

O-0761-25

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO. 3972365
BY SWISS HAVEN LTD
TO REGISTER

Swiss Haven

AS A TRADE MARK
IN CLASSES 36 & 43
AND OPPOSITION THERETO (UNDER NO. 445772)
BY
HAVEN LEISURE LIMITED

Background and pleadings

1. Swiss Haven Ltd (“the applicant”) applied for the trade mark **Swiss Haven** on 26 October 2023. It was published in the Trade Marks Journal on 10 November 2023 in classes 36 and 43. The services are set out in Annex 1 of this decision.

2. Haven Leisure Limited (“the opponent”) opposed the application in full on 9 February 2024 under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under sections 5(2)(b) the opponent relies on the following three UK registrations, in class 43 and under section 5(3) it relies on the additional classes 35, 41 and 44. All the services relied on are set out in Annexes 2, 3 and 4 of this decision.

Registrations relied on:	Services relied on:
UK TM No.2172056 (“the ‘056 registration”) HAVEN Filing date: 14 July 1998 Registration date: 31 March 2000	Classes 41, 43 & 44: see Annex 2
UK TM No.1283317 (“the ‘317 registration”) HAVEN Filing date: 1 October 1986 Registration date: 26 February 1990	Classes 43 & 44: see Annex 3
UK TM No.2395412 (“the ‘412 registration”) COMBE HAVEN Filing date: 28 June 2005 Registration date: 1 December 2006	Classes 35, 41 & 43: see Annex 4

3. Under section 5(4)(a) the opponent relies on the sign **HAVEN** which it claims to have used since at least 1985 throughout the UK for the following services, namely *Temporary accommodation services; retail services connected with the sale of mobile homes and caravans; agency services for the sale and purchase of mobile homes and caravans; information, advisory and consultancy services relating to all the aforesaid services; letting services connected with caravans and mobile homes; financial and insurance services relating to holidays; caravan insurance services; real estate services; sale, listing, leasing, financing, managing, acquisition, brokerage and rental of property; information, advisory and consultancy services relating to all the aforesaid services.*

4. The applicant filed a counterstatement in which it denied all the claims brought under opposition.

5. During the proceedings the applicant has represented itself whilst the opponent has been represented by Potter Clarkson LLP. Both sides filed evidence and, as no hearing was requested, both sides filed written submissions in lieu.

6. I make this decision based on a reading of all the material before me.

7. 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 that predate the UK's withdrawal from the EU.

Preliminary issues

8. The opponent's three UK registrations have filing dates that are earlier than the filing date of the contested application and are therefore considered earlier marks, by virtue of section 6 of the Act. As the registration procedure for the earlier marks was completed more than 5 years prior to the filing date of the contested application, they are subject to the use conditions, as per section 6A of the Act. The opponent made a

statement of use in respect of all the services it relies on. However at question 7 on the form TM8, the request for “Proof of Use”, the applicant ticked the “no” box. As a consequence, under sections 5(2)(b) and 5(3), the opponent can rely on the services claimed in its notice of opposition without having to show genuine use.

EVIDENCE

Opponent’s evidence in chief

9. A witness statement dated 21 May 2024 was filed in the name of Sarah Talland, a Partner and Chartered Trade Mark Attorney for the opponent’s legal representative. Ms Talland appends 7 exhibits.

10. Ms Talland states that the opponent’s turnover for 2021 was £659,858,000 and for 2022, the turnover was £744,453,000.

11. Ms Talland exhibits undated screenshots, but which have a 2024 copyright symbol in their footers, from the opponent’s website, namely haven.com, which explain the opponent’s company structure (as it is part of the Bourne Leisure Ltd group of companies) and the services it provides running a number of holiday camps and leisure parks in England, Scotland and Wales.¹ The opponent provides holiday accommodation in the form of chalets, lodges, beach houses, apartments, glamping pods, static caravans and camping pitches for tents and touring caravans. In addition the opponent also sells static caravans at seven of its sites.² As part of its other offerings the opponent provides food and drink facilities as well as a range of leisure activities. The mark used in the screenshot text is **HAVEN** and the mark used on the masthead is the word **Haven** with a swirling ribbon device. The mark **COMBE HAVEN** is mentioned in the 2024 rubric for that particular holiday park location in a listing entitled “Top 5 things to do...” in various camps run by the opponent.³

12. Ms Talland also exhibits a number of press releases from the opponent dated between 2021 – 2024 which feature a number of current and former Team GB Olympic

¹ Exhibits ST1 & 2.

² Exhibit ST3, pages 15 &16

³ Exhibit ST3, page 10.

athletes, in addition to several members of the England Women's national football team, making promotional appearances at the various sites operated by the opponent. In addition, a press release is exhibited for the visit of then PM Boris Johnson to the opponent's site at Perran Sands in Cornwall. Mr Johnson was visiting to see preparations for the re-opening of the site as part of HM Government's post covid "roadmap out of lockdown".⁴

13. Ms Talland also exhibits screenshots outlining the awards won by the opponent. These include three British Travel Awards in 2017, 2018 and 2022, a business leadership award in 2019 from Cornwall Tourism Awards, a "Best Family Friendly Holiday Provider" in 2019 from Tommy's Awards, a Travel Bulletin Star award in 2017 and an entry in the Sunday Times Best Big Companies list in both 2018 and 2019.⁵

Applicant's evidence

14. The applicant filed a witness statement dated 30 June 2024 in the name of Dr Rupert Paget who is the director and owner. Dr Paget appends 37 exhibits.

