O/0946/24

TRADE MARKS ACT 1994

IN THE MATTER OF
UK TRADE MARK APPLICATIONS NOS. 3733240 AND 3787998
ANGROW COMPANY LIMITED

FOR

"Voibon"

AND

VOIBON

IN CLASSES 3,5,10,35

AND

OPPOSITIONS THERETO UNDER NOS. 432671 AND 436001
BY MARRIOTT WORLDWIDE CORPORATION

BACKGROUND AND PLEADINGS

1. Angrow Company Limited ("**the Applicant**") seeks to register these two trade marks:

(i) UKTM No. 3733240 - "Voibon" (plain word mark)

Filing date 15 December 2021

Published: 14 January 2022

(ii) UKTM No. 3787998  (figurative mark)

Filing date 15 May 2022

Published: 3 June 2022

For both trade marks, registration is sought in respect of the same specifications of goods in Classes 3, 5, 10 and services in Class 35, as follows:

Class 3:

Cleansing milk for toilet purposes; Shampoos; Cakes of toilet soap; Hair lotions; Bath gel; Ethereal oils; Aromatics [essential oils]; Lipsticks; Beauty masks; Cosmetics; Cosmetic creams; Scented water; Oils for cosmetic purposes; Lotions for cosmetic purposes; Perfumes; Tissues impregnated with cosmetic lotions; Dentifrices

Class 5:

Thermal water; Liniments; Serums; Pharmaceutical preparation for skin care; Dietary fibre; Acne treatment preparations; Nutritional supplements; Deodorants for clothing and textiles; Belts for sanitary napkins [towels]; Sanitary tampons; Sanitary pads; Sanitary towels; Sanitizing wipes; Sanitary pants; Medicated skin care preparations; Medicinal sprays; Nutraceuticals for use as a dietary supplement; Protective creams (Medicated -); Medicines for human purposes; Medical preparation for slimming purposes; Dietary supplements with a cosmetic effect

Class 10

Body fat monitors; Electric massage apparatus for personal use; Apparatus for use in medical analysis; Esthetic massage apparatus; LED masks for therapeutic purposes; Lasers incorporating optical fibres for medical use; Gloves for massage; Abdominal pads; Dental apparatus and instruments; Medical apparatus and instruments; Physiotherapy apparatus; Foam massage rollers; Sphygmotensiometers; Electric esthetic massage apparatus; Medical skin abraders; Microdermabrasion apparatus; Massage mitts

Class 35

Advertising and advertisement services; Sample distribution; Arranging of displays for trade purposes; Market analysis; Business advice, inquiries or information; Marketing research; Organising exhibitions for commercial or advertising purposes; Import and export agencies; Market analysis services; Sponsorship search; Retail or wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies; Provision of an on-line marketplace for buyers and sellers of goods and services; Advertising and marketing; Product merchandising; Providing business information via a web site; Sales promotion for others

2. The contested trade mark applications are opposed by Marriott Worldwide Corporation ("**the Opponent**"), based on claims under **sections 5(2)(b)**, **5(3)** and **3(6)** of the Trade Marks Act 1994 ("**the Act**").

3. The Opponent relies on the four earlier registered trade marks set out below.

Earlier Mark 1:

UKTM Number 917975943:

"BONVOY"

Filing Date: 29 October 2018 Priority Date: 30 April 2018

Registered: 26 February 2019, for services in Classes 35, 36, 43

Earlier Mark 2:

UKTM Number 917975947:

"MARRIOTT BONVOY"

Filing Date: 29 October 2018 Priority Date: 30 April 2018

Registered: 26 February 2019, for services in Classes 35, 36, 43

Earlier Mark 3:

UKTM Number 3361302:

MARRIOTT BONVOY

Filing Date: 17 December 2018

Registered: 8 March 2019 - for services in Classes 35, 36, 43

Earlier Mark 4:

UKTM Number 3421307:

"MARRIOTT BONVOY BOUTIQUES"

Filing Date: 14 August 2019

Registration Date: 1 November 2019

Registered for goods in Classes 3, 20, 24, 25 and services in Class 35

4. **Section 5(2)(b):** The Opponent relies on Earlier Marks 1, 2 and 3 as a basis for a section 5(2)(b) objection directed against the Applicant's Class 35 services only. The section 5(2)(b) objection based on Earlier Mark 4 is again directed against the Applicant's services in Class 35, but also against the Applicant's goods in Class 3. The objections under section 5(2)(b) are that the parties' marks are similar and their goods or services are identical or similar, leading to a likelihood that consumers will be confused as to the origin of the goods or services.

5. **Section 5(3):** The Opponent claims a reputation for all of its registered services under Earlier Marks 1, 2 and 3, on which it relies as a basis for a section 5(3) objection against all of the Applicant's goods and services. It claims that it has made extensive use of its prior marks such that the marks have acquired a reputation in the United Kingdom in respect all of the goods and services registered under its three trade marks. The Opponent claims that the Applicant's marks are similar to its marks and that use of the Applicant's trade marks without due cause would take unfair advantage of, or would be detrimental to, the distinctive character or reputation of the Opponent's trade marks.

6. **Section 3(6):** the Opponent claims that the UK trade mark application was filed in bad faith for lack of any intention to use the application for the goods and services covered by the specification. The Opponent makes this allegation on the basis that, in a trade mark application to the United States Intellectual Property Office ("USPTO"), the Applicant filed what purported to be specimen images of commercial use of its trade mark in Classes 3, 5, 10 and 35, but which appeared to be doctored from images of third party products.

