

O/0864/24

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO.

UK00003497530

TO REGISTER THE TRADE MARK:



IN CLASS 36

AND IN THE MATTER OF APPLICATION NO.

UK00003545118

TO REGISTER THE TRADE MARK:



IN CLASSES 35 AND 36

BY REALIA EM LTD

AND THE OPPOSITIONS THERETO UNDER NOS.

OP000421575 AND OP000424473

BY GLEB BORUKHOV

Background and pleadings

1. REALIA EM LTD (“the applicant”) applied to register the trade mark shown below, No. UK00003497530 (“the 530 mark”), on 5 June 2020.



2. It was accepted and published in the Trade Marks Journal on 10 July 2020 in respect of the following services:

Class 36 Real estate acquisition [for others]; Real estate acquisition [on behalf of others]; Real estate acquisition services; Real estate administration; Real estate affairs; Real estate affairs services; Real estate agencies; Real estate agency; Real estate agency services.

3. The applicant also applied to register the trade mark shown below, No. UK00003545118 (“the 118 mark”), on 16 October 2020.



4. It was accepted and published in the Trade Marks Journal on 26 February 2021 in respect of the following services:

Class 35 Real estate marketing; Real estate marketing analysis.

Class 36 Real estate (Leasing of -); Real estate acquisition [for others]; Real estate acquisition [on behalf of others]; Real estate acquisition services; Real estate administration; Real estate affairs; Real estate affairs services; Real estate agencies; Real estate agency; Real estate agency services; Real estate agency services for the leasing of land; Real estate agency services for the rental of buildings; Real estate agency services relating to the purchase and sale of buildings; Real estate agency services relating to the purchase and sale of land; Real estate agents services; Real estate and property management services; Real estate appraisal; Real estate appraisal and valuation; Real estate appraisal services; Real estate appraisals; Real estate appraisals [valuations]; Real estate assessment [financial]; Real estate brokerage; Real estate broking; Real estate consultancy; Real estate consultation; Real estate consultations; Real estate equity sharing; Real estate escrow services; Real estate financing; Real estate insurance services; Real estate investment; Real estate investment advice; Real estate investment consultancy; Real estate investment management; Real estate investment planning; Real estate investment services; Real estate lease renewal services; Real estate lease surrender services; Real estate leasing; Real estate lending services; Real estate listing services for housing rentals and apartment rentals; Real estate management; Real estate management services; Real estate management services relating to building complexes; Real estate management services relating to commercial buildings; Real estate management services relating to entertainment venues; Real estate management services relating to housing estates; Real estate management services relating to industrial premises; Real estate management services relating to office premises; Real estate management services relating to residential buildings; Real estate management services relating to retail premises; Real estate management services relating to

shopping centers; Real estate management services relating to shopping malls; Real estate procurement for others; Real estate property management; Real estate selection and acquisition [on behalf of others]; Real estate services; Real estate services related to management of property investments; Real estate settlement services [financial services]; Real estate syndication; Real estate time-sharing; Real estate trustee services; Real estate valuation services; Real estates evaluation (fixing of a price).

5. Gleb Borukhov (“the opponent”) opposes the above trade marks on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the series of two trade marks shown below, under No. UK00003455240, filed on 3 January 2020 and registered on 27 March 2020.

Series 1 of 2



Series 2 of 2

realia family office

6. The opponent opposes all of the applicant’s services and relies upon the following services:

Class 36 Advisory services relating to real estate ownership; Advisory services relating to real estate valuations; Corporate real estate advisory services; Investment advisory services relating to real estate; Investment advisory services; Capital investment