15. Dr Paget states that the applicant is providing "Swiss-quality real estate and hospitality" services in a niche market, rather than providing the holiday accommodation services offered by the opponent. He exhibits an undated screenshot from the applicant's website, although there is a 2021-2024 copyright symbol in its footer, which states that applicant develops serviced accommodation in Lancashire as a property investment.⁶

16. Dr Paget also exhibits a number of screenshots from a number of third party businesses which have HAVEN either in their trade marks or in their business name.⁷

17. Before I move on, it is important to point out why the applicant's evidence does not assist me. Even if I accept that the applicant and the opponent currently operate in different areas of real estate/accommodation, this would not in any case be relevant to the issue of confusion which I must decide in these proceedings. It is settled law that in assessing whether there is a likelihood of confusion, I must make my

⁴ Exhibit ST6.

⁵ Exhibit ST7.

⁶ Exhibit RP01.

⁷ Exhibits RP02-37.

comparison of “notional and fair use”⁸ based on the class 36 and 43 services covered by the application and since the earlier marks are not subject to proof of use, the opponent’s class 43 services. It is the *inherent* nature of the specifications which I have to consider. Current use and business activities are not relevant to this notional comparison. My task, therefore, is to conduct the comparison simply on the basis of the services as they are set out in the respective specifications. The concept of notional and fair use is outlined in paragraph 78 of *Roger Maier* decision, viz:

“78.the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion.”

18. The applicant also provided evidence of other trade marks on the UK register containing HAVEN as well as examples of other entities using it in their business names. Such “state of the register” evidence is also irrelevant to my decision. In *Zero Industry Srl v OHIM*,⁹ the General Court (“GC”) stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere

⁸ *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220

⁹ Case T-400/06

fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71).”

Opponent’s evidence in reply

19. The opponent filed a second witness statement in the name of Sarah Talland dated 30 August 2024. Ms Talland appends 4 exhibits including screenshots from the applicant’s website identifying a commercial interest in buying and renting holiday accommodation in Blackpool, which is also the location of two of the opponent’s holiday parks.¹⁰ In addition Ms Talland rebuts the applicant’s state of the register evidence with regard to the status of several of the trade marks mentioned.¹¹

20. That concludes my summary of the evidence.

DECISION

Section 5(2)(b)

21. Section 5(2)(b) of the Act 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”.

22. Section 5A is also relevant and reads:

¹⁰ Exhibits ST2-1 and ST2-3

¹¹ Exhibit ST2-4

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

23. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, EU:C:1997:528, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, EU:C:1998:442, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, EU:C:1999:323, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, EU:C:2000:339, *Matratzen Concord GmbH v OHIM*, Case C-3/03, EU:C:2004:233, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, EU:C:2005:594, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P, EU:C:2007:333, and *Bimbo SA v OHIM*, Case C-591/12P, EU:C:2016:591:

(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 will wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of services

24. In *Canon*¹², the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

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

¹² *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, C-39/97

25. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case)¹³, 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.

26. In addition I find the following case law to be helpful when in *Gérard Meric v Office for Harmonisation in the Internal Market*,¹⁴ the GC stated that:

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

27. The services to be compared are set out in annexes 1-4. I remind myself that the opponent only relies on its class 43 services under section 5(2)(b).

Applicant’s class 36 services

¹³ [1996] R.P.C. 281

¹⁴ Case T- 133/05

28. The applicant's class 36 services can broadly be described as real estate services, namely rental, leasing, letting, purchasing, financing, management and investment services for both residential and commercial property. The opponent has no directly equivalent class within its earlier registrations. In its written submissions,¹⁵ the opponent says that,

“28. As can be seen from the witness statement and exhibits,¹⁶ the Applicant has a particular focus on services (i.e., investment/ buying/ selling/ rental/ leasing services) specifically relating to holiday properties, primarily located in Blackpool, UK.

29. Therefore, it is submitted that the Applicant's services in class 36 are highly similar to the Opponent's services in class 43, all of which include the provision of holiday and/or holiday accommodation services. Furthermore, as can be seen from Exhibit ST2-3, the Opponent also has 2 holiday sites located in Blackpool and so, the geographical proximity of the services offered by the Applicant to the services offered by the Opponent leads to high likelihood of confusion on the part of the consumer between the two commercial undertakings.

30. In light of the above, the Opponent submits that the contested services in class 36 are highly similar in their nature, commercial sector, and geographical location to the Opponent's services in class 43.”.

29. I note the above submissions, but the geographic location of service provision is not a factor I can consider. I must instead consider the notional and fair use of the services as set out in the specification.

30. The opponent has the following services in its various class 43 specifications namely *provision of tourist house and accommodation services; provision of holiday accommodation; booking and reservation services, all for accommodation; tour and*

¹⁵ Written submissions, paragraphs 28-30.

¹⁶ Second witness Statement of Sarah Talland, paragraphs 3-5 and exhibits ST2-1 – ST2 -4.

tourist services, all for arranging accommodation. In my view these services are similar to a low degree to the applicant's terms namely Rental of property; Leasing of property; Leasing of freehold property; Rental of real estate and property; Leasing of real estate property; Real property letting; Accommodation (rental of -) [apartments]; Apartment rental services; Housing accommodation (Provision of permanent -); Rental of apartments; Rental of apartments; Rental of flats, studios and rooms; Leasing of real estate; Real estate (Leasing of -); Real estate leasing; Rental of real estate; Lease of real estate; Property leasing [real estate property only]; Arranging letting of real estate.

31. I make this finding as the respective services offer short term accommodation lettings or rental. As such they overlap in nature and purpose, albeit in a limited way as the applicant's services focus more on permanent living arrangements whereas the opponent's services are for seasonal tourist accommodation. The users may also overlap and the services may reach the user through the same trading channels, i.e. letting agencies.

