

O/0501/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004077649

IN THE NAME OF

GREENE KING BREWING AND RETAILING LIMITED

TO REGISTER THE FOLLOWING TRADE MARK:

HOST

IN CLASS 43

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. OP000451431

BY

HOST STUDENT HOUSING MANAGEMENT (UK) LTD.

BACKGROUND AND PLEADINGS

1. On 19 July 2024, Greene King Brewing and Retailing Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was first accepted and published in the Trade Marks Journal on 18 October 2024.
2. On 7 January 2025, the applicant filed a Form TM12 seeking to divide the application, and the application proceeded with only the following services applied for:

Class 43 Hospitality services [food and drink]; Restaurant booking and reservation services; Meal booking and reservation services; Reservation services for booking meals; Catering services including mobile catering services and catering services provided online from a computer database or from the Internet; Restaurant services; Bar, public house, snack bar, wine bar, wine club services, sandwich bar, cafeteria, canteen and café services; Wine tasting services (provision of beverages); Take away services; Reservation services for booking meals; Tourism services being the provision of information about places to eat and drink and including booking services relating thereto; Information, advisory and consultancy services in relation to all the aforesaid services, including those provided online from a computer database or from the Internet.

3. The remaining goods and services went forward under a separate application, no. UK00004147004, which is not part of these opposition proceedings.
4. Host Student Housing Management (UK) Ltd. (“the opponent”) opposes the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following mark:



UK registration no. UK00003168170 (“the earlier mark”)

Filing date: 6 June 2016

Date of registration: 2 September 2016

5. The applicant’s Class 43 services are opposed, and the opponent relies upon the following services:

Class 43 Accommodation services; Accommodation services for students.

6. By virtue of its earlier filing date, the above mark constitutes an earlier mark in accordance with section 6 of the Act. As the mark was registered more than five years prior to the date that the contested mark was filed, it is subject to proof of use in accordance with section 6A of the Act.
7. The opponent submits that the marks are similar and for identical or similar services.
8. The applicant filed a counterstatement denying the claims made and seeking proof of use of the opponent’s Class 43 services “In particular, the Opponent's evidence of use relating to their provision of food and beverage related services prior to the filing of the Subject Mark.”
9. Both parties filed evidence, but only the applicant filed submissions in lieu.
10. The applicant is represented by Birketts LLP. The opponent is represented by Handsome I.P. Ltd.

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 filed evidence in the form of a witness statement from Chris Mcilhinney, the Commercial Director of the opponent, signed and dated 2 May 2025. The witness statement is accompanied by exhibits A - E.

13. The applicant filed evidence in the form of a witness statement from Lynne Hill, Senior Legal Counsel (Solicitor) for the applicant's representatives, signed and dated 15 August 2025, together with Exhibit LH1.

14. The applicant also filed evidence in the form of a witness statement from Melanie Harvey, a Chartered Trade Mark Attorney for the applicant's representatives, signed and dated 15 August 2025, together with Exhibits MH1 and MH2.

DECISION

Proof of use

15. I will begin by assessing whether there has been genuine use of the earlier mark.

The law

16. Section 6A of the Act states:

“(1) This section applies where

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

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

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

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

(4) For these purposes – (a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the

purposes of this section as if it were registered only in respect of those goods or services.”

17. Consequently, the onus is upon the opponent to prove that genuine use of the registered trade mark was made in the relevant period. The relevant period in which genuine use must be established is the five-year period ending on the date of filing of the contested mark, i.e. 20 July 2019 to 19 July 2024.

18. Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

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

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

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

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

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

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

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns:

Ansul at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

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

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

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

11. Arnold LJ followed his summary of the principles to be applied when assessing proof of use with the following paragraph:

“107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and *Ferrari* at [73]-[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and

sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council* [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

“19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know.

...

22. ... it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal ... comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said the public.”

Form of the mark

12. The predominant use of the mark in the evidence is in a slightly variant form i.e. as registered, but with the exception that the colour scheme is red on a white background instead of white on a red background.

