

O/0863/24

TRADE MARKS ACT 1994

**IN THE MATTER OF THE UK DESIGNATION OF INTERNATIONAL
REGISTRATION NO. 1672376
IN THE NAME OF AIC HOTEL GROUP**

FOR THE TRADE MARK

DOMA RESIDENCES

IN CLASSES 36 AND 43

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 438530
BY MARK CAPITAL MANAGEMENT LIMITED**

BACKGROUND AND PLEADINGS

1. On 15 March 2022, International Registration (“IR”) No. 1672376 was registered for the word mark shown on the cover page of this decision, based on US Trade Mark No. 90862271. With effect from the same date, AIC HOTEL GROUP (“the holder”) designated the United Kingdom for protection of the mark. The designation was accepted and published for opposition purposes on 7 October 2022, in respect of services in classes 36 and 43.

2. The designation is opposed by MARK Capital Management Limited (“the opponent”). The opposition was filed on 9 January 2023 and is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the services in class 36 only of the designation.¹ The opponent relies upon the following two marks:

doma

UK trade mark registration number 3609407

Filing date: 12 March 2021

Registration date: 8 October 2021

Registered in Classes 9, 35, 36 and 38

Relying on all goods and services, as listed in the table under paragraph 13 of this decision.

(Mark 1); and

doma life

UK trade mark registration number 3609335

Filing date: 12 March 2021

¹ The opposition was originally filed against all of the services in classes 36 and 43 of the designation. However, subsequent to the filing of the counterstatement, a preliminary indication (PI) was issued to the parties under the provision of Rule 19 of The Trade Marks Rules 2008. That indication was that the opposition was likely to succeed only in relation to the class 36 services. The holder filed form TM53 requesting that the opposition proceed to evidence rounds. The opponent did not challenge the PI but instead filed an amended form TM7 on 1 September 2023, removing class 43 as a basis for the opposition. As a result, the opposition proceeds against class 36 of the designation only. To clarify, the PI, given by a different Hearing Officer, is not binding upon me and will have no bearing upon my decision, which I make based on consideration of the facts before me.

Registration date: 8 October 2021

Registered in Classes 9, 35, 36 and 38

Relying on all goods and services, as listed in the table under paragraph 13 of this decision.

(Mark 2).

3. The opponent's marks qualify as earlier marks under section 6(1) of the Act. As neither mark had completed its registration procedure more than five years before the date of designation for the contested mark, they are not subject to the use provisions contained in section 6A of the Act.

4. The opponent submits that as a result of the identical and/or similar nature of the services and the similarity of the marks, there exists a likelihood of confusion on the part of the public, including a likelihood of association. It requests that the designation be refused in relation to the services in class 36 and that an award of costs be made in favour of the opponent.

5. The holder filed a counterstatement denying the claims and requests that the opposition be refused and the application (designation) be allowed to proceed. It submits that the holder ought to be entitled to costs occasioned by these proceedings.

6. Neither party elected to file evidence and neither party requested a hearing. Only the holder filed written submissions in lieu of a hearing which will be referred to as and where appropriate during this decision. This decision is taken following careful consideration of the papers.

7. In these proceedings, the opponent is represented by Stobbs and the holder is represented by BPE Solicitors LLP.

DECISION

8. 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.

Section 5(2)(b)

9. Section 5(2)(b) is relied on and reads as follows:

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

(a) ...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

10. Section 5A states:

“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.”

11. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (“OHIM”)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

Comparison of goods and services

12. Pursuant to section 60A of the Act, goods and services are not to be automatically regarded as being similar to each other on the ground that they appear in the same class, nor automatically regarded as dissimilar from each other on the ground that they appear in different classes.

13. The goods and services to be compared are:

Holder's services
<u>Class 36</u> <i>Real estate management of vacation homes; real estate management of vacation clubs; real estate services; vacation home rental management services.</i>
Opponent's goods and services
<u>Class 9</u> <i>Computer software relating to real estate and the sale and rental of properties; mobile apps for searching, retrieving, viewing, organising, reviewing, valuing, booking, selling and buying in the field of real estate, the sale and rental of properties, and economics and data analysis; downloadable applications for searching, retrieving, viewing, organising, reviewing, valuing, booking, selling and buying in the field of real estate, the sale and rental of properties, and economics and data analysis; business application software for searching, retrieving, viewing, organising, reviewing, valuing, booking, selling and buying</i>

