

O/0523/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3758446 BY

ANDREA REITANO

TO REGISTER:



AS A TRADE MARK IN CLASSES 35 AND 43

AND IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 435478 BY

ROCCO FORTE HOTELS LIMITED

BACKGROUND AND PLEADINGS

1. On 23 February 2022, Andrea Reitano (“the applicant”) applied to register the trade mark shown on the cover page of this decision (“the contested mark”) in the United Kingdom, with registration sought for the following services:

Business management of restaurants; Restaurant management for others; Marketing services in the field of restaurants; Business advice relating to restaurant franchising; Business management assistance in the operation of restaurants; Business advisory services relating to the running of restaurants; Business advisory services relating to the setting up of restaurants; Business management assistance in the establishment and operation of restaurants; Online ordering services in the field of restaurant take-out and delivery; online ordering services in the field of restaurant take-out and delivery; On-line ordering services in the field of restaurant take-out and delivery; Business management of hotels; Consultancy services relating to the administration and management of hotels. (Class 35)

Restaurants; Restaurant services; Delicatessens [restaurants]; Restaurant information services; Providing reviews of restaurants; Bar and restaurant services; Booking of restaurant seats; Agency services for reservation of restaurants; Hotel restaurant services; Provision of hotel accommodation; Catering; Mobile catering; Business catering services. (Class 43)

2. The application was published for opposition purposes on 13 May 2022 and, on 9 August 2022, the application was opposed by Rocco Forte Hotels Limited (“the opponent”). The opposition is based on sections 5(1)¹/5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) and concerns all services applied for.

3. For the purpose of both grounds, the opponent relies upon the following four trade marks:

¹ The opponent’s section 5(1) claim is limited to its first earlier mark. It relies upon section 5(2)(b) in the alternative.

United Kingdom Trade Mark (“UKTM”) 91477026² (“the first earlier mark”):

FORTE

Filing date: 28 May 2015

Registration date: 23 December 2015

The bringing together, for the benefit of others, of a variety of goods namely cleaning, polishing, scouring and abrasive preparations, preparations for personal care, preparations for application to or for the care of the skin, scalp, hair, body, teeth, eyes and/or nails, enabling customers to conveniently view and purchase those goods from a retail store, by mail order catalogue, or from an Internet web site; the bringing together, for the benefit of others, of a variety of goods namely non-medicated toilet preparations, bath and shower gels, shampoo, cosmetics, soaps, perfumery, essential oils, cosmetic goods for the skin, hair and body, hair lotions, dentifrices, cosmetic skin creams, enabling customers to conveniently view and purchase those goods from a retail store, by mail order catalogue, or from an Internet web site; the bringing together, for the benefit of others, of a variety of goods namely lip balms, mouth freshening and mouth sprays, not for medical use, talcum powder for hygienic purposes, cosmetic wipes, enabling customers to conveniently view and purchase those goods from a retail store, by mail order catalogue, or from an Internet web site; preparation and presentation of advertising matter; sales promotion services; marketing and marketing planning; advisory and consultancy services relating to marketing, marketing assessment services; operation and supervision of customer loyalty, sales, incentives and promotional activity schemes and advice; advertising; business management; business administration; office functions; business consultancy; business information; business management of hotels; consultancy and information services relating to such services. (Class 35)

² The first and second earlier marks are comparable marks deriving from EUTMs. On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UKIPO created comparable UK trade marks for all rights holders with existing EUTMs. As a result, the marks were automatically converted to comparable UK trade mark. Comparable UK marks are now recorded on the UK trade marks register, have the same legal effect as if they had been applied for and registered under UK law, and the original filing dates remain the same.

Entertainment services; health club services, provision of recreation facilities; discotheque services; education services; training services; conducting of and/or provision of conferences and seminars; casino services; casino facilities; nightclub services; advice, information and consultancy on the foregoing. (Class 41)

Hotel services; motel services; provision of temporary accommodation; services for providing food and drink; hotel restaurant and hotel catering services; cocktail lounge services; restaurant, cafeteria, cafe, snack bar and bar services; booking and reservation services for restaurants and hotels; advice, information and consultancy on the foregoing. (Class 43)

Health and beauty care services; beauty salon and beauty treatment services; beauty spa services; health spa services; hairdressing services; spa, sauna and steam rooms services; advice, information and consultancy on the foregoing. (Class 44)

UKTM 917946242 ("the second earlier mark"):

ROCCO FORTE

Filing date: 22 August 2018

Registration date: 30 March 2019

Hotel and motel services; booking and reservation services for hotels, motels, guest houses and accommodation; provision and rental of temporary accommodation; provision of serviced apartments; room rental services; real estate services, namely operation and rental of serviced apartments, holiday homes, temporary accommodation and property; services for providing food and drink; hotel restaurant and hotel catering services; restaurant, cafe, brasserie, bar, public house and catering services; cocktail lounge services; preparation and provision of food and drink; banqueting services; provision of conference, seminar, meeting and exhibition facilities; booking and reservation services for restaurants and hotels; information, advice and consultancy in respect of the aforesaid services (Class 43)

UKTM 801323855³ (“the third earlier mark”):

ROCCO FORTE

Filing date: 30 September 2016

Registration date: 22 May 2017

Priority date: 5 May 2016 (UK)

Advertising; business management; business administration; hotel management services. (Class 35)

UKTM 3163048 (“the fourth earlier mark”):

ROCCO FORTE

Filing date: 5 May 2016

Registration date: 5 August 2016

Advertising; business management; business administration; hotel management services. (Class 35)

Hotel services; motel services; provision of temporary accommodation; services for providing food and drink; hotel restaurant and hotel catering services; cocktail lounge services; restaurant, cafeteria, cafe, snack bar and bar services; booking and reservation services for restaurants and hotels; advice, information and consultancy on the foregoing. (Class 43)

4. The opposition (in its entirety) is directed against all services applied for. The opponent relies on its first and fourth earlier mark to oppose all services. It relies upon its second mark to oppose services in class 43 and its third mark to oppose class 35.