13. I am mindful of *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, in which Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

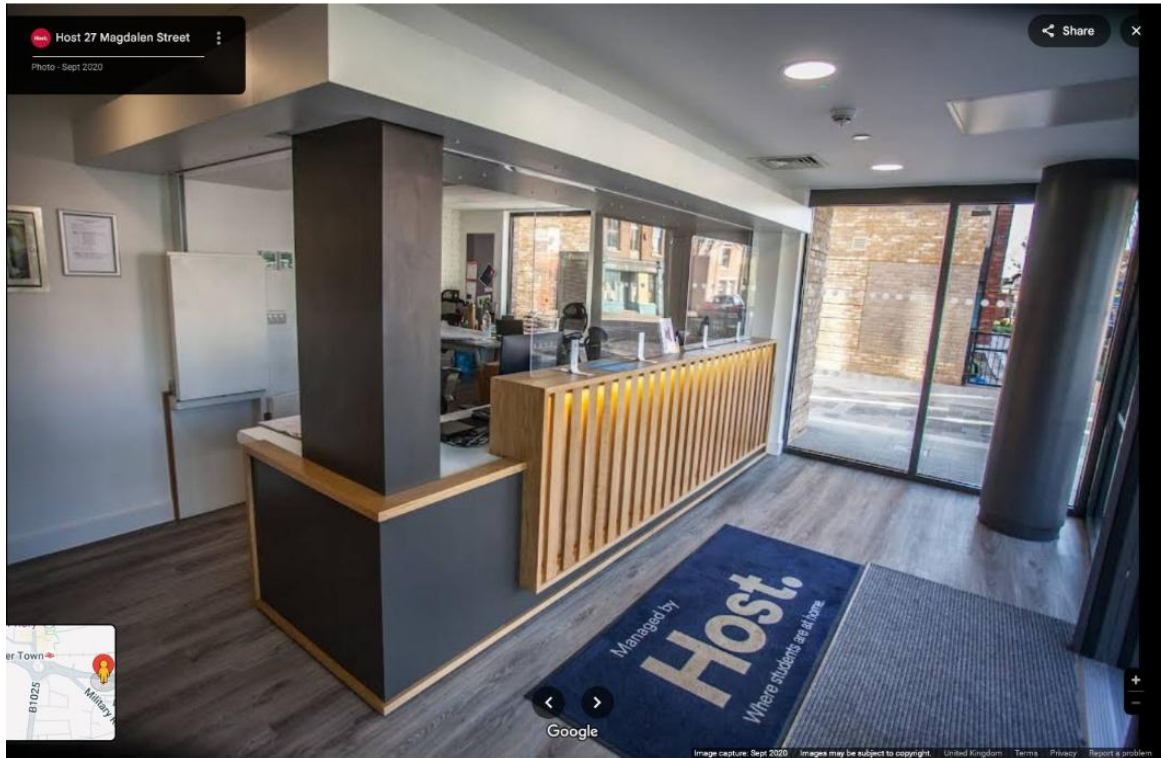
“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.”

14. Given the above case law, I do not consider that the transposition of the colours in the mark as registered alters the distinctive character of the mark and so I consider its variant use to be acceptable.

15. There are some instances in the evidence of the mark being shown on a blue mat in white text with the addition of the text “Managed by”, as per this example extracted from page 5 of Exhibit D:



16. The use of a different background colour does not alter the distinctive character of the mark. Per *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, the presence of the large word “Host” followed by a full stop and the smaller strapline will continue to be perceived as indicative of the origin of the service at issue and so this is acceptable variant use.

17. I make the same finding for the small number of instances in the evidence where the mark is shown affixed to buildings, but with the strapline absent: The large word “Host” followed by a full stop will continue to be perceived as indicative of the origin of the service at issue.

18. My findings of acceptable variant use do not extend to the single instance in the evidence of the mark being truncated to the letter “H” alone followed by a full stop.

The opponent's evidence of use

15. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.¹

16. I remind myself that the relevant period is 20 July 2019 to 19 July 2024.

17. The opponent states that its mark “has been used with regard to the services in all parts of the United Kingdom.”

18. The opponent declares that its revenue, described as “annual sales of the services”, is follows:

“April 2022 – April 2023: £3,313,164 (income)
April 2023 – April 2024: £3,635,690 (income)
April 2024 – April 2025: £3,664,05 (income)”²

19. The opponent further declares that its marketing expenditure is as follows:

“April 2022 – April 2023: £91,067
April 2023 – April 2024: £61,818
April 2024 – April 2025: £67,805”³

20. I note that the figures quoted begin in April 2022 and end in April 2025 whereas the relevant period begins in July 2019 and ends in July 2024.

21. Exhibits A and B and a large part of Exhibit C consist of within-the-relevant-period screenshots from the opponent’s website – host-students.com. These screenshots detail the student accommodation offered by the opponent in various cities around the UK, including Birmingham, Bristol, Cambridge,

¹ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

² Opponent’s witness statement, paragraph 10

³ Opponent’s witness statement, paragraph 11

Cardiff, Chester, Coventry, Exeter, Glasgow, Leeds, Leicester, Liverpool, London, Nottingham, Oxford, Plymouth, Sheffield, and Southampton.