7. The Opponent claims that the examples showing the Applicant to have represented imagery from third party brands as its own, suggests that the applicant is not currently using the Application for the goods and services, nor has any intention to do so. The opponent claims that the applicant will not make legitimate use of the mark and that the Application has therefore been made in bad faith.

The Applicant's defence

8. The Applicant filed a Form TM8 in defence of each opposition, including counterstatements denying all of the grounds.

Papers filed, hearing and representation

9. During the evidence rounds both parties filed evidence. The attorneys for the Opponent are D Young & Co LLP; the attorneys for the Opponent are Filemot Technology Law Ltd. An oral hearing of the matter was held by video conference on 2 November 2023. Victoria Jones of counsel attended for the Opponent; Barbara E. Cookson attended for the Applicant. Both sides filed very helpful skeleton arguments ahead of the hearing. I make this decision having read all the papers filed and refer to their contents where I consider it warranted to do so.

EVIDENCE

10. The Opponent's evidence in chief comprised:

    (i) a **witness statement of Bao Giang Val Baudin** (24 January 2023) ("**WSBGVB**") with **Exhibits BGVB1 – BGVB21**. Bao Giang Val Baudin is Vice President of the Opponent. His evidence includes content relating to the bad faith claim, but the main purpose of his evidence is to seek to establish the claimed reputation of the Opponent's trade marks and the claimed enhanced distinctive character acquired through use.

    (ii) a **witness statement of** Anthony Yarborough (19 January 2023) with **Exhibit AY1 – AY4**. Mr Yarborough is Vice President of Robert Jackson and Associates, Inc. His company was instructed by the law firm Kilpatrick Townsend and Stockton, on behalf of the opponent, to conduct a test purchase of products bearing the contested trade marks offered on the Applicant's websites. His evidence shows that each of his attempts to do so were unsuccessful.

11. The Applicant filed evidence in chief in the form of a **witness statement of Yang Den Fong** (23 March 2023), introducing **Exhibit Voibon1**. The witness is CEO of the Applicant. His exhibit shows extracts from voibon.com, which he states show use of the Applicant's trade marks.

12. The Opponent filed further evidence in the form of **witness statement of Anna Reid** (23 May 2023), introducing **Exhibits AMR1 -5**. The witness is a partner at D Young & Co LLP, and her evidence highlights that luxury hotels may have a brand interest in scent and beauty products, which the Opponent submits "demonstrates that a likelihood of confusion is in fact inevitable."

Evidence of use

13. The Applicant requests at paragraph 4 of its counterstatements that the Opponent provide proof of genuine use of the earlier trade marks. However, since none of the earlier marks had been registered for more than five years at the filing date of either of the Applicant's contested marks ("**the relevant dates**"), the earlier marks are not subject to the use conditions under section 6A of the Act. Accordingly, for its section 5(2)(b) ground, the Opponent is able to rely on its earlier marks in respect of all of the goods and services relied on without proving genuine use.

14. While the Opponent is not required to show evidence to establish genuine use of its marks, evidence is of course required to establish the Opponent's claim that its earlier marks benefit from an **enhanced distinctive character** acquired through use, and to establish the **reputation** claimed in respect of Marks 1, 2 and 3. Those claims are to be assessed as at the relevant dates (15 December 2021 and 15 May 2022). I deal with the evidence of enhanced distinctiveness and reputation later in this decision.

THE SECTION 5(2)(B) CLAIM

15. The Act states:

> "Section 5 Relative grounds for refusal of registration.
> (2) A trade mark shall not be registered if because—
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

16. The Opponent's section 5(2)(b) claim relies on four trade mark registrations, all filed before the filing dates of the Applicant's trade marks, and which therefore qualify as an "earlier trade mark" for the purposes of section 5.[1]

17. The case law principles are very well established and not disputed:

(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;

1 Section 6 of the Act.

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

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

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

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

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

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

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

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

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

Similarity of marks

18. A prerequisite for success under section 5(2)(b) is that the marks are similar. The marks to be compared are shown in the following table:

Earlier Marks 1, 2, 3 and 4	The Applicant's Marks
BONVOY MARRIOTT BONVOY MARRIOTT BONVOY MARRIOTT BONVOY BOUTIQUES	Voibon VOIBON

19. As the case law principles above make clear, 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.

20. At the hearing submissions focused on Earlier Mark 1 ("BONVOY") and Earlier Mark 4 "MARRIOTT BONVOY BOUTIQUES". This decision takes the same approach, since the additional word "Marriott" in Earlier Mark 2 and the additional word and stylisation in Earlier Mark 3, clearly lead to a lower degree of similarity than may be found in respect of Earlier Mark 1. This decision will also focus on the word mark applied for, since the device element and modest stylisation present in the Applicant's figurative mark again clearly lead to a lower degree of similarity than may be found based on the plain word mark.

21. As Ms Jones submitted, the overall impressions of the Applicant's plain word mark, and of the Opponent's Earlier Mark 1 and Earlier Mark 4 reside in the totality of the respective words.