in the field of real estate, the sale and rental of properties, and economics and data analysis; consumer data storage software in the field of real estate, apartment and residential rentals, apartment and residential sales, economics and data analysis, and consumer goods and consumer services; computer software programs for searching, retrieving, viewing, organising, reviewing, valuing, booking, selling and buying in the field of real estate, the sale and rental of properties, and economics and data analysis; downloadable software for searching, retrieving, viewing, organising, reviewing, valuing, booking, selling and buying in the field of real estate, the sale and rental of properties, and economics and data analysis; computer software for searching, retrieving, viewing, organising, reviewing, valuing, booking, selling and buying relating to real estate and the sale and rental of properties; recorded and downloadable media in the field of property and real estate: computer software in the field of property; blank digital or analogue recording and storage media in the field of property; computer memory devices in the field of property; computer programs in the field of property; downloadable computer programs in the field of property; downloadable computer software applications in the field of property; recorded or downloadable computer software platforms in the field of property; downloadable electronic publications in the field of property; downloadable mobile applications in the field of property; mobile application software in the field of property; mobile apps in the field of property; software applications for mobile devices in the field of property; computer software in the field of real estate; downloadable computer programs in the field of real estate; downloadable computer software applications in the field of real estate; downloadable electronic publications in the field of real estate; downloadable mobile applications in the field of real estate; mobile application software in the field of real estate; mobile apps in the field of real estate; software applications for mobile devices in the field of real estate; podcasts; downloadable podcasts; media content; downloadable media; parts and fittings for all the aforesaid goods.

Class 35

Advertising of commercial or residential real estate; advertising services relating to real property; real estate marketing; business project management; management of business projects [for others]; auctioneering of property; office functions services; administrative services relating to referrals for general building contractors; business acquisitions; business assistance relating to the formation of commercial undertakings; business management services relating to the development of businesses; business operation of shopping centers for others; outsourcing services in the field of customer relationship management; preparation of project studies relating to business matters; auctioning of

property; business project management services for construction projects; retail services in relation to construction equipment; business management of apartments; advertising services relating to investable assets; arranging and conducting of real estate auctions; **advice relating to the business operation of fitness clubs; advice relating to the business operation of health clubs;** real estate marketing analysis services; not including the advertising or marketing of goods or services of others through the custom preparation of apparel, promotional items or incentive merchandise; information, advisory and consultancy services relating to the aforesaid.

Class 36

Financial, monetary and banking services; insurance services; real estate affairs; financial services relating to real property and buildings; financial services relating to the acquisition of property; financial services relating to the sale of property; financial evaluation of real property; financing of property development; real estate services; rental of properties; arranging leases for the rental of property; agency services for the leasing of real property; management of property; property investment; property management; leasing of commercial property; property asset management services; property portfolio management; rental of commercial property; consultancy relating to the financial valuation of intellectual property assets; arranging finance for construction projects; financing of development projects; funding of product development; financing of real estate development; rental of apartments in an apartment community; apartment house management; real estate listing services for housing rentals and apartment rentals; asset management; asset management for third parties; asset management services; brokerage of equities; brokerage of financial investments; capital investment; capital investment in real estate; financial evaluation [real estate]; financial management and investment services relating to securities and equities; financial structuring services relating to joint ventures; financial, investment and real estate asset management; financing of real estate development projects; investment advice; investment analysis; investment banking; investment brokerage; investment consultancy; investment management; investment management services in the field of acquiring joint ventures; investment of funds; investment portfolio management services; investment services; investment services relating to equities; management of private equity funds; portfolio management and investment services; private equity financing; private equity fund investment services; private equity investment management; project financing; providing funding for joint ventures; providing funding for the development of new technology; providing real estate information; providing real estate listings and real estate information