22. Paragraph 7, parts o. and p. cover the opponent's YouTube presence as documented on pages 64 to 68 of Exhibit C. This shows that the opponent joined YouTube on 5 November 2010. As at 1 May 2025, it had approximately two and a half thousand subscribers, had uploaded 51 videos and had 515,201 views. Although 1 May 2025 is after the relevant period, given that the opponent has been on YouTube since 2010, it is reasonable to assume that some of this YouTube activity took place during the relevant period.
23. Exhibit D consists of numerous within-the-relevant-period images from Google Maps showing the mark affixed to, outside, and present within, the opponent's student accommodation situated around England.
24. Exhibit E consists of catering invoices and images of some people eating food at a catered event (all from within the relevant period) that purport to show that the services that the opponent offers include "hospitality services [food and drink] and catering services."

Sufficient use

25. Notwithstanding the fact that the revenue figures attested to by the opponent do not cover the beginning of the relevant period, nor are they broken down to the level of each of the opponent's student accommodation sites, they exceed £3m for each financial year provided and as such they represent significant sums of money accrued under the mark.
26. The opponent has also provided evidence of modest, but not trivial, marketing expenditure and has shown that it had a YouTube presence during the relevant period.
27. Over and above the top-level figures offered in evidence as to revenue and marketing activity, the opponent has also filed comprehensive evidence of offering student accommodation via a website which details numerous sites

around the UK. It has corroborated this with evidence of the physical bricks and mortar existence of its student accommodation through a variety of Google Maps photographs of its buildings from around England.

28. Considering all of the evidence in the round, I am satisfied that it denotes real commercial exploitation of the mark on the market in accordance with its commercial *raison d'être*, which is to create an outlet for the service that bears the mark. Hence, I consider genuine use to have been demonstrated.

Fair specification

29. Having determined that the opponent has shown use of its goods under its mark, I must now set out what I consider to be a fair specification having reviewed the use shown against its current specification.

30. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

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

31. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation (which also applies to proof of use cases), as follows:

“245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which

is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. [...] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered.”

32. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) at [47], the late Carr J pointed out that it is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do; for example, in *Pan World Brands v Tripp Ltd*

(*Extreme Trade Mark*) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally.

33. The approach in *Merck* was endorsed by the Supreme Court in *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36:

“261. ... save that it must now be seen in light of the more recent guidance given by the CJEU in, for example: *Ferrari SpA v DU* (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106, at paras 36-53. There the CJEU explained, at para 40, that the essential criterion to apply for the purposes of identifying a coherent subcategory of goods or services capable of being viewed independently is their purpose and intended use.”

34. I remind myself that the opponent is reliant upon the following services:

Class 43 Accommodation services; Accommodation services for students.

35. The services that are shown in the evidence are clearly accommodation services for students, not accommodation services at large. There are numerous examples of this, not least in the strapline of its mark – “Where students are at home”. The domain name of the opponent’s website includes the word “students” and there are multiple references to students and their accommodation requirements in the evidence. A case in point is the stated purpose of the opponent which is set out under the FAQs on pages 46 to 47 of Exhibit C:

“About Host:

Who is Host? Host is a private specialist student accommodation company that builds and manages premium quality student accommodation. Something we've been doing since 1996. Everything we do is designed to help students get more out of their university experience; from offering comfortable, stylish rooms to also ensuring all costs are covered in your rent. It's hassle-free freedom.”

36. The opponent has endeavoured to show that it offers accommodation services at large by referring me to a handful of instances on its website that refer to summer accommodation being available as per the extract below. It says this “demonstrates accommodation services for everyone (not just students).”

Extract from host-students.com, website panel, Exhibit C, page 8

**Summer stays.
Make yourself at home.**

Need a place to stay for summer? We've got this covered. North, South, large cities, historic towns, short stays or long stays – there is a Host for everyone this summer. With self-catering accommodation available in major cities across the UK, it's time to make the most of your summer and explore the country.

[More about summer accommodation](#)

37. However, I consider this to be an example of the opponent maximising the commercial potential of its student accommodation services by advertising its purpose-built student accommodation as available for short term rental during the summer holidays. While the student accommodation could be rented over the summer holidays by members of the public other than students, the website on which the panel appears is clearly targeted at, and will be seen almost

exclusively by, students. As such, I do not consider this to be evidence that the opponent has offered a wide range of accommodation services under the mark that would justify the retention of accommodation services at large.

38. The opponent also claims that its evidence shows that it has offered “hospitality services [food and drink] and catering services” and “services including provision of food and drink” under the mark. However, the opponent is reliant solely upon Class 43 “Accommodation services” and “Accommodation services for students” and so I dismiss its evidence of having offered other services under the mark.

