O/0962/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003913741

BY GENERAL INDUSTRIAL PARTNERS LLP

TO REGISTER THE FOLLOWING SERIES OF TRADE MARKS:

IN CLASS 36

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. OP000444101

BY GLOBAL INFRASTRUCTURE MANAGEMENT, LLC

Background and pleadings

1. On 19 May 2023, General Industrial Partners LLP ("the applicant") applied to register the series of two trade marks shown on the cover page of this decision in the UK. The application was published on 11 August 2023 for the following services:

Class 36: Asset and portfolio management; Fund management; Hedge fund management; Hedge fund services; Investment asset management; Investment fund management; Investment services; Management of investment portfolio; Offshore fund management.

2. On 13 November 2023, Global Infrastructure Management, LLC ("the opponent") opposed the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent relies upon the following mark:

GIP

UKTM no. UK000908308521[1]
Filing date 19 May 2009[2]
Registration date 09 June 2010

3. The opponent relies upon the following services:

Class 36: Infrastructure fund investment services, excluding all investment performance reporting standard-setting services; management of infrastructure funds.

[1] Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Registration designating the EU. As a result, the opponent's earlier mark was converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.
[2] Priority filing date of 19 November 2008 based on US filing no. 77618013

4. The opponent claims that the marks are highly similar and that the respective services are identical or highly similar, with the result that there is a likelihood of confusion.

5. The applicant filed a counterstatement denying the opponent's claims and putting the opponent to proof of use in respect of its earlier mark.

6. The opponent is represented by Haseltine Lake Kempner LLP and the applicant represents itself.

7. Both parties filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate. No hearing was requested however the opponent filed submissions in lieu of the same. This decision is taken following careful consideration of the papers.

8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Evidence

9. The opponent filed evidence in the form of the witness statement of Gregg Myers, the Chief Financial Officer of Global Infrastructure Management, LLC, signed and dated 24 June 2024. The witness statement is accompanied by exhibits GM1 – GM13. The purpose of the evidence is to demonstrate that the earlier mark has been put to genuine use for the services on which the opponent relies.

10. The applicant filed evidence in the form of the witness statement of Cyrus de Weck, the founder of General Industrial Partners LLP, signed and dated 6 November 2024. The witness statement is accompanied by exhibits 1 and 2.

11. Whilst I do not intend to summarise the evidence here, I have taken it into consideration in reaching my decision and I will refer to it below where necessary.

DECISION

12. 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."

13. The trade mark relied upon by the opponent qualifies as an earlier trade mark pursuant to section 6 of the Act. The opponent's mark had completed its registration process more than 5 years prior to the application date of the mark at issue and, as above, the applicant has requested proof of use. As a result, the opponent's mark is subject to proof of use pursuant to section 6A of the Act.

Proof of use

14. I will begin by assessing whether and to what extent the evidence supports the opponent's statement that it has made genuine use of the mark in relation to the services relied upon.

15. The relevant statutory provisions are set out in Section 6A of the Act, which states:

> "(1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)- (5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services."

16. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

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

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

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

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

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

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

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

17. Section 100 is also relevant, which reads:

"If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

18. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five-year period ending with the filing date of the application at issue i.e., **20 May 2018 to 19 May 2023.**

Relevant case law

19. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal*

Market (Trade Marks and Designs) [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with

the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]."

20. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real" because the use would not be "viewed as warranted in the

economic sector concerned to maintain or create a share in the market for the goods and services protected by the mark" is not, therefore, genuine use.[3]

Use of the mark

21. I take the following from the opponent's evidence:

a. The opponent specialises in investing in, owning and operating some of the largest most complex assets across the energy, transport, digital infrastructure, water and waste management sectors.[4]

b. The opponent's company was founded in New York in 2006 and established its UK company in 2009 to help facilitate operations in the UK market. This is confirmed in exhibit GM1 which shows web printouts from Companies House showing that the UK company was incorporated in 2009. This exhibit also shows an extract from the UK's Financial Conduct Authority showing that the UK company has been authorised to act in the UK since 2009.

c. Exhibit GM2 shows web printouts from the opponent's Wikipedia page. Whilst the company name is shown is "Global Infrastructure Partners", the mark "GIP" is used throughout the Wikipedia article. I note that as of January 2023, its portfolio includes investments in several UK based businesses and assets. These include Biffa, Edinburgh Airport, Gatwick Airport, Great Yarmouth, Hornsea 1, London City Airport and Peel Ports.