*via the Internet; public equity financing; public equity investment management; raising of capital for joint ventures; real estate acquisition services; real estate appraisal; real estate brokerage; real estate consultation; real estate evaluations; real estate financing services; real estate insurance brokerage; real estate insurance consultancy; real estate insurance information; real estate investment; real estate investment management; real estate investment services; real estate management; real estate procurement for others; venture capital advisory services; administration of property portfolios; acquisition of land to be let; advisory services relating to real estate valuations; apartment and office rentals; arranging letting of real estate; brokerage of real estate; building leasing; computerised information services relating to real estate; property management services; property (real estate -) investment; provision of information relating to the property market [real estate]; management services relating to real estate; real estate and property management services; electronic transfer of money; computerised information services relating to real estate; valuation, appraisal, brokerage, listing, management, letting and leasing of real estate; real estate services; property management services of condominiums, apartment buildings, commercial property, residential property and rental property; estate agencies; real estate agencies; estate property management agencies; mortgage compliance consulting services concerning financial requirements for mortgages, mortgage financial planning services and mortgage refinancing; financial administration services; administration of financial affairs relating to real estate; providing an interactive web portal featuring news, information and user generated content in the nature of information via online communications in the field of real estate; accommodation bureau services [apartments]; rental of apartments; financial evaluation [insurance, banking, real estate]; financial management; real estate agency services; rental of real estate; rent collection; business management and operation of retirement communities for others; business management and operation of residential communities for others; operation of a business for others, namely, fitness and health clubs; **advice relating to the business operation of fitness clubs; advice relating to the business operation of health clubs**; tenant management services; letting of apartments; information, advisory and consultancy services relating to the aforesaid.*

Class 38

Telecommunications services; telecommunications; telecommunication services; advisory services relating to telecommunications; telecommunication services for providing access to computer databases; interactive telecommunicating services; internet based telecommunication services; interactive web portals; operation of chat rooms; provision of

chat room services; electronic mail services; receiving and exchanging of information, text, sounds, images, data and messages; message sending; interactive web pages/services; providing an online, interactive bulletin board for the transmission of messages among computer users concerning real estate and the sale and rental of properties via a global communications network; information and advisory services relating to the aforesaid; information and advisory services relating to the aforesaid; information and advisory services relating to the aforesaid services provided on-line from a computer database or the internet; audio conferencing services; communication services; electronic mail; video conference services; television and radio broadcasting; provision of access to an electronic marketplace [portal] on computer networks; telecommunication services provided via platforms and portals on the internet and other media; providing access to platforms and portals on the internet; communication services between real estate agents, vendors of real estate, purchasers of real estate, lessors of real estate, lessees of real estate, lenders, mortgage brokers, borrowers, conveyancers, lawyers and other parties; communication services for the purpose of e-commerce; e-mail and messaging services via a global computer network; the provision of access to real estate information and analysis over a global computer network or the internet; provision of on-line portals and forums in relation to the sale of houses and real estate property; information, advisory and consultancy services relating to the aforesaid.

14. The goods and services relied upon by the opponent are essentially identical for both its earlier marks, with the exception that the services shown in bold in the above table in class 35 are only relied upon under Mark 2, while the services in bold under class 36 are only relied upon under Mark 1.

15. Where goods or services in the specification of one party are included in a broader term from the other party's specification, those goods or services are considered to be identical: See *Gérard Meric v OHIM*, Case T-133/05 at [29].

16. For the purposes of considering the issue of similarity of the goods and/or services, it is permissible to consider groups of terms collectively where appropriate: *Separode Trade Mark*, BL O-399-10.²

² Paragraph 5

17. Specifications for services should not be interpreted widely but confined to the core of the possible meanings attributable to the terms: *Sky Plc & Ors v Skykick UK Ltd & Anor* [2020] EWHC 990 (Ch), at [56].

18. In considering the similarity or not of the parties' goods and services, I take into account the holder's written submissions that except for the broad term "*real estate services*", the remainder of its services are limited to vacation homes and clubs, which it submits have no similarity with the opponent's goods and services.³

19. The holder's "*real estate services*" are self-evidently identical to the opponent's "*real estate services*" as relied upon under class 36 of both earlier marks.

20. While bearing in mind the guidance in *Skykick* not to give an overly wide construction to the services, I consider the holder's "*Real estate management of vacation homes; real estate management of vacation clubs*" to be encompassed by the opponent's broad term "*real estate management*", common to class 36 of both its earlier marks, and therefore the services are identical as per the principles outlined in *Meric*.

21. I further consider that the holder's "*vacation home rental management services*" to be encompassed by the opponent's broad terms "*property management services*", "*real estate management*" and "*arranging letting of real estate*" in class 36 (under Mark 1 and Mark 2) and as such I find the services to be identical as per *Meric*.

The average consumer and the nature of the purchasing act

22. The average consumer is a legal construct, deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. 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: *Lloyd Schuhfabrik Meyer*, Case C-342/97, at [26].