39. Overall, I consider a fair specification to be:

Class 43 Accommodation services for students.

Section 5(2)

40. The opposition is based upon Sections 5(2)(b) of the Act, which 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”.

41. 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 be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of the services

42. The services for comparison are as follows:

Opponent's services	Applicant's services
<p><u>Class 43</u> Accommodation services for students.</p>	<p><u>Class 43</u> Hospitality services [food and drink]; Restaurant booking and reservation services; Meal booking and reservation services; Reservation services for booking meals; Catering services including mobile catering services and catering services provided online from a computer database or from the Internet; Restaurant services; Bar, public house, snack bar, wine bar, wine club services, sandwich bar, cafeteria, canteen and café services; Wine tasting services (provision of beverages); Take away services; Reservation services for booking meals; Tourism services being the provision of information about places to eat and drink and including booking services relating thereto; Information,</p>

	advisory and consultancy services in relation to all the aforesaid services, including those provided online from a computer database or from the Internet.
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43. In *Gérard Meric v OHIM*, Case T-133/05, the General Court (“GC”) stated that:

“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 für 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”.

44. 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 Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

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

- a. The respective uses of the respective goods or services;
- b. The respective users of the respective goods or services;

- c. The physical nature of the goods or acts of service;
- d. The respective trade channels through which the goods or services reach the market;
- e. In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
- f. The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

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

“82. ...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”.

47. For the purposes of considering the issue of similarity of the goods and services, it is permissible to consider groups of terms collectively where appropriate: *Separode Trade Mark*, BL O-399-10.

48. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin set out the proper approach to considering terms in specifications:

“365. [...] The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or

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

49. 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.”

50. In comparing the respective services, the opponent makes the following points in its statement of grounds:

“28. The earlier mark's services relate to relate to [*sic*] any form of service typically concerned with accommodation, especially, but not

exclusively, for students. These include the supply of lodging; food and drink, and services related to lodging and food and drink.

29. For instance, it is submitted that these days, it is quite common to have bars, cafés, canteens, and even restaurants offering food and drink in student accommodation, especially the more recently available premium accommodation sites.

30. Furthermore, take-away food is also often provided in student accommodation which has a canteen or café.

31. Further still, in accommodation sites aimed at overseas students, the provision of reservation services, information and recommendations is not unknown, or is, at least, similar to those of "accommodation services".

32. Accordingly, it is submitted that the nature of the relevant services of the Earlier Mark is identical, or at least highly similar, to the nature of the relevant services of the Application Mark."

51. The applicant argues the following in its submissions in lieu:

"10. The Opponent's registered scope in their earlier mark includes no applicable food and beverage related terms or scope.

11. The Opponent is seeking to prevent registration of a variety of food and drink-based services, i.e. non-accommodation related services in the Applicant's contested mark and they justify this position based on their earlier mark's solely accommodation-based scope.

...

15. ... [I]n this case, the respective goods and services in question are not similar enough to give rise to a likelihood of confusion between the

respective marks as being alleged by the Opponent owing to their dissimilar and non-overlapping nature.

...

18. Having brought this opposition against food and drink related services in class 43 of the contested mark, based on their earlier mark's accommodation related scope, the Opponent failed to show why food and drink related goods and services should be considered as confusingly similar to accommodation services falling under the scope of their earlier registration to support their opposition having shown in their evidence that the Opponent provides no food and drink related services as part of their accommodation rental offerings.”

52. As previously stated, I consider the opponent's claims in its witness statement that it has offered “hospitality services [food and drink] and catering services” and “services including provision of food and drink” under its mark to be claims to have offered services for which it does not hold a registration and I therefore dismissed the evidence in that context. However, if I was to consider such claims to be supportive of the proposition that student accommodation services typically include the provision of food and drink, then I do not find that the opponent's evidence shows this.

53. The evidence in respect of offering of pizza nights and the running of catered events at its sites, documented in Exhibit E, shows that where invoices are offered as evidence, they are for food provided by third-party companies, not the opponent. The invoices in question come from Arabica Kings Cross Ltd (for canapes), Wok to Walk (for noodles, chow mein, teriyaki, and udon), and Together for Pink Diamond Catering (for “private event catering”), all for events run by the Aga Khan Foundation (United Kingdom). Where there are photographs said to be of people enjoying catered food at one of the opponent's sites in February 2024, the food in question is supplied by Wok to Walk. There is nothing in the photographs said to be of people enjoying food at one of the

opponent's sites in April 2024 to indicate that the food is supplied by the opponent.

54. There are two photographs of coffee machines in the opponent's buildings, but the machines are from a third-party provider – Nespresso.