22. The Opponent contends that the marks are highly similar, which claim it argues in this way:

"*Visual similarity:* *Both marks comprise one invented word, each containing 6 letters, with 5 of those letters being identical, with the only difference being with the use of an "i/I" or a "y/Y", which are themselves visually similar when presented as capitals. Further, each mark contains the letters "BON" in the same order and "VO" in the same order with the only difference being that the presentation of these elements is inverted in the Voibon Word Mark[2]. Taking all of this into account, the marks are visually similar to a high degree with the difference between "i/I" and "y/Y" being swallowed up by the similarities between the marks and with the inversion of the "BON" and "VOY/VOI" elements having little visual impact.*

Aural similarity: *Both marks comprise 2 syllables which are identical but inverted[3] namely, "BON-VOY" ("VOY" being similarly pronounced to "BOY") and "VOY-BON" (the "OI" element in "VOI" being pronounced in the same way as the British "Oi!" used to attract someone's attention). The degree of aural similarity is therefore very high.*

Conceptual similarity: *Neither mark is an identifiable English dictionary word and as such each will be regarded as an invented word. The Applicant argues [in its counterstatement] that the Earlier Marks' "BONVOY" alludes to "BON VOYAGE", but it has not adduced any evidence in support of the assertion e.g. evidence showing that "VOYAGE" is commonly abbreviated to "VOY" by members of the relevant English-speaking public. In any event, particularly due to the identical pronunciation of "VOY" and "VOI", if, arguendo, consumers did see "VOY" as abbreviation for "VOYAGE", this would apply equally to the Application Marks giving rise to an identical concept. However, as set out above, there is no evidence that a significant proportion of average consumers would understand "VOY" in this way immediately upon first impression without further scrutiny (See by analogy Bnkvoy - Decision O/0571/23 at [48] and [49]). In fact, BONVOY is a unique, coined term, created by Marriott, and it is not based on any other term. Accordingly, when seen as a whole the marks are invented words with no dictionary definition, and no conceptual comparison is possible and therefore they will be rendered conceptually neutral (See EUIPO Decision No B 3 167 308 BONVOY/VOIBON*)."

23. Arguing against the claimed similarity of the marks, Ms Cookson submitted as follows:

2 The mere inversion of elements of a mark cannot allow the conclusion that there is no visual/aural similarity: *VITS4KIDS v Kids Vits* T-484/08 and *HEDGE INVEST v InvestHedge* T-67/08 at §§35-41.

3 *Ibid.*

"*Conceptually BONVOY brings to mind the traditional farewell to a traveller of* ***Bon Voyage.*** *Voibon has no conceptual significance. Phonetically it is accepted the BON syllable is likely to be sounded the same by the average consumer. VOI and VOY do not match in the contexts of their signs. Because of the differing positions of the syllables, phonetic and visual similarity does not exist. Average consumers do not count letters or reposition them. They are not playing Scrabble when selecting goods and services.*

In respect of the second comparison MARRIOTT BONVOY BOUTIQUES/ Voibon, it is barely credible even to suggest any comparison given the dominant and distinctive element MARRIOTT which is well known as a hotel brand. The alliteration of ***BO****NVOY* ***BO****UTIQUES emphasise the significance of the beginning B sound so that the signs are dissimilar on any phonetic or visual comparison*."

24. My own views align more closely with those of Ms Cookson. Based on overall impressions, I find that there is no similarity between the three-word Earlier Mark 4 "MARRIOTT BONVOY BOUTIQUES*"* and the Applicant's mark "Voibon". Since similarity between the marks is required by section 5(2)(b), **the opposition based on Mark 4 inevitably fails** (and thereby the 5(2)(b) attack against the applied-for Class 3 goods).

25. In comparing Voibon with Bonvoy, the position is more contestable, since the comparison involves two single words of six letters, with shared syllables. Nonetheless, I do not think it would be unreasonable to regard those two marks as not similar. In reaching that view, I accept that for the average consumer in the UK the "voi" and "voy" elements may be spoken identically, despite their being spelled differently;[4] and clearly one mark begins with "Bon" and the other ends with that identical component. However, the inversion of the "bon" syllables is significant, and, taken with the different spelling of the other syllable, is in my view enough to regard the two invented marks as not similar for the purpose of section 5. (By rough analogy, I would not consider "Cotes" similar to "Tesco".)

26. Since similarity of marks is required for section 5(2)(b) – and for rection 5(3) – my finding that the marks are not similar means that the opposition based on Earlier Marks 1, 2 and 3 inevitably fails.

27. If, contrary to my primary view, the marks should properly be considered to have a

4 A proportion of UK consumers may give the opening syllable of the contested mark its French pronunciation (approximating a "vwar" sound), as in "voilà".

relevant degree of similarity, then I would estimate the visual similarity as low and the aural similarity as no more than medium.

28. Conceptually, I accept that both words are invented and with no immediate concept, such that I find the conceptual position to be neutral. While that is my finding on the conceptual position, I do not discredit the Applicant's assertion that BONVOY alludes to "BON VOYAGE". Indeed, I note that the Opponent's evidence at Exhibit BGVB1 includes an article from Forbes magazine in which it is stated that "Bonvoy" is a "play on the French saying "Bon voyage". This allusion may well strike a significant proportion of the average consumer group, given the nature of the Opponent's business interests. No such allusion would be perceived in the Applicant's mark. The more unique construction of the Applicant's mark contributes to its having a different overall impression; the Bonvoy mark not only may carry (for some) the "Bon voyage" allusion, but is a less singular construction in the English language, given the existence of common words like 'convoy' and 'envoy'.

29. Proceeding on the premise that the marks are similar to some degree, I will consider the other aspects of the section 5 claims.