5. Under its section 5(1) and/or 5(2)(b) ground, the opponent claims that the parties’

³ The opponent’s third earlier mark is a comparable trade mark based on a pre-existing IR designating the EU. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing IRs designating the EU.

marks are identical or similar, and that the respective services are identical and/or similar, such that there exists a likelihood of confusion on the part of the public, including a likelihood of association. The opponent also completed a statement of use in respect of the first, third and fourth earlier mark.

6. For the purpose of its claim under section 5(3), the opponent submits that the earlier marks enjoy a reputation for all of the services it has identified and that, in light of the similarity between the parties' marks, use of the applicant's mark would take unfair advantage of, or be detrimental to, the distinctive character or repute of the opponent's earlier marks.

7. In his counterstatement, the applicant put the opponent to proof in respect of the first earlier mark, specifically the class 43 terms for which it is registered, and the fourth earlier mark in its entirety. The applicant submits that the only common element between the parties' marks is the word FORTE, which it argues is "easily recognisable for its laudative meaning", and therefore "could not be monopolized".

EVIDENCE AND SUBMISSIONS

8. The opponent's evidence in chief comes in the form of a witness statement from its General Counsel, Mr Nicholas John Clayson, dated 27 November 2024, alongside seven supporting exhibits.

9. The applicant filed evidence in the form of two witness statements, the first from its General Counsel, Mr Emanuele Montelione, dated 27 January 2025,⁴ and the second from the applicant himself, dated 24 January 2025.

10. In reply, the opponent filed a witness statement from Mr Ian Gruselle of Bristows LLP dated 26 March 2025.

11. Neither party requested a hearing, though both parties elected to file written submissions in lieu of the same on 6 May 2025.

⁴ The date was obscured on the original copy of Mr Montelione's statement. It was refiled on 29 April 2026.

REPRESENTATION

12. In these proceedings, the opponent is represented by Bristows LLP. The applicant is represented by Mr Emanuele Montelione.

RELEVANCE OF EU LAW

13. 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.

Sections 5(1) and 5(2)(b)

14. Section 5(1) of the Act is as follows:

“5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

15. Section 5(2)(b) reads as follows:

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

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

16. The trade marks relied upon by the opponent clearly qualify as earlier trade marks pursuant to section 6 of the Act. Those that had been registered for more than five years

at the application date of the contested mark are, in theory, subject to the proof of use provisions set out in section 6A of the Act. However, the applicant has requested proof of use in respect of the first (specifically the class 43 services) and fourth earlier marks only. The opponent may therefore rely upon the second and third earlier marks and all services it has identified for which they are registered without providing evidence of use. The opponent can also rely upon the remaining terms in the specification of the first earlier mark, for which the applicant has not requested evidence of use. Whilst I recognise that the proceedings will therefore continue regardless of whether or not use is established, I will move to consider the matter of genuine use in the ordinary way.

Proof of use

17. 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 or international trade mark (UK) 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,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.

[...]

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

18. Section 6A reads as follows:

“(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.”

19. Section 100 of the Act is also relevant. It reads:

“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.”

20. As the first mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It is as follows:

“(1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the ‘five-year period’) has expired before IP completion day-

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day-

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A to the United Kingdom include the European Union.”

21. In *easyGroup Ltd v Nuclei Ltd & Ors*,⁵ 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 Bundesvereinigung 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]

⁵ [2023] EWCA Civ 1247

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 sub-category 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].

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.’

22. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”⁶ because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

23. Section 6A of the Act (cited above) makes clear that the relevant period for the present assessment is the five-year period prior to the filing date of the applicant’s mark,

⁶ *Jumpman* BL O/222/16

being 23 February 2022. The relevant period is, therefore, 24 February 2017 to 23 February 2022 (“the relevant period”).

The opponent’s evidence

24. Mr Clayson describes the opponent as “one of the world’s leading luxury hotel and leisure companies offering our customers accommodation, entertainment, spa, restaurant, bar and club services.” The opponent’s company and Sir Rocco Forte Limited (Sir Rocco Forte being chairman and director of the opponent) were set up in 1996 after the Forte Group was taken over by Granada. The opponent’s hotel chain was initially known as RF Hotels and re-branded as ROCCO FORTE Hotels in 2003. The opponent operates across the UK and EU, with its UK sites being Browns Hotel in Mayfair, London and the Balmoral in Edinburgh.

25. Sir Rocco Forte was knighted in 1994 by Queen Elizabeth II in recognition of his contribution to the tourism industry.⁷ In 2005, Sir Rocco Forte was granted the *Grand Croce dell’Ordine al Merito della Repubblica Italiana*, described by Mr Clayson as “the highest Italian accolade”. The award serves to “reward merit acquired to the Nation in the field of literature, arts, and the economy in the hallway of public functions or activities for social, philanthropic and humanitarian, as well as for long and services reported in the civilian and military careers.”⁸ Sir Rocco Forte was awarded a Lifetime Achievement Award at the European Hospitality Awards in 2014.⁹ A 2014 article from *Arena International* says of Rocco Forte Hotels “...these hotels occupy magnificent buildings in great locations...the company operates hotels in key European destinations such as Edinburgh, Brussels, Florence, Rome, London, Munich, Frankfurt, Manchester, Berlin, and St. Petersburg.”