advisory services; Investment banking consulting and advisory services; Agency services for the leasing of real estate property; Agency services for the selling on commission of real property; Real estate brokerage; Brokerage of real estate; Financial brokerage services for real estate; Property (Real estate -) brokerage services; Private equity fund investment services; Management of private equity funds; Fund management for private clients; Fund management services; Capital fund management; Capital investment fund management; Funds management services; Investment fund management; Investment management of funds; Venture capital fund management; Administration of property portfolios; Arranging of leases for the rental of commercial property; Commercial property investment services; Estate management services relating to transactions in real property; Evaluation of real property; Financial services relating to property; Financial services relating to real estate property; Financial services relating to real estate property and buildings; Financial services relating to the acquisition of property; Financial services relating to the sale of property; Financial valuation of freehold property; Financial valuation of leasehold property; Financial valuation of personal property and real estate; Financing of property development; Financing of property loans; Leasing of real estate property; Property (Real estate -) consultancy services; Property (Real estate -) evaluations; Property (Real estate -) finance; Property (Real estate -) investment; Property (Real estate -) management; Property (real estate -) appraisal [financial]; Property appraisal services [valuation]; Property asset management services; Property investment banking services; Property investment services; Property leasing [real estate property only]; Property management services; Property portfolio management; Property valuation; Provision of finance for property development; Real estate and property management services; Real estate property management; Real

estate services related to management of property investments; Valuations and financial appraisals of property; Property (Real estate -) brokerage services; Financial brokerage services; Financing and funding services; Financing in relation to the buying and selling of businesses; Financing of acquisitions; Financing of bridging loans; Financing of building projects; Financing of development projects; Financing of land acquisition; Financing of loans against security; Financing of mergers; Financing of property development; Financing services relating to real estate development; Asset-based financing; Brokerage services for arranging financing by other financial institutions; Consultancy concerning financing of energy projects; Corporate financing; Equity financing; Facilitating and arranging financing; Project financing; Providing financing to emerging and start-up companies; Provision of aircraft financing; Real estate financing; Venture capital financing; Advisory services relating to real estate ownership.

7. In its notices of opposition, the opponent argues that the respective services are identical or similar and that the marks are highly similar.
8. The applicant filed Form TM8s and counterstatements denying the opponent's claims.
9. The two oppositions were consolidated on 16 May 2022.
10. Neither party filed written submissions, but the applicant filed evidence which is detailed below.
11. A hearing was held before me on 13 February 2024.
12. Prior to the hearing, the applicant filed skeleton arguments, whereas the opponent attended the hearing without having filed skeleton arguments.

13. Both parties represented themselves, the applicant in the person of Mr Sergey Pechinin, and the opponent in the person of Mr Gleb Borukhov.

Evidence

14. The evidence takes the form of a witness statement from Mr Sergey Pechinin, a director of the applicant, signed and dated 3 February 2023.

15. There are also exhibits N1 to N18, along with certified translations of 7 May 2023.

Preliminary issue

16. Both parties have made allegations as to the other's business conduct and their ownership status in relation to particular companies and websites. However, these allegations are not pertinent to the matter before me, i.e. the claim under section 5(2)(b) of the Act.

17. The applicant has also claimed that it has used the sign "Realia Family Office" prior to the opponent's registration of that sign. While that may be the basis for a counterclaim under section 5(4)(a) of the Act, no such counterclaim having been filed by the applicant, I must again restrict myself to examining the matter before me – a claim under section 5(2)(b).

18. While I have thoroughly reviewed the documentation supplied to me, including the evidence that the applicant has filed, I cannot take account of those parts of the applicant's counterstatements, witness statement, and skeleton arguments that relate to business conduct, ownership issues, or prior use of the sign "Realia Family Office" because they are not relevant to the section 5(2)(b) claim. I also do not find any of the applicant's exhibits to be of assistance in determining the 5(2)(b) claim as they cover the same non-5(2)(b) points.

19. The parties were asked to confine their comments at the hearing to the question of the similarity or otherwise of the marks and the services at issue

and were advised that any other matters of concern to them would need to be addressed through other avenues.