Comparison of services

30. When considering whether goods or services are similar, all the relevant factors relating to the goods should be taken into account. Those factors include, inter alia:[5]

i. the physical nature of the acts of service;

ii. their intended purpose / uses;

iii. the method of use;

iv. who are the users of the services;

v. the trade channels through which the services reach the market; and

vi. whether they are in competition with each other;

vii. whether they are complementary to each other. Complementary has been described as meaning that *"there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking"*.[6]

5 See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.,* [1996] R.P.C. 281 – the *"Treat"* case

6 *Boston Scientific Ltd v OHIM,* Case T-325/06, paragraph 82

Complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity.[7]

31. I bear in mind too that when interpreting terms in a specification that it is *"necessary to focus on the core of what is described* [... and that] *trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise",* although *"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* [and services] *in question"*.[8]

32. Where goods or services in the specification of one party are included in a broader term from the other party's specification, they are considered to be identical.[9]

33. The section 5(2)(b) opposition based on Earlier Marks 1, 2 and 3 is directed only against the applied-for services in Class 35, which are these:

Advertising and advertisement services; Sample distribution; Arranging of displays for trade purposes; Market analysis; Business advice, inquiries or information; Marketing research; Organising exhibitions for commercial or advertising purposes; Import and export agencies; Market analysis services; Sponsorship search; Retail or wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies; Provision of an on-line marketplace for buyers and sellers of goods and services; Advertising and marketing; Product merchandising; Providing business information via a web site; Sales promotion for others

34. At the hearing, both sides agreed that the Class 35 services under Earlier Mark 1 (Bonvoy) provide the Opponent with its closest points of similarity.[10] The Opponent's Class 35 services are these:

Advertising, business management, business administration; office functions; incentive award programs; promoting hotel, resort, airline, car rental, time share, travel, and

7 *Kurt Hesse v OHIM, Case C-50/15 P*
8 *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12
9 *Gérard Meric v OHIM*, Case T-133/05 at [29].
10 (More so than its registered services in Class 36 and 43, as listed at paragraph 59 below.)

vacation services through an incentive award program; organization, operation and supervision of loyalty programs.

35. Ms Cookson accepted that the Opponent's specification of *Advertising* are services identical to the applied-for *Advertising and advertisement services* and agreed that a degree of similarity exists between Opponent's specification of *business management, business administration; office functions* and the applied-for *Business advice, inquiries or information*. On the other hand, Ms Cookson submitted that none of the services under Earlier Mark 1 are similar to the applied-for *Retail or wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies.* Since section 5(2)(b) requires at least some similarity of goods or services, the opposition inevitably fails on this ground for services that are not similar, which includes applied-for the *Retail or wholesale* services and *Import and export agencies.*

36. Since I agree that the respective specifications include both identical and similar services. I proceed on that basis, bearing in mind that even a low degree of similarity may be a basis for finding a likelihood of confusion.[11]

Average consumer and purchasing process

37. Trade mark questions must be approached from the point of view of the presumed expectations of the average consumer - a legal construct who is reasonably well informed and reasonably circumspect; "average" denotes that the person is typical.[12] It is necessary to determine who is the average consumer for the respective goods and services and how the consumer is likely to select them. 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.[8]

38. As Ms Jones submitted in her skeleton argument, the average consumer of the identical or similar services in Class 35 (e.g. for advertising) will be professional/business users. These users may tend in general to pay a higher degree of attention than would a member of the general public; the degree of attention paid will be at least medium.

11 *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA, paragraph 49.
12 Per Birss J (as he then was) 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), paragraph 60.

39. Ms Jones submitted that the purchasing process is likely to involve both visual and aural considerations: "Class 35 services may be advertised online or in printed advertised/promotional material, but, when it comes to purchasing the services, aural considerations will play a significant role as there are likely to be conversations, discussions, meetings and/or presentations." I accept that aural considerations are relevant, though in my view visual considerations are likely to be more significant.

Distinctive character of the earlier trade marks

40. Registered trade marks possess varying degrees of inherent distinctive character - ranging from 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. A greater degree of distinctiveness of an earlier mark may tend to increase the likelihood of confusion. In *Lloyd Schuhfabrik* 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 …*
>
> *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)."*[13]

41. The distinctive character of a trade mark can be appraised only, first, by reference to the

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

goods and services specified in the registration and, secondly, by reference to the way it is perceived by the relevant public.[14] Earlier Marks 1, 2 and 3 are all registered for the same services in Classes 35, 36 and 43, as follows:

Class 35: *Advertising, business management, business administration; office functions; incentive award programs; promoting hotel, resort, airline, car rental, time share, travel, and vacation services through an incentive award program; organization, operation and supervision of loyalty programs.*

Class 36: *Insurance, financial affairs, monetary affairs, real estate; real estate timesharing services featuring an incentive award program; real estate listing, rental and leasing services for residential housing, apartments, rooms in homes, vacation homes, and villas featuring an incentive award program; credit card services*.

Class 43: *Services for providing food and drink; temporary accommodation; hotel services featuring an incentive award program; hotel reservations*.