26. The opponent has traded under its ROCCO FORTE and ROCCO FORTE HOTELS marks since 2003. Mr Clayson alleges that the name FORTE is synonymous with the

⁷ Information pertaining to knighthoods and a photograph of the official document are enclosed at Exhibit 1

⁸ See Exhibit 2

⁹ Articles pertaining to the award are enclosed at Exhibit 3: arena-international.com (“European Hospitality Award – Lifetime Achievement Award Winner, 2014”), hmi-online.com (“Europe’s finest – the 2014 European Hospitality Awards”, 10 October 2014, “The big interview – Sir Rocco Forte”, 13 December 2014, “European Hospitality Awards 2014”, 12 December 2014)

opponent and the family of Sir Rocco Forte. In a narrative from Sir Rocco Forte on the opponent's website,¹⁰ he reflects on the company's growth and future plans, writing: "We have expanded from a single hotel to a collection of 11 mainly concentrated in major European cities... In the next five years, we intend to become a 15-strong group, adding to it in Europe and elsewhere. Italy is a particular focus as the country still has so much potential as a luxury destination... In 2024, we will be unveiling three further Italian properties".¹¹ In an introduction dedicated to each member of the Forte family, a section pertaining to Ms Lydia Forte is headed "The Art of Eating and Drinking". Amongst the blurb, it reads "Take a seat at any Rocco Forte hotel restaurant or bar, and you'll immediately know where you are: creative cocktails, locally-made honeys and marmalades (and in the case of Balmoral in Edinburgh, salmon smoked in-house)".



ROCCO FORTE HOURISH



VERDURA RESORT SPA, SICILY

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27. The opponent's directories are available from its website¹³ and are published in English, French, German and Italian. It is estimated that the brochures are downloaded 130 times per month and Mr Clayson assures me that the opponent's marks, including ROCCO FORTE, feature prominently in the brochures which offer information pertaining to accommodation, spa, bar and restaurant services.

28. Finally, Mr Clayson directs me to a number of press clippings which are at Exhibits 6 and 7, the first articles providing coverage of the opponent's hotels and later articles

¹⁰ Appears to be retrieved from the present website (or at least the website active at the time of collation)

¹¹ "Our history" (Rocco Forte Hotels & Resorts website)

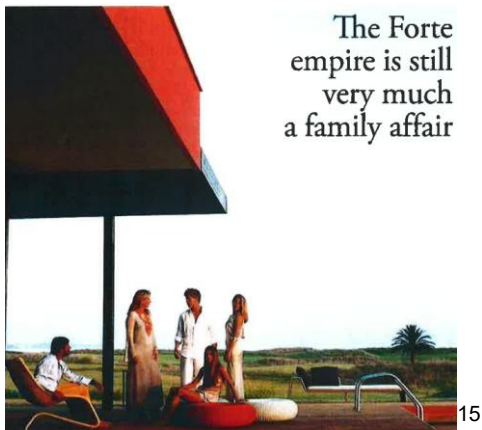
¹² Images from the opponent's site

¹³ www.roccofortehotels.com

concerning Sir Rocco Forte, as an individual. I summarise these clippings, in the order they were exhibited, in the table below:

Date	Publication	Details
16 November 2013	www.thisismoney.co.uk	"Hotel empire owned by Sir Rocco Forte and his family say it's 'turned a corner' this year"
23 May 2019	PR Newswire	"Hotel de la Ville, A Rocco Forte Hotel, The Most Anticipated Hotel Opening in Rome"
21 October 2020	www.travelprnews.com	"Rocco Forte Hotels launches a recognition program unlike any other – Rocco Forte Friends"
4 June 2021	www.aspiretravelclub.co.uk	"Rocco Forte Hotels opens property in Sicily"
30 November 2014	The Sunday Times (Business magazine)	An interview with Sir Rocco Forte, headed "I'll let my children make own mistakes"
7 March 2014	British Airways "Business life"	"What I've learnt: hotelier Sir Rocco Forte"
2010	Tatler Travel Guide 2010	The opening of the opponent's hotel in Sicily is featured, "Starring the 1010 best hotels in the world"
16 September 2011	Caterer and Housekeeper	"What Makes a Good Leader?" <i>"The Forte Legacy: It's impossible to talk about hospitality leaders without acknowledging the role of Lord Charles Forte and his empire"</i>
20 November 2011	www.independent.co.uk	"Sir Rocco Forte: 'I still

		haven't got to Paris...and I want to try New York"
_14	https://dreamescape.co.uk	"Chatting with Holly" and Sir Rocco Forte" <i>"A Dream Escape favourite is the J.K.Rowling Suite in The Balmoral Hotel in Edinburgh... We also love the Kiplin Suite in Brown's Hotel...Sir Rocco was excited to share some new development news in the UK"</i>
1 June 2021	British Airways "High Life" magazine	"The connoisseur: Sir Rocco Forte"



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Assessment

29. I begin my assessment by acknowledging that the opponent's evidence faces a number of shortcomings. In particular, the opponent's evidence is absent of any turnover figures, visitor information and promotional insight (including means of promotion and associated expenditure). A significant number of the articles featuring the hotel group and Sir Rocco Forte pre-date the start of the relevant period and the accolades awarded to Sir Rocco Forte, whilst impressive, came some years prior. His knighthood, for

¹⁴ I cannot see a date in the article and the publication date is not set out in Mr Clayson's statement

¹⁵ Tatler 2010

example, was awarded in 1994 and he was awarded the Lifetime Achievement Award at the European Hospitality Awards in 2014. I turn then to consider whether what the evidence *does* show is sufficient to overcome the aforementioned deficiencies.