Arguments put forward by the parties

20. In his statement of grounds opposing the 530 mark the opponent states that the applicant's trade mark "is an attempted copycat of our earlier trademark, 'Realia Family Office', which forms part of our range of registered trademarks (including 'Realia Capital Group', 'Realia Investor Services' and 'Realia Estates' all of which use a similar visual representation with word 'Realia' at the top and the rest of words set in coloured rectangular shapes underneath). ... The applicant of the later trademark is evidently trying to benefit from this fact by copying not only our name but also the distinctive visual representation of our logo."
21. In response to the opponent's statement of grounds opposing the 530 mark the applicant's counterstatement denies the opponent's claims and says that in "designing my company's logo, I took into account 'Asset Lifestyle & Management'. So it's written in big white letters. The family office is a non-exclusive and non-core part of my business (and the logo is marked quite slightly, 10 percent of the space) ... '[A]sset lifestyle and management' is not registered and is not patent right. The lifestyle is a fundamental difference between my activity and his."
22. In his statement of grounds opposing the 118 mark the opponent contends that this is "a second attempt by the applicant to copycat our earlier trademark, 'Realia Family Office', which forms part of our range of registered trademarks ... All of our trademarks use a similar visual representation with the key word 'Realia' ... In his second attempt the applicant is trying to conceal the similarity with our brand ... by adding multiple generic words around the keyword 'Realia' (which represents one of the core elements of our brand)."

23. In response to the opponent's statement of grounds opposing the 118 mark the applicant's counterstatement denies the opponent's claims and says that "The logo has a different background colour as his logo is white coloured while mine is brown. Also in word Realia EM has completely different meaning to his realia as EM stands for Event Management. As well we used different shape and placement of a rectangle as his one is directly under Realia word while mine is directly on the right side in a square shape as well as completely [sic] different words and meaning (On our logo it says Multi Family Office while on his says regular Family office as well as includes a completely different font, the word Multi family office relates to our connections with varios [sic] families with whom we work) ... This logo is a completely different brown color, a font on a yellow-golden background and the semantic meaning of Lifestyle and Asset management. The Lifestyle and Asset management inscription is also not registered by Gleb Borukov. Nevertheless it is important to point out that currently there are 437 marks of large construction and investment companies registered, that contain the word 'Realia' in any form, and thus should not be viewed as an original intellectual property. Moreover Sergey Pechinin's business operates in a different medium such as Public Affairs and lifestyle management, which is indicated in the selected categories of this trademark."

24. In reference to the above point, I note that I must compare the services notionally as applied for and as registered, not taking account of the applicant's claim to be operating in the public affairs and lifestyle management sectors which the applicant considers differentiates its business from that of the opponent.

25. In the applicant's skeleton arguments, Mr Pechinin adds to what was said about the 530 mark in the counterstatement, referencing the black background of the 530 mark, going on to make this point at the hearing. He reiterates what was said about the 118 mark having a brown background. He also restates the point about the phrase "asset and lifestyle management" being present in both of the applicant's marks, but absent from the opponent's series of two marks, emphasising this argument at the hearing.

He also repeated his contention that “there are over 400 companies with the name Realia” in writing and at the hearing.

26. In respect of the “437 marks of large construction and investment companies registered, that contain the word 'Realia' in any form”, I do not consider this to constitute a particularly compelling argument in the applicant’s favour. As per the decision of the Appointed person in the BREXIT case (reference O/262/18), state of the register information is rarely helpful to the Tribunal and, furthermore, no evidence has been filed in support of the applicant’s contention. We are not told of the specific makeup of these other marks, nor do we know what specifications they are registered for other than being generally in the fields of construction and investment. Also, construction services are different from the services before me - real estate services and financial services on the part of the opponent and real estate services on the part of the applicant.

27. At the hearing, Mr Pechinin also raised the question of the consumer, positing it as a sophisticated consumer who is not buying goods in the supermarket or in sales. Rather, it is someone who is “deeply knowledgeable” about the people who sell the applicant’s goods and services, and who is able to identify the applicant’s services as emanating from the applicant “not only by the colour and name of the company logo”.