42. **Inherent distinctiveness**: Classes 36 and 43 played no role in the parties' submissions on similarity of services, which were limited to earlier specified terms in Class 35. The question of the distinctiveness of the Earlier Marks in respect of those services may therefore be a moot point. In any event, BONVOY" is an invented word without an immediately graspable meaning. I accept that it therefore enjoys a high level of inherent distinctiveness for its registered services.[15]

43. **Enhancement through use**: With regard to which marks are featured across the evidence, it is fair to say that there is some evidence of use of each of earlier marks, though the preponderance of the references are to "Marriott Bonvoy" (Marks 2 and 3). There are some references to Bonvoy on its own, in word only format, and in conjunction with other marks/words, including "MARRIOTT" and "American Express".[16] In considering whether the distinctiveness of an earlier mark may have been enhanced, it is relevant to take account of the context in which it has been shown to be used, including its use alongside other trade marks. However, given the inherent distinctiveness of Earlier Mark 1 (the plain single word), I accept Ms Jones' submission that in relation to all

14 *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

15 I consider the mark highly distinctive even if some may perceive it as (obliquely) allusive in respect of the Opponent's *promoting hotel, resort, airline, car rental, time share, travel, and vacation services through an incentive award program in Class 35*

16 This is permissible use: *Colloseum Holdings AG v Levi Strauss & Co.,* C-12/12 at [31] to [35]

forms of use in the evidence, the variations/ additions do not impair the mark's ability to indicate trade origin and do not alter the distinctive character of the mark.

44. The skeleton arguments for both sides included summary perspectives on the evidence in respect of enhanced distinctive character and reputation. I note the following points.

i. The evidence in **WSBGVB** shows that Marriott is the world's largest hotel company and operates over 120 hotels throughout the UK. The Opponent's loyalty program has operated under the mark "Marriott Bonvoy" since February 2019. It has over 5 million members in the UK,[17] having brought together pre-existing separate loyalty programs that already had a large number of members in the UK at the time that the programs consolidated.[18] Customers can earn points through hotel stays, tours and activities and credit card spending. Points can be used, for example, towards hotels, travel and shopping; and towards sporting, cultural, entertainment and dining experiences offered by reference to the mark "Marriott Bonvoy MOMENTS".

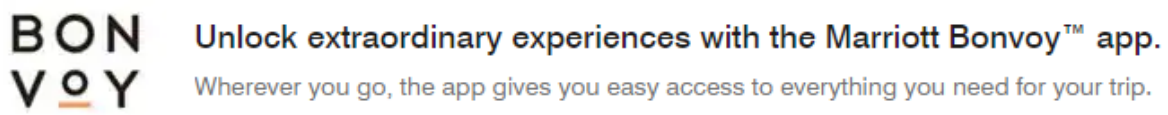
ii. "Marriott Bonvoy" serves as the umbrella sign for the Opponent's portfolio of brands on marriott.com, as a credit card co-brand with American Express and as a name of a mobile app.[19] The App is shown to have hundreds of thousands of active users in the UK in each of the years 2019-2021.[20]

iii. The Opponent annually spent hundreds of millions of dollars on advertising worldwide 2019 – 2021. The witness states that "a large amount of this advertising expenditure is attributable to the Bonvoy programme and ancillary goods and services featuring the Bonvoy marks".[21] UK figures are not given.

iv. The Marriott Bonvoy mark is shown on the racing suit of Lewis Hamilton in Montreal as he drove in 2019 for the Mercedes-AMG Petronas F1 team, which is one of the partners in the Marriott Bonvoy Moments program. UK partners include Manchester United and the O2.

17 Exhibit BGVB13
18 WSBGVB para 25
19 Exhibit BGVB3, Exhibit BGVB5, Exhibit BGVB7, Exhibit BGVB8, Exhibit BGVB9.
20 Exhibit BGVB7
21 Exhibit BGVB16

v. Examples of use are shown below:



45. Ms Jones argued that the evidence of use establishes that, as at the filing date of the Application Marks, 15 December 2021, Earlier Mark 1 (Bonvoy) as well as the MARRIOTT BONVOY Marks (Earlier Marks 2 and 3) enjoyed an enhanced distinctive character in the UK, at the very least, in relation to at least the following services:

Class 35: Advertising, business management, business administration; incentive award programs; promoting hotel, resort, airline, car rental, time share, travel, and vacation services through an incentive award program; organization, operation and supervision of loyalty programs.

Class 36: real estate listing, rental and leasing services for residential housing, apartments, rooms in homes, vacation homes, and villas featuring an incentive award program; credit card services.

Class 43: temporary accommodation; hotel services featuring an incentive award program; hotel reservations.

46. I do not agree that the distinctiveness of the word Bonvoy has been enhanced in the UK to the extent submitted above. The credit card services, under the Marriott Bonvoy marks, in association with American Express, were first offered in the UK in March 2020, just a couple of years before the relevant dates (December 2021 and May 2022) and even by October 2022, only around 15,000 cards had been issued. This is insufficient to warrant a finding that the earlier marks (still less Bonvoy solus) had enhanced their distinctiveness by virtue of use in the UK in respect of credit card services.

47. In my view, the evidence is sufficient to find that, despite their first use only in 2019, the Marriott Bonvoy marks (Marks 2 and 3) enjoy an enhanced distinctive character in respect of the following from the earlier marks' specifications:

Class 35: incentive award programs; promoting hotel, resort and travel services through an incentive award program; organization, operation and supervision of loyalty programs.

Class 43: hotel services featuring an incentive award program; hotel reservations.