d. Revenue figures for the UK company in relation to its services have been provided below. I note that these figures have been corroborated by Companies House records provided.[5] The figures are as follows:

Year	Approximate Revenue (US$)
2023	150,000,000

[3] *Intermar Simanto Nahmias v Nike Innovate C.V.*, BL O/222/16
[4] Paragraph 8 of the Witness Statement of Gregg Myers
[5] Exhibit GM4

2022	118,000,000
2021	186,000,000
2020	189,000,000
2019	197,000,000
2018	85,000,000

e. Exhibit GM6 displays archived printouts of the opponent’s website using the “Wayback Machine” for the years 2018-2023. The earlier mark “GIP” is displayed throughout these examples. I note that from the 2019 printouts it is apparent that some of the UK investments listed at point C above were exited by the opponent before the relevant period (Biffa, London City Airport and Great Yarmouth Port Company).

f. There are, however, several press releases dated within the relevant period that highlight the opponent’s UK-based activities and display the “GIP” mark throughout.[6] These include:

-One press release dated 27th December 2018 is regarding the opponent’s long-term partnership with Vinci Airports for London Gatwick Airport. The press release also names the opponent as the owner of Edinburgh Airport and refers to the opponent’s recent acquisition of 50% of the UK’s largest offshore windfarm, Honsea 1.
-Another article dated 1 November 2021 details the opponent’s acquisition of a 37% holding in Peel Ports Group. In the article, Peel Ports is described as a critical UK infrastructure asset and one of the largest UK port operators.
-A further article dated 22 December 2021 is about the opponent’s acquisition of 25% interest in Scotia Gas Networks, a UK infrastructure asset which operates two gas distribution networks in Scotland and the south-east of England.

[6] Exhibit GM9

g. The opponent claims that it does not operate social media accounts due to the specialised nature of its activities and services however, it has operated a LinkedIn account since 2023 and has approximately 48,000 followers.[7] It is not clear what proportion of these followers are based in the UK.

h. Exhibit GM11 shows several more UK news articles featuring the opponent's investments within the relevant period. These include:

-An article from The Telegraph dated 11 January 2021 detailing the opponent's acquisition of Gatwick Airport.
-A Daily Business article dated 21 April 2019 regarding the opponent's shares in Edinburgh Airport.
-An FN London article dated 27 December 2018 about the opponent selling part of its Gatwick Airport shares.
-A further article detailing the same story regarding the opponent selling part of its shares in Gatwick Airport from The Guardian dated 27 December 2018
-An article from a website called Hydrogen-Central dated 22 December 2021 detailing the opponent's acquisition of a 25% interest in Scotia Gas Networks.

i. The opponent has received several awards within its sector during the relevant period.[8] In 2020, the opponent was named *Project Finance International's Investor of the Year* based on its global (including the UK) investments and events that year. In 2023, the opponent was named *Global Fund Manager of the Year* for the period of 1 April 2022-31 August 2023.

j. The opponent is also a founding member of the *One Planet Private Equity Funds Initiative,* which is part of the *One Planet Sovereign Wealth Fund (OPSWF) Network.* The OPSFW Network was established following the

[7] Paragraphs 22 and 23 of the witness statement of Gregg Myers
[8] Exhibit GM12

2015 Paris agreement to collectively mitigate the effects of climate change. In 2021, the opponent met with French President Emmanual Macron, US Special President Envoy for Climate and Finance Advisor to the UK Prime Minister to review the latest trends behind the surge in climate related investments and strategies. The opponent also attended the 5th annual OPSFW Network summit in 2022. I note that the 2021 OPSFW Framework document provided at GM13 refers to "GIP" several times and highlights the opponent's presence in the UK.

22. That concludes my summary of the opponent's evidence to the extent that I consider it necessary.

Genuine Use

23. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each piece of evidence shows use by itself.[9] Genuine use depends upon a variety of factors, including the nature of the services and the characteristics of the market, the consistency of sales over time and whether the use is warranted to create or maintain a share in that market.