³ Paragraph 24 of the holder's written submissions in lieu, dated 20 February 2024.

23. The holder submits that the average consumer of the opponent's goods and services are investors acquiring and/or managing dwellings and small apartment complexes, while the holder's services are targeted at travellers in the tourism market.

24. In my view, given the broad nature of the "real estate services" common to both parties, the average consumer will be both the general public and business consumers concerned with the buying, selling, letting or developing of both residential and commercial properties. The services may be selected through physical premises such as 'high street' estate agents or through specialist or niche property providers, both including via online platforms. The selection will be predominantly visual, with the services being advertised on billboards, in newspapers, and on websites, although they may also be promoted orally, for example, on local radio. Given the importance and possible financial implications of choosing the right undertaking to administer the client's interests, I consider that both types of consumers would pay a high degree of attention during the selection of the services, with the consumer selecting the services based on, inter alia, the reputation of the provider, the scale of the included services and the overall cost.

25. For the overlapping services relating specifically to the management of vacation homes, clubs and rentals, while the end user will be travellers, I consider the average consumer of such management services will be property owners (be that individuals or businesses) soliciting professional services to oversee the administration of the running of vacation clubs and the rental of holiday homes to third parties. The services will be selected by predominantly visual means, after viewing promotional material either online or in print, although aural considerations such as word of mouth recommendations and the likes of tv or radio advertising will also play a part. As the consumer will be entrusting the management of their property to the service provider, I would expect the degree of attention to the selection of the services to be high on the part of all consumers.

Comparison of marks

26. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated in *Bimbo SA v OHIM* Case C-591/12P, that:

“34.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.”

27. 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.

28. The respective trade marks are shown below:

Opponent's trade marks	Holder's trade mark
<u>Mark 1</u> doma	DOMA RESIDENCES
<u>Mark 2</u> doma life	

Overall impression

29. The opponent's Mark 1 consists of the single word "doma" presented in a bold black cursive script. Although I do not consider the stylisation would go unnoticed, it does not contribute greatly to the overall impression of the mark, and as such it is the word itself which dominates.

30. The opponent's Mark 2 consists of two words "doma life" presented in a standard black typeface in lower case. To some consumers, each of the words will play an independent distinctive role within the mark, with neither word dominating. To other consumers, the word "life" will be allusive of a lifestyle that the services provide, and to those consumers, the word "doma" will make the greatest contribution to the overall impression.

31. The holder's mark consists of two words "DOMA RESIDENCES" presented in a standard black typeface in capital letters. As the word "RESIDENCES" is non-distinctive in relation to the class 36 real estate services, I consider that the dominant word "DOMA" will make the greatest contribution to the overall impression, although the word "RESIDENCES" will not be entirely overlooked.

Visual comparison

32. The holder's mark and the opponent's Mark 1 share visual similarity by way of the word "doma", which makes up the entirety of the earlier mark and is wholly incorporated in the holder's mark. As mentioned previously, while the presentation of the opponent's mark is unlikely to go completely unnoticed, it does not make a huge visual impact on the mark as a whole. The word in common is situated at the start of the holder's mark, and in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the General Court ("GC") noted that the beginning of words tend to have more visual and aural impact than the ends, although I accept that this is not always the case. However, the word "DOMA" in the holder's mark is followed by the word "RESIDENCES", an element which I do not consider will be entirely overlooked by the average consumer, and which reduces the visual similarities between the contested

marks. Considering the marks as a whole, I find there to be a medium degree of visual similarity between them.

33. The opponent's Mark 2 and the holder's mark coincide by way of the identical first word "doma/DOMA". I do not consider the difference in capitalisation/lower case to be relevant to the visual impact, as the registration of a word mark gives protection irrespective of capitalisation: see *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17. The respective subsequent words "life" in the opponent's mark and "RESIDENCES" in the holder's mark create a visual disparity between the marks. Overall, I consider the marks to be visually similar to a medium degree.

Aural comparison

34. The holder submits that the "DOMA" element common to each of the marks will be articulated in various ways. To my mind, the most likely pronunciation will be as two syllables DOH-MAH. Regardless of any regional variations to the pronunciation, the way it is articulated will be identical in each of the competing marks. The opponent's Mark 1 will therefore be voiced in its entirety as DOH-MAH, while the holder's mark will be pronounced in its entirety as six syllables, DOH-MAH-RES-ID-ENSE-IS. Given that the commonality between the marks is at the beginning, I consider them to be aurally similar to a medium degree.