Given the prominence of the inherently distinctive Bonvoy component in Earlier Marks 2 and 3, I find that Earlier Mark 1 also benefits from some enhancement in respect of the above services, even though it has been used alongside the distinctive brand "Marriott".[22]

22 Ms Jones' skeleton argument stated: "the concept of use to establish an enhanced distinctive character was assessed by the General Court in *Adidas AG v Shoe branding Europe BVBA* T-307/17. The GC determined that the use to achieve an enhanced distinctive character must be interpreted in the same way as the concept of genuine use of a mark. Therefore, provided the additional elements or stylisation do not alter the distinctive character of the mark it may still be permissible use."

Conclusion as to likelihood of confusion

48. It is perhaps worth recapping as follows:

(i) I have previously found the opposition under section 5(2)(b) based on Earlier Mark 4 to fail, because the respective marks are not similar.

(ii) Indeed, that was also my primary finding based on Earlier Marks 1, 2 and 3; but in case those Earlier Marks 1, 2 and 3 may be considered to be similar at least to some degree, I have considered the ground fully based on those Earlier Marks contesting the applied-for services in Class 35.

(iii) Some of the services in Class 35 I have found to be not similar and the section 5(2)(b) has failed for those services.

(iv) However, some of the services are identical, and others are admitted to be similar.

49. Deciding whether there is a likelihood of confusion is not based on simply applying a formula and seeing what comes out at the end; rather, it requires a global assessment of all relevant factors in accordance with case law principles, especially those outlined at my paragraph 17 above. The factors are interdependent and include the consideration that 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. It is also necessary for me to keep in mind the distinctive character of the Opponents' trade marks, the average consumer for the services and the nature of the purchasing process. I must also note 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.

50. I shall base my determination of a likelihood of confusion on the following findings:

(i) Of the Earlier Marks 1, 2 and 3, in line with the parties' arguments at the hearing, it is Mark 1 that offers the Opponent's strongest case in terms of similarity;

(ii) The Applicant's contested word-only mark is closer in similarity than its later figurative mark with device;

(iii) Earlier Mark 1 is visually similar to the contested mark to a low degree, and is aurally similar to no more than a medium degree. The conceptual position is neutral;

(iv) Aural considerations are relevant in the purchasing processing, but visual considerations are more significant overall, the marks being seen on websites and in consumer engagement materials;

(v) Some of the parties' services, such as "advertising" are identical;

(vi) Earlier Mark 1 is inherently highly distinctive by virtue of being an invented word. This inherent degree of distinctiveness applies in respect of all of the services registered under Earlier Mark 1, though the Opponent's services that are *identical* to the Applicant's services come only from Class 35; likewise it is only on the basis of the Opponent's Class 35 services that submissions were made as to *similarity* with the Applicant's Class 35 (and where Ms Cookson admitted some similarity).

(vii) The evidence of use between 2019 and the relevant date (15 December 2021), even if mostly in combination with "Marriott", cannot but have enhanced the distinctiveness Earlier Mark 1, though the effect of such enhancement is limited. The enhanced distinctiveness attributable to use is limited to the following from the earlier marks' specifications (none of which are services that may be considered identical to the Applicant's contested services in Class 35):

Class 35: incentive award programs; promoting hotel, resort and travel services through an incentive award program; organization, operation and supervision of loyalty programs.

Class 43: hotel services featuring an incentive award program; hotel reservations.

(viii) The average consumer of the identical or similar services in Class 35 (e.g. for advertising) will be professional/business users. The degree of attention paid will be at least medium.

51. It may be no surprise, given my primary finding that the marks are not similar, and my secondary estimation that the visual similarity between the marks "VOIBON" and "BONVOY" is low, that I find that there is no likelihood of confusion, even where the marks may be used for services that are identical. While BONVOY has a high degree of distinctive character, so too does the Applicant's invented word "VOIBON". Even affording the marks a medium degree of aural similarity, the overall impressions created by the marks themselves are different and sufficient to ensure that the average consumer

- reasonably circumspect and observant, and even paying a less than heightened degree of attention – will not be likely to misremember and mistake the marks for each other. There is no direct confusion.

52. The Opponent submitted that there is alternatively a likelihood of indirect confusion, arguing that "the inversion of the words and/or the replacement of a "Y" with an "I" being obvious sub-brands/brand extensions, particularly taking into account the identity in pronunciation." I disagree with that submission. Since the average consumer would apprehend these invented marks as different from one another, there is no basis on which they would conclude that the services, offered under different distinctive marks, nonetheless derive from the same undertaking or economically linked undertakings – there is thus no possibility of indirect confusion.

Outcome: The opposition under section 5(2)(b) ground fails.

THE SECTION 5(3) CLAIM

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

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

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

54. The parties do not dispute the relevant case law guidance on section 5(3), as derived from judgments of the CJEU,[23] and I here repeat the applicable principles as set out in the Opponent's skeleton argument, so far as necessary to make a determination of the claim under this ground.

55. In order to succeed with a claim under section 5(3) the Opponent must establish (i) similar or identical marks, (ii) a reputation, (iii) a link with the earlier mark in the mind of the relevant public, (iv) in consequence of the link, a finding that the use of the mark will take

23 *General* Motors C-375/97*, Intel* C-252/07, *Addidas-Salomon* C-408/01, *L'Oréal v Bellure* C-487/07 and *Marks and Spencer v Interflora* C-323/09

unfair advantage of the distinctive character or repute of the earlier mark or is detrimental to that distinctive character or repute, and (v) that the mark is applied for and to be used without due cause.