24. In considering the evidence as a whole, I am satisfied that it demonstrates genuine use of the opponent's mark in relation to all of its services. In making this finding, I appreciate that the opponent has not filed any evidence of invoices or marketing expenditure. However, within its submissions, the opponent explains that due to the nature of the opponent's business, it does not typically produce invoices or operate social media accounts. In this instance, I find that the use made by the opponent by way of its turnover figures, UK investments and UK press coverage during the relevant period is more than merely token and is clearly an attempt to create or maintain a market for the services relied upon.

[9] *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, General Court of the European Union, Case T-415/09

Section 5(2)(b) - Case law

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

The principles:

(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 the earlier mark to mind, is not sufficient;

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

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

Comparison of services

26. In *Canon*, the Court of Justice of the European Union ("CJEU") stated at paragraph 23 of its judgment:

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia,

their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

27. 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 users of the respective goods or services;

b) The physical nature of the goods or acts of services;

c) The respective trade channels through which the goods or services reach the market;

d) 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;

e) 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.

28. In *Gérard Meric v OHIM*, 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.”

29. The services to be compared are as follows:

Opponent’s services	Applicant’s services
Class 36: Infrastructure fund investment services, excluding all investment performance reporting standard-setting services; Management of infrastructure funds.	Class 36: Asset and portfolio management; Fund management; Hedge fund management; Hedge fund services; Investment asset management; Investment fund management; Investment services; Management of investment portfolio; Offshore fund management.

30. The applicant’s terms *Fund Management* and *Investment fund management* have not been limited in any way and could encompass the management of infrastructure funds. As such, I consider these terms to be identical to *Management of infrastructure funds* on the principle outlined in *Meric.*

31. In considering the applicant’s term *Investment services,* my reasoning above is also applicable here. *Investment services* is a broad term and could include *Infrastructure fund investment services, excluding all investment performance reporting standard-setting services.* These terms are therefore identical in line with *Meric.*

32. The application includes the term *Offshore fund management.* To my mind, this service involves managing investment funds based outside of an investor’s home country whereas the *Management of infrastructure funds* would manage funds in infrastructure industries such as waste management and transportation systems. There is therefore some overlap in nature and purpose with the opponent’s *Management of infrastructure funds* and both services involve the management of funds. There may also be an overlap in users and trade channels. There is nothing in the evidence before me to suggest that the competing services would enjoy a competitive or complementary relationship. I consider these services have a medium degree of similarity.

33. The remaining services are all, broadly speaking, services pertaining to portfolio management, hedge fund management and asset management. They have not been limited in any way and could relate to funds in the field of infrastructure. As such, I

consider there would be an overlap in terms of nature and purpose with the opponent's services. Users and trade channels would also overlap. There may be some degree of competition, however, the services are not complementary. Overall, I find these services share a high degree of similarity.

The average consumer and the purchasing act

34. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer,* Case C-342/97.

35. 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. 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."

36. The average consumer for the contested services will be either businesses or professionals, for example, in the financial sector, without excluding entirely members of the general public. The services are highly specialised, and consumers would be alive to matters such as return for investment, security, interest rates and service standards. Typically, for all the above services, prior consultation or research is conducted before purchase. This leads me to conclude that all consumer groups will pay a high degree of attention.

37. The services are likely to be selected through perusal of brochures, websites and advertisements, so the visual element will be important. However, I do not discount aural considerations, since the services may be acquired through word-of-mouth recommendations or following initial meetings with potential providers or financial advisors.

Comparison of trade marks

38. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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."

39. It would be wrong, therefore, to dissect the trade marks artificially, 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.

40. The respective trade marks are shown below:

Opponent's mark	**Applicant's marks (series of 2)**

GIP	GIP GENERAL INDUSTRIAL PARTNERS LLP GIP GENERAL INDUSTRIAL PARTNERS LLP

41. The opponent's mark is in word-only format and consists of the letter sequence "GIP" presented in an upper-case font. The overall impression lies in the word itself.