28. Mr Pechinin also filed skeleton arguments which referred to Exhibits N5, N6, N7 and N9 from the evidence that has been filed, and spoke at the hearing, about the applicant’s use of the sign “Realia Family Office” prior to the opponent’s registration of that sign. At the hearing, he referred to two pieces of case law and an EU directive relating to trade marks that has now been superseded. However, I consider that what he was trying to do was build a case for a counterclaim under section 5(4)(a) of the Act. However, he has filed no such counterclaim and the above information is not pertinent to my decision as to whether the oppositions under section 5(2)(b) of the Act should be partially or wholly upheld.

29. At the hearing, Mr Borukhov said that the 530 mark was “pretty much an exact copycat, including the font. He just changed the colours so I think any reasonable person would be very confused”. He went on to say that the applicant’s use of its applied for marks was causing actual confusion.
30. Beginning by referencing the 118 mark, Mr Borukhov then said, “The second attempt by Mr. Pechinin has provided some distinction, so to speak. However, in both cases he has applied for very similar classes of services”.
31. In concluding the first part of his comments, Mr Borukhov said, “So the visuals are similar, the classes are similar ...”
32. In his second set of comments by way of reply to the applicant’s comments, Mr Borukhov said that it is not correct to say that there are 400 companies registered under “REALIA”, there being only two pages of companies using the word “REALIA” on the IPO website, a large number of which were his own companies.
33. Mr Borukhov also questioned the applicant’s comments about the sophistication of the consumer such that they would not be confused by seeing “two Realias”. He said that a lot of his clients are “confused as to why Mr. Pechinin is using a brand which is very similar to Realia Capital. Actually, for most of our clients, Realia Capital is associated with the name Realia; that is how they know it. The rest of the wording is not really perceived as a distinctive feature.”
34. While the question at hand is not whether the applicant’s marks are similar to “Realia Capital”, but rather whether they are similar to “REALIA FAMILY OFFICE”/“realia family office”, I take the opponent’s essential point that “REALIA”/“realia” is the distinctive element of his marks.

DECISION

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

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

(a)...

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

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

36. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.- (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) a European Union trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

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

37. Given their respective filing dates, the trade mark upon which the opponent relies qualifies as an earlier trade mark as defined above. Given the date on which the earlier mark was registered, it is not subject to the proof of use provisions.

Section 5(2)(b) – case law

38. 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.

39. The following principles 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 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 the services

40. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have

pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

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

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

42. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49].

Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

43. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold summarised the principles of interpretation of terms as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

44. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“GC”) stated that:

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

45. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM), Case T-325/06, the GC stated that “complementary” means:

“... there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think the responsibility for those goods lies with the same undertaking.”

46. The services in question are as follows:

Opponent’s services	Applicant’s services (all the services detailed below are listed for the 118 mark, while those in bold listed for the 530 mark)
	<u>Class 35</u> Real estate marketing; Real estate marketing analysis.
<u>Class 36</u> Advisory services relating to real estate ownership; Advisory services relating to real estate valuations; Corporate real estate advisory services; Investment advisory services relating to real estate; Investment advisory services; Capital investment advisory services; Investment banking consulting and advisory services; Agency services for the leasing of real estate property; Agency services for the selling on commission of real property; Real	<u>Class 36</u> Real estate (Leasing of -); Real estate acquisition [for others]; Real estate acquisition [on behalf of others]; Real estate acquisition services; Real estate administration; Real estate affairs; Real estate affairs services; Real estate agencies; Real estate agency; Real estate agency services; Real estate agency services for the leasing of land; Real estate agency services for the rental of buildings; Real estate agency services relating to the