30. The articles dated 23 May 2019 and 4 June 2021 announce the opening of two hotels, respectively; one in Rome and the other in Sicily. The article published in October of 2020 details the launch of a recognition programme which, according to the article, is “aimed at inviting its most loyal guests as well as new guests to sign up and take part in bespoke activities that will create lifelong memories.” The opening in Rome is relevant and, whilst by the time the Sicily hotel was opened the UK had left the EU, I take into account the amount of time likely required in readiness and, nonetheless, this could still carry weight were the evidence to show that UK guests were targeted. Whilst the aforementioned articles also appear to indicate that the opponent’s UK hotels were at least in operation at the time of publication, this is not corroborated to any extent that could help me identify precisely which services the marks relied upon were used in relation to, nor how the marks were used (i.e. as registered or otherwise). Further, whilst the opponent’s brochures are (currently) downloaded approximately 130 times each month, I have not been informed what these figures were during the relevant period, and even if I were to infer based on the languages the brochures are published in (and in light of the surrounding evidence) that the brochures target EU consumers, there is nothing to suggest that these downloads led to any real engagement with the services. Furthermore, the evidence fails to show to what extent the website or brochures were trying to *attract* customers from the relevant territory within the relevant period.¹⁶

31. The evidence as a whole indicates that Sir Rocco Forte and Rocco Forte Hotels are well-recognised and respected within the hospitality industry, or at least were in the years prior to the relevant period. I note, for example, a feature in Tatler declaring that “The Forte empire is still very much a family affair” and a publication subtitled “The Forte Legacy: It’s impossible to talk about hospitality leaders without acknowledging the role of Lord Charles Forte and his empire”, albeit published in 2010 and 2011 respectively. However, as far as use of the trade marks is concerned, the evidence does not provide a clear enough picture of precisely which services the marks have been used for throughout the relevant period and what efforts have been employed to create or

¹⁶ See, for example, BL-O/0984/25 (AP)

preserve a share in the marketplace. The opponent intends to rely upon a number of different services but, as already indicated, the evidence does not allow me to conclude with any confidence for which specific services use has been satisfied. In this regard, I keep in mind the decision in *Palmerwheeler Ltd v Prnnet*¹⁷ where Ms Amanda Michaels, as the Appointed Person, emphasised that it is incumbent on a party to identify with clarity which parts of its lengthy specification it is said were proved to have been used (and by which parts of its evidence). I am not satisfied that this expectation has been met by the opponent in the present case. It seems to me that information such as turnover, number of visitors or its promotional investment would have been readily available to the opponent and it is not clear why such pivotal pieces of evidence are absent. Further, on account of the lack of evidence concerning the actual use made of the earlier marks during the relevant period, I am unable to say with any degree of certainty that consumers would have been confronted with the marks as relied upon (as opposed to any variant use, for example). To presume this was the case would, to my mind, inappropriately remove the burden of proof from the opponent and risk being prejudicial to the applicant.

32. I have already reproduced case law above which makes clear that the burden of proof lies firmly with the opponent. Having considered my issues with the evidence before me in light of said case law and Section 100 of the Act, my conclusion concerning genuine use is that the opponent has failed to show with sufficient precision how much use has been made of the earlier marks during the relevant period, and in relation to which specific services. As a result, the opponent is not permitted to rely upon its fourth earlier mark or the class 43 services for which its first mark is registered for the purpose of the present proceedings. On this point, because proof of use is equally as applicable to section 5(3) grounds as it is to section 5(2)(b) grounds, these limitations will naturally extend to my assessment under section 5(3).

The parties' remaining evidence

33. I do not intend to summarise the applicant's evidence, nor the opponent's evidence in reply. Both go to the nature of the word FORTE and its role as a trade mark. In his witness statement, Mr Montelione appears to suggest that, because FORTE is "highly

¹⁷ BL O/484/13

descriptive and/or laudatory”, it is likely to be registered “only in a stylized form”. For the opponent, in the witness statement of Mr Ian Gruselle, this suggestion is refuted. Mr Gruselle maintains that FORTE, in word-only format, is *inherently registrable* for the relevant services proper to classes 35, 41, 42, 43 and 44.

34. As the registrability of FORTE is not a matter presently before me, I need not say anything further on this point. I will return to consider the matter of the mark’s distinctive character later in my decision.

My approach

35. Given that the opponent is able to rely upon the full breadth of terms it has identified in respect of its second and third earlier mark, I will continue my assessment on the basis of these marks only and return to consider the matter in respect of the opponent’s first mark (and the remaining services relied upon) only if necessary.

Section 5(2)(b) – the principles

36. 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 Pairs Europe Inc & Anor*:¹⁸

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their mind, and whose attention varies according to the category of goods or services in question;

¹⁸ [2025] UKSC 25

- 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; 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 services

37. For ease, I set out the services to be compared in the table below, with the opponent’s second mark (and the class 43 services for which it is registered) used to oppose the applicant’s class 43 services and its third earlier mark (and the class 35 services for which it is registered) used to oppose the applied-for services in class 35.