42. The contested series of marks identically feature a thin blue outline of a square with the bottom right corner overlayed by the letter sequence "GIP", presented in a large, upper-case font. Positioned below in a much smaller standard blue font is the wording "GENERAL INDUSTRIAL PARTNERS LLP". The first mark in the series is presented over a white background with the letter sequence "GIP" appearing in a black or dark blue font whereas the second mark in the series is presented over a black or dark blue background with the letter sequence "GIP" presented in white. Given that consumers tend to be drawn to elements of marks that can be read, I find that in the case of both marks, the letter sequence "GIP" plays the greater role in the overall impression. Due to the size and positioning of the "GENERAL INDUSTRIAL PARTNERS LLP" wording and for reasons I will come to discuss in the conceptual comparison, I find that this wording will play a smaller role in the overall impression of both marks. The square device element and the stylisation in both marks is fairly banal and will play an even lesser role.

Visual comparison

43. Visually, the marks overlap through the letter sequence "GIP". This is the entirety of the earlier mark and the dominant feature of both contested marks. I note

that the earlier mark is filed as a word mark which protects the words contained in the mark, whatever form, colour or typeface are used,[10] however it is not legitimate to perform a comparison between a word mark and a stylised mark by considering specific ways in which the words might be presented.[11] Whilst the respective fonts of the earlier mark and both contested marks may differ (slightly), given my earlier comments regarding the limited relative weight of the stylisation of the fonts in the overall impression of those marks, that difference is not significant. Further differences arise between the earlier mark and the contested marks by way of the figurative elements and additional wording "GENERAL INDUSTRIAL PARTNERS LLP" that are present in both contested marks but have no counterpart in the earlier mark. Considered as a whole and taking into account what I have said about the overall impressions of each mark, I find the earlier mark to be similar to both contested marks to a medium to high degree.

<u>Aural comparison</u>

44. The earlier mark is likely to be pronounced one of two ways: being letter by letter or as one word. In either case, the "GIP" element of the earlier mark and the contested marks will be pronounced identically.

45. It is my view that the additional smaller wording in the contested marks will not be articulated by a significant proportion of consumers. In making this finding, I have borne in mind the decision of Mr Philip Harris, sitting as the Appointed Person, in *Purity Hemp Company Improving Life as Nature Intended.*[12] At paragraph 31, he said that the descriptiveness of an element does not <u>in itself</u> render that element negligible or *"aurally invisible".* In the present case, the wording "GENERAL INDUSTRIAL PARTNERS LLP" is a lot smaller than the "GIP" element, and when articulated in the usual way, it would add a further twelve syllables to both contested marks. For those consumers who do not articulate this element, the marks are aurally identical. For those consumers who do articulate all the verbal elements, the beginning of the marks are aurally identical but then follows an additional twelve syllables with no replication

[10] *LA Superquimica v EUIPO*, Case T-24/17, paragraph 39
[11] See *HERNO S.p.A. v Miss Sparrow Ltd*, BL O/954/22, paragraph 23
[12] BL O/115/22

in the earlier mark. For these consumers, the marks are aurally similar to a low to medium degree.

Conceptual comparison

46. In respect of the earlier mark, I find that it will either be perceived as a word "GIP" or the letters "G-I-P". If the former, the mark will be understood as a made-up word with no obvious meaning. If the latter, the mark will be understood as an initialism/acronym with no obvious meaning.

47. While the contested marks consist of both verbal and figurative elements, the square element does not add a conceptual message, so I consider that the conceptual meaning of both contested marks solely derives from the verbal elements. The "GIP" element will likely be seen as an acronym for "General Industrial Partners". I say this because the wording "General Industrial Partners" is present below the letters "GIP", so consumers are likely to make this connection. As regards the wording "General Industrial Partners", this will be regarded as the company's name with "LLP" being seen as an acronym for "Limited Liability Partnership". This wording will therefore give rise to a point of conceptual difference, although this will not be a distinctive point of difference given the services at play.

Distinctive character of the earlier mark

48. 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)."

49. 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 and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

50. I will begin by initially assessing the inherent distinctiveness of the opponent's mark.

51. I have set out under my conceptual comparison of the marks above that "GIP" will either be viewed as the word "GIP" or the letters "G-I-P". If viewed as a word, then I consider that its inherent degree of distinctiveness will be high. This is because it will be viewed as a made-up word which is neither descriptive nor allusive of the services at issue.

52. Alternatively, if it is perceived as an initialism/acronym then it will be attributed a lower degree of distinctive character even if it is not allusive or descriptive of the services at issue. This is because the average consumer in the UK is used to seeing initialisms as the basis for trade marks. Overall, I consider that, inherently, the opponent's mark enjoys a medium degree of distinctive character.