estate brokerage; Brokerage of real estate; Financial brokerage services for real estate; Property (Real estate -) brokerage services; Private equity fund investment services; Management of private equity funds; Fund management for private clients; Fund management services; Capital fund management; Capital investment fund management; Funds management services; Investment fund management; Investment management of funds; Venture capital fund management; Administration of property portfolios; Arranging of leases for the rental of commercial property; Commercial property investment services; Estate management services relating to transactions in real property; Evaluation of real property; Financial services relating to property; Financial services relating to real estate property; Financial services relating to real estate property and buildings; Financial services relating to the acquisition of property; Financial services relating to the sale of property; Financial valuation of freehold property; Financial valuation of leasehold property; Financial valuation of personal property and real estate; Financing of property development; Financing of property loans; Leasing of real estate property; Property (Real

purchase and sale of buildings; Real estate agency services relating to the purchase and sale of land; Real estate agents services; Real estate and property management services; Real estate appraisal; Real estate appraisal and valuation; Real estate appraisal services; Real estate appraisals; Real estate appraisals [valuations]; Real estate assessment [financial]; Real estate brokerage; Real estate broking; Real estate consultancy; Real estate consultation; Real estate consultations; Real estate equity sharing; Real estate escrow services; Real estate financing; Real estate insurance services; Real estate investment; Real estate investment advice; Real estate investment consultancy; Real estate investment management; Real estate investment planning; Real estate investment services; Real estate lease renewal services; Real estate lease surrender services; Real estate leasing; Real estate lending services; Real estate listing services for housing rentals and apartment rentals; Real estate management; Real estate management services; Real estate management services relating to building complexes; Real estate management services relating to commercial buildings; Real estate

estate -) consultancy services; Property (Real estate -) evaluations; Property (Real estate -) finance; Property (Real estate -) investment; Property (Real estate -) management; Property (real estate -) appraisal [financial]; Property appraisal services [valuation]; Property asset management services; Property investment banking services; Property investment services; Property leasing [real estate property only]; Property management services; Property portfolio management; Property valuation; Provision of finance for property development; Real estate and property management services; Real estate property management; Real estate services related to management of property investments; Valuations and financial appraisals of property; Property (Real estate -) brokerage services; Financial brokerage services; Financing and funding services; Financing in relation to the buying and selling of businesses; Financing of acquisitions; Financing of bridging loans; Financing of building projects; Financing of development projects; Financing of land acquisition; Financing of loans against security; Financing of mergers; Financing of property development; Financing services relating to real estate development;

management services relating to entertainment venues; Real estate management services relating to housing estates; Real estate management services relating to industrial premises; Real estate management services relating to office premises; Real estate management services relating to residential buildings; Real estate management services relating to retail premises; Real estate management services relating to shopping centers; Real estate management services relating to shopping malls; Real estate procurement for others; Real estate property management; Real estate selection and acquisition [on behalf of others]; Real estate services; Real estate services related to management of property investments; Real estate settlement services [financial services]; Real estate syndication; Real estate time-sharing; Real estate trustee services; Real estate valuation services; Real estates evaluation (fixing of a price).

<p>Asset-based financing; Brokerage services for arranging financing by other financial institutions; Consultancy concerning financing of energy projects; Corporate financing; Equity financing; Facilitating and arranging financing; Project financing; Providing financing to emerging and start-up companies; Provision of aircraft financing; Real estate financing; Venture capital financing; Advisory services relating to real estate ownership.</p>	
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47. The applicant’s Class 36 real estate services are *Meric* identical to the opponent’s “Real estate and property management services”.

48. While they are in a separate class, Class 35, the applicant’s “Real estate marketing” and “Real estate marketing analysis” services are highly similar to the opponent’s “Real estate and property management services”. Marketing is generally considered to be an integral part of a real estate service.

The average consumer and the nature of the purchasing act

49. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. In *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), Birss J (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the

relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

50. The typical consumer in this case would be a member of the public purchasing a private home, a landlord, or a property developer. All of these types of consumers would pay close attention when utilising estate agents’ services in respect of such things as claimed service levels and rates of commission. The sums of money at stake would be considerable. The level of attention paid would be high.