Opponent’s services	Applicant’s services
<p><i>Class 43: Hotel and motel services; booking and reservation services for hotels, motels, guest houses and accommodation; provision and rental of temporary accommodation; provision of serviced apartments; room rental services; real estate services, namely operation and rental of serviced apartments, holiday homes, temporary accommodation and property; services for providing food and drink; hotel restaurant and hotel catering services; restaurant, cafe, brasserie, bar, public house and catering services; cocktail lounge services; preparation and provision of food and drink; banqueting services; provision of conference, seminar, meeting and exhibition facilities; booking and reservation services for restaurants and hotels; information, advice and consultancy in respect of the aforesaid services (second earlier mark)</i></p>	<p><i>Class 35: Business management of restaurants; Restaurant management for others; Marketing services in the field of restaurants; Business advice relating to restaurant franchising; Business management assistance in the operation of restaurants; Business advisory services relating to the running of restaurants; Business advisory services relating to the setting up of restaurants; Business management assistance in the establishment and operation of restaurants; Online ordering services in the field of restaurant take-out and delivery; online ordering services in the field of restaurant take-out and delivery; On-line ordering services in the field of restaurant take-out and delivery; Business management of hotels; Consultancy services relating to the administration and management of hotels. (Class 35)</i></p>
<p><i>Class 35: Advertising; business management; business administration; hotel management services (third earlier</i></p>	<p><i>Class 43: Restaurants; Restaurant services; Delicatessens [restaurants]; Restaurant information services;</i></p>

mark)	<i>Providing reviews of restaurants; Bar and restaurant services; Booking of restaurant seats; Agency services for reservation of restaurants; Hotel restaurant services; Provision of hotel accommodation; Catering; Mobile catering; Business catering services. (Class 43)</i>
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38. Throughout my comparison of the parties' services, I will consider factors including their nature, intended purpose, method of use, user, trade channels and whether they are in competition or are complementary.¹⁹

39. As for when goods (though it equally applies to services) can be considered identical, in *Gérard Meric v Office for Harmonisation in the Internal Market*,²⁰ the General Court ("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."

40. In *Kurt Hesse v OHIM*,²¹ the Court of Justice of the European Union ("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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*²², the GC stated that "complementary" means:

"...there is a close connection between them, in the sense that one is indispensable

¹⁹ *Canon*, Case C-39/97; *Treat*, [1996] R.P.C. 281

²⁰ Case T- 133/05

²¹ Case C-50/15 P

²² Case T-325/06

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”.

41. For the purpose of a comparison it is permissible to group goods or services together, where appropriate.²³

Class 35

Business management of restaurants; Business management assistance in the operation of restaurants; Business management assistance in the establishment and operation of restaurants; Business management of hotels

42. The opponent relies upon *business management* services at large. To my mind, this will naturally encompass the business management services identified above and will extend to the business management assistance services. I find the respective services are identical in line with *Meric*.

Restaurant management for others

43. The opponent’s *business management* service is a broad term which, to my mind, awards protection for the management of a range of businesses which could include restaurants or eateries. It may be, therefore, that the respective services can be considered identical. In the alternative, in circumstances such as those set out above, the parties’ services may coincide in a number of factors including use and users. The services’ nature may be similar at least to a degree and they may occupy competitive roles and share an element of complementarity. On this basis, I find the services at least highly similar.

Marketing services in the field of restaurants

44. The opponent relies upon *advertising* at large. If marketing and advertising are to be deemed identical, I find the above term would naturally be encompassed by the opponent’s services. In the alternative, were there a distinction to be made between

²³ *Separode Trade Mark* BL O-399-10 (AP)

marketing and advertising, the respective services nonetheless share a similar purpose. The services are likely to share users and there may be some elements of similarity in their nature. Given the coincidence in purpose, even in broad terms, the services may in some circumstances be competitive and it would not seem unreasonable to expect a single undertaking to offer both services simultaneously. I find the services at least highly similar.

Business advice relating to restaurant franchising; Business advisory services relating to the running of restaurants; Business advisory services relating to the setting up of restaurants.

45. The opponent relies upon *business management* and *business administration* at large. These are fairly broad terms which, where applicable to the same context as the applicant's services, will share a similar purpose, be selected by the same users and, whilst not necessarily competitive, could certainly be offered by a shared undertaking. I acknowledge, however, that the nature of the respective services is likely to be distinct. I find the services' similarity is of a medium degree.

Consultancy services relating to the administration and management of hotels

46. I consider the above goods against the opponent's *hotel management services*. If it would be too generous to find these identical in accordance with *Meric*, I find at least a high degree of similarity. The services will be accessed by the same users, for at least a highly similar purpose. There may be some coincidence in the nature of the respective services as delivered, and it would not seem unreasonable to expect both services to be offered by a single provider to fulfil a shared or similar brief.

Online ordering services in the field of restaurant take-out and delivery; online ordering services in the field of restaurant take-out and delivery; On-line ordering services in the field of restaurant take-out and delivery

47. The opponent relies upon *business management* services at large which I have already found will likely encompass the management of businesses such as restaurants or eateries. Applying the same reasoning here, this may result in a possible

coincidence between the use of the services, in broad terms at least. There may also be an opportunity for the services to be accessed by the same users. Though the services' nature is likely distinct in general terms, an undertaking offering a breadth of services for the purpose of managing a restaurant (for example) may provide an online ordering function, which could create some overlap in nature. This may also invite an opportunity for competitiveness, though not necessarily in every circumstance. Finally, where the services are undertaken in the same context there may be an element of complementarity. Generally speaking, applying due weight to the factors and opportunities for similarity set out here, I find the services similar to a low degree.