32. I find the remainder of the applicant's class 36 services namely *Management of property; Property management; Property (Real estate -) management; Real estate property management; Property (Real estate -) investment; Real property management; Property (Real estate -) finance; Property investment services; Real estate and property management services; Property portfolio management; Financing of property development; Financial services relating to real estate property and buildings; Commercial property investment services; Administration of property portfolios; Property management services; Real estate services related to management of property investments; Securing of funds for the purchase of property; Provision of finance for property development; Provision of permanent housing accommodation; Letting and rental of permanent accommodation; Rental of offices; Real estate investment; Real estate affairs; Real estate financing; Real estate consultancy; Real estate management; Management of real estate; Real estate services; Real estate administration; Real estate consultation; Real estate consultations; Real estate investment advice; Real estate investment planning; Investment in real estate (Services for -); Real estate investment services; Real estate equity sharing; Real estate investment management; Real estate agents services;*

Capital investment in real estate; Real estate acquisition services; Residential real estate agency services; Real estate management services; Management services for real estate investment; Financial services related to real estate; Real estate management services relating to housing estates; Providing real estate information relating to property and land; Provision of information relating to the property market [real estate]; Estate management services relating to transactions in real property; Investment advisory services relating to real estate; Real estate management services relating to commercial buildings; Real estate management services relating to residential buildings; Arranging the provision of finance for real estate purchase to be dissimilar to the opponent's class 43 services as they relate to the management, finance and administration of real estate rather the provision of accommodation.

33. Where I have found the services to be dissimilar, it follows that there is no likelihood of confusion to be considered. I am guided on this matter by the case of *eSure Insurance v Direct Line Insurance*,¹⁷ where Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

Applicant's class 43 services

34. The applicant's class 43 services are essentially the provision of temporary accommodation, temporary holiday accommodation and booking of same. In my view the services are sufficiently broad to cover the opponent's services namely *Hotel, motel and boarding house services; provision of tourist house and accommodation services; provision of holiday accommodation; booking and reservation services, all for accommodation; tour and tourist services, all for arranging accommodation*, therefore the services are considered to be identical on the *Meric* principle.

¹⁷ [2008] ETMR 77 CA

Average consumer and the purchasing process

35. I next consider who the average consumer is for the services at issue and how they are purchased. It is settled case law that the average consumer is deemed to be reasonably well informed and reasonably observant and circumspect.¹⁸ For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.¹⁹

36. The average consumer for the contested services will be the general public and potentially some businesses. There are many services contained within the specifications so the price range will vary from the relatively inexpensive such as short term holiday lets to the more expensive letting of real estate. Consumers will likely purchase the services directly online or via a travel or lettings agency's physical premises or online equivalent. Consequently, the purchasing process for the contested services will be predominately visual but may include an aural element if assistance is sought from sales personnel. The degree of attention will vary according to the services but even a consumer considering a short break holiday let will factor in the size of the accommodation, the duration of stay and the facilities available so in my view there will be at least a medium degree of attention paid.

Mark comparisons

37. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*²⁰, that:

¹⁸ *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch)

¹⁹ *Lloyd Schuhfabrik Meyer*, Case C-342/97.

²⁰ Case C-591/12P

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

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

39. The respective trade marks to be compared are:

Opponent's registrations	Applicant's mark
HAVEN COMBE HAVEN	Swiss Haven

40. The opponent's registrations consist of the words **HAVEN** and **COMBE HAVEN** in plain block capitals with no other aspect to them such as stylisation. The overall impression in the two **HAVEN** marks derives solely from the word itself. In the **COMBE HAVEN** registration, neither word dominates the other and both words make an equal contribution to the overall impression.

41. The applicant's mark consists of two words **Swiss Haven** in plain typeface in title case with no other aspect to them such as stylisation. No one word dominates the other and both words make an equal contribution to the overall impression.

Visual comparison

42. The respective marks all share the word **HAVEN**. It is the entirety of the opponent's '056 and '317 registrations and the second word of the '412 registration. It is also the second word of the applicant's mark. The points of difference occur in the first word

of the opponent's '412 registration and the applicant's mark, being **COMBE** and **Swiss** respectively. Taking all this into account I find there is a medium degree of visual similarity between the **HAVEN** marks and **Swiss Haven**. This is reduced to a below medium degree of visual similarity between **COMBE HAVEN** and **Swiss Haven**.

Aural Comparison

43. The shared word **HAVEN** will be pronounced in the usual way and will be the same for all marks. As previously stated, the point of difference will be the **COMBE** and **Swiss** word elements which will be verbalised as they are the first words of the respective marks but have entirely different pronunciations. Overall, I find there is a medium degree of aural similarity between the **HAVEN** marks and **Swiss Haven**. This is reduced to a below medium degree of aural similarity between **COMBE HAVEN** and **Swiss Haven**.

Conceptual comparison

44. The shared word **HAVEN** is a known dictionary word which the applicant gives a definition as "a place of safety or refuge".²¹ I agree that consumers will bring that concept to mind for the shared word. The applicant goes on to state that **HAVEN** is descriptive and commonly used in the travel and leisure industries and evidences a number of third party usages. As pointed out earlier in this decision the state of the register is not something I can take into account.

45. The opponent's word **COMBE** is a lesser known dictionary word for a narrow valley and is often used in UK placenames. In my view it is likely that some consumers who see the whole, namely **COMBE HAVEN**, may not be able to bring a meaningful concept to mind. To other consumers, the whole mark may resemble a placename.

46. In terms of the applicant's mark, the word **Swiss** is an adjective meaning "relating to Switzerland" which I find will be readily understood by consumers. In Dr Paget's witness statement,²² the applicant states it is "promoting Swiss-quality real estate and hospitality". Whilst I accept that Switzerland has a reputation in the banking sector, I

²¹ Applicant's written submissions, Section 1.