55. There are also photographs of snack and sweet vending machines in the opponent's buildings. Absent any evidence to the contrary, these are also likely to be from a third party as such vending machines tend to be owned and operated by third parties. The applicant has carried out a thorough assessment of this evidence, and I concur with its analysis as set out in paragraph 30 of the witness statement by Melanie Harvey:

“ ...

- On site vending machines whatever they dispense do not automatically equate to the provision of food and beverages on the Opponent's part, not unless they own and are responsible personally for the stocking and restocking of the vending machines' contents, and no such claims have been made by the Opponent.

- Occupiers and any users of said vending machines will note the vendor's details either on the front or side of the machine as this typically clearly displayed in case of faults, re-stocking or for contact or review purposes.

...

- It is noted that the Opponent's statements do not confirm ownership of the vending machines in their provided images.”

56. Further, the applicant has considered the opponent's evidence in respect of sweet vending machines and in relation to Exhibit D it notes the following at paragraph 33 of Melanie Harvey's witness statement:

“... page 60's image includes a visible reference to STARLIGHT and confirms these images as TUBZ Brands vending machines rather than owned by the Opponent.”

57. The applicant then offers its own evidence of TUBZ's marketing activity and its relationship with the STARLIGHT charity.

58. I conclude that the opponent's evidence does not show that its student accommodation services include the provision of food and drink and therefore it does not serve as evidence of the general proposition that student accommodation services typically include the provision of food and drink. On the contrary, I find that student accommodation services cover the provision of a room and washing and self-catering facilities. As such, they do not overlap with the applicant's services. The respective services differ in terms of nature, purpose and method of use. They also differ in terms of users – students versus the public at large. They further diverge in terms of trade channels – students seeking accommodation would purchase it through different outlets from those offering a variety of food and drink-related services. The services are not complementary - there is not a close connection between them, in the sense that they are indispensable or important to each other in such a way that customers may think that the responsibility for the services lies with the same undertaking – nor are the services in competition.

59. Having carefully compared the respective services, I find them to be dissimilar and because some degree of similarity between the goods and services is required for there to be a likelihood of confusion,⁴ the opposition fails in its entirety at this point.

⁴ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

CONCLUSION

60. Subject to appeal, the opposition has failed in its entirety and the application proceeds to registration in full.

COSTS

61. The applicant is the successful party and is entitled to a costs award.

62. The applicant seeks an off the scale costs award as stated in paragraph 26 of Melanie Harvey's witness statement, considering the opposition to have been without merit:

“a. An off the scale award of costs is being requested as the Applicant confirmed no conflict between the related services looking to reach an amicable resolution avoiding opposition prior to being opposed and was forced to participate in these proceedings to prevent the automatic loss of rights being sought.”

63. This stance is confirmed at paragraph 25 of the applicant's submissions in lieu where it says that it is seeking an off the scale award “having been made to defend their application against an opposition that had no prospect of success.”

64. Tribunal Practice Notice (“TPN”) 1 of 2023 says the following about off the scale claims:

“Off-scale costs

5. Notwithstanding the published scale, the Tribunal retains the discretion to award costs “off the scale” to deal proportionately with unreasonable behaviour. It is not possible to set out all the circumstances in which a Hearing Officer might depart from the scale. It is worth clarifying though that just because a party has lost, this in itself is not indicative of unreasonable behaviour. Some examples of what

might constitute unreasonable behaviour include a party seeking an (avoidable) amendment to its statement of case which, if granted, would cause the other party to have to amend its statement or would lead to the filing of further evidence. Other examples include behaviour designed to delay, frustrate or unreasonably increase the costs/burden on the other party and/or repeated breaches of procedural rules. Off-scale costs may also be awarded if a losing party unreasonably rejected efforts to settle a dispute before an action was launched or a hearing held, or unreasonably declined the opportunity of an appropriate form of Alternative Dispute Resolution.”

65. While I have found in favour of the applicant, I do not consider it to have been unreasonable of the opponent to have launched an opposition action. Its assessment of the respective services and the marks at issue led it to consider that it had a valid case, and I note that at the point it filed its opposition it was reliant upon accommodation services at large as well as accommodation services for students. As such, I consider an on-the-scale costs award to be appropriate as follows:

Preparing a statement and considering the other side’s statement:	£250
Preparing evidence and considering and commenting on the other side’s evidence:	£1000
Preparation of submissions:	£350
Total:	£1600

66. I therefore order Host Student Housing Management (UK) Ltd. to pay Greene King Brewing and Retailing Limited the sum of £1600. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 11th day of June 2026

John Williams
For the Registrar