Class 43

Restaurants; Restaurant services

48. The aforementioned terms are identical to the opponent's *restaurant services*.

Delicatessens [restaurants]

49. To my mind, the above services are identical to the opponent's *restaurant services* in accordance with *Meric*. If that is too generous a finding, I find the services are at least highly similar. They will be accessed by the same consumers for the same purpose, are likely to be somewhat similar in nature and share a competitive dynamic insofar as the consumer may wonder which eatery best suits its requirement.

Restaurant information services

50. I consider the above term identical to the opponent's *restaurant services... [and] information in respect of the aforesaid*.

Providing reviews of restaurants

51. The opponent relies upon *restaurant services* and *information* and *advice* in respect of the same. In my view, such services may naturally encompass reviews of said restaurants, which would result in a finding of identity. Alternatively, I find the

services will nonetheless be accessed for at least a similar purpose, and likely by the same users. There would likely be some element of similarity in the nature of the services provided and, whilst not necessarily competitive, I find there is a degree of complementarity. I find the services at least highly similar.

Booking of restaurant seats; Agency services for reservation of restaurants

52. The opponent relies upon *booking and reservation services for restaurants*. I find the above applied-for terms will naturally fall within the remit of the opponent's services. The services are identical in accordance with *Meric*.

Hotel restaurant services; Bar services

53. The above terms are included in both parties' specifications. These services are identical.

Provision of hotel accommodation

54. The opponent relies upon *hotel services* at large. I find this encompassing of the applicant's term. The services are identical in accordance with *Meric*.

Catering; Mobile catering; Business catering services

55. I find the above services are caught within the remit of the opponent's *catering* services. They are to be deemed identical in accordance with *Meric*.

Average consumer and the purchasing process

56. In *Iconix Luxembourg Holdings*, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor*,²⁴ where he pointed out that:

"16. First, the average consumer is both a legal construct and a normative

²⁴ (Rev1) [2024] EWCA Civ 262

benchmark. They are a legal construct in that consumers who are ill-informed or careless and consumers with specialised knowledge or who are excessively careful are excluded from consideration. They are a normative benchmark in that they provide a standard which enables the courts to strike a balance between the various competing interests involved, including the interests of trade mark owners, their competitors and customers.

17. Secondly, the average consumer is neither a single hypothetical person nor some form of mathematical average, nor does assessment from the perspective of the average consumer involve a statistical test. They represent consumers who have a spectrum of attributes such as gender, age, ethnicity and social group. ... It follows that assessment from the perspective of the average consumer does not involve the imposition of a single meaning rule akin to that applied in defamation law (but not malicious falsehood). ... if having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, then a finding of infringement may properly be made.

18. Thirdly, assessing from the perspective of the average consumer is designed to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence. ...

19. Fourthly, the average consumer's level of attention varies according to the category of goods or services in question.

20. Fifthly, the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind."

57. The average consumer of the services at issue will likely comprise both members of the general public and professional undertakings. To my knowledge, the services are predominantly sourced via visual means such as online resources or brochures.

The visual impression of the parties' marks is therefore likely to bear the greatest weight during the selection process. That being said, I do not overlook the significance of the marks' aural impression given that the consumer may rely to some extent upon word-of-mouth recommendations from peers or agents, for example. The frequency of the purchase and the cost associated with the services can vary rather significantly. Still, the consumer is likely to be alive to a number of considerations such as amenities and reputation (in the case of the class 35 services) and menu choices and accessibility (in the case of the class 43 services). Weighing all factors, I find the consumer will apply between a medium and fairly high degree of attention to its selection of the services at issue.

Comparison of marks

58. It is clear from the judgment of the CJEU in *SABEL BV v Puma AG*,²⁵ 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 in *Bimbo SA v OHIM*²⁶ that:


“34. ... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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.”

59. Artificial dissection of the marks would therefore be wrong, although it is necessary for me to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

²⁵ Case C-251/95 (particularly paragraph 23)

²⁶ Case C-519/12 P

60. The respective marks are shown below:

The opponent's second and third mark	Applicant's mark
ROCCO FORTE	

61. Given that the opponent's second and third marks are identical, I consider it appropriate to make a single finding. The mark comprises two five-letter words; ROCCO FORTE. Together, the words are likely to be perceived as a person's name, with the words creating a unit. I do not find either the forename or surname to offer a greater degree of distinctiveness or dominance (than the other). The marks' overall impression lies in its entirety.

62. The applicant's mark is figurative, with a word element (FORTE) positioned on a rectangular black background. The letters are all presented in white, in upper-case and in an unremarkable font. The mark's overall impression is dominated by the word "FORTE", with its figurative element playing a significantly lesser role.

63. Visually, the parties' marks coincide in the word "FORTE", which is the second of two word elements in the opponent's mark and only word element in the applicant's mark. The applicant's mark also features a figurative device absent of any counterpart. That said, given what I have found in regard to the marks' overall impressions and being mindful of the general rule of thumb concerning the beginnings of marks, which typically have a greater impact on the consumer,²⁷ I find the marks are visually similar to no more than a medium degree.

²⁷ See, for example, *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02
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64. Aurally, the opponent's mark is likely to be expressed in four syllables, vaguely ROCK-OH-FOR-TAY. The applicant's mark will likely be articulated in two syllables, FOR-TAY. Having regard again to the effect of the beginnings of marks, notwithstanding the marks' identical FOR-TAY sequence, I find the marks' aural similarity is of no more than a medium degree.

