the provider of these services uses a computer software internally to provide the services to its consumers,

that would be internal use, not use by the end consumers of the services. I also do not have any further submissions or evidence before me to establish how these goods and services are similar. I therefore consider that they do not overlap in trade channels, they target different users, have different uses, nature, purpose and methods of use and are neither complementary nor in competition. These goods are dissimilar.

Class 42

Scientific risk assessment; Environmental hazard assessment; Environmental assessment services; Environmental monitoring services; Technical data analysis services.

40. Similar considerations apply to these services. Even if the provider of these services uses a computer software internally to provide the services to its consumers, that would be internal use, not use by the end consumers of the services. I also do not have any further submissions or evidence before me to establish how these goods and services are similar. I therefore consider that they do not overlap in trade channels, target different users, have different uses, nature, purpose and methods of use and are neither complementary nor in competition. These goods are dissimilar

Conclusion on the similarity of the goods and services

41. As some degree of similarity between the respective goods and services is a prerequisite for assessing the likelihood of confusion under the present ground,[3] a finding of no similarity means the opposition must fail in its entirety as I have determined that all of the applied for services are dissimilar to the opponent's goods and services.

42. The claim under section 5(2)(b) fails in its entirety. I now turn to the Section 5(3) ground.

Section 5(3)

[3] *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA

43. 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".

44. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case C-252/07, *Intel,* Case C-408/01, *Adidas-Salomon,* Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows:

> (a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.
>
> (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; G*eneral Motors*, paragraph 26.
>
> (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.
>
> (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

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

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oreal v Bellure NV*, paragraph 44.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel,* paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

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

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV,* paragraph 40*.* The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

(j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails

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

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

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

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

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

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

46. In *Spirit Energy Limited* v *Spirit Solar Limited* - BL O/034/20 – Mr Phillip Johnson, as the Appointed Person, held that the opponent had not established a qualifying reputation for section 5(3) purposes. The opponent traded in solar energy equipment

and installations and had used its mark in relation to such goods/services for 7 years prior to the relevant date in the proceedings. During the 5 years prior to the relevant date, it had installed solar energy generation equipment in over 1000 domestic homes and made over 700 installations for commercial customers. These sales had generated nearly £13m in income. However, there was limited evidence of advertising and promotion, and the amount spent promoting the mark had fallen in the years leading up to the relevant date. Additionally, the mark had only been used in South East England and the Midlands. Taking all the relevant factors into account, the Appointed Person therefore decided that such use of the mark was not sufficient to establish a reputation for the purposes of section 5(3).

47. In *GNAT and Company Ltd & Anor v West Lake East Ltd & Anor* [2022] EWHC 319, HHJ Hacon held that the claimants had not established a qualifying reputation for the purposes of section 10(3). The claimants had operated a restaurant at the Dorchester Hotel in Park Lane for around four years prior to the relevant date. Turnover was between £5m and £6m each year, which equated to approximately 70,000 customers served per year; advertising spend had varied significantly, from around £5,000 at its lowest to over £47,000. The claimants had provided dining vouchers worth about £17,000 to charities and there had been some press coverage and awards but only 7 such articles appear to have been in evidence. The judge stated that, although it was likely that a spread of individuals across the UK would have read the articles or been made aware of the awards, the claimants' market share was tiny relative to the UK restaurant business as a whole. The advertising sums were also very small in that context and the business was in relation to a single restaurant. The judge concluded that the evidence satisfied the 'geographic' aspect of the test but not the 'economic' one, and that the use was not sufficient to establish that the claimants' mark had a reputation.

48. The relevant date for assessing whether the opponent's mark benefits from reputation is the filing date of the contested mark, i.e. 05 August 2024.

49. I have already commented on Mr Birch's evidence, and I said that there is very little in his witness statement about the use of the earlier mark. Mr Birch says that the earlier mark has been used since April 2016 initially on the website

ww.heathview.co.uk. However, the only supporting evidence provided is a screenshot dated 23 November 2024 which is after the relevant date. The same problem affects the evidence about use of ‘HeatView’ in relation to an app and an in-house manufactured camera, as the screenshots provided are also dated 23 November 2024. Mr Birch also talks about the ‘HeatView’ mark having been used extensively in local and national discussions with funding partners (e.g. the British Gas "Energy for Tomorrow" grant-making body) and actual and potential licensees, as well as for local and national awards. However, first it is not clear what goods and services falling within the registered specification were marketed, and secondly, the screenshots attached at exhibit JB3 which Mr Birch describes as evidence relating to this use, are all about a different mark, namely “The Cheese Project CIC”, which it is said to be a different company of which Mr Birch was formerly a director. In this connection, the annual turnover figures which Mr Birch provides relate to the same company (i.e. The CHEESE Project) and, it is not clear whether any proportion of the turnover was generated from goods and services falling within the registered specification and sold under the earlier “HeatView” mark. In any event, the figures provided are very low, being as follows:

2023 £39,578
2022 £71,629
2021 no figure available
2020 £24,695
2019 £14,738

50. This equates to a total of £150K.

51. In addition, Mr Birch says that from 2020 through to 2023, another company (First Thermal Ltd) which was formed by the CHEESE project, was a licensee of the earlier trade mark and had a total turnover of £500,000 from a grant from the Energy For Tomorrow fund of British Gas. However, first this evidence is wholly unsupported as the licencing agreement was not provided within the evidence; second, I do not think that the grant of funding to a different company which allegedly was a licensee of the earlier mark counts toward use in relation to the registered goods and services, as receiving a grant is not use in relation to goods and services which are marketed or

about to be marketed. In this connection, Mr Keohane filed copy of a report showing that on 3 July 2023 the directors of First Thermal Ltd took the decision to dissolve it having failed to achieve sustainability.

52. Bearing in mind the absence of marketing figures, the fact that none of the evidence filed is dated prior to the relevant date, the very small level of turnover, and the fact that it is not clear what percentage of turnover was generated by the sale of goods and services falling within the registered specification and offered under the earlier mark, I am satisfied that the evidence falls short of establishing reputation. Lastly, as I have anticipated, I do not consider that the applicant's counterstatement contains an admission that, at the relevant date, the opponent's earlier mark enjoyed a protectable reputation on the basis that the applicant claims that use of the earlier mark is to a limited geographical area which is, by definition, incompatible with the concept of reputation among a significant part of the public concerned by the products or services covered by that trade mark.

53. As the opponent's evidence does not establish the necessary reputation, the claim under Section 5(3) fails at the first hurdle.

OUTCOME

54. The opposition has failed. The contested mark will proceed to registration.

COSTS

55. The applicant has been successful and would ordinarily be entitled to an award of costs. However, as the applicant is an unrepresented party, the tribunal wrote to the applicant and asked it complete and return a costs pro forma if it intended to seek an award of costs. It was advised that, if the pro forma was not returned, no award of costs would be made. The pro-forma has not been received by the tribunal and I therefore direct that the parties bear their own costs.

Dated this 9th day of April 2026

TERESA PINTO

For the Registrar