35. The opponent's Mark 2 will be articulated in its entirety as three syllables, DOH-MAH-LIFE, and again the competing marks have the first two syllables in common, which leads me to consider the marks to be aurally similar to a medium degree.

Conceptual comparison

36. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer – Case C-361/04 P *Ruiz-Picasso and others v OHIM* [2006]⁴.

⁴ Paragraph 56.

37. The holder submits that the word “DOMA” means *house, home, dwelling*, although it has provided no evidence to that effect. Without any such evidence, I cannot assume that the meanings attributed to the word by the holder will be commonly understood by the average consumer of the services.⁵ To my knowledge, “DOMA” is not a defined term in regular UK based English dictionaries. In my view, a significant proportion of the average consumer will perceive it to be an invented word with no clear and recognisable semantic content.

38. I consider that the dictionary-defined word “RESIDENCES” in the holder’s mark will be readily understood and as such, the average consumer will assume that the word relates directly to the type of services being provided, i.e. services relating to either permanent or temporary homes or ‘residences’. When viewed solus, the word “life” in the opponent’s Mark 2 will be attributed its natural meaning, while in conjunction with the word “doma” in relation to the opponent’s goods and services, it may be seen as alluding to a particular (unspecified) lifestyle.

39. While the additional words “life” in the opponent’s Mark 2 and “RESIDENCES” in the holder’s mark give rise to a point of conceptual difference between the marks, I consider that to a significant proportion of consumers, the common element “DOMA” in each of the competing marks will not convey any immediate conceptual message and therefore I find the shared distinctive element to be conceptually neutral.

Distinctive character of the earlier marks

40. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. The factors 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*, Case C-342/97:

⁵ See *Chorkee Ltd v Cherokee Inc.*, Case BL O/048/08, at [36-38].

“23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

41. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and services, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. Although the opponent has claimed that its marks benefit from an enhanced distinctiveness as a result of the longstanding and continuous use made of the marks in the UK,⁶ it has not filed any evidence of such use. Therefore, I only have the inherent characteristics of the mark to consider.

42. Earlier in this decision, I considered that to a significant proportion of consumers, the word “DOMA” would be seen as an invented word with no recognisable semantic content. Therefore, to those consumers, the opponent’s Mark 1 is high in inherent distinctive character.

43. With regard to Mark 2, as per the principles outlined earlier under paragraph 11, to some consumers, the “life” element will retain an independent distinctive role within the composite mark, without necessarily constituting a dominant element of the mark. I note that it is the distinctiveness of the common element that is important here: *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, at [39]. As such, due to the shared “doma” element, for the same reasons given above for Mark 1, I find Mark 2 to be inherently distinctive to a high degree. Where the word “life” is construed in

⁶ See paragraph 8 of the statement of grounds.

conjunction with the word “doma” as alluding to a particular, but indeterminate, lifestyle, the mark as a whole is inherently distinctive to a medium degree.

Likelihood of confusion

44. There is no simple formula for determining whether there is a likelihood of confusion. It is clear that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them 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 (*Canon* at [17]). I must consider the various factors from the perspective of the average consumer, bearing in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

45. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different, but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

“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 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).”

46. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

47. Earlier in this decision, I found:

- All the holder’s services to be either self-evidently identical, or identical as per the principles outlined in *Merix*, to the opponent’s services in class 36;
- That the degree of attention during the selection of the services for both the general public and business consumers would be high, and that both groups of consumers, whilst not ignoring aural considerations, would select the services at issue by predominantly visual means;
- Both the opponent’s marks compared against the holder’s trade mark to be visually and aurally similar to a medium degree; conceptually, I considered that a significant proportion of the average consumer would perceive the word “DOMA”, common to all three marks, to be an invented word with no

recognisable semantic content. While the additional words “life” in the opponent’s Mark 2 and “RESIDENCES” in the holder’s mark gave rise to a point of conceptual difference between the marks, the distinctive common element was conceptually neutral;

- The opponent’s Mark 1 to be inherently distinctive to a high degree, being seen as an invented word with no clearly recognisable semantic content;
- The common element “doma” in the opponent’s Mark 2 to be inherently distinctive to a high degree when the “doma” and “life” elements retain independent distinctive roles within the composite mark, and inherently distinctive to a medium degree when the composite mark as whole is seen as alluding to a particular, but indeterminate, lifestyle.