56. Section 5(3) requires firstly that a contested mark must be at least similar to an earlier mark (that claims reputation). I have previously given my primary view that the respective marks are not similar. Since a certain degree of similarity is required between the marks overall, it follows that the section 5(3) must inevitably fail.[24]

57. However, I have also considered the possibility that the marks may properly be regarded as similar in some relevant degree, and allowed that the aural similarity may be medium (at most) and the visual similarity low (at most). There is no conceptual similarity, the conceptual position being neutral. Overall, I consider the marks to be similar only to low degree and it is based on that estimation that I will deal with the section 5(3) grounds, which are directed against all of the applied for goods in Classes 3, 5, 10 and services in Class 35.

58. The second requirement is reputation – which is a knowledge threshold requirement. To establish reputation, the trade mark must be known by a significant part of the relevant section of the public as regards the goods or services for which the mark is registered. Relevant factors to take into account are market share, intensity, geographical extent and duration of use, and the size of the investment made by the Opponent in promoting the mark.[25]

59. The Opponent relies on Earlier Marks 1, 2 and 3, all having the same registered specifications. The Opponent claims reputation is for all of its earlier registered services, namely:

Class 35: *Advertising, business management, business administration; office functions; incentive award programs; promoting hotel, resort, airline, car rental, time share, travel, and vacation services through an incentive award program; organization, operation and supervision of loyalty programs.*

24 See paragraph 68 of the CJEU ruling in *Calvin Klein Trademark Trust v OHIM,* Case C-254/09P.

25 *General Motors* at [24]-[27]

Class 36: *Insurance, financial affairs, monetary affairs, real estate; real estate timesharing services featuring an incentive award program; real estate listing, rental and leasing services for residential housing, apartments, rooms in homes, vacation homes, and villas featuring an incentive award program; credit card services*.

Class 43: *Services for providing food and drink; temporary accommodation; hotel services featuring an incentive award program; hotel reservations*.

60. Reputation must be established by evidence of use of the marks in respect of the claimed services. The evidence mainly contains references to Earlier Marks 2 and 3 (Marriott Bonvoy), but the Opponent's focus at the hearing was on Earlier Mark 1 (Bonvoy), since the Marriott element lessens the degree of similarity. I have previously found that the Earlier Marks enjoy an enhanced distinctive character in respect of the following from the earlier marks' specifications:

Class 35: incentive award programs; promoting hotel, resort and travel services through an incentive award program; organization, operation and supervision of loyalty programs.

Class 43: hotel services featuring an incentive award program; hotel reservations.

61. Although the tasks of assessing evidence for enhanced distinctive character and for reputation do not entail precisely the same analysis, there is substantial overlap in the relevant considerations. In the present case, it is my view, that the reputation extends only to the same services as listed above for the Marks' enhanced distinctive character. Despite use for less than 3 years, I find that in respect of those few hotel and loyalty services in Class 35 and 43, the reputation is reasonably strong given the success of the loyalty program and the numbers of customers in the UK.

62. Establishing a link can include calling the earlier mark to mind. To establish a link is a less onerous hurdle than establishing a likelihood of confusion. Whether a link will be made is to be assessed globally taking into account all relevant factors including the degree of similarity between the respective marks and between the goods/services, the extent of overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness.[26]

26 *Intel* at [42] and [63]

63. Among the challenges for the Opponent under this ground is once again the degree of similarity between the marks (which is low at most). Additionally, there is a considerable distance between the services for which the Earlier Marks have a reputation and the goods and services of the application.

64. While similarity of goods/services is expressly not a pre-requisite for success under section 5(3), it is a relevant factor in assessing the penumbra of protection to be extended to a reputed mark; the broad lack of similarity between the Opponent's reputed services (hotel services and loyalty programs) and the Applicant's contested goods and services (set out again below) also support a rejection of the claim.

Class 3: *Cleansing milk for toilet purposes; Shampoos; Cakes of toilet soap; Hair lotions; Bath gel; Ethereal oils; Aromatics [essential oils]; Lipsticks; Beauty masks; Cosmetics; Cosmetic creams; Scented water; Oils for cosmetic purposes; Lotions for cosmetic purposes; Perfumes; Tissues impregnated with cosmetic lotions; Dentifrices*

Class 5: *Thermal water; Liniments; Serums; Pharmaceutical preparation for skin care; Dietary fibre; Acne treatment preparations; Nutritional supplements; Deodorants for clothing and textiles; Belts for sanitary napkins [towels]; Sanitary tampons; Sanitary pads; Sanitary towels; Sanitizing wipes; Sanitary pants; Medicated skin care preparations; Medicinal sprays; Nutraceuticals for use as a dietary supplement; Protective creams (Medicated -); Medicines for human purposes; Medical preparation for slimming purposes; Dietary supplements with a cosmetic effect*

Class 10: *Body fat monitors; Electric massage apparatus for personal use; Apparatus for use in medical analysis; Esthetic massage apparatus; LED masks for therapeutic purposes; Lasers incorporating optical fibres for medical use; Gloves for massage; Abdominal pads; Dental apparatus and instruments; Medical apparatus and instruments; Physiotherapy apparatus; Foam massage rollers; Sphygmotensiometers; Electric esthetic massage apparatus; Medical skin abraders; Microdermabrasion apparatus; Massage mitts*

Class 35: *Advertising and advertisement services; Sample distribution; Arranging of displays for trade purposes; Market analysis; Business advice, inquiries or information; Marketing research; Organising exhibitions for commercial or advertising purposes; Import and export agencies; Market analysis services; Sponsorship search; Retail or*

wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies; Provision of an on-line marketplace for buyers and sellers of goods and services; Advertising and marketing; Product merchandising; Providing business information via a web site; Sales promotion for others

65. I find that the significant differences between the marks themselves and the distance between the contested specifications and the reputed services will prevent the Earlier Marks – whether "Marriott Bonvoy" or "Bonvoy" - being called to mind by the relevant public encountering the Applicant's mark "Voibon" used in respect of its applied-for goods and services in Classes 3, 5, 10 and 35.