²² Witness statement of Dr Rupert Paget, paragraph 1.2

am not aware of its particular reputation in real estate or hospitality. Nor did the applicant provide evidence to this effect. Absent any such evidence, the average consumer, in my view, is likely to regard the concept for the whole mark, **Swiss Haven**, as rather more basic where the word Swiss acts as an adjective and therefore attributes a geographical origin of the word Haven, i.e. as a haven relating to Switzerland or of Swiss origin, rather than giving the mark the qualitative concept outlined by the applicant.

47. Taking all the aforesaid into account, I find the word **HAVEN** has a shared concept and the marks are conceptually similar overall to a medium degree for the **HAVEN** and **Swiss Haven** marks and to a lower degree for the **COMBE HAVEN** and **Swiss Haven** marks.

Distinctive character of the earlier marks

48. The degree of distinctiveness of the earlier marks must be assessed. This is because the more distinctive the earlier marks, based either on inherent qualities or because of use made, the greater the likelihood of confusion. In *Lloyd Schuhfabrik Meyer*²³ the CJEU stated that:

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically

²³ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

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

49. Registered trade marks possess varying degrees of inherent distinctive character starting from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, scaling up to those with high inherent distinctive character, such as invented words.

50. The ‘056 and ‘317 registrations consist of an ordinary dictionary word **HAVEN** which is not descriptive of the services for which it is registered, although in my view it has a somewhat allusive quality in relation to the provision of holiday services, with its dictionary meaning as a place of refuge. Therefore I find that these earlier marks are inherently distinctive to a slightly lower than medium degree. The opponent’s ‘412 registration consists of two words, **COMBE HAVEN**, which is also not descriptive of its registered services but, in my view, gives it a slightly elevated degree of distinctive character as it moves further away from the somewhat allusive nature of the word **HAVEN** solus. I find the ‘412 registration to be inherently distinctive to a medium degree.

51. I next consider whether the opponent can claim enhanced distinctiveness of its earlier marks, because of the use made of them. The relevant market I must consider is the UK and I bear in mind the *Chiemsee* factors given above. The opponent’s evidence is examined at paragraphs 9-13. Although evidence of genuine use was not provided in this case, I have examined the evidence provided for the section 5(3) and 5(4)(a) grounds of opposition. I note that although just two years of turnover figures were provided, these amounted to hundreds of millions of pounds under the **HAVEN** mark. I also note that the opponent was the recipient of several national and regional tourism awards between 2018 and 2021. It has holiday parks all over mainland UK and it follows therefore that it must have a geographical spread of customers. I do not find the same level of use has been made for the **COMBE HAVEN** mark, but for the

HAVEN solus marks I find that the distinctiveness has been enhanced through use to higher than medium degree for *Hotel, motel and boarding house services; provision of tourist house and accommodation services; provision of holiday camp and camp ground services, facilities and amenities; booking and reservation services, all relating to all the aforesaid services; provision of holiday accommodation; provision of caravan, mobile home, camp and camp ground services.*

Likelihood of confusion

52. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The factors are interdependent, and include the principle that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's registrations, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alert to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

53. In *L.A. Sugar Limited*,²⁴ Iain Purvis K.C. sitting as the Appointed Person, 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

²⁴ *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10

process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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).”

54. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*,²⁵ 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

²⁵ [2021] EWCA Civ 1207

be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”

55. However it is also settled case law that it is not sufficient to find a likelihood of confusion if a mark merely calls to mind another mark.²⁶ This is considered mere association not indirect confusion.

56. So far in this decision I have found that the

- The services are identical or similar to a low degree with some being dissimilar.
- The average consumers are the general public or businesses who will pay a medium level of attention during the primarily visual purchasing process, but I also consider that aural considerations may play a part.
- There is a medium degree of visual and aural similarity between the opponent’s **HAVEN** registrations and the applicant’s mark, but a lower than medium degree of visual and aural similarity between the opponent’s **COMBE HAVEN** registration and the applicant’s mark.
- There is a medium degree of conceptual similarity between the opponent’s **HAVEN** registrations and the applicant’s mark but there is a lower than medium degree of conceptual similarity between the opponent’s **COMBE HAVEN** registration and the applicant’s mark.
- The opponent’s earlier **HAVEN** marks are inherently distinctive to a lower than medium degree, although the distinctiveness of the **HAVEN** solus marks for some class 43 services have been enhanced through use to a higher than medium degree. The opponent’s **COMBE HAVEN** registration is inherently distinctive to a medium degree.

57. Taking all of the above into account and bearing in mind the principle of imperfect recollection, it is my view that consumers will be able perceive the visual, aural and conceptual differences between the respective marks and use those differences to recall which mark was which. Consequently, I do not consider that there exists a likelihood of direct confusion between the marks at issue, even when viewed on identical or similar goods.

²⁶ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

58. Having found that there is no likelihood of direct confusion, I now consider whether there is any indirect confusion. I remind myself of the guidance given in *L.A.Sugar* that indirect confusion requires a consumer to undertake a thought process whereby they acknowledge the differences between the marks yet attribute the common element to a shared undertaking, taking one mark to be a possible brand extension or sub brand of the other mark. However, I am also alert to the guidance in *Duebros* that a finding of indirect confusion should not be made simply because the respective marks share a common element.

59. I find that the average consumer on seeing **Swiss Haven**, may note the additional first word element but given its role as an adjective qualifying the word **Haven**, would likely assume that this is a plausible brand extension from the opponent, e.g. perhaps providing accommodation in Swiss chalets. I find this to be on a par with the sort of brand extensions envisaged in paragraph 17(c) of *L.A. Sugar Limited* especially as the opponent provided some evidence that two of its parks incorporate a prefix plus the word 'Haven' into their names, i.e. Combe Haven and Presthaven. As such I find consumers are likely to be confused in to believing that the respective services come from the same or economically linked undertakings and I find there is a likelihood of indirect confusion, even where the similarity of services is low.