51. Visual considerations would predominate during the purchasing process with the initial inspection of websites and marketing literature being to the fore. However, I do not discount there being some verbal factors in play as consumers begin to engage in dialogue with estate agents.




Comparison of the trade marks

52. 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 CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....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.”

53. 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.

54. The respective trade marks are shown below.

Opponent's trade marks	Applicant's trade marks
<p data-bbox="379 808 571 842">Series 1 of 2:</p> 	<p data-bbox="975 808 1185 842">The 530 mark:</p> 
<p data-bbox="379 1191 571 1225">Series 2 of 2:</p> <p data-bbox="260 1308 691 1361">realia family office</p>	<p data-bbox="975 1191 1185 1225">The 118 mark:</p> 

55. The opponent's figurative mark consists of the word "REALIA" in black block capitals sitting above two words, "FAMILY OFFICE". "FAMILY OFFICE" is in white block capitals sitting inside a blue bar. Given that the average consumer reads from left to right and it is the first word that the consumer would encounter, and it is also significantly larger than the two words it sits above, "REALIA" is the most dominant of the three words which feature in the mark having the greatest weight in the overall impression. It is also the only distinctive word, being a word that I consider the average consumer would see as invented or as a foreign language word of which it would not know the meaning. In that respect, I note that neither party has made any submissions

as to the meaning of “REALIA”. While the word is present in the Oxford English Dictionary,¹ I consider that any consumers that were aware of this would not constitute a significant proportion of average consumers. The other words in the mark are wholly descriptive. These, together with the stylistic elements, will play a much lesser role in forming the mark’s overall impression.

56. The opponent’s word mark consists of the three words “realia family office”, there being no other elements that contribute to the overall impression of the mark which lies in the words alone, but the word “realia” is the dominant and distinctive element. It is the first word encountered by the consumer and less weight will be given to the other words which are wholly descriptive.

57. The applicant’s 530 mark is a figurative mark. On the left-hand side of the mark is the word “REALIA” in white block capitals sitting above two words, “FAMILY OFFICE”. “FAMILY OFFICE” is in white block capitals sitting inside a blue bar. The word “REALIA” is significantly larger than the two words it sits above. On the right-hand side of the mark are the words “ASSET & LIFESTYLE MANAGEMENT in white block capitals. The words “ASSET & LIFESTYLE” sit above the word “MANAGEMENT”. The mark has a black rectangular background and the two sets of words discussed above are divided by a white vertical line. The word “REALIA” is the most dominant of the words which feature in the mark, being the largest word by height and the first word that the average consumer’s eye would be drawn to, the average consumer being someone who reads from left to right. It is also the only distinctive word, having the greatest weight in the overall impression, whereas the other words in the mark are wholly descriptive. These, together with the stylistic elements, play a much lesser role in forming the mark’s overall impression.

58. The applicant’s 118 mark is also a figurative mark. The word and letters “REALIA EM” feature prominently, occupying the centre and right-hand side of the mark, consisting of large bold block capitals, underlined in bold. Below

¹ https://www.oed.com/dictionary/realia_n?tab=meaning_and_use&tl=true#26849064

“REALIA EM”, appear the words “Asset & Lifestyle management” in smaller text. All the words and letters in this section are in dark brown text. On the left-hand side of the mark are the words “Multi Family Office” each word being above the next in white text, the words sitting inside a gold square. The mark as a whole has a light brown rectangular background. While it is true that the average consumer reads from left right, the word and letters “REALIA EM” are the most dominant element in the mark, being prominently displayed in bold type and being larger than the other words in the mark having the greatest weight in the overall impression. They also contain the mark’s only distinctive element, “REALIA” (I do not consider that the average consumer would see the initial letters “EM” as standing for Event Management as the applicant says they do, but rather it would see them as not having any particular meaning). The other words in the mark are wholly descriptive. These, together with the stylistic elements, play a much lesser role in forming the mark’s overall impression.