Outcome of section 5(3): Since I find that no link arises, there can be no possibility of consequent damage. The opposition based on section 5(3) fails.

THE SECTION 3(6) CLAIM

66. Section 3(6) of the Act states that a trade mark shall not be registered if or to the extent that the application is made in bad faith.

Bad faith case law principles

67. In *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121 the Court of Appeal considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07 EU:C:2009:361, *Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker* Case C-320/12, EU:C:2013:435, *Koton Mağazacilik Tekstil Sanayi ve Ticaret AŞ,* Case C-104/18 P, EU:C:2019:724, *Hasbro, Inc. v EUIPO, Kreativni Dogaaji d.o.o. intervening,* Case T-663/19, EU:2021:211, *pelicantravel.com s.r.o. v OHIM, Pelikan Vertriebsgesellschaft mbH & Co KG (intervening),* Case T-136/11, EU:T:2012:689, and *Psytech International Ltd v OHIM, Institute for Personality & Ability Testing, Inc (intervening),* Case T-507/08, EU:T:2011:46. At paragraph 68 of its judgment, the Court of Appeal's summary of the law gleaned from these CJEU authorities included the following points:

> […]
>
> 3. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives of the

law namely the establishment and functioning of the internal market, contributing to the system of undistorted competition in the Union, in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin: *Lindt* at [45]; *Koton Mağazacilik* at [45].

4. The concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct which departs from accepted standards of ethical behaviour or honest commercial and business practices: *Hasbro* at [41].

5. The date for assessment of bad faith is the time of filing the application: *Lindt* at [35].

6. It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved: *Pelikan* at [21] and [40].

7. Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application: *Hasbro* at [42].

8. Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case: *Lindt* at [37].

9. For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case: *Lindt* at [41] – [42].

10. Even where there exist objective indicia pointing towards bad faith, however, it cannot be excluded that the applicant's objective was in pursuit of a legitimate objective, such as excluding copyists: *Lindt* at [49].

11. Bad faith can be established even in cases where no third party is specifically targeted, if the applicant's intention was to obtain the mark for purposes other than those falling within the functions of a trade mark: *Koton Mağazacilik* at [46].

12. It is relevant to consider the extent of the reputation enjoyed by the sign at the time when the application was filed: the extent of that reputation may justify the applicant's interest in seeking wider legal protection for its sign: *Lindt* at [51] to [52]."

68. An allegation of bad faith is a serious allegation. It must be distinctly proved on the basis of the usual civil evidence standard (i.e. the balance of probabilities). It is not enough to establish facts which are as consistent with good faith as bad faith.[27]

69. The Opponent's statement of grounds claims that the Applicant filed its UK trade mark application in bad faith because it had no intention to use the trade mark. It supports this claim by reference to misleading or inaccurate specimens that the Applicant filed with the USPTO. The Opponent included examples, such as this:

Applicant's Class 3 Specimen as submitted to the USPTO

Amazon listing for UpNature Essential Oil

70. Ms Cookson argued that the Opponent's claim of lack of intention to use the mark is a mere assertion, and that in line with the established law, more is needed.[28] Ms Cookson argued that there has been no bad faith toward the Opponent, and the Applicant has provided some evidence of actual use - albeit in respect of the Applicant's local US market

27 *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch)
28 *Pelikan* - point 6 above

on 23 March 2023 - and this has not been contested. Ms Cookson argued that the Opponent's own evidence, from Mr Yarborough, corroborates that the website existed, even though Mr Yarborough's "associate was unable to make a purchase without a PayPal account from the USA some 5 months prior to the making of his hearsay witness statement."

71. Ms Cookson correctly submitted that the Applicant has 5 years to initiate use in the United Kingdom. Ms Cookson argued that the admission in the Applicant's counterstatement that it had difficulties with the US procedure cannot and should not give rise to a rebuttable presumption of bad faith, and that even if it did, the Applicant's defence of its UK trade mark application, supported by evidence, including of its website, indicates at the very least a plausible genuine intention to enter the UK market.

72. I agree with Ms Cookson. The Opponent has not established that the application was filed in bad faith. **The Opponent's opposition based on section 3(6) of the Act fails.**

OUTCOME: The oppositions have failed on all grounds. Subject to any successful appeal, trade marks application numbers 3733240 and 3787998 may proceed to registration in full.

COSTS

73. The oppositions have failed on all grounds and the Applicant is entitled to a contribution towards its costs in these proceedings, in line with the scale set out in Tribunal Practice Notice 2/2016. I award the sum of **£2000**, which is calculated as follows:

Considering the statement of grounds and preparing a counterstatement: **£200**
Considering the other side's evidence and preparing response: **£800**
Preparation for and attending a hearing: **£1000**

74. I order Marriott Worldwide Corporation to pay Angrow Company the sum of £2000. The above sum should be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 3rd day of October 2024

Matthew Williams
For the Registrar