60. The opposition brought under section 5(2)(b) has partially succeeded in class 36 and fully succeeded in class 43.

Section 5(3)

61. I next consider the claim made under section 5(3). The opponent opposed the application under this ground based on all its earlier registrations for which it claims that the application would take advantage of and be detrimental to the reputation of opponent's registrations. In addition, the opponent claims that the application would benefit from the opponent's well established position in the industry which would lead in turn to dilution of the opponent's brand.

62. Section 5(3) of the Act states:

“5(3) A trade mark which -

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

63. Section 5(3A) of the Act states:

“Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

64. The relevant case law can be found in the following judgments of the CJEU: Case C375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oréal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora*, Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *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/services, the extent of the overlap between the relevant

consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

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

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

(g) 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*.

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

(i) 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 holder of the mark in order to create and maintain the mark's image. This covers, in particular, cases

where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

65. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its registrations and the application are similar. Secondly, the opponent must show that its registrations have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them, in the sense of the earlier registrations being brought to mind by the contested mark. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be 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.

Reputation

66. I must consider whether the opponent's registrations have met the test for reputation. In *General Motors*, Case C-375/97, the CJEU held that:

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

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

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market

share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

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

67. Having considered the factors set out above and weighing in the evidence that I assessed earlier in this decision, I find that the opponent has established the requisite reputation for the following services namely *Hotel, motel and boarding house services; provision of tourist house and accommodation services; provision of holiday camp and camp ground services, facilities and amenities; booking and reservation services, all relating to all the aforesaid services; provision of holiday accommodation; provision of caravan, mobile home, camp and camp ground services* for the **HAVEN** solus marks. This reputation is also accepted by the Applicant.²⁷ I do not find that there is sufficient evidence of reputation for the mark **COMBE HAVEN**. This mark is featured once in the opponent's evidence as the name of one of its holiday parks and there was no further evidence to suggest this mark features significantly as part of the opponent's overall brand messaging.

Link

68. Having found that the opponent has established the requisite reputation for its **HAVEN** marks, I will go on to make the assessment of whether the public will make the required mental 'link' between the marks, taking account of all relevant factors. The factors identified in *Intel* (underlined below) are:

The degree of similarity between the conflicting marks

69. For the reasons given previously I find there is a medium degree of visual, aural and conceptual similarity.

²⁷ Applicant's submissions in lieu, section 2.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

70. The applicant is seeking to register its mark for real estate services and the provision of holiday rental property. The latter is the same field for which the opponent has demonstrated a reputation providing holiday accommodation. As such the relevant consumer concerned with holiday accommodation will perceive the degree of closeness between the respective services as identified in *Intel*. In my view it is less likely that a consumer will see a closeness between the opponent's services and those services of the applicant which are related to the finance and management of property namely *Management of property; Property management; Property (Real estate -) management; Real estate property management; Property (Real estate -) investment; Real property management; Property (Real estate -) finance; Property investment services; Real estate and property management services; Property portfolio management; Financing of property development; Financial services relating to real estate property and buildings; Commercial property investment services; Administration of property portfolios; Property management services; Real estate services related to management of property investments; Securing of funds for the purchase of property; Provision of finance for property development; Provision of permanent housing accommodation; Letting and rental of permanent accommodation; Rental of offices; Real estate investment; Real estate affairs; Real estate financing; Real estate consultancy; Real estate management; Management of real estate; Real estate services; Real estate administration; Real estate consultation; Real estate consultations; Real estate investment advice; Real estate investment planning; Investment in real estate (Services for -); Real estate investment services; Real estate equity sharing; Real estate investment management; Real estate agents services; Capital investment in real estate; Real estate acquisition services; Residential real estate agency services; Real estate management services; Management services for real estate investment; Financial services related to real estate; Real estate management services relating to housing estates; Providing real estate information relating to property and land; Provision of information relating to the property market [real estate]; Estate management services relating to transactions in real property; Investment advisory services relating to real estate; Real estate management services*

relating to commercial buildings; Real estate management services relating to residential buildings; Arranging the provision of finance for real estate purchase

The strength of the earlier mark's reputation

71. I found that the opponent's evidence has demonstrated a reasonably strong reputation for *Hotel, motel and boarding house services; provision of tourist house and accommodation services; provision of holiday camp and camp ground services, facilities and amenities; booking and reservation services, all relating to all the aforesaid services; provision of holiday accommodation; provision of caravan, mobile home, camp and camp ground services* in the UK at the relevant date.

The degree of the earlier marks' distinctive character, whether inherent or acquired through use

72. I found that the earlier HAVEN marks are inherently distinctive to a lower than medium degree but that this has been enhanced through use to a higher than medium degree in respect of *Hotel, motel and boarding house services; provision of tourist house and accommodation services; provision of holiday camp and camp ground services, facilities and amenities; booking and reservation services, all relating to all the aforesaid services; provision of holiday accommodation; provision of caravan, mobile home, camp and camp ground services.*

Whether there is a likelihood of confusion

73. Previously in this decision, I found a likelihood of indirect confusion.

74. Taking the above factors into account, I find that the required link will be made.

Damage

75. I next assess whether unfair advantage will arise, as claimed by the opponent.

76. I bear in mind that unfair advantage has no effect on the consumers of the services of the earlier marks, but instead the taking of unfair advantage of the reputation and distinctive character of earlier marks means that consumers are more likely to

purchase the services of the later mark than they would otherwise have done if they had not been reminded of the earlier marks.