65. The marks' conceptual position must be viewed from the perspective of the average consumer. Beginning with the opponent's mark, as already indicated I find it will be perceived as a person's name (forename being Rocco and the surname Forte). As for the applicant's mark, to my mind the average consumer will understand *forte* to be a word meaning (broadly) a person's strength or a positive attribute or skill. It may be that the word is awarded the same meaning in the earlier mark, or the consumer will at least recognise that the mark incorporates a word with this meaning, but its pairing with the word ROCCO alters its conceptual impact. On this basis I find the marks, in their entirety, are not conceptually similar. In the alternative, where the coincidence in 'FORTE' promotes an identical meaning to the effect described above, I find the marks' conceptual similarity would be of a fairly low degree.

Distinctive character of the earlier marks

66. Distinctive character is a measure of how strongly a mark distinguishes the goods or services of one undertaking from those of others. The factors that I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*²⁸:

"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

²⁸ Case C-39/97

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

67. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of the mark can be enhanced by the use that has been made of it.

68. I have already found that the opponent’s “ROCCO FORTE” mark will be viewed as a person’s name. In *Harman International Industries, Inc v OHIM*,²⁹ the CJEU found that:

“Although it is possible that, in a part of the European Union, surnames have, as a general rule, a more distinctive character than forenames, it is appropriate, however, to take account of factors specific to the case and, in particular, the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character. That is true of the surname ‘Becker’ which the Board of Appeal noted is common.”

69. In general terms, the use of names in trade marks is not an unusual practice and such use would therefore not usually make for particularly distinctive marks. However, viewed from the perspective of the UK consumer, both ROCCO and FORTE are likely to be seen as fairly uncommon names, which (as indicated above) will have a bearing on the degree of distinctiveness enjoyed by the mark. With this in mind, I find the inherent distinctiveness of the earlier mark is slightly above a medium degree.

70. The opponent has filed evidence of use of the earlier marks, which is summarised above (albeit likely filed predominantly for the purpose of showing genuine use of its first and fourth earlier marks). Still, I remind myself at this point of the deficiencies faced by the evidence including, for example, turnover or visitor information and clarification of the marks’ promotional means or expenditure. Whilst consumers may have had sight of

²⁹ Case C-51/09P

some of the press articles exhibited in evidence, I have no insight as to circulation figures nor any geographical breakdown. For the purpose of assessing enhanced distinctiveness, it is specifically the UK consumer to which I must be mindful and the evidence shows very little engagement in this regard. For reasons already discussed, I find the evidence insufficient to show that the marks' distinctiveness has been enhanced by virtue of their use.

The global assessment of the likelihood of confusion

71. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive it is, the greater the likelihood of confusion. Conversely, the less distinctive it is, the lower the likelihood of confusion.

72. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and the respective goods and/or services down to the responsible undertakings being the same or related.

73. I take note of the comments made by Mr Iain Purvis Q.C., as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*,³⁰ where he explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may

³⁰ Case BL O/375/10

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.”

17. Instances where one may expect the average consumer to reach such a conclusion 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).”

74. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*,³¹ Arnold LJ approved Mr Purvis’s formulation but added:

“13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] ‘a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion’. Mr Mellor went on to say that, if there is no likelihood of direct confusion, ‘one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion’. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there

³¹ [2021] EWCA Civ 1207

is no likelihood of direct confusion.”

75. In *The Picasso Estate v OHIM*,³² the CJEU found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

76. In *Nokia Oyj v OHIM*,³³ the GC stated that:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

77. I begin by considering a likelihood of direct confusion. Particularly in light of the level of attention likely to be applied by the average consumer in its selection of the relevant services, which I have found will be of at least a medium degree, I find there are sufficient differences between the parties’ marks to overcome a likelihood of direct confusion. The introduction of ROCCO in the earlier marks (or vice versa) creates a significant distinction in the marks’ visual and aural representation and alters the concept of the marks’ shared ‘FORTE’ element such that the consumer will readily distinguish between them, even when considered in respect of identical services.

78. I turn now to consider the likelihood of indirect confusion. Whilst the average consumer will identify that the marks are not the same, to my mind they will nonetheless also identify that the marks share an identical element in FORTE. Although I appreciate that the parties’ marks take on distinct conceptual impressions (my primary finding being that the marks are not conceptually similar), which is sometimes sufficient to counteract

³² Case C-361/04 P

³³ Case T-460/07

the marks' similarities elsewhere, particularly in light of the relationship between the respective services I can foresee circumstances whereby the consumer would be inclined to conclude that the marks originate from a shared or related undertaking. For example, a consumer who has previously accessed services offered under the ROCCO FORTE mark would, upon encountering the applicant's mark which is dominated by the word FORTE, presume that the services originate from *at least* a related undertaking which is, for example, electing to use the surname only as part of a sub-brand or re-branding exercise. In short, I find there is a likelihood of indirect confusion in respect of all services applied-for.

79. The opposition under section 5(2)(b) is successful.

80. As the opponent has succeeded on the basis of its second and third earlier marks, it is not necessary for me to make a finding on the basis of its first earlier mark and the remaining terms for which it is registered.³⁴ It is also not necessary that I consider the matter of identity for the purpose of the opponent's claim under section 5(1).

Section 5(3)

81. Section 5(3) of the Act is as follows:

"A trade mark which—

(a) is identical with or similar to an earlier trade mark,

[...]

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom 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."