53. I will now consider whether the evidence filed by the opponent demonstrates that the distinctiveness of the earlier mark has been enhanced through use. I rely on the summary of the opponent's evidence that I provided in points a-j in paragraph 21 earlier in this decision. I do not intend to reproduce that evidence in full but have borne it in mind in reaching my decision on enhanced distinctiveness. The relevant date for this assessment is the filing date of the applicant's mark being 19 May 2023 and the relevant market for assessing enhanced distinctiveness is the UK market.

54. Whilst I recognise that there has been some coverage in UK publications, I have no information about the advertising expenditure in the UK or any activities taken to promote the opponent's services in this jurisdiction.

55. I have no information about the opponent's market share however, I note that the Wikipedia article[13] states that as of January 2023, the opponent had aggregate assets under management of approximately US$100 billion, generating revenues of US$80 billion. Judging by the turnover figures provided, it would be reasonable to infer that the UK turnover figures, while sizeable, make up a very small percentage of the opponent's overall revenue.

56. Whilst I found the opponent's evidence sufficient to show genuine use, I remind myself that the bar for proving enhanced distinctiveness is considerably higher. This is because it requires a level of knowledge of the mark amongst average consumers leading to the mark having a greater capacity to identify the services as coming from a particular undertaking, not simply that there has been an attempt to create or maintain a market for services under the mark. In my view, the evidence filed is not sufficient to establish any enhanced distinctiveness.

Likelihood of confusion

57. There is no simple formula for determining whether there is a likelihood of confusion. I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them (*Canon* at [17]) and considering the various factors from the perspective of the average consumer. In making my

[13] Exhibit GM2

assessment, I must bear in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

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

59. Earlier in this decision I concluded that the parties' services are either identical or range in similarity to between a medium to high degree. I concluded that the average consumer would be either businesses or professionals, for example, in the financial sector, without excluding entirely members of the general public. I concluded that all consumer groups will pay a high degree of attention during the purchasing process. I found that the services would be selected primarily by visual means, although I did not discount an aural aspect to the purchasing process. I found the respective marks to be visually similar to a medium to high degree. I found the marks to be either aurally identical or similar to a low to medium degree depending on how the later mark is articulated. I found that the additional wording in the later mark will give rise to a point of conceptual difference between the marks, although this will not be a distinctive point of difference given the services at play. I found the earlier mark holds either a medium or high degree of inherent distinctiveness (depending on if it is seen as an invented word or an acronym), though the level of distinctiveness has not been enhanced through the use made of it.

60. Taking all the relevant factors into account and even bearing in mind the principle of imperfect recollection, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other for services that are at least similar to a medium degree or even identical. This is on the basis that I do not consider the average consumer, when paying a high degree of attention, would overlook the figurative elements and additional wording in the later mark notwithstanding the lesser roles they play in the marks overall impression. As such, there is no likelihood of direct confusion.

61. I now go on to consider indirect confusion.

62. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).
>
> (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.).
>
> (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example.)

63. Even if the differences between the marks are identified, the common presence of the letter sequence “GIP” is likely to lead a significant proportion of average consumers to conclude that the marks originate from the same or economically linked undertakings. In these circumstances, the stylisation/background in the applicant’s mark is likely to be viewed as simply an alternative presentation to the use of “GIP”. Even where the wording “General Industrial Partners” in the applicant’s mark is not obviously descriptive, the letter sequence “GIP” retains a dominant and independent distinctive role, and relevant consumers are still likely to perceive this as indicating common origin especially in the case of services that are at least similar to a medium degree.

Conclusion

64. The opposition under section 5(2)(b) of the Act has succeeded. Subject to any successful appeal against my decision, the application will be refused for all applied services.

COSTS

65. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings commenced on or after 1 February 2023 are governed by Annex A of Tribunal Practice Notice (‘TPN’) 1 of 2023. Using that TPN as a guide, I award the opponent the sum of £1300 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee:	£100
Preparing a statement and considering the other side’s statement:	£250
Preparing and filing evidence:	£600
Filing written submissions:	£350

Total:	**£1300**

66. I therefore order General Industrial Partners LLP to pay the sum of £1300 to Global Infrastructure Management, LLC. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 15th day of October 2025

Catrin Williams
For the Registrar