77. In *Jack Wills Limited v House of Fraser (Stores) Limited*²⁸, Arnold J. (as he then was) considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

78. As set out above, I found sufficient evidence that the opponent enjoys a reputation for *Hotel, motel and boarding house services; provision of tourist house and accommodation services; provision of holiday camp and camp ground services, facilities and amenities; booking and reservation services, all relating to all the aforesaid services; provision of holiday accommodation; provision of caravan, mobile home, camp and camp ground services*. Given that reputation and the identity and similarity of the contested services, it is clear that there is the potential for the applicant to gain an unfair commercial advantage, namely benefitting from the opponent's reputation without paying financial compensation.

²⁸ [2014] EWHC 110 (Ch)

79. As damage is made out on the basis of unfair advantage, it is not necessary for me to go on and consider the other heads of damage.

80. The opposition is therefore partially successful under section 5(3).

Section 5(4)(a)

81. I remind myself that under this ground the opponent relies on the sign **HAVEN**, for which it claims use since 1985 for the following services, namely *Temporary accommodation services; retail services connected with the sale of mobile homes and caravans; agency services for the sale and purchase of mobile homes and caravans; information, advisory and consultancy services relating to all the aforesaid services; letting services connected with caravans and mobile homes; financial and insurance services relating to holidays; caravan insurance services; real estate services; sale, listing, leasing, financing, managing, acquisition, brokerage and rental of property; information, advisory and consultancy services relating to all the aforesaid services.*

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

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

83. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of

application for registration of the trade mark or date of the priority claimed for that application.”

84. Section 5A of the Act is as follows:

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

85. In *Reckitt & Colman Products Limited v Borden Inc. & Ors*,²⁹ Lord Oliver of Aylmerton described the ‘classical trinity’ that must be proved in order to reach a finding of passing off:

“First, [the plaintiff] must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source of the defendant’s goods or services is the same as the source of those offered by the plaintiff.”

86. Halsbury’s Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

²⁹ [1990] RPC 341, HL, page 406.

“Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action”.

Relevant date

87. In terms of the relevant date for assessment of section 5(4)(a), in *Advanced Perimeter Systems Limited v Multisys Computers Limited*,³⁰ Mr Daniel Alexander QC (as he was then), sitting as the Appointed Person, quoted with approval the summary made by Mr Allan James, acting for the Registrar, in SWORDERS Trade Mark:³¹

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’”

88. The filing date of the application is 26 October 2023. As such, all factors will be considered as at this date.

Goodwill

89. The first hurdle for the opponents is to show that they had the required goodwill at the relevant date. The issue of what constitutes goodwill was discussed in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd*³² viz,

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

³⁰ BL O-410-11

³¹ BL O-212-06

³² [1901] AC 217 (HOL)

90. In *Smart Planet Technologies, Inc. v Rajinda Sharm*³³, Mr Thomas Mitcheson QC (as he was then), sitting as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

“.. a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon.”

91. Goodwill arises as a result of trading activities and accrues to the business that the public thinks is responsible for the services. The relevant market for assessing goodwill is the UK. I reviewed the opponent’s evidence at paragraphs 9-13 and I found that at the relevant date the opponent had evidence to support the following services, namely *Temporary accommodation services; retail services connected with the sale of mobile homes and caravans; information, advisory and consultancy services relating to all the aforesaid services; letting services connected with caravans and mobile homes* and has therefore established goodwill in these services. However there was no evidence supporting the remainder of the services namely *agency services for the sale and purchase of mobile homes and caravans; financial and insurance services relating to holidays; caravan insurance services; real estate services; sale, listing, leasing, financing, managing, acquisition, brokerage and rental of property; information, advisory and consultancy services relating to all the aforesaid services*. I am guided in reaching this conclusion by Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*,³⁴. Although the comments relate to genuine use, in my view, it is also analogous to the situation in this case. In *Dosenbach*, Mr Hobbs stated that:

³³ BL O/304/20

³⁴ Case BL O/404/13

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘*show*’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

92. It is plausible that the opponent could provide insurance services for caravans or holidays for example, but it has not been shown in evidence. The same applies to the real estate and finance related services. It is not sufficient for the opponent to state

that it has “built up a reputation for consistently developing its own real estate portfolio, which has subsequently led to it building a significant reputation and goodwill in the real estate industry”.³⁵ Firstly I would say that developing one’s own real estate properties does not show use of real estate services at large, i.e. as a service provided to others. Secondly where use has not been shown in evidence then I cannot find goodwill for these specific services.

Misrepresentation

93. Having cleared the first hurdle of goodwill for some services, I now go on to consider the second hurdle of misrepresentation. In *Neutrogena Corporation and Another v Golden Limited and Another*³⁶, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants’ [product] in the belief that it is the respondents’[product]”

The same proposition is stated in *Halsbury’s Laws of England 4th Edition Vol.48 para 148* . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd. (1941) 58 R.P.C. 147 at page 175* ; and *Re Smith Hayden’s Application (1945) 63 R.P.C. 97 at page 101.*”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court’s reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions

³⁵ Opponent’s written submission, paragraph 47.

³⁶ [1996] RPC 473.

are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

94. On the subject of how many of the relevant public must be deceived or confused for the opponent to be successful in a claim under this ground, I bear in mind the decision in *Lumos Skincare Limited v Sweet Squared Limited and others*³⁷, where Lord Justice Lloyd commented on the paragraph above as follows:

“64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the “substantial number” of people who have been or would be misled by the Defendant's use of the mark, if the Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small.”

95. Accordingly, once it has been established that the party relying on the existence of an earlier right under section 5(4)(a) had sufficient goodwill at the relevant date to found a passing-off claim, the likelihood that only a relatively small number of persons would be likely to be deceived does not mean that the case must fail. There will be a misrepresentation if a substantial number of customers, or potential customers, of the claimant's actual business would be likely to be deceived.