³⁴ If I am incorrect to have interpreted the scope of the proof of use requested in the applicant's counterstatement in the way I have above at paragraph 7, it would not affect the outcome of my decision as the counterstatement identified the first and fourth earlier marks only and I have used only the second and third marks as the basis for the opposition.

82. As the first and second earlier marks are comparable marks, paragraph 10 of Part 1, Schedule 2A of the Act is relevant. It reads as follows:

“(1) Sections 5 and 10 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the reputation of a comparable trade mark (EU) falls to be considered in respect of any time before IP completion day, references in sections 5(3) and 10(3) to-

(a) the reputation of the mark are to be treated as references to the reputation of the corresponding EUTM; and

(b) the United Kingdom includes the European Union.”

83. The third earlier mark is a comparable trade mark (IR) and so paragraph 10 of Part 1, Schedule 2B of the Act also applies:

“(1) Sections 5 and 10 apply in relation to a comparable trade mark (IR), subject to the modifications set out below.

(2) Where the reputation of a comparable trade mark (IR) falls to be considered in respect of any time before IP completion day, references in section 5(3) and 10(3) to-

(a) the reputation of the mark are to be treated as references to the reputation of the corresponding (IR), and

(b) the United Kingdom includes the European Union.”

84. The relevant case law can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case

C-408/01), *L'Oréal SA & Ors v Bellure & Ors* (Case C-487/07), *Interflora Inc & Anor v Marks and Spencer plc & Anor* (Case C-323/09) and *Environmental Manufacturing LLP v OHIM* (Case C-383/12 P). 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; *General 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 Salomon*, 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 and/or services, the extent of the overlap between the relevant consumers for those goods and/or 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 that 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'Oréal*, paragraph 44.

g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods and/or 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 and/or services for which the earlier mark is registered, or a serious risk that this will happen in the 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 on the earlier mark; *L'Oréal*, paragraph 40.

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; *Interflora*, paragraph 74, and the court's answer to question 1 in *L'Oréal*.

85. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its marks have achieved a level of knowledge, or reputation, amongst a significant part of the public. Secondly, the opponent must establish that the public will make a link between the marks, in the sense of the earlier mark being brought to mind by the later mark. Thirdly, assuming the first and second conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the opponent will occur.

It is unnecessary for the purposes of section 5(3) that the goods or services are similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

86. The relevant date for the assessment under section 5(3) is the application date of the mark at issue, being 23 February 2022.

Reputation

87. In *General Motors*, 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.”

88. For the purpose of assessing reputation in respect of the opponent’s comparable marks, the relevant territory prior to IP Completion Day is the EU. Thereafter, it is the reputation in the UK which is relevant. The courts have held that the mark must have a reputation in a substantial part of the territory of the EU, but that, depending on the

particular facts of the case, that may be a single EU Member State.³⁵

89. The opponent claims to have a reputation in respect of a wide range of services spread amongst classes 35, 41, 43 and 44.

90. In order to be successful under section 5(3), the opponent is required to demonstrate that it had a reputation amongst a significant part of the relevant public at the relevant date. In making this assessment, it is necessary for me to consider whether the opponent's earlier marks will be known by a significant part of the public concerned with the services. In reaching this decision, I must consider a number of factors which, as set out in the case law above, include the market share held by the marks, the intensity, geographical extent and duration of use, and the size of the promotional investment made by the opponent.

91. I have summarised the evidence of use above. The opponent's evidence is lacking any insight into the share of the market enjoyed by the opponent's marks or the turnover generated by sales made under those marks by the relevant date. It fails to offer any figures concerning promotional expenditure, nor does it discuss the means of promotion engaged with to any meaningful degree. For the purpose of an assessment under section 5(3), these are significant deficiencies to overcome. The articles enclosed in evidence span a number of years prior to the relevant date, and suggest that Sir Rocco Forte had been operating within the hospitality industry for many years. The articles also appear to show an element of anticipation surrounding the opening of Rocco Forte hotels in Rome or Sicily, for example. However, absent of any corroborative narrative evidence or specific examples concerning the opponent's activities, it is difficult to establish the intensity of use and to identify which of the opponent's services any potential reputation would expand to. The accolades awarded to Sir Rocco Forte are significant and would certainly hold weight if the surrounding evidence provided greater insight, but they were issued some years before the relevant date of assessment and it is difficult to determine on the basis of the remaining evidence what the position would have been at the relevant date. All things considered, I am not satisfied that the evidence is sufficient to show that the opponent had established a reputation in the services relied upon at the relevant date.

³⁵ See *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07, paragraphs 20-30.

92. As I have found the opponent's evidence insufficient to support a finding of reputation, **the opposition reliant upon section 5(3) must fail.**

COSTS

93. The opponent's claim under section 5(2)(b) of the Act has been successful. The opponent is therefore entitled to a contribution toward its costs based on the scale set out in Tribunal Practice Notice ("TPN") 2/2016³⁶. In accordance with the TPN, I award costs as follows:

Preparing a Notice of Opposition:	£250
Official fee:	£200
Preparing evidence and considering and commenting on the other side's evidence:	£650
Filing submissions in lieu of a hearing:	£300
Total:	£1400

94. I therefore order Andrea Reitano to pay Rocco Forte Hotels Limited the sum of £1400. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the determination of this case if any appeal against this decision is unsuccessful.

Dated this 22nd day of June 2026

Laura Stephens
For the Registrar,
Comptroller-General

³⁶ This TPN is applicable because the proceedings commenced after 1 July 2016 but before 1 February 2023.