48. I note that in its written submissions, the holder has requested that should the services at issue be found to be materially similar to the goods and services of the opponent, that the holder be given the opportunity to further limit the scope of the specification to avoid an objection under 5(2)(b) of the Act.⁷ However, even if the self-evidently identical term “*real estate services*” were to be limited in a way that was compliant with the CJEU’s ruling in *Postkantoor*⁸, it would still be encompassed by the opponent’s broad term, rendering the services identical as per *Meric*. Further, as per my considerations at paragraphs 20 and 21 of this decision, given the nature of the opponent’s broad terms in class 36 which encompass the holder’s already limited terms, I cannot see how any proposed further limitation would negate the broad scope of protection afforded to the opponent without adversely altering the scope of the holder’s protection, which would not be permissible. I also acknowledge that there is a public interest in resolving disputes before the Tribunal efficiently, and that by granting the holder’s request, it would unreasonably delay the issue of a final decision and would also be likely to incur unwarranted additional costs to the parties. Accordingly, I see no merit in allowing the holder the opportunity to propose a further limitation to its specification in class 36, which if permitted, for the reasons given above, would be highly unlikely to affect the overall outcome of this decision.

⁷ See paragraph 28 of the holder’s written submissions in lieu of a hearing, dated 20 February 2024.

⁸ Case C-363/99.

49. I acknowledge the holder's submissions that the parties operate in entirely different markets and sectors, being finance, banking and investment for the opponent, and tourism for the holder, and that in the circumstances, there can be no likelihood of confusion.⁹ However, I must make my assessment based on how the goods and services might fairly be used now or in the future. In *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the CJEU stated that:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

50. Although the average consumer views the mark as a whole, case law also directs me to bear in mind the dominant and distinctive elements of the marks. It is settled case-law that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind.

51. In my view, the consumer would be likely to recall the word “DOMA” in each of the competing marks but be less certain about the exact presentation of the word in the opponent's Mark 1 or about the additional elements present in the earlier Mark 2 and the holder's mark. I consider this would be the case even taking into account the high level of attention paid by the consumer during the selection process. Keeping in mind the identity of the services of the marks, I find that there is a likelihood of direct confusion for all the opposed services.

52. I accept that there will be some consumers who note the differences between the marks, therefore, taking into account the previously outlined guidance of Mr Iain Purvis Q.C. (as he then was) in *L.A. Sugar*, I will now consider whether there might be a likelihood of indirect confusion.

⁹ See paragraphs 31 to 35 of the holder's written submissions in lieu of a hearing.

53. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

54. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, Lord Justice Arnold referred to the comments of James Mellor QC (as he then was) sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said (at [16]) that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Lord Justice Arnold added that there must be "a proper basis" for concluding that there is a likelihood of indirect confusion when there is no likelihood of direct confusion.

55. I bear in mind the various factors in my decision and the principle of interdependency between them, and I acknowledge the previously outlined guidance of Mr Iain Purvis Q.C. (as he then was), in *L.A. Sugar*. The distinctive element "DOMA" is found within each of the competing marks and to my mind, it would not be unreasonable for those consumers who notice the additional word elements between the opponent's marks and the holder's mark to conclude that they are attributable to variant brands from the same, or economically connected, undertakings. Consequently, I consider there to be a likelihood of indirect confusion between the competing marks in relation to all the opposed services.

56. As I have found a likelihood of confusion between the holder's mark and the earlier marks, the opposition under section 5(2)(b) of the Act succeeds in its entirety in respect of the opposed services in class 36.

CONCLUSION

57. The opponent has been successful. Subject to any successful appeal, the IR will be refused protection in the UK for all the class 36 services. The IR will be granted

protection in the UK in respect of the services in class 43 only for which the opposition was deemed withdrawn.

COSTS

58. The opponent has been successful and is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice (“TPN”) 2/2016, as was relevant at the time that the opposition was filed. Applying the guidance in that TPN, I award the opponent the sum of £400, which is calculated as follows:

Official fee:	£100
Preparing a statement and considering the counterstatement:	£300
Total:	£400

59. I therefore order AIC HOTEL GROUP to pay MARK Capital Management Limited the sum of £400. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 5th day of September 2024

Suzanne Hitchings
For the Registrar,
the Comptroller-General