59. Visually, by comparison with the applicant’s 530 mark, the opponent’s figurative mark is identical to the left-hand side of the mark. It has the same words and the same layout. It only differs in that the word “REALIA” is black on white as opposed to white on black. Even the opponent’s word mark has identical words to those that feature on the left-hand side of the 530 mark. However, the 530 mark differs from the opponent’s marks in that it has the additional words “ASSET & LIFESTYLE MANAGEMENT”. Overall, I find that the respective marks are of at least a medium level of visual similarity.

60. By comparison with the applicant’s 118 mark, both the opponent’s figurative and word marks share the words “FAMILY OFFICE” with the left-hand side of the 118 mark, the applicant’s mark differing in that regard because “Family Office” is preceded by “Multi”. The respective marks also share the dominant and distinctive word “REALIA”, but with the applicant’s “REALIA” being succeeded by the letters “EM” and the phrase “Asset & Lifestyle management”. Overall, I find that the respective marks are of medium visual similarity.

61. Aurally, by comparison with the applicant's 530 mark, the marks are aurally identical as "RAY-ALIA FAMILY OFFICE" if the wholly descriptive "ASSET AND LIFESTYLE MANAGEMENT" in the applicant's mark is not voiced. If it is voiced, the marks would be of medium aural similarity.
62. By comparison with the applicant's 118 mark, the marks are "RAY-ALIA FAMILY OFFICE" versus "RAY-ALIA E-EM" and they are of medium aural similarity were the wholly descriptive "ASSET AND LIFESTYLE MANAGEMENT" and "MULTI FAMILY OFFICE" not to be voiced. If the descriptive words were to be voiced, the marks would be of low aural similarity.
63. Conceptually, by comparison with the applicant's 530 mark, both the opponent's marks and the applicant's mark feature the words "REALIA FAMILY OFFICE". "REALIA" would be seen by the average consumer as an invented word or as a foreign language word of which it would not know the meaning and so no particular concept would be derived from it. "FAMILY OFFICE" connotes an office whose services are aimed at families. In the case of the 530 mark the additional "ASSET & LIFESTYLE MANAGEMENT" conveys the straightforward concept of the management of assets and lifestyles. The shared distinctive word "REALIA" is conceptually neutral, the only conceptual similarity arising from the identical and descriptive words "FAMILY OFFICE". The rest of the word elements comprise the only conceptual difference between the competing marks. Taking into account the marks as a whole and the points of conceptual similarity and difference, I find that there is a low degree of conceptual similarity.
64. By comparison with the applicant's 118 mark, both the opponent's marks and the applicant's mark feature the word "REALIA" which would be seen by average consumer as an invented word or as a foreign language word of which it would not know the meaning, and so no particular concept would be derived from it. The letters "EM" in the 118 mark are initial letters that do not convey any particular meaning and again no particular concept would be derived from them. "FAMILY OFFICE" connotes offices whose services are aimed at families whereas "Multi Family Office" connotes multiple offices

whose services are aimed at families. “Asset & Lifestyle management” conveys the straightforward concept of the management of assets and lifestyles. The shared distinctive word “REALIA” and the letters “EM” being conceptually neutral, the only conceptual similarity arises from the identical and descriptive words “FAMILY OFFICE”/“...Family Office”. The rest of the word elements comprise the only conceptual difference between the competing marks. Taking into account the marks as a whole and the points of conceptual similarity and difference, I find that there is a low degree of conceptual similarity.

Distinctive character of the earlier mark

65. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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 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).”

66. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

67. The earlier marks are a series of two, the first being figurative, the second being word only, but the stylistic elements of the figurative mark do not impact upon its level of distinctiveness. "REALIA" would be seen by the average consumer as an invented word or as a foreign language word of which it would not know the meaning, and therefore is not suggestive of the opponent's services. "FAMILY OFFICE" is wholly descriptive. Overall, I find the earlier marks to be of a high degree of inherent distinctiveness. I bear in mind that the degree of distinctiveness of the earlier mark is only likely to be significant to the extent that it relates to the point of commonality between the marks², the word "REALIA". To that extent, I confirm that my view is that that word is inherently distinctive alone to a high degree.

Likelihood of confusion

68. 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 first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services and vice versa. As I mentioned above, it is necessary for me to keep in mind the

² See, *Kurt Geiger v A-List Corporate Limited*, BL O-075- 13

distinctive character of the opponent's trade mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive 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.

69. I have found the parties' marks to be either visually similar to at least a medium degree, or simply similar to a medium degree. They are aurally identical in respect of the applicant's 530 mark (or, if the descriptive words are voiced, are of a medium level of aural similarity) and of medium aural similarity in respect of the applicant's 118 mark (or, if the descriptive words are voiced, are of a low level of aural similarity). The respective marks are conceptually similar to a low degree.

70. I have identified the typical consumer in this case to be a member of the public purchasing a private home, a landlord, or a property developer. All of these types of consumers would pay a high degree of attention during the purchasing process of the services at issue – real estate services. Visual considerations would predominate, but I do not discount there being some verbal factors in play.

71. I have found the opponent's marks to have a high degree of inherent distinctive character.

72. The parties' services are identical or highly similar.

73. By comparison with the left-hand side of the applicant's 530 mark, the opponent's figurative mark is virtually identical and the opponent's word mark features identical words. However, while the words on the right-hand side of the applicant's mark – "ASSET & LIFESTYLE MANAGEMENT" – are wholly descriptive, I consider that they would be noticed by the average consumer and so there is no likelihood of direct confusion.

74. By comparison with the applicant's 118 mark, the respective marks share the word "REALIA" which is the only distinctive word in the marks, and the most prominent, but the applicant's mark has the additional letters "EM" as well as "Asset & Lifestyle management" and "Multi Family Office". While "EM" would not be seen as having any particular meaning and the other words are wholly descriptive, these differences would be noticed by the average consumer and so there is no likelihood of direct confusion.

75. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

"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 recognised 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."

76. In respect of the applicant's 530 mark, the average consumer will see the addition of the wholly descriptive phrase "ASSET & LIFESTYLE MANAGEMENT" as indicative of a brand variation of "REALIA FAMILY OFFICE" alone. Therefore, there is a likelihood of indirect confusion.

77. In respect of the applicant's 118 mark, the average consumer would consider the respective marks to be variants of the "REALIA" brand, "REALIA" being regarded as a house mark and being the only distinctive element of the

respective marks. Both the opponent's marks and the applicant's mark refer to family offices, but the applicant's mark emphasises the asset and lifestyle management aspect of "REALIA"'s services. The additional initial letters "EM" would not be interpreted as having a particular meaning but would be seen as an adjunct of the "REALIA" brand. I consider there to be a likelihood of indirect confusion.

CONCLUSION

78. Subject to appeal, the oppositions – reference numbers OP000421575 and OP000424473 – have succeeded in their entirety and the applications are refused.

COSTS

79. The opponent has been wholly successful.

80. As an unrepresented party, Mr Borukhov filed a Tribunal Cost Pro Forma claiming for 8 hours. In determining the hourly rate due, the usual practice is to set that at £19 in line with the Civil Procedure Rules, Part 46. Although the hourly rate claimed by Mr Borukhov is considerably higher, I see no reason to depart from the usual procedure and so the costs award is as follows:

8 hours x £19 per hour:	£152
Official fees:	£100 x 2 = £200
Total:	£352

81. I order REALIA EM LTD to pay Gleb Borukhov the sum of £352. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 5th day of September 2024

JOHN WILLIAMS
For the Registrar