96. The contested mark is **Swiss Haven** which I have previously found to be visually, aurally and conceptually similar to a medium degree to the opponent's **HAVEN** marks. I have also found that the opponent has established goodwill in the sign **HAVEN** for the services listed above. I find that some of the applicant's class 36 services and the entirety of their class 43 services will be in competition with these listed services.

³⁷ [2013] EWCA Civ 590

97. I recognise that the test for misrepresentation is different to that for likelihood of confusion, namely, that misrepresentation requires “a substantial number of members of the public are deceived” rather than whether the “average consumers are confused”. However, as recognised by Lewison L.J. in *Marks and Spencer PLC v Interflora*³⁸, it is doubtful whether the difference between the legal tests will produce different outcomes. I find that misrepresentation will occur in respect of the contested services as they are in competition with those services of the opponent that I have identified as *Temporary accommodation services; retail services connected with the sale of mobile homes and caravans; information, advisory and consultancy services relating to all the aforesaid services; letting services connected with caravans and mobile homes.*

Damage

98. Having found that the goodwill and misrepresentation limbs of the test have been satisfied, damage to the opponent’s goodwill can be inferred, the most obvious example being the diversion of trade from the opponent to the applicant.

99. In conclusion I find the opposition partially succeeds under section 5(4)(a).

OVERALL CONCLUSION

100. The opposition has been partially successful. Subject to any appeal of this decision, the application can proceed to registration for the following services in class 36 only, namely *Management of property; Property management; Property (Real estate -) management; Real estate property management; Property (Real estate -) investment; Real property management; Property (Real estate -) finance; Property investment services; Real estate and property management services; Property portfolio management; Financing of property development; Financial services relating to real estate property and buildings; Commercial property investment services; Administration of property portfolios; Property management services; Real estate services related to management of property investments; Securing of funds for the purchase of property; Provision of finance for property development; Provision of permanent housing accommodation; Letting and rental of permanent accommodation; Rental of offices; Real estate investment; Real estate affairs; Real estate financing; Real estate consultancy; Real estate management; Management of real estate; Real*

³⁸ [2012] EWCA (Civ) 1501

estate services; Real estate administration; Real estate consultation; Real estate consultations; Real estate investment advice; Real estate investment planning; Investment in real estate (Services for -); Real estate investment services; Real estate equity sharing; Real estate investment management; Real estate agents services; Capital investment in real estate; Real estate acquisition services; Residential real estate agency services; Real estate management services; Management services for real estate investment; Financial services related to real estate; Real estate management services relating to housing estates; Providing real estate information relating to property and land; Provision of information relating to the property market [real estate]; Estate management services relating to transactions in real property; Investment advisory services relating to real estate; Real estate management services relating to commercial buildings; Real estate management services relating to residential buildings; Arranging the provision of finance for real estate purchase.

101. The application will be refused registration for the following services in class 36, namely *Rental of property; Leasing of property; Leasing of freehold property; Rental of real estate and property; Leasing of real estate property; Real property letting; Accommodation (rental of -) [apartments]; Apartment rental services; Housing accommodation (Provision of permanent -); Rental of apartments; Rental of apartments; Rental of flats, studios and rooms; Leasing of real estate; Real estate (Leasing of -); Real estate leasing; Rental of real estate; Lease of real estate; Property leasing [real estate property only]; Arranging letting of real estate* and for all services in Class 43.

COSTS

102. The opponent has been partially successful in its opposition. As such it is entitled to a contribution towards the costs incurred. Awards of costs for proceedings commenced after 1 February 2023 are governed by Annex A of Tribunal Practice Notice (TPN) 1/2023. Bearing in mind the guidance given in TPN 1/2023 and factoring in the partial nature of the opponent's success, I award costs as follows:

£200 Official fee

£400 Preparing Notice of Opposition and considering the Counterstatement

£700 Preparing evidence and commenting on other side's evidence

£400 Preparing submission in lieu

£1700 Total

103. I order Swiss Haven Limited to pay Haven Leisure Limited the sum of £1700. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 18th day of August 2025

June Ralph

For the Registrar

The Comptroller-General

Annex 1

Applicant's published services:

36: Rental of property; Leasing of property; Leasing of freehold property; Rental of real estate and property; Management of property; Property management; Leasing of real estate property; Property (Real estate -) management; Real estate property management; Property (Real estate -) investment; Real property management; Property (Real estate -) finance; Property investment services; Real estate and property management services; Property portfolio management; Financing of property development; Financial services relating to real estate property and buildings; Commercial property investment services; Administration of property portfolios; Property management services; Real estate services related to management of property investments; Real property letting; Securing of funds for the purchase of property; Provision of finance for property development; Accommodation (rental of -) [apartments]; Apartment rental services; Housing accommodation (Provision of permanent -); Provision of permanent housing accommodation; Letting and rental of permanent accommodation; Rental of apartments; Rental of apartments and offices; Rental of flats, studios and rooms; Real estate investment; Leasing of real estate; Real estate (Leasing of -); Real estate leasing; Rental of real estate; Real estate affairs; Lease of real estate; Real estate financing; Real estate consultancy; Real estate management; Management of real estate; Real estate services; Real estate administration; Real estate consultation; Real estate consultations; Real estate investment advice; Real estate investment planning; Investment in real estate (Services for -); Real estate investment services; Real estate equity sharing; Real estate investment management; Real estate agents services; Capital investment in real estate; Property leasing [real estate property only]; Real estate acquisition services; Residential real estate agency services; Real estate management services; Arranging letting of real estate; Management services for real estate investment; Financial services related to real estate; Real estate management services relating to housing estates; Providing real estate information relating to property and land; Provision of information relating to the property market [real estate]; Estate management services relating to transactions in real property; Investment advisory services relating to real estate; Real estate management services relating to commercial buildings; Real estate management services relating to residential buildings; Arranging the provision of finance for real estate purchase.

43: Letting of holiday accommodation; Holiday lodgings; Arranging of accommodation for holiday makers; Rental of holiday homes; Rental of holiday accommodation; Arranging of holiday accommodation; Arranging holiday accommodation; Holiday accommodation services; Providing temporary accommodation in holiday homes; Provision of holiday accommodation; Reservation of temporary accommodation in the nature of holiday homes; Providing temporary accommodation in holiday flats; Booking services for holiday accommodation; Services for reserving holiday accommodation; Rental of temporary accommodation in holiday homes and flats; Booking agency services for holiday accommodation; Rental of vacation accommodation; Hotels, hostels and boarding houses, holiday and tourist accommodation; Accommodation services; Accommodation (Rental of temporary -); Rental of temporary accommodation; Rental of accommodation [temporary]; Provision of temporary furnished accommodation; Reservation services for accommodation; Temporary accommodation services; Hospitality services [accommodation]; Booking of temporary accommodation; Booking of accommodation for travellers; Temporary accommodation reservation services; Temporary accommodation; Reservation services for the booking of accommodation; Rental of rooms as temporary living accommodations; Reservation of tourist accommodation; Providing temporary accommodation; Reservation of temporary accommodation; Accommodation reservations; Agency services for the reservation of temporary accommodation; Arranging of accommodation for tourists; Rental of rooms; Providing temporary accommodation as part of hospitality packages; Arranging of temporary accommodation; Provision of temporary accommodation; Temporary accommodation reservations; Reservations (Temporary accommodation -); Accommodation reservations (Temporary -); Booking of temporary accommodation via the Internet; Providing guesthouse services; Arranging and providing temporary accommodation; Providing temporary housing accommodations; Temporary accommodation information, advice and reservation services; Provision of temporary work accommodation; Reception services for temporary accommodation (conferment of keys); Reception services for temporary accommodation [management of arrivals and departures]; Resort lodging services; Arranging temporary housing accommodations.

Annex 2

Services relied on under opponent's earlier registration no.2172056:

41: Provision of entertainer, amusement, leisure and recreation facilities, services and amenities; nightclub, discotheque, music hall, concert, dance hall, ballroom, cabaret, cinema and theatre services; amusement park, arcade and amusement centre services; leisure centre, boating lake and water-chute complex services; funfair, circus and bingo hall services; provision of public baths, aquatic recreation, swimming, windsurfing, water skiing and outdoor recreation facilities, services and amenities; health and fitness club services; tenpin bowling alley and bowling green services; sports instruction services; organisation of recreational activities, quizzes, games and competitions; production of shows and of cabarets; organisation of beauty competitions; consultancy services relating to the planning of conferences and seminars; bingo club services; gaming, gambling and casino services; snooker and pool club services; theme park services; instruction and tuition in association with all of the aforesaid services; all provided in association with accommodation or on caravan sites or leisure parks or as part of a package holiday.

43: Hotel, motel and boarding house services; provision of tourist house and accommodation services; café, cafeteria, canteen, bar, coffee shop, snack-bar and restaurant services; catering services; provision of holiday camp and camp ground services, facilities and amenities; provision of exhibition facilities and amenities; provision of facilities and amenities, all for conferences, seminars and banquets; consultancy services relating to the planning of banquets; booking and reservation services, all relating to all the aforesaid services; provision of holiday accommodation; provision of caravan, mobile home, camp and camp ground services; provision of nurseries and creches; all provided in association with accommodation or on caravan sites or leisure parks or as part of a package holiday.

44: Provision of sauna and solarium services, facilities and amenities; booking and reservation services, all relating to all the aforesaid services.

Annex 3

Services relied on under opponent's earlier registration no.1283317:

43: Provision of facilities for holiday camps, camp grounds or exhibitions; hotel services; booking and reservation services, all for accommodation; tour and tourist services, all for arranging accommodation; but not including any such services for the provision of food or drink.

44: Beauty salon, sauna and solarium services.

Annex 4

Services relied on under opponent's earlier registration no.2395412:

35: Advertising; the bringing together for the benefit of others, of a variety of goods, being mobile homes and caravans and accessories therefor, enabling customers to conveniently view and purchase those goods, agency services for the sale and purchase of mobile homes and caravans.

41: Provision of entertainer, amusement, leisure and recreation facilities, services and amenities; night-club, discotheque, music hall, concert, dance hall, ballroom, cabaret, cinema and theatre services; amusement park, arcade and centre services; gaming, gambling and casino services; snooker and pool club services; theme park services; leisure centre, boating lake and water-shute complex services; funfair, circus and bingo hall services; provision of public baths, aquatic recreation, swimming, windsurfing, water skiing and outdoor recreation facilities, services and amenities; tennis courts; health and fitness club services; provision of gymnastic facilities; tenpin bowling and bowling green services; sports instruction services; organisation of recreational activities, quizzes, games and competitions; production of shows and of cabarets; organisation of beauty competitions; instruction and tuition in association with all of the aforesaid; educational services; provision of education and entertainment services for club members; publication of books, booklets, magazines, journals, manuals, brochures, leaflets or pamphlets in printed or electronic form; information services relating to all of the aforesaid.

43: Hotel, motel and boarding house services; provision of tourist house and accommodation services, cafe, cafeteria, canteen, bar, coffee shop, snack-bar and restaurant services; catering services; provision of holiday camp and camp ground services, facilities and amenities; operation of nurseries and creches; provision of exhibition facilities and amenities; provision of facilities and amenities, all for conferences, seminars and banquets; provision of holiday accommodation; provision of caravan, mobile home, camp and camp-ground services; rental of standing places for mobile homes and caravans; organisational services for caravan sites including reservation, booking and reception services for caravans for holiday purposes; information services relating to all of the